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Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

WINTER

August 2, 2018

Opposition No. 91233641

Eataly S.r.l. and Eataly Distribuzione Srl

v.

Eatelli Inc.

**Before Wolfson, Adlin, and Larkin,
Administrative Trademark Judges.**

By the Board:

Background

Eatelli Inc. (“Applicant”) seeks registration of the mark EATELLI in standard characters for “computerized on-line ordering services in the field of restaurants and bars; on-line ordering services in the field of restaurant take-out and delivery” in International Class 35, and “agency services for reservation of restaurants; reservation of restaurants; restaurant reservation services; making reservations and bookings for restaurants and meals,” in International Class 43.¹ Eataly S.r.l. and Eataly Distribuzione Srl (“Opposers”) oppose registration of the applied-for mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15

¹ Application Serial No. 87097070, filed July 8, 2016, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

U.S.C. § 1052(d), and dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). In support of their claims, Opposers allege that they are joint owners of the mark EATALY; that EATALY establishments comprise an Italian-style marketplace that includes a variety of restaurants, food and beverage counters, a bakery, retail items, a cooking school, and various classes and events; that Opposers, their predecessors and/or their exclusive licensees have continually operated EATALY marketplaces in the United States since August 2010; that EATALY marketplaces are located in New York City, Chicago and Boston; that the EATALY website may be accessed at www.eataly.com; that Opposers' rights in the United States in the trademark EATALY relate back to February 11, 2003, from a priority claim made in Opposers' application to register the mark EATALY (typed drawing)² based on a foreign registration filed by Opposers' predecessor, which matured into Opposers' pleaded U.S. Registration 3065012;³ that Opposers also own U.S. Reg. No. 3567939 for the mark EATALY (in standard characters) for a variety of educational, exhibition, publication and cookery, gastronomy, oenology and food science

² Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings.

³ U.S. Reg. No. 3065012 issued March 7, 2006, under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), based on application no. RM2003C00072 filed in Italy on February 11, 2003; renewed March 7, 2016, for: "supermarkets and retail department store services; retail and wholesale stores in the field of foods and general consumer merchandise; food kiosk stall services" (International Class 35); "travel agencies, namely, making reservations and bookings for transportation by air, sea, rail and automobile, and for travel tours; arranging travel tours; transport by air, sea, rail, automobile and truck; business warehouse management" (International Class 39); and "table cloth restaurants; fast food restaurants; bar services; bar lounge services; wine bar services; cafes; cafeterias; bar services; food court restaurant services; travel agencies, namely, making reservations and bookings for temporary accommodations" (International Class 43).

competition services;⁴ that Applicant's EATELLI mark so resembles Opposers' EATALY mark that if used on or in conjunction with Applicant's related services, it is likely to cause confusion among relevant purchasers; that Applicant's proposed use of EATELLI in connection with its identified services is likely to dilute the distinctive quality of Opposers' famous EATALY mark through blurring and/or tarnishment; and that Opposers' mark became famous prior to the filing date of the involved application. In its answer, Applicant denies the salient allegations in the notice of opposition.

Opposer's Motion for Summary Judgment

This case now comes up for consideration of Opposer's fully briefed motion (filed November 3, 2017) for partial summary judgment on its claim of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). We have considered the parties' briefs and evidence submitted in connection with the contested motion, but do not repeat or discuss all of their arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, we presume

⁴ U.S. Reg. No. 3567939 issued January 27, 2009, based on Int'l Reg. No. 0957648, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), for the following services: "arranging and conducting of educational conferences, congresses, seminars, symposiums and workshop in the fields of cookery, gastronomy, oenology and food science; organization of exhibitions and shows for cultural and educational purposes in the fields of cookery, gastronomy, oenology and food science; publication of books and magazines in the fields of cookery, gastronomy, oenology and food science; organization of competitions in the fields of cookery, gastronomy, oenology and food science"; a Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 has been accepted; and Int'l Reg. No. 0957648 was renewed on January 16, 2018.

the parties' familiarity with the pleadings and the parties' arguments and evidence filed in support of the subject motion.

