

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Cortopassi Partners
Mark: TRATTORIA
Docket No.: 5511-2
Serial No.: 88/342,342
Filed: March 15, 2019
Examining Attorney: Max Faucette
Law Office: 107

Response to Office Action

I. INTRODUCTION

Applicant Cortopassi Partners (“Applicant”) is responding to the Office Action dated June 10, 2019 concerning its application to register the word mark TRATTORIA, shown at App. Serial No. 88/342,342 for “Sauces; tomato-based sauces; ready-made sauces; tomato sauce; canned tomato sauce; spaghetti and pasta sauce; marinara sauce” in Class 30 (“Applicant’s Mark”).

The Examining Attorney has initially refused registration on the Principal Register pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a finding of likelihood of confusion with the marks TRATTORIA PARISI, Reg. No. 5,254,976 for use with “Pasta sauce; Sauces” in Class 30, TRATTORIA ALFREDO, Reg. No. 5,283,157 for use with “Soups, soup concentrates; prepared meals, included in this class, mainly consisting of meat, fish, poultry, game, sausages, processed fruit, processed vegetables, processed mushrooms, processed potatoes, cheese, or cream served with added rice or pasta; including the aforesaid goods being chilled or frozen” in Class 29 and “Bread; pastry; confectionery, namely, frozen confectionery, confectionery made of sugar, confectionery chips for baking; gateaux; edible ices; pasta; pizzas; baguettes; prepared meals consisting primarily of pasta; sauces being condiments; prepared meals, included in this class, consisting primarily of rice or pasta served with added meat, fish, poultry, game, sausage, prepared fruit, prepared vegetables, processed mushrooms, processed potatoes, cheese, or cream; including the aforesaid goods being chilled or frozen” in Class 30, TRATTORIA ALFREDO, Reg. No. 4,400,195 for use with “Soups, soup concentrates; refrigerated, deep frozen, and prepared meals consisting primarily of meat, fish, poultry, game, sausages, fruits, vegetables, mushrooms, potatoes, cheese or cream with added rice and/or pasta” in Class 29 and “Bread, pastry, confectionery, namely, biscuits, cookies, chocolate, chocolate candy, peanut butter confectionery chips, confectionery chips for baking, chocolate mousse, chocolate truffles, pralines, chocolate covered nuts and almonds, marzipan, liquorices, candies, chewing gum, sweetmeats, lollipops, candy covered popcorn, candy mints, caramel, toffee, edible ices, pasta, pizza, baguettes, prepared meals consisting primarily of noodles; sauces, namely, soy sauce, spaghetti sauce, fruit sauces excluding cranberry sauce and applesauce, tartar sauce, tomato sauce, artichoke sauce, barbecue sauce, cheese sauce, ketchup, mustard, mayonnaise, ready made sauces, teriyaki sauce, chocolate sauce; prepared, refrigerated or deep-frozen meals consisting primarily of rice or pasta and also containing meat, fish, poultry, game, sausages, fruits, vegetables, mushrooms, potatoes, cheese or cream” in Class 30, and

Fratelli

Trattoria, Reg. No. 4,435,625 for use with “Pasta sauce; Pizza sauce; Sauces; Spaghetti sauce; Tomato sauce” in Class 30 (collectively, the “Cited Marks”). In addition, the Examining

Attorney has refused registration of Applicant's Mark on the Principal Register on the grounds that the Mark is merely descriptive.

As detailed below, Applicant respectfully disagrees with the Examining Attorney's conclusion that there is a likelihood of consumer confusion as to the source of the goods offered under the Cited Marks and those provided under Applicant's Mark. As set forth more fully below, the Cited Marks are not likely to be confused with Applicant's Mark when each of the relevant factors is considered. Moreover, Applicant respectfully asserts that its Mark is not merely descriptive.

II. THERE IS NO LIKELIHOOD OF CONFUSION WITH RESPECT TO APPLICANT'S MARK AND THE CITED MARKS.

Registration should only be denied when the applicant's mark "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. §1052. A determination of likelihood of confusion between marks is determined on a case-by-case basis. *In re Dixie Restaurants Inc.*, 41 USPQ 2d 1531, 1533 (Fed. Cir. 1997). The test for likelihood of confusion is whether a "reasonably prudent consumer" in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 476 F.2d 1357 (C.C.P.A 1973). In determining whether a likelihood of confusion exists, some of the factors essential to the analysis include the similarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression, the likely consumers, and the number and nature of similar marks in use on similar goods or services. *Id.* at 1361; TMEP § 1207.01. An application of the relevant *DuPont* factors to the instant case results in no likelihood of confusion between Applicant's Mark and the Cited Marks.

A. Applicant's TRATTORIA Mark and the Cited Marks Are Already Coexisting in the Marketplace and on the Register.

Applicant's existing registration for the mark TRATTORIA, U.S. Reg. No. 1,541,749, has co-existed with the registrations for each of the Cited Marks for at least two years without any conflict or known instances of consumer confusion.

