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Mother's Restaurants Incorporated v. Mother's Other Kitchen, Inc.

No Number in Original

U.S. Patent and Trademark Office, Trademark Trial and Appeal Board

218 U.S.P.Q. (BNA) 1046

Decided June 2, 1983

CASE HISTORY and DISPOSITION: Trademark opposition No. 61,624, by Mother's Restaurants Incorporated, against Mother's Other Kitchen, Inc., application, Serial No. 103,201, filed Oct. 14, 1976. Opposition sustained; Allen, Member, concurring in part and dissenting in part with opinion.

HEADNOTES:

TRADEMARKS

[**1H] 1. Acquisition of marks -- Character and extent of use -- In general (67.0731)

Prior use and advertising of mark in connection with goods or services marketed in foreign country, whether that advertising occurs inside or outside U.S., creates no priority rights in such mark in U.S. as against one who, in good faith, has adopted same or similar mark for same or similar goods or services in U.S. prior to foreigner's first use of mark on goods or services sold and/or offered in U.S., at least unless it can be shown that foreign party's mark was, at time of adoption and first use of similar mark by first user in U.S., "famous" mark within meaning of *Vaudable v. Montmartre, Inc.*, 123 USPQ 357.

[**2H] 2. Marks and names subject to ownership -- In general (67.501)

Fact that word is commonly used word in everyday language is not determinative of whether term can become trademark or whether such trademark is strong or weak.

[**3H] 3. Opposition -- Pleading and practice (67.589)

Apparent admission against interest that represents position inconsistent with position now taken in opposition is not conclusive on question of whether mark is strong or weak.

[**4H] 4. Identity and similarity -- How determined -- Side by side comparison (67.4073)

Side-by-side comparison is not proper test in evaluating question of likelihood of confusion since that is not the way customers will come in contact with mark in marketplace; rather, one must look to general overall commercial impression created in mind of consumer whose memory of mark is imperfect.

[**5H] 5. Identity and similarity -- Words -- Similar (67.4117)

Use of "Mother's Other Kitchen" and of "Mother's Pizza Parlour," for restaurant services, is likely to cause confusion.

CLASS-NO: 67.0731, 67.4073, 67.4117, 67.501, 67.589

COUNSEL: Gottlieb, Rackman & Reisman, P.C., New York, N.Y., for Mother's Restaurants Incorporated.
James T. Fitzgibbon and Angelo J. Bufalina, both of Chicago, Ill., for Mother's Other Kitchen, Inc.

JUDGES: Before Allen, Simms, and Krugman, Members.

OPINIONBY: Krugman, Member.

OPINION:

An application has been filed by Mother's Other Kitchen, Inc. to register "MOTHER'S OTHER KITCHEN" for carry out restaurant services. n1 The word "KITCHEN" has been disclaimed apart from the mark as shown.

n1 Application Ser. No. 103,201 filed Oct. 14, 1976, with an alleged date of first use of January, 1976.

Registration has been opposed by Mother's Restaurants, Incorporated. As grounds for opposition, opposer asserts that applicant's mark so resembles opposer's previously registered mark "MOTHER'S PIZZA PARLOUR" for restaurant services n2 (the term PIZZA PARLOUR being disclaimed apart from the mark) and previously used marks "MOTHER'S" and "MOTHER'S PIZZA PARLOUR & SPAGHETTI HOUSE" both for restaurant services, as to be likely, when applied to applicant's services, to cause confusion, mistake or to deceive.

n2 Reg. No. 1,040,322 issued May 25, 1976. Section 8 affidavit accepted. The application which matured into this registration was filed on Sept. 17, 1971.

Applicant, in its answer to the opposition, has denied the salient allegations therein.

The record consists of the pleadings, the file of applicant's application, opposer's pleaded registration made of record

pursuant to Trademark Rule 2.122(b), n3 portions of printed publications relied on by opposer and testimony taken by opposer. Both parties have filed briefs on the case and opposer has filed a reply brief. Both parties were represented at oral hearing.

n3 While the status and title copy of opposer's pleaded registration showed ownership of said registration in another entity, opposer has proved its ownership of the registration through testimony of one of its witnesses.

Opposer's priority in the mark "MOTHER'S PIZZA PARLOUR" for restaurant services has been established by the introduction into evidence of opposer's pleaded registration in connection with the testimony of Mr. Grey Sisson, president and chairman of the board of opposer corporation. In this regard, applicant has raised the question that opposer should not be allowed to rely on its trademark registration and that applicant should be declared the prior user for the reason that the application that matured into the registration involved herein was statutorily defective; that the Office improperly and erroneously allowed said registration to issue; and that if the Office had followed proper procedures, opposer's registration would have issued subsequent to the filing date of applicant's application.