- **Legal Standard**

Summary judgment is appropriate where the movant shows the absence of any genuine dispute as to any material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *see also Celotex Corp. v. Catrett*, 477 U.S. 317, 323-324 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987); *Freki Corp. N.V. v. Pinnacle Entm't, Inc.*, 126 USPQ2d 1697, 1700 (TTAB 2018). "A party asserting that a fact cannot be or is genuinely disputed must support the assertion by (A) citing to particular parts of materials in the record ...; or (B) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact." Fed. R. Civ. P. 56(c)(1). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-movant. *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board may not resolve any factual dispute; it may only determine whether a genuine dispute of material fact exists. *See, e.g., Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055, 1056 (Fed. Cir. 1990) ("If there is a real dispute about a material fact or factual inference, summary judgment is inappropriate; the factual dispute should be reserved for trial"). Specifically, when

deciding a motion for summary judgment, the Board may not weigh the evidence in an area of disputed fact or make credibility determinations. *See, e.g., Lemelson v. TRW, Inc.*, 760 F.2d 1254, 225 USPQ 697, 701 (Fed. Cir. 1983) (court cannot engage in fact-finding on a motion for summary judgment); *Metro. Life Ins. Co. v. Bancorp Servs. LLC*, 527 F.3d 1330, 87 USPQ2d 1140, 1146 (Fed. Cir. 2008) (when resolving conflicting accounts requires ruling on the weight and credibility of the evidence, summary judgment not available). Further, the non-movant must be given the benefit of all reasonable doubt as to whether a genuine dispute as to material facts exists, and the evidentiary record on summary judgment and all inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the non-movant. *See Opryland*, 23 USPQ2d at 1472.

Additionally, when the movant has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact and that the moving party is entitled to judgment as a matter of law, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009); *see also Opryland*, 23 USPQ2d at 1472-73 (non-movant not required to present its entire case but just sufficient evidence to show an evidentiary conflict as to the material fact in dispute).

To prevail on summary judgment on their claim of likelihood of confusion, Opposers must establish that there is no genuine dispute that they have standing to maintain this proceeding; that they have priority of use or that priority is not at issue;

and that contemporaneous use of the parties' marks in connection with their respective services would be likely to cause confusion, mistake or to deceive consumers. See 15 U.S.C. § 1052(d); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

- **Standing and Priority**

Standing is a threshold issue that must be proven by a plaintiff in every inter partes case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); see also *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 (TTAB 2007) (at summary judgment, opposer must not only establish a valid ground, but also must prove its standing). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Here, Opposers have pleaded ownership of two registrations for the mark EATALY. However, Opposers submitted⁵ only photocopies of their original registration certificates, supported by the declarations of Adam Saper (CFO of Opposers' exclusive licensee, Eataly USA LLC), who oversees and manages the

⁵ Opposers also submitted copies of the involved application, as well as the notice of opposition filed in this proceeding. Submission of these documents was unnecessary insofar as these documents are automatically of record. See *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 92 USPQ2d 1626, 1628-29 (Fed. Cir. 2009); Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).

EATALY operations in the United States, and of their attorney, Mary L. Grieco. Mr. Saper testified that Opposers own U.S. Reg. No. 3567939 and also refers to “the Certificates of Registration owned by Opposers.” (Saper dec., ¶¶ 8-9 & Exh. B; 6 TTABVUE 31, 207-208). Ms. Grieco states that U.S. Reg. No. 3065012 is incontestable pursuant to 15 U.S.C. §§ 1064 and 1115(b). (Grieco dec. ¶ 2, 6 TTABVUE 5). While Opposers’ declarations establish Opposers’ *ownership* of the pleaded registrations, the declarations supported by the photocopies are not sufficient to show that there is no genuine dispute as to the *status* of the registrations. *See* Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1); *see also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (photocopy of registration without status and title information insufficient); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1042 (TTAB 2014) (citing *Teledyne Techs., Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203, 1206 (TTAB 2006)). Nonetheless, a registration owned by a party to a proceeding may be deemed of record even though it was not properly introduced in accordance with the applicable rules, if the adverse party in its brief treats the registration as being of record. *See Crown Radio Corp. v. Soundscriber Corp.*, 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1885 (TTAB 1993) (“There is not of record a status and title copy of the registration nor did the parties make any mention of the current status of the registration. Nonetheless, applicant ... treats the registration as if properly of record. In view thereof, we have treated opposer’s registration to be of record”); *Local Trademarks Inc. v. Handy Boys Inc.*, 16 USPQ2d

