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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pastarito S.r.l.

Serial No. 75/812,311

Michael Schwarz of The Ruchelman Law Firm for Pastarito S.r.l.

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Before Simms, Seeherman and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 30, 1999, Pastarito S.r.l. (applicant) applied to register the mark PASTARITO PIZZARITO and design shown below on the Principal Register for "restaurant services" in International Class 42.¹

¹ Serial No. 75/812,311. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. The application also contains a claim of ownership under 15 U.S.C. § 1126 of an Italian trademark registration.



Applicant's mark is described as consisting of "the word PASTARITO in white on a red background and below a representation of a column topped by a representation of a bow-tie shaped piece of pasta in yellow with a red outline; and of the word PIZZARITO in white on a red background and below a representation of a column topped by a representation of a tomato in yellow with a red outline." Response dated November 7, 2000, p. 2.²

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a registration for the mark PIZZARITO, in typed form, for "pizzas and ingredients for making same" in International Class 30.³

After the examining attorney⁴ made the refusal final, this appeal followed.

² The drawing is not lined for color. Response dated November 7, 2000.

³ Registration No. 1,251,249 issued September 13, 1983, affidavits under Sections 8 and 15 accepted and acknowledged.

⁴ The current examining attorney was not the original attorney in this case.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

The examining attorney maintains that the "dominant part of applicant's mark is the distinctive term PIZZARITO" and the design elements are "relatively smaller and less prominent, and they merely repeat the allusions to pasta in PASTARITO and to tomato-based pizza sauce in PIZZARITO." Brief at 3-4. Applicant argues that the "Examining Attorney only considered the one similarity between the marks and failed to consider the numerous dissimilarities." Brief at 2. Applicant also maintains that "pizzarito" is not the dominant element of its mark and that the overall impressions of the marks are different.

Because of the unusual nature of applicant's mark, we first discuss applicant's mark by itself. While applicant's mark is for the words PASTARITO and PIZZARITO and a design element, the mark almost appears as two marks inasmuch as the word PASTARITO and its design is separated from the word PIZZARITO and its design.



As a result, the PIZZARITO portion of applicant's mark creates a strong separate commercial impression. Further, the similarities between the two portions are emphasized through the use of similar designs and word portions--both consist of Italian food items beginning with the letter P (pasta and pizza), and ending in "-arito."

Now we must determine whether applicant's and registrant's marks are similar. While we must compare them in their entireties, 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 and services marketed under the respective marks is likely to result. "[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

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Registrant's mark is identical to the word PIZZARITO in applicant's mark, and it is similar to the only other word in the mark, PASTARITO. The PASTARITO portion of the mark does not distinguish applicant's and registrant's marks. PASTARITO and PIZZARITO have a similar composition, both beginning with a "P" and ending with "ARITO," and both beginning with a 5-letter word that references a common Italian food item. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted) ("Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion"). In addition, because registrant's mark is presented in typed form, there is no viable difference in type style between registrant's and applicant's mark as applicant asserts on page 3 of its brief. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). We can assume that registrant's mark may be displayed in the same style that applicant uses.

Regarding the design elements in applicant's mark, applicant has indicated that these elements create an impression "of a place in which [a] variety of foods (suggested by the images of pasta, pizza and tomatoes) can

be consumed in an atmosphere suggestive of Italy (suggested by the Roman columns and the Italian foods imagery)."

Reply Br. at 4. Thus, the design elements are suggestive of applicant's proposed restaurant services, which would include restaurants serving pasta and pizza, and, therefore, potential customers are not likely to distinguish the marks based on the design. Applicant's argument that "the design elements are entitled to greater weight" (Reply Br. at 2) is not persuasive. Applicant's services are "restaurant services." The Federal Circuit has held in a case involving the marks DELTA and design and DELTA that the "identity of the dominant portion of Dixie's mark and the registered mark is especially important in the restaurant industry 'because restaurants are often recommended by word of mouth and referred to orally, [so] it is the word portion of applicant's mark which is more likely to be impressed on the consumer's memory.'" In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation and insertion in original), quoting, Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Therefore, the marks would appear very similar.