Applicant has raised the issue of the propriety of the issuance of opposer's pleaded registration in its brief. This is the first time that this issue has been raised and under the circumstances, this issue is considered to be raised in an untimely manner. This new issue was neither pleaded nor proved and the registration file of opposer's pleaded registration was not introduced into evidence either pursuant to a notice of reliance under Trademark Rule 2.122(c) or in connection with the testimony of a witness. Thus, it is the Board's view that the propriety of the issuance of the registration is not an issue that was tried by either the express or implied consent of the parties in accordance with Rule 15(b) FRCP. Moreover, even if applicant had pleaded and sought to prove the new allegations raised in its brief, opposer has correctly pointed out in its reply brief that it is well settled that applicant may not attack the validity of opposer's pleaded registration in the absence of a counterclaim to cancel said registration. Knorr-Nahrmittel Aktiengesellschaft v. Holland International, Inc. 206 USPQ 827 (TTAB 1980). Accordingly, the Board may not give any consideration to applicant's arguments relative to the issue of the propriety of the issuance of opposer's pleaded registration.

Go to Headnotes [**1R] [1] With respect to the question of opposer's asserted priority in the pleaded marks "MOTHER'S" and "MOTHER'S PIZZA PARLOUR & SPAGHETTI HOUSE", opposer has shown by way of testimony that its predecessor in interest opened a restaurant under the name "MOTHER'S PIZZA PARLOUR" in Hamilton, Ontario, Canada on December 1, 1970; that some 55 additional restaurants under the same name subsequently opened up in Canada and the United States; that the first restaurant opened in the United States was in November 1977 in Columbus, Ohio; that opposer since 1971 has used its marks "MOTHER'S" and "MOTHER'S PIZZA PARLOUR & SPAGHETTI HOUSE" in radio advertisements; that many of the radio advertisements used during the period 1971-1977 were broadcast on Canadian radio stations having radio signals reaching the United States, specifically, parts of New York and Michigan; that in 1975, opposer began a promotional campaign for its Canadian restaurants whereby promotional materials were distributed at tourist information booths in southern Ontario; that these promotional packages contained dis [*1048] count coupons and take-out menus using the term "MOTHER'S"; that some 50,000 promotional packages were distributed in the summer of 1975 and the promotional campaign has continued every summer to the present with over 100,000 promotional packages distributed in 1981; and that Americans have dined in opposer's Canadian restaurants as evidenced by a market survey as well as letters from Americans containing comments about their dining experiences at opposer's restaurants as well as business inquiries concerning franchise opportunities from interested Americans. It is opposer's position that applicant, not having taken any testimony or offered any evidence, is limited to its filing date as its date of first use (October 14, 1976); that the aforementioned promotional activities of opposer predated applicant's filing date; and that by virtue of opposer's radio spot advertising and promotional efforts directed to Americans entering Canada from the United States along tourist