1156, 1157 (TTAB 1990) (applicant conceded ownership and validity in trial brief); *Floralife, Inc. v. Floraline Int'l Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (applicant's treatment of pleaded registrations as properly of record in its trial brief was deemed a stipulation as to current status and title); *see also* Trademark Trial and Appeal Manual of Procedure ("TBMP") § 704.03(b)(1) (June 2018).

Applicant refers to "Opposers' registrations" in its responsive brief, and analyzes them in support of its arguments against a likelihood of confusion (10 TTABVUE 7-8). Based on Applicant's treatment of the pleaded registrations in opposition to the summary judgment motion, Opposers' pleaded registrations are of record and there is no genuine dispute as to the status and title of Opposers' pleaded registrations. In any event, Applicant does not dispute either Opposers' standing or priority. Therefore, there is no genuine dispute as to Opposers' standing, and priority is not at issue with respect to the services identified in Opposers' pleaded registrations. *See King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).⁶

⁶ Moreover, Opposers established that there are no genuine disputes as to their standing and priority by relying on common law rights accrued in the EATALY marks through their exclusive licensee. *See, e.g., Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (common-law use sufficient to establish standing); *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1118 n.8 (TTAB 2009) (evidence of a licensee's use of a mark sufficient to establish standing); *Gen. Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008) (standing established by testimony and exhibits showing prior use of the mark for vehicles and current licensing of the mark). Specifically, Mr. Saper states in his declaration that Opposers, their predecessors and/or their exclusive licensees have been using the EATALY trademark in the United States continuously since August 2010 (Saper dec. ¶¶ 3-4, 6 TTABVUE 29-30). Applicant did not introduce any evidence of use of EATELLI in connection with the identified services, and the record shows that Applicant is not using the applied-for mark in commerce (Belke dec. ¶ 8, 10 TTABVUE 40) (discussing mere "intent" to use mark rather than actual use). However, Applicant may rely on the filing date of its trademark application to establish priority, i.e.,

- **Likelihood of Confusion**

We turn next to likelihood of confusion. “We determine likelihood of confusion by focusing on ... whether the purchasing public would mistakenly assume that the applicant’s [goods or services] originate from the same source as, or are associated with [opposer’s goods or services].” *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *see also In re Viterra Inc.*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In considering this question with respect to Opposers’ motion for summary judgment, we analyze the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), as well as whether there are genuine disputes as to any of these factors which would be material to a decision on the merits. *See Olde Tyme Foods, Inc. v. Roundy’s, Inc.*, 22 USPQ2d at 1544 (only those *du Pont* factors shown to be material or relevant in the particular case and about which there is evidence are to be considered). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences

July 8, 2016. *See Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1604 (TTAB 2018); *Embarcadero Tech. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1834 (TTAB 2013). Therefore, even if we were to rely solely on Opposers’ accrued common law rights in the EATALY mark, because August 2010 precedes July 8, 2016, there is no genuine dispute of material fact as to Opposers’ standing or priority of use.

in the essential characteristics of the goods and differences in the marks.”); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

- **Fame/Strength of EATALY trademark**

Before considering the similarities and dissimilarities in Opposers’ and Applicant’s marks, we assess the relative strength of Opposers’ mark under the fifth *du Pont* factor to decide the scope of protection to which it should be accorded. In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself, and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

Fame of the prior mark, if it exists, plays a “dominant role in the process of balancing the *du Pont* factors.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). A famous mark has extensive public recognition and renown and enjoys a broad scope of protection or exclusivity of use. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *see also Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (a strong mark “casts a long shadow which competitors must avoid”). Because of the wide latitude of legal protection accorded a famous mark, the

party asserting fame must clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps. Inc.*, 73 USPQ2d at 1694). Additionally, “likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Id.* Fame may be measured indirectly in a number of ways: by the volume of sales of and advertising expenditures related to the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06, 1309; *see also Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983). We generally determine the strength of a plaintiff’s mark at the time of trial, and accept and consider evidence of fame and strength, for purposes of likelihood of confusion, up to the time of trial. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 n.18 (TTAB 2014).