Applicant is the owner of U.S. Reg. No. 1,541,749 for the mark TRATTORIA for use in connection with, "Canned foods, namely, canned tomatoes" in Class 29 and "Food sauces, namely, pizza sauce" in Class 30. Applicant's TRATTORIA registration was granted on May 30, 1989. Each of the Cited Marks were registered with the USPTO after the registration date of Applicant's existing TRATTORIA registration. All of the Cited Marks are therefore already co-existing with Applicant's existing TRATTORIA registration.

The existence of a registration for the same or a similar mark owned by an applicant that has coexisted for an extended period of time with a third-party registration can be evidence of a lack of likelihood of confusion between the marks. *See In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (ITAB 2012) (reversing a likelihood of confusion refusal between the marks ANYWEAR and ANYWEAR

BY JOSIE NATORI, both for use with clothing products, chiefly because the applicant also owned a registration for the same mark that was already co-existing with the cited registration). Applicant already owns a registration for the mark TRATTORIA for use in connection with goods very similar in nature to the goods covered by its instant application, and this registration has been coexisting with each of the Cited Marks for several years. This fact is clear evidence that weighs against any potential likelihood of confusion between the marks at issue.

B. The USPTO Did Not Previously Find a Likelihood of Confusion Between Applicant's TRATTORIA Mark and the Cited Marks.

As discussed above, Applicant is the owner of an existing registration for the same mark, TRATTORIA, in Classes 29 and 30. Applicant was granted a registration for this mark from the USPTO on May 30, 1989. All of the applications for the Cited Marks were filed after the registration date of Applicant's existing registration. Despite the continued existence of Applicant's registration for the mark TRATTORIA, the USPTO did not cite Applicant's TRATTORIA registration as a basis for refusing any of the Cited Marks. *See* Exhibit A. Thus, four different Examining Attorneys at the USPTO reviewed each of the Cited Marks and determined that there was no likelihood of confusion between those marks and Applicant's TRATTORIA mark.

Applicant respectfully requests that the Examining Attorney follow the past findings of the USPTO which determined there was no likelihood of consumer confusion between Applicant's TRATTORIA mark and the Cited Marks.

C. The Word "TRATTORIA" Has Been Disclaimed By the Owners of Two of the Cited Marks.

The owners of two of the Cited Marks, namely TRATTORIA PARISI and

The logo for Fratelli Trattoria features the word "Fratelli" in a large, elegant, cursive script font. Below it, the word "Trattoria" is written in a smaller, clean, sans-serif font.

have disclaimed the exclusive right to use the word "TRATTORIA" apart from the mark as shown in each of its registrations. *See* Exhibit B. A disclaimer to a statement that "no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark." *Sprague Electric Co. v. Erie Resistor Corp.*, 101 USPQ 486, 486-87 (Comm'r Pats. 1954). It is true that disclaimed matter is to be considered as part of the whole mark for likelihood of confusion purposes. *See* *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046 (Fed. Cir. 2012). However, disclaimed matter typically "will not be regarded as the dominant, or most significant, feature of a mark." TMEP 1213.10.

Applicant respectfully asserts that because the owners of two of the Cited Marks have disclaimed exclusive rights to the word "TRATTORIA", those respective Cited Marks cannot in turn serve as a basis for refusal of Applicant's registration.

D. Applicant's Mark and the Cited Marks are Visually Distinguishable.

Applicant's Mark is also visually distinguishable from each of the Cited Marks. For purposes of determining whether a likelihood of confusion exists between two marks, the overall visual impression of the marks derived from viewing the marks in their entirety is controlling. See *In re Homeland Vinyl Products, Inc.*, 81 USPQ 2d 1378, (TTAB 2006); *Messey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399 (C.C.P.A. 1974) ("It is axiomatic that a mark should not be dissected and considered piece meal; rather, it must be considered as a whole in determining likelihood of confusion."). The key analysis is whether the total effect conveyed by the two marks is confusingly similar, not simply whether certain elements of the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ 2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole). Even the use of identical dominant elements does not automatically mean that two marks are similar. For example, applying this same reasoning, the 10th Circuit in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ 2d 1865, 1874 (10th Cir. 1996), found the marks "FirstBank" and "First Bank Kansas" not to be confusingly similar. Additionally, in *Luigino's Inc. v. Stouffer Corp.*, 170 F.3d 827, 833 (8th Cir. 1999), the mark "Lean Cuisine" was found not to be confusingly similar to "Michelina's Lean 'N Tasty" even though both marks included the term "lean" and were in the same class of goods, namely, low-fat frozen food.