routes, opposer created good will in the United States market and established service mark rights in "MOTHER'S" and "MOTHER'S PIZZA PARLOUR & SPAGHETTI HOUSE" as of 1971. In support of this position, opposer is able to cite only one case, Koffler Stores Ltd. v. Shoppers Drug Mart, Inc., 193 USPQ 165 (E.D. Mich. 1976). However, the Koffler case presented a much different situation from the instant case. In the Koffler case, the plaintiff, a Canadian drug store chain, obtained a United States registration for the mark "SHOPPERS DRUG MART" on February 12, 1974. The Court held that the defendant, a Detroit, Michigan area drug store chain, did not use the mark "SHOPPERS DRUG MART" in connection with its stores until April or May, 1974, a date subsequent to the issuance of plaintiff's registration. The remarks of the court regarding plaintiff's radio advertising on Ontario radio stations reaching the Detroit area and other United States cities related to plaintiff's unfair competition claim against defendant based on the common law principles of unfair competition. The Court noted with respect to this claim of unfair competition that defendant's activities were such as to negate any inference of innocent adoption by the junior user and further, that plaintiff's advertising was extensive and a significant amount of the advertising originated in the United States. The present situation involves no such unfair competition claim and our view coincides with the Court in Mother's Restaurants Inc. v. Mother's Bakery, Inc., 210 USPQ 207 (W.D. N.Y. 1980) where in response to plaintiff's (opposer's) argument that it should be accorded an actual use date of 1971 by virtue of Canadian radio broadcasts reaching New York and the citation of the Koffler case, supra' the Court said: "The court does not in any case find this argument compelling, nor do I find the evidence supporting it strong; the Koffler Stores, Ltd. v. Shoppers Drug Mart, Inc., 434 F.Supp. 697 (E.D., Mich. 1976), case involved a much different set of circumstances." Accordingly, we decline to hold that opposer's promotional activities in Canada regarding "MOTHER'S" and "MOTHER'S PIZZA PARLOUR & SPAGHETTI HOUSE" prior to 1976 resulted in superior rights in said marks in the United States so as to preclude applicant from registering a confusingly similar mark. Rather, it is our view that prior use and advertising of a mark in connection with goods or services marketed in a foreign country (whether said advertising occurs inside or outside the United States) creates no priority rights in said mark in the United States as against one who, in good faith, has adopted the same or similar mark for the same or similar goods or services in the United States prior to the foreigner's first use of the mark on goods or services sold and/or offered in the United States [Cf. Johnson & Johnson v. Diaz, et al., doing business as Johnson Laboratories, 172 USPQ 35 (DC CD Ca 1971)], at least unless it can be shown that the foreign party's mark was, at the time of the adoption and first use of a similar mark by the first user in the United States, a "famous" mark within the meaning of Vaudable v. Montmartre, Inc., 20 Misc 2d 757, 193 NYS 2d 332, 123 USPQ 357 (N.Y. Sup. Ct. 1959). Under the circumstances, we will limit our determination of the question of likelihood of confusion to an analysis of the mark covered by opposer's registration "MOTHER'S PIZZA PARLOUR" for restaurant services vis-a-vis the mark covered by applicant's application "MOTHER'S OTHER KITCHEN" for carry out restaurant services.

Since opposer's restaurant services are not otherwise restricted, said services are considered to include all types of restaurant services, including carry-out restaurant services of the type recited in the identification of goods in applicant's application. Therefore, the only issue is whether the contemporaneous use of "MOTHER'S PIZZA PARLOUR" and "MOTHER'S OTHER KITCHEN" in connection with identical services would be likely to cause confusion as to the origin of the services, for purposes of Section 2(d) of the Trademark Act.

It is applicant's position that the marks as a whole are distinguishable from each other; and that the only common element in the respective marks is the word "MOTHER'S" [*1049] which is a weak term. Applicant has relied on the U.S. District Court decision in Mother's Restaurant, Inc. v. Mother's Bakery, Inc., supra, wherein the plaintiff therein (opposer) successfully argued no likelihood of confusion between, inter alia, "MOTHER'S PIZZA PARLOUR" and "MOTHER'S BAKERY", both for restaurants. Applicant has pointed out that in that case, plaintiff argued that "MOTHER'S" was a weak mark used frequently in various businesses, including restaurants. Applicant concludes by asserting that in view of opposer's prior judicial admissions and the prior decision by the Court in the Mother's Restaurant, Inc. case, supra, opposer may not now argue likelihood of confusion between the two marks since the only commonality between the instant marks is, as was the case in the prior action, the word "MOTHER'S."

Opposer, on the other hand, denies that the opposition is based solely on the existence of "MOTHER'S" in both marks.

Opposer asserts that the marks as a whole generate the same commercial impression and render the marks confusingly similar. Opposer argues that "PIZZA PARLOUR" and "OTHER KITCHEN" as used in connection with "MOTHER'S" all bring to mind locations where "MOTHER'S" might have done her good old-fashioned cooking; that applicant's use of "OTHER" implies that there is another location where "Mother" cooks outside her home; and that the decision in the Mother's Restaurant's Inc. case *supra*, relied on by applicant is not inconsistent with a finding of likelihood of confusion herein.