Initially, we note that there is no evidence that the mark EATALY is anything but inherently distinctive and, in view of Opposers’ registrations, we proceed on the basis that Opposers’ registered mark is entitled to all presumptions, including the

presumption of validity, accorded registered marks under Trademark Act Section 7(b), 15 U.S.C. § 1057(b). We also look at the evidence of record showing any renown of Opposers' mark for the period preceding the filing of Opposers' motion for summary judgment.

Opposers operate their EATALY establishments in two locations in New York City (Flatiron and downtown), as well as in Chicago, Boston and, since the filing of the notice of opposition, Los Angeles (Saper dec. ¶¶ 3, 7; 6 TTABVUE 30); the two New York City EATALY locations, i.e., Flatiron and downtown, generate "currently" at least \$80 million and \$45 million in annual gross sales, respectively (*Id.* at ¶ 6); and Opposers have generated "over \$200 million in annual gross sales in the U.S." in connection with the EATALY brand (*Id.*). Additionally, Opposers submitted evidence which shows that the EATALY establishments have been the subject of numerous unsolicited articles in the media (Exh. A-1, A-2, A-3, A-4, A-5, A-6, & A-7, Saper dec. ¶ 6; 6 TTABVUE 36). We highlight the following:

- (1) Online article dated November 29, 2016, from The Boston Globe entitled "Will Eataly take a bit out of Boston's food scene? (accessed on October 30, 2017, 4:48 p.m. from www.bostonglobe.com/business/2016/11/29/will-eataly-take-bite-...) (6 TTABVUE 36-41);
- (2) Online article from the POPSUGAR website entitled "What is Eataly?" (accessed on October 27, 2017, 4:59 p.m. from www.popsugar.com/food/What-Eataly-43805717) (6 TTABVUE 42-44);
- (3) Online article from The New York Times dated October 19, 2010, entitled "Eataly Offers Italy by the Ounce" (accessed October 31, 2017, 8:53 a.m. from www.nytimes.com/2010/10/20/dining/reviews/20Eataly.html) (6 TTABVUE 49-52);
- (4) Online article from ELLE magazine dated September 1, 2010, entitled "Behold: Eataly" (accessed on October 27, 2017, at 4:57 p.m. from

www.elle.com/culture/celebrities/a11371/ behold-eataly-473383/) (6 TTABVUE 53-55);

- (5) Online article from Harper's Bazaar magazine dated September 26, 2016, entitled "Eat Chic: The Best Italian Imports to Buy Stateside" (accessed October 30, 2017, 3:39 p.m. from www.harpersbazaar.com/culture/travel-dining/g7900/best-italian-in...) (6 TTABVUE 56);
- (6) Page from the blog of Martha Stewart dated February 22, 2011, entitled "Eataly – A Unique Food Lovers' Paradise!" (accessed November 3, 2017, 9:18 a.m. from www.themarthablog.com/2011/02/eataly-a-unique-food-lovers-par...) (6 TTABVUE 57-60);
- (7) Online article from FASTCOMPANY dated February 20, 2015, entitled "Eataly Charms The World With Italian Fare And Flair" (accessed November 3, 2017, 9:17 a.m. from www.fastcompany.com/3041563/eataly-charms-the-world-with-ita...) (6 TTABVUE 63-77);
- (8) Online article regarding Eataly Chicago in Restaurant Review – Zagat (© 2017) (accessed October 31, 2017, 8:54 a.m. from www.zagat.com/r/eataly-chicago) (6 TTABVUE 79-81);
- (9) Online article from USA TODAY dated August 2, 2016, entitled "Eataly Downtown to debut in New York City" (accessed November 3, 2017, 9:16 a.m. from www.usatoday.com/story/travel/experience/food-and-wine/2016/0...) (6 TTABVUE 82);
- (10) Online article from ENTREPRENEURS : WORTH KNOWING dated October 30, 2014, entitled "Eataly Elevates Food Retail, Tastes Success. What's Next?" (accessed November 3, 2017, 9:16 a.m. from www.entrepreneur.com/article/238389) (6 TTABVUE 83);
- (11) Online article from URBANDADDY dated October 30, 2017, entitled "67,000-Square-Foot of Things You'll Need to Eat and Drink" (accessed October 31, 2017, 8:28 a.m. from www.urbandaddy.com/articles/40830/los-angeles/eataly-la-eata...) (6 TTABVUE 84-85);
- (12) Online article from HOLLYWOOD REPORTER *Pret-a-Porter*, dated October 30, 2017, entitled "5 Only-In-LA Things To Try At Eataly LA Opening This Week" (accessed October 31, 2017, 8:52 a.m. from www.hollywoodreporter.com/news/eataly-la-what-eat-105311) (6 TTABVUE 86-93);