As to the pronunciation of the marks, they would be pronounced very similarly and in part identically. The

term PIZZARITO in applicant's mark would, of course, be pronounced the same as the same word in the registered mark. The alliteration of PASTARITO PIZZARITO underscores the similarity of the word PASTARITO with the cited mark PIZZARITO, rather than emphasizing their differences. Just as in Squirtco, applicant's mark incorporates the registered mark PIZZARITO. 216 USPQ at 939 ("Not only does appellee's mark SQUIRT SQUAD incorporate the whole of appellant's mark SQUIRT, but also, in SQUIRT SQUAD, SQUIRT retains its identity. Because of the alliteration with SQUIRT, SQUAD is an apt choice to combine with SQUIRT to suggest a line or group of toys from the same source as SQUIRT balloons. Thus, the marks do not create different commercial impressions").

We do not find that the meaning of the two marks would be significantly different. The words in applicant's mark consist of the name of a food item, "pasta" and "pizza," with "-rito" added. The term PIZZARITO in applicant's mark is identical to the cited mark, and clearly has the same meaning. The additional word in applicant's mark has a similar meaning to the registered mark since both refer to common Italian food.

Applicant argues that the "overall impressions of the marks are different" (Brief at 4). We disagree. Although

applicant's mark contains the additional element PASTARITO, for the reasons discussed above, this does not serve to distinguish the marks. Consumers are likely to assume, when viewing applicant's mark in connection with restaurant services, that the additional element PASTARITO indicates the restaurant serves pasta as well as pizza rather than viewing this element as indicating that PASTARITO PIZZARITO and design restaurant services emanate from a separate source that does PIZZARITO pizza.

We now consider whether the services of the applicant and the goods of registrant are related. We must consider the goods and services as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources."

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McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Here, applicant has applied to register its mark in connection with restaurant services, while the goods in the cited registration are identified as "pizzas and ingredients for making same." Applicant asserts that: "The Goods/Services are Totally Different: The cited mark is registered for pizza and ingredients for making pizza. The applicant is seeking registration of its mark for restaurant services. The marks will be encountered in different contexts, preventing consumer confusion." Response dated October 12, 2001, p. 4. We are aware that there is no per se rule that confusion is likely simply because "similar or even identical marks are used for food products and for restaurant services." Jacobs v. International Multifoods Corporation, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982). In this case, the record provides support for our conclusion that pizza and restaurant services are related. First, we note that applicant's identification of services is not limited so it could include pizza restaurant services. Second, one of the words in applicant's mark is "Pizzarito," which consists of the word "pizza" with "-rito" added to it.

This word certainly suggests that pizza will be an item served in applicant's restaurant when applicant begins using the mark in commerce. Third, applicant maintains that its mark creates the impression "of a place in which [there] are [a] variety of foods (suggested by the images of pasta, pizza and tomatoes)." Reply Br. at 4. Thus, applicant admits that its design suggests a connection between pizza and restaurant services. The fact that the word and design in applicant's mark suggests the applicant's restaurants will serve registrant's goods (pizza) provides another indication that applicant's restaurant services are related to pizza. See In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209, 1211 (TTAB 1999) ("The average consumer, therefore, would be likely to view Mexican food items and Mexican restaurants services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks"). See also Opus One, 60 USPQ2d at 1815 ("The fact that applicant's restaurant serves the type of goods (indeed the actual goods) identified in the cited registration is certainly probative evidence which supports a finding under the second *du Pont* factor that applicant's services and opposer's goods are related").

In addition, the examining attorney has submitted copies of third-party registrations to suggest that the same source may provide both pizza and restaurant services. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). The following use-based registrations show pizza and restaurant services in the same identification of goods and services: Nos. 2,459,339; 2,440,404; 2,318,460; 2,309,457; 2,307,621; 2,305,088; 2,214,604; 2,233,765; 2,236,421; 2,105,503; 2,094,869; 2,064,463; 2,047,184; 1,963,149; 1,927,362; and 1,875,442.

Inasmuch as the goods are pizzas and the services include restaurants serving pizzas, the classes of potential purchasers of these goods and services would be at least in part identical and include the general public. Such consumers are not likely to be highly discriminating or sophisticated purchasers.

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For the foregoing reasons, we find that the marks are similar and that consumers are likely to believe that there is an association between restaurant services and pizza, and we conclude that there is a likelihood of confusion.

Finally, to the extent that we have any doubts, we must resolve doubt on the issue of likelihood of confusion against the applicant and in favor of the registrant. In re Hyper Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.