Go to Headnotes [**2R] [2,3] Although applicant has argued that the

Go to Headnotes [**3R] term "MOTHER'S" is weak in connection with restaurant services, the record is devoid of any evidence whatsoever to support such a claim. While it is clear that the word "mother's" is a commonly used word in everyday language, this fact is not determinative of whether such a term can become a trademark or whether such a trademark is strong or weak. The Court, in the Mother's Restaurant's Inc., case, *supra*, concluded that "MOTHER'S" was a relatively weak mark. However, that conclusion was based on an affidavit made of record in that case. While said affidavit was that of counsel for opposer herein, and while we recognize that the affidavit appears to be an admission against interest in that it represents a position inconsistent with the position taken herein by opposer, nevertheless such an admission is not conclusive. See: Movement Corporation v. Air Lift Company, 174 USPQ 395 (CCPA 1972) and cases cited therein. While the position adopted by opposer in the prior case may be considered as a fact illuminative of shade and tone in the total picture confronting the Board, we may not be relieved of reaching our own conclusion based on the entire record. See: Interstate Brands Corporation v. Celestial Seasonings, Inc., 198 USPQ 151 (CCPA 1978); Lasek & Miller Associates v. Rubin, et al. 201 USPQ 831 (TTAB 1978). In the present case, we cannot presume to know the contents of the affidavit in the prior proceeding nor can we take judicial notice of the weakness of a term without any factual support. Accordingly, we decline to hold, on the record presented before us, that "MOTHER'S" is a weak mark as applied to restaurant services. Moreover, it should be noted that the prior decision in Mother's Restaurant's Inc., *supra*, was based in part on several factors not relevant here such as the different logos and typefaces of the respective marks as well as the fact that while plaintiff's mark "MOTHER'S PIZZA PARLOUR" suggested that one could obtain pizza at the establishment, the other mark "MOTHER'S BAKERY" made no such impression.

Go to Headnotes [**4R] [4,5] In the present case, both marks are

Go to Headnotes [**5R] dominated by the identical word "MOTHER'S." The "PIZZA PARLOUR" portion of opposer's mark, which has been properly disclaimed, is clearly subordinate matter which merely indicates the type of food obtained at opposer's restaurant. Similarly, the term "KITCHEN" is virtually devoid of any trademark significance as applied to applicant's carry-out restaurant services and has been disclaimed. While the differences between the marks are readily apparent from a side-by-side comparison, such comparison is not the proper test in evaluating the question of likelihood of confusion since that is not the way customers will come in contact with the marks in the marketplace. See: L. Leichner (London) Limited v. Robbins, 189 USPQ 254 (TTAB 1975) and cases cited therein. Rather, we must look to the general overall commercial impression created in the mind of the consumer whose memory of a mark is imperfect. See: Glamorene Products Corporation v. Boyle-Midway, Inc., et al., 188 USPQ 145 (SDNY 1975); Sealed Air Corporation v. Scott Paper Company, 190 USPQ 106 (TTAB 1975) and cases cited therein. We conclude that purchasers familiar with "MOTHER'S PIZZA PARLOUR" restaurants would, upon coming into contact with "MOTHER'S OTHER KITCHEN" carry out restaurants, be likely to believe that they were somehow related as to ownership or that they otherwise shared a common sponsorship or origin. Accordingly, we hold that confusion as to source or origin would be likely for purposes of Section 2(d) of the Trademark Act. [*1050]

Decision The opposition is sustained and registration to applicant is refused.

CONCURBY: Allen, Member, concurring in part, dissenting in part.

DISSENTBY: Allen, Member, concurring in part, dissenting in part.

DISSENT:

I fully agree with the decision of the majority holding that opposer's pre-1976 promotional activities in Canada, including spillover advertising into the United States, on behalf of "MOTHER'S" and "MOTHER'S PIZZA PARLOUR & SPAGHETTI HOUSE" restaurants in Canada did not bestow upon opposer any superior rights in these service marks in the United States. However, it seems to me that this holding rests on a more solid foundation than that which is set forth in the majority opinion. Since this holding is pivotal to my opinion as to our final decision in the case, this additional support is set forth below.

Firstly, the state of the law prior to enactment of the Trademark Act of 1946, 15 U.S.C. 1052 et seq. (1976) was as declared by the Court of Appeals for the Second Circuit in *Le Blume Import Co. v. Coty*, 293 F. 344 (1923). That court held as follows:

But the right of Coty to protect his trademark "Lorigan" or his right to use "L'Origan" upon his perfumes in the United States is not dependent upon whether he has any exclusive right to the trade mark or to the trade name in France. It cannot be denied that the protection of a trade mark in the United States is not to be defeated by showing a prior use of a like trade mark in France, or in some other foreign country. It is not essential that one who claims protection of his trade mark should in all cases be able to show that he first used it. The prior use of a mark by another in some foreign country is not fatal if the one claiming protection is able to show that he was first to use it in this country.

See also, *Coty, Inc. v. Parfums de Grande Luxe, Inc.*, 298 F. 865 (2nd Cir. 1924), cert. denied, *Parfums De Grande Luxe, Inc. v. Coty* 266 U.S. 609; *Moxie Co. v. Noxie Kola Co.*, 29 F. Supp. 167, 42 USPQ 443 (D. N.Y. 1939); *Fraser v. Williams*, 61 F. Supp. 763, 66 USPQ 482 (D. Wis. 1945).