- (13) Online article from THE LOS ANGELES TIMES dated October 27, 2017, entitled “Everything you need to know about (and eat!) at the Eataly in Century City, open Nov. 3” (accessed October 30, 2017, 4:46 p.m. from www.latimes.com/food/dailydish/la-fo-eataly-20171103-story.html) (6 TTABVUE 94-96);
- (14) Online article from HUFFINGTON POST Arts & Culture, dated April 13, 2017, entitled “Fancy Food Market Eataly Is Going To Help Save Leonardo Da Vinci’s ‘Last Supper’” (accessed October 31, 2017, 8:55 a.m. from www.huffingtonpost.com/entry/eataly-last-supper-da-vinci_us_58...) (6 TTABVUE 97-98);
- (15) Online article from EATER dated October 30, 2017, entitled “How Eataly Became an Italian Food Superpower — A brief history of the trailblazing Italian megamarket” (accessed October 30, 2017, 3:38 p.m. from www.eater.com/2016/8/12/12442512/eataly-history-store-locations) (6 TTABVUE 104-110);
- (16) Online article from THE NEW YORKER MAGAZINE, November 6, 2017 issue, entitled “L.A.’S FIRST EATALY AUDITIONS LOCAL PRODUCTS” (accessed October 30, 2017, 5:12 p.m. from www.newyorker.com/magazine/2017/11/06/las-first-eataly-auditio...) (6 TTABVUE 123-125);
- (17) Page from the blog of AAA [THE AMERICAN AUTOMOBILE ASSOCIATION] entitled “NYC’s Eataly: Come with an open mind, empty stomach” dated “August 13” (accessed October 30, 2017, 5:06 p.m. from westerncentralny.aaa.com/member-connection/blog/nycs-eataly-...) (6 TTABVUE 128-129);
- (18) Online article from BLOOMBERG NEWS FOOD & DRINKS, dated August 16, 2016, entitled “Here’s Why 15,000 People Lined Up at Eataly Last Week” (accessed www.bloomberg.com/news/articles/2016-08-16/roman-pizza-is-th...) (6 TTABVUE 130-135);
- (19) Online article from EATER dated March 5, 2015, entitled “The 23 Most Anticipated Food Halls in the Country” (accessed November 3, 2017, 9:15 a.m. from www.eater.com/2015/3/5/8105295/23-most-anticipated-food-halls...) (6 TTABVUE 137-159);
- (20) Online article from SERIOUS EATS entitled “The Serious Eats Guide to Conquering Eataly Chicago” dated March 2014 (accessed October 27, 2017, 4:50 p.m. from <http://chicago.serioouseats.com/2014/03/the-serious-eats-guide-to-conque...>) (6 TTABVUE 183-188).

