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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 14
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nice N Easy Grocery Shoppes, Inc.

Serial No. 75/492,944

Laurence P. Trapani of Trapani & Molldrem for Nice N Easy Grocery Shoppes, Inc.

Craig D. Taylor, Managing Attorney, Law Office 111.

Before **Cissel**, Seeherman and Hanak, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 29, 1998, applicant filed the above-identified application to register the mark "MAMA MIA'S CLASSIC PIZZA" on the Principal Register for "restaurant services," in Class 42. The application was based on applicant's claim of use of the mark since February 9, 1998, and use of it in interstate commerce since April 1, 1998.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's mark, when used in connection with restaurant

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services, so resembles four registered trademarks that confusion is likely. Each registration is owned by a different entity. The four cited registered marks are shown below.

for "restaurant services"¹; "MAMA MIA," for "Italian bread"²;

for "cheese, namely ricotta, mozzarella and grated Parmesan

¹ Registration No. 1,321,346, issued on the Principal Register to Mama Mia! Pasta, an Illinois corporation, on February 19, 1985. Combined affidavit under Sections 8 and 15 of the Lanham Act accepted and acknowledged.

² Registration No. 1,376,575, issued on the Principal Register to My Bread and Baking Co. on December 24, 1985. Combined affidavit under Sections 8 and 15 of the Lanham Act accepted and acknowledged.

cheeses"³; and

for "pizza."⁴

In addition to the refusal to register under Section 2(d) of the Lanham Act, the Examining Attorney required a disclaimer of the term "CLASSIC PIZZA" apart from the mark as shown.

Responsive to the first Office Action, applicant amended the recitation of services to state them as "restaurant carry-out services" and proffered the requested disclaimer. Applicant also argued that there is no likelihood of confusion with any of the registered marks cited as bars to registration under Section 2(d) of the Act. Citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), applicant argued that a key factor in determining whether there is a likelihood of confusion between marks is the number and nature of similar

³ Registration No. 1,393,405, issued on the Principal Register to Eastern States Marketing Inc. on May 13, 1986. Combined affidavit under Sections 8 and 15 of the Lanham Act accepted and acknowledged.

⁴ Registration No. 1,625, 073, issued on the Principal Register to Pasquale Food Company, Inc. on November 27, 1990. Affidavit under Section 8 of the Lanham Act accepted.

marks in use on similar goods, and that in the case at hand, widespread use of "MAMA MIA" or its equivalent by third-party food and restaurant businesses, combined with differences between applicant's mark and the cited registered marks and the goods and services with which they are used, combine to create situations wherein confusion is not likely.

Submitted in support of applicant's arguments was a copy of a common law/business name search report. The report lists over 300 company names, 220 of which contain either "MAMA MIA" or "MAMMA MIA" for various restaurants, grocers and other businesses providing food products. Also submitted were the results of a search of a computerized advertising directory database. That search revealed more than 90 business names containing the wording "MAMA MIA," most of which were used in connection with restaurants, pizza and pizzerias. Applicant pointed out that this search showed that in the Chicago area, eight business names incorporate "MAMA MIA," only one of which appears to belong to the owner of the cited registered mark "MAMA MIA! PASTA" and design, (Registration No. 1,321,346).

Applicant contended that this evidence of widespread third-party use of "MAMA MIA" by food-related businesses is competent evidence to suggest that purchasers of these

goods and services have been conditioned to look to the other elements of such marks as a means of distinguishing the source of the goods or services with which they are used. Applicant cited *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996), wherein the refusal to register "BROADWAY CHICKEN" based on two registrations, one for "BROADWAY PIZZA" and the other for "BROADWAY BAR & PIZZA," was reversed by the Board in view of evidence of widespread third-party use of the term "BROADWAY" in connection with food establishments. Applicant argued that in the case at hand, substantial third-party use of "MAMA MIA" in the food field and differences between applicant's mark and the cited registered marks, as well as differences between the goods and services with which these marks are used, mandate a finding that confusion is not likely.