A comparison of the marks at issue makes clear that Applicant's Mark differs significantly in visual appearance from the Cited Marks. The first Cited Mark, TRATTORIA PARISI, contains the word "PARISI" which is not found in Applicant's Mark. The second and third Cited Marks, both of which consist of the wording TRATTORIA ALFREDO and are owned by the same entity, contain the word "ALFREDO" which is not found in Applicant's Mark. The fourth and final mark,

The image shows the logo for Fratelli Trattoria. The word "Fratelli" is written in a large, elegant, cursive script. Below it, the word "Trattoria" is written in a smaller, simpler, sans-serif font.

, contains the wording "FRATELLI" and a design element not found in Applicant's Mark. Thus, each of the Cited Marks contains additional wording not found in Applicant's Mark, which renders all of the Cited Marks visually dissimilar to that of Applicant's Mark.

III. APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE OF ITS GOODS.

Applicant's Mark does not merely describe a feature or characteristic of Applicant's goods. On the contrary, Applicant's Mark is a suggestive mark that requires consumers to pause and make a leap of imagination before reaching a determination as to the nature of Applicant's goods. Courts have commonly held that this stop-and-pause moment is the key component of a suggestive mark. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 1976 537 F.2d 4 (2nd Cir. 1974) ("a term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods."). As detailed more fully below, Applicant's Mark requires such thought and perception in order for a consumer to understand the nature of the goods provided under the mark.

1. A Mark Should be Refused Registration on the Principal Register Based on 15 U.S.C. §1052(e)(1) Only When the Examining Attorney Establishes That the Mark is Merely Descriptive.

A trademark cannot be registered on the Principal Register if it consists of a mark that is “merely descriptive” of the applicant’s goods or services. 15 U.S.C. § 1053(e)(1) (emphasis added). It is well recognized that a mark is merely descriptive only if it directly conveys information concerning the function, characteristics, purpose or use of the goods or services. *Towers v. Advent Software, Inc.* 913 F. 2d 942, 16 U.S.P.Q.2d 1039, 1040 (Fed. Cir. 1990). The Trademark Trial and Appeal Board (“TTAB”) has stated the test for mere descriptiveness as follows:

It is well established that a term is considered to be merely descriptive of goods or services, within the measure of Section 2 (e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services.

In re Pennzoil Products. Co., 20 U.S.P.Q.2d 1753, 1755 (T.T.A.B. 1991).

Thus, the focus of the merely descriptive test is not whether the mark can, in some manner, be considered descriptive, but rather whether the mark immediately and directly conveys the function or characteristics of the goods provided under the mark. By using such terms as “immediately” and “directly” the Trademark Trial and Appeal Board has set a high threshold under which a mark can be categorized as merely descriptive. The Examining Attorney has not provided sufficient evidence to show that Applicant’s mark crosses this threshold. Because Applicant’s Mark on its face does not immediately convey to potential consumers the essence of Applicant’s products, it cannot be merely descriptive.

2. Applicant Uses its Mark in a Suggestive Manner in Relation to Its Goods.

A mark is suggestive if, when applied to the goods or services at issue, some “imagination, thought, or perception” is required in order “to reach a conclusion as to the nature of those goods or services.” Trademark Manual of Examining Procedure (“TMEP”) § 1209.01(a). There is a fine line that differentiates a mark that “immediately describes” from a mark that requires a “modicum” of imagination and thought. *See Plyboo America, Inc. v. Smith & Fong Co.*, 51 U.S.P.Q.2d 1633, 1640 (T.T.A.B. 1999). Moreover, a term may possess elements of suggestiveness and descriptiveness at the same time. *In re Nett Designs, Inc.*, 57 U.S.P.Q. 2d 1564, 1566 (Fed. Cir. 2001).

Applicant’s Mark consists of an Italian word, “Trattoria,” that means a “small Italian restaurant” or “an Italian-style eating establishment . . . with an emphasis on a steady clientele rather than on haute cuisine.” *See Exhibit C.* Accordingly, a consumer will necessarily need to stop, think and translate Applicant’s Mark in order to ascertain how its meaning relates to the goods in the description. Applicant’s Mark at most evokes a feeling of an informal Italian restaurant and does not merely describe the goods in the application. The wording is thus suggestive of the high-quality

nature of Applicant's products which have been produced with great care. The requirement for consumers to exercise such imaginative thinking to understand the nature of Applicant's goods means the mark is not merely descriptive.

3. If the Examining Attorney Has Any Doubts as to Whether Applicant's Mark Can be Registered on the Principal Register, Such Doubts Are to be Resolved in Applicant's Favor.

If there is any doubt as to whether Applicant's Mark should be registered, such doubts should be resolved in Applicant's favor and the mark should be published for opposition. *See In re Fat Boys Water Sports*, 118 USPQ2d 1511, 1513 (TTAB 2016).

Applicant therefore submits that should the Examining Attorney have any doubts as to whether Applicant's Mark is merely descriptive, the Examining Attorney should resolve such doubts in Applicant's favor and allow the mark to proceed with registration.

IV. CONCLUSION

For all the foregoing reasons, Applicant requests that its application to register TRATTORIA be approved for publication on the Principal Register.