In view of the foregoing evidence of sales volume and unsolicited media recognition or publicity by third parties, we find that Opposers have established that there is no genuine dispute that their EATALY mark has achieved at least some degree of recognition and strength in the restaurant market and that the EATALY mark is therefore entitled to a broader scope of protection than might be accorded a mark with less recognition. *See, e.g., Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017). In response to Opposers' evidence, Applicant submitted the statement of Marcus Belke, its President, viz. "I do not think that the term EATALY is famous" (Belke dec., ¶ 5; 10 TTABVUE 40). Mr. Belke's "belief" does not raise a genuine dispute as to whether the trademark EATALY is strong for purposes of likelihood of confusion. Although the Board is required to draw all reasonable inferences in favor of the non-moving party, the Board is not required to credit unsupported factual allegations, speculation or conclusory statements, such as the statement contained in Applicant's declaration. *See, e.g., Sukumar v. Nautilus, Inc.*, 785 F.3d 1396, 114 USPQ2d 1626, 1632 (Fed. Cir. 2015) ("[A party] cannot create a genuine issue of material fact by simply submitting a conclusory declaration against overwhelming evidence to the contrary.") (citing *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1112 (Fed. Cir. 2000) ("A party may not overcome a grant of summary judgment by merely offering conclusory statements.")); *see also Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 430 (TTAB 1985) (non-movant, in responding to motion for summary judgment, "must set out, usually in affidavit form by one with knowledge of specific facts, what specific evidence could be offered at trial"). In any

event, Mr. Belke is not qualified to opine on anyone's beliefs but his own. In view of the foregoing, we find that there is no genuine dispute of material fact that Opposers have achieved significant market exposure and that their mark is strong among the relevant public. *See Palm Bay Imps.*, 73 USPQ2d at 1694-95; *see also Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738-39 (TTAB 2014).

- **Similarity of the Marks**

Opposers argue that EATELLI and EATALY have the same sound and connotation, a highly similar appearance, and create the same commercial impression. In particular, Opposers assert that insofar as there is no "correct" pronunciation of a mark, any possible difference in how the parties' marks are or would be pronounced cannot be relied upon to avoid likelihood of confusion. Opposers also point out that both marks commence with the term "EAT." Opposers explain further that their customers often misspell the EATALY mark (Saper dec., ¶ 17; 6 TTABVUE 33); therefore, upon viewing Applicant's mark on its website for the same or related services, customers would likely assume that EATALY and EATELLI are one and the same provider of services, or somehow associated with each other (6 TTABVUE 238).

In response, Applicant contends that the parties' marks are highly dissimilar because they convey different connotations and are pronounced differently. Applicant suggests that Opposers' mark refers to the country Italy; whereas Applicant's mark comes from "eatery" and "intelligence." Applicant argues that the consuming public will recognize that EATELLI is a shortened version of those two terms. In support of

its arguments, in addition to the declaration of Mr. Belke, Applicant has submitted the declaration of its counsel, Kevin J. Keener, along with printouts of online definitions of the terms “eatery” and “intelligence” (Keener dec. ¶¶ 4-5, Exh. D & E; 10 TTABVUE 14-15, 27-37). Mr. Belke avers that EATELLI is a term he “coined as a combination of ‘eatery’ and ‘intelligence’” (Belke dec. ¶ 7; 10 TTABVUE 39-40).

With respect to the similarity of the marks, we look to the marks in their entireties as to appearance, sound, meaning or connotation, and commercial impression. *Palm Bay Imps.*, 73 USPQ2d at 1692. In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average consumer who retains a general rather than specific impression of the marks. *See Inter IKEA Sys.*, 110 USPQ2d at 1740 (citing *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)). In fact, under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1228

(TTAB 2015) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.”) (citation omitted); *San Fernando Elec. Mfg. Co.*, 196 USPQ at 2-3 (marks “must be considered as wholes, and not on the basis of side-by-side comparison, and in the light of the fallibility of memory”)). Accordingly, the fact that there are specific, minor differences between the marks is not determinative. The question is whether the overall impression of the marks is so similar that there is no genuine dispute that consumers will believe that the marks identify services emanating from a single source.