The Examining Attorney was not persuaded by applicant's arguments, and the refusal to register under Section 2(d) of the Lanham Act was made final in the second Office Action.

Applicant timely filed a Notice of Appeal and a Request For Reconsideration, attached to which were copies of the cited registrations. In them, "MAMA MIA" or its equivalent is translated as "My Mother," "My Momma," "Dear Me" or "My Goodness." Applicant argued that these

connotations are laudatory in nature, suggesting that the goods are as good those which a mother would make, or are so good that they warrant an exclamation. Applicant again drew distinctions between its mark and each of the cited registered marks, as well as distinctions between the goods and services with which these marks are used.

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of the Request for Reconsideration. He was not persuaded to withdraw the refusal, so action on the appeal was resumed. Applicant then submitted its brief on appeal, the Examining Attorney submitted his appeal brief, and applicant filed a brief in reply. Applicant did not request an oral hearing before the Board.

Based on careful consideration of the record before us in this appeal as well as the arguments of applicant and the Examining Attorney, we reverse the refusals to register. In view of the evidence of substantial use by third parties of "MAMA MIA," differences between applicant's mark and the cited registered marks and distinctions among the goods and services which are specified in the application and the registrations, respectively, we find that confusion is not likely.

The simple fact that all four of the cited registered marks, each of which consists of or incorporates "MAMA MIA" or its equivalent, have been registered to four different entities is an indication that this term is weak in source-identifying significance in the field of food products and services. Just as distinctions between these four marks and the goods or services with which they are used permitted issuance of these registrations without running afoul of Section 2(d) of the Act, similar distinctions allow registration of applicant's mark.

The mark in Registration No. 1,625,073, as noted above, combines "Mama-Mia's Kitchen" with an illustration of a woman. The goods listed in the registration are "pizza." This mark, considered in its entirety, is different in appearance, pronunciation and connotation from the mark applicant seeks to register, "MAMA MIA'S CLASSIC PIZZA." The commercial impressions generated by these marks are different. Given the weakness of "MAMA MIA" in connection with food products and services that the record establishes, the design components and the word "Kitchen" in this registered mark distinguish it from applicant's mark, which has no design and incorporates the term "CLASSIC PIZZA," but not "Kitchen."

The mark in cited Registration No. 1,393,405 combines "MAMA MIA" with a design showing a woman with a spoon in her hand, feeding her child from a bowl, framed by a vine or leaf design. The goods are listed in the registration as ricotta, mozzarella and Parmesan cheeses. Again, in view of the demonstrated weakness of the common element in both applicant's mark and this registered mark, "MAMA MIA," the differences in commercial impression between the marks in their entireties and between the goods set forth in the registration and the services identified in the application are sufficient to make confusion unlikely.

"MAMA MIA" by itself is the mark in Registration No. 1,376,575, and the goods are identified therein as "Italian bread." In view of the above-referenced weakness of "MAMA MIA" in connection with food and food services, the combination of the differences in the marks and the goods/services in the cited registration and applicant's application are sufficient to preclude confusion.

The mark in Registration No. 1,321,346 combines "Mama Mia!" on one line, "Pasta" on the line below, and a rectangular design featuring diagonal parallel lines within a rectangular frame. The services are listed in the registration as "restaurant services." Although applicant's services, as identified in the amended

application, are encompassed within the recitation of services in this registration, this registered mark presents "Mama Mia!" in the context of an exclamatory expression, rather than in the possessive form, "MAMA MIA'S" (MY MOTHER'S) in which it appears as part of applicant's mark. In view of the substantial third-party use of "MAMA MIA," the differences in the marks, particularly in terms of connotation, are sufficient to make confusion unlikely.

In summary, in view of the evidence of substantial third-party use of names and marks in the food field consisting of or incorporating "MAMA MIA," the differences between applicant's mark and the registered marks and differences in the goods and services set forth in the application and the registrations lead us to the conclusion that confusion is not likely.

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