Here, each mark begins with “EAT,” and therefore they evoke a highly similar connotation related to food or eating. “[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *see also Palm Bay Imps.*, 73 USPQ2d 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

Additionally, both terms contain the same number of syllables (three) and could have the same stress pattern, with the primary accent on the initial word “EAT,” the

second syllable of each being virtually identical, and the third syllable having the identical “ē” sound. The subtle distinctions in the marks resulting from the letters that follow “EAT” are not likely to be recalled by purchasers encountering the marks at different times, especially because both parties’ services involve restaurants. *See, e.g., In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (noting that “restaurants are often recommended by word of mouth and referred to orally...” (quotation omitted); *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (noting the propensity of persons to try restaurants based on word-of-mouth recommendations). Moreover, as indicated, even though Applicant may have intended that its mark be pronounced in a particular manner, there is no assurance that purchasers, upon viewing the mark, would pronounce Applicant’s mark so differently from Opposers’ mark that confusion would not arise. *See, e.g., In re Viterra Inc.*, 101 USPQ2d at 1912 (“there is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner”); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (“There is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark.”).

Further, both Opposers and Applicant argue that their marks are fanciful or coined (Saper dec. ¶ 17, 6 TTABVUE 33; Belke dec. ¶ 7, 10 TTABVUE 40). When, as here, both marks are coined terms that look alike and sound alike, and there are no known differences in meaning to distinguish them, the marks are often found to engender a similar commercial impression. *Inter IKEA Sys.*, 110 USPQ2d at 1741

(citing *E.I. du Pont de Nemours and Co. v. Yoshida Int'l Inc.*, 393 F.Supp. 502, 185 USPQ 597, 604 (E.D.N.Y. 1975) (TEFLON and EFLON found similar because of the shared letters and because the use of coined words without known, distinctive meanings renders confusion more likely); *Procter & Gamble Co. v. Johnson & Johnson*, 485 F.Supp. 1185, 205 USPQ 697, 708 (S.D.N.Y. 1979) (“When arbitrary or fanciful marks are involved, the distinctiveness of the marks will make the public more conscious of similarities than differences. ... In contrast when common words are involved ... the degree of difference rather than the degree of similarity is likely to be more noticeable.”), *aff'd without opinion*, 636 F.2d 1203 (2d Cir. 1980)).

In view of the foregoing, we find that there is no genuine dispute that the overall commercial impression created by Applicant’s mark is highly similar to Opposers’ mark.

- **Similarity of the Parties’ Services and Channels of Trade**

In determining likelihood of confusion, the question of registrability of an applicant’s mark must be decided on the basis of the recitation of goods or services set forth in the application, regardless of what the record may reveal as to the particular nature of applicant’s goods or services, the particular channels of trade, or the class of purchasers to which sales of the goods or services are directed. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comp. Servs.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

As noted supra, Applicant's services are identified as "computerized on-line ordering services in the field of restaurants and bars; on-line ordering services in the field of restaurant take-out and delivery" and "agency services for reservation of restaurants; reservation of restaurants; restaurant reservation services; making reservations and bookings for restaurants and meals." Opposers' services identified in U.S. Reg. No. 3065012 include "table cloth restaurants; fast food restaurants; and cafes." Opposers' services in use in commerce since August 2010 are identified by Mr. Saper as "an Italian marketplace that includes a variety of restaurants, food and beverage counters, bakery, retail items, a cooking school, and various classes and events" (Saper dec., ¶ 2; 6 TTABVUE 29). Additionally, Mr. Saper explains that "customers can order a variety of products online and even make reservations for events and classes on the Eataly Website" (*Id.* ¶ 13; 6 TTABVUE 32); and that the "Eataly Website also offers services that help consumers make dine-out decisions, including but not limited to, Chef's Table offerings, special culinary events, and the ability to make reservations at Eataly restaurants" (*Id.* ¶ 14). For example, customers can order Thanksgiving dinner online from Opposers' Eataly website. (6 TTABVUE 211). Customers can also view the various EATALY restaurants and "happenings" at the Flatiron/New York Eataly location and make reservations online for "Baita on the Roof" (6 TTABVUE 218-219).

Thus, U.S. Reg. No. 3065012 includes three different types of restaurants or dining establishments and other evidence shows that EATALY establishments include restaurants and that a customer can order a Thanksgiving dinner online from

EATALY. In view thereof, there is no genuine dispute that Applicant's broadly defined "computerized on-line ordering services in the field of restaurants and bars" encompass Opposers' more specific online ordering services and, therefore, are legally identical to Opposers' services. *Southwestern Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015), *aff'd*, 652 Fed.Appx. 971 (Fed. Cir. 2016) (given broad identification of services, "we must presume that the services encompass all services of the type identified"). Similarly, there is no genuine dispute that Applicant's "restaurant reservation services" encompass Opposers' online restaurant reservations services and, therefore, are legally identical to Opposers' services. *Id.* We may find that there is a likelihood of confusion when only one item in a class of services is related to one of the other party's services. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any service that comes within the recitation of services in that class).

With respect to the parties' trade channels, because there are no limitations as to channels of trade or classes of purchasers in the description of services in Applicant's application, it is presumed that Applicant's services move in all channels of trade normal for those services, and that they are available to all classes of purchasers for those services. *See Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 1 USPQ2d at 1815; *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340, 343 (TTAB 1983). Because there is no genuine dispute that Applicant's services are legally identical to those services which Opposers have established based on common law, there is no

genuine dispute that the parties' channels of trade for those services overlap. *See e.g., Hard Rock Cafe International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1512 (TTAB 2000) (noting that while opposer's channels of trade were limited to its common law uses, there was no restriction in applicant's identification on the channels of trade and therefore applicant's goods were deemed to be sold in all channels of trade appropriate for such goods). Thus, Mr. Belke's statement that the goods and services that Eatelli intends to offer "are for the direct benefit of vendors of goods ... to allow vendors to gain business intelligence into their sale of products" (Belke dec. ¶ 10, 10 TTABVUE 40), does not raise a genuine dispute as to a material fact as to the similarity of the parties' services or their purchasers. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1825-26 (TTAB 2015) (citing *Paula Payne Prods. Co. v. Johnson Publ'g Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973) ("[A]bsent any explicit restriction in the application or registration, we must presume the parties' identified goods to travel through all normal channels of trade for goods of the type identified, and we must consider them to be offered and sold to all of the usual customers for such goods."). Moreover, Mr. Belke's statement is inconsistent with Applicant's confidential evidence, which shows that Applicant's services are also directed to persons who purchase food from restaurants (Exh. F, 11 TTABVUE). In view of the foregoing, we find that there is no genuine dispute that the parties' services are highly similar and that the parties' services which are legally identical are sold in the same channels of trade.

Decision

Having considered the parties' arguments and the record in its entirety, and viewing the evidence in the light most favorable to Applicant and drawing all justifiable inferences in favor of Applicant, we find that each of the relevant *du Pont* factors in evidence favors a finding of likelihood of confusion and that Opposers have satisfied their burden of setting forth a *prima facie* case showing that there is no genuine dispute as to any material fact remaining for trial in regard to their likelihood of confusion claim; that Applicant has failed to demonstrate the existence of a genuine dispute regarding at least one material fact which requires resolution by trial; and that Opposers are entitled to judgment as a matter of law as to their claim of priority and likelihood of confusion based on their prior use and registration of the EATALY trademark. Accordingly, Opposers' motion for summary judgment is **GRANTED**, the opposition is sustained, and registration is refused.⁷

⁷ Having determined that Applicant is not entitled to registration based upon Opposers' likelihood of confusion claim, we need not reach Opposers' remaining dilution claim. *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (the Board's determination of registrability does not require, in every instance, decision on every pleaded claim); *see also City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1679 n.23 (TTAB 2013) (because registration at issue is cancelled on ground of abandonment, no need to reach second ground involving alleged lack of *bona fide* intent to use the applied-for mark at the time the application was filed); *Am. Paging Inc. v. Am. Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989), *aff'd unpublished*, 932 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990) ("Having determined that petitioner is entitled to the relief it seeks based upon its claim pursuant to Section 2(d) of the Lanham Act, we need not address petitioner's claim that registrant has abandoned its rights in the mark AMERICAN MOBILPHONE PAGING and design.").