Decisions under the Trademark Act of 1946 continued -- with one notable exception, as hereinafter discussed -- to follow these pre-Lanham Act precedents. Most of the cases involved trademarks used on products sold in the foreign country but not in foreign commerce with the United States, the unsuccessful claim of United States priority having been based on advertising or some other activity affecting American citizens or touching American territory. E.g. *Oland's Breweries, Ltd. v. Miller Brewing Co.*, 189 USPQ 481 (TTAB 1975) aff'd, 548 F.2d 349, 192 USPQ 266 (CCPA, 1976) [Publicizing "SCHOONER" beer in magazines circulated in the United States and on U.S. radio stations, aimed at United States tourists visiting the Maritime provinces in Canada, held not sufficient to establish technical trademark use in United States, albeit such activities were sufficient to rebut a presumption that Canadian owner had abandoned that mark, the United States registration of which had inadvertently been cancelled due to failure to file 8 declaration.]; *Sterling Drug Inc. v. Knoll A.-G. Chemische Fabriken*, 159 USPQ 628, 630 (TTAB 1968) [Neither advertising in foreign publication which may be found in United States libraries nor therapeutic use of trademarked drug "TALUSIN" on U.S. citizens in U.S. military hospital in Germany held sufficient to establish priority in United States.] See also, *Interlego A.G. v. Leslie Henry Co.*, 214 F. Supp. 238, 136 USPQ 601, 605 (M.D. Pa. 1963); *S Maw Son & Sons, Ltd. v. Mochida Pharmaceutical Mfg. Co.*, 138 USPQ 652, 653 (TTAB 1963); *Johnson & Johnson v. Diaz*, supra, 172 USPQ 35, 37 . At least one decision involved services. *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977) [Promotional activity of Dr. Chaney in the United States concerning public health services rendered in Southeast Asia, held insufficient to establish priority for Chaney in the service mark "INTERMED" in the United States.]

Determination of the issue should not be influenced by whether the case involves goods or services. Although the requirement of use is more easily satisfied in the case of services -- use in advertising being sufficient -- the definition of commerce in the Trademark Act of 1946 is the same for either kind of mark. n4 There has been a change in this definition from the predecessor statute, however. n5 This [*1051] difference brings us to the previously referred to exception, i.e., *In re Silenus Wines, Inc.*, 557 F.2d 806, 194 USPQ 261 (CCPA 1977). In Silenus, the Court drew attention to the definitional difference and noted that the Patent and Trademark Office had been determining "use in commerce" issues as if the definition had not been changed. In fact, as the Court conceded, Silenus, at 194 USPQ 264, 265 , there was significant evidence in the legislative history that no change had been intended. Nevertheless, it held in Silenus that the statutory language of the 1946 Act was clear and unambiguous and, consequently, it must be applied

without regard to the seemingly inconsistent, yet ambiguous, history. *Silenus*, at 194 USPQ 266 . Accordingly, the question raised herein must be evaluated in the light of *Silenus*. In my opinion, the result in this case is the same. In *Silenus*, the importation of wine, followed by its intrastate sale by the importer, was held to have had a sufficient impact on foreign commerce to satisfy the "commerce which may lawfully be regulated by Congress" test, citing *Katzenbach v. McClung*, 379 U.S. 294 (1964), for its authority on the broad scope of federal regulatory power under the commerce clause. However, in the instant case, the only impact of the spillover advertising is on commerce within Canada. The rendering of the services is in Canada, by Canadian persons and entities. The profit, if any, emanating from the rendering of such services accrues to Canadian citizens. To avail oneself of the services one must be in Canada. Thus, there is no impact as a result of the spillover advertising on commerce between Canada and the United States. Accordingly, the prior spillover advertising of "MOTHER'S" and "MOTHER'S PIZZA PARLOUR & SPAGHETTI HOUSE" created no rights or priority for opposer in the United States.

n4 "Commerce the word 'commerce' means all commerce which may lawfully be regulated by Congress." Sec. 45, Trademark Act, 15 U.S.C. 1127 (1976).

n5 The Act of Feb. 20, 1905, Chapter 592, 1, 33 Stat. 724, provided that "the owner of a trademark used in commerce with foreign nations, or among the several states or with Indian Tribes, * * * may obtain registration for such trademark * * *" (emphasis added).

It should be added that the contrary result urged by opposer herein would have enormous consequences, in terms of uncertainty, on our trademark system. Considering the rapid technological advances in telecommunications, especially satellite communications, a television signal transmitting advertising of a restaurant in a distant foreign land can be captured and viewed or retransmitted in the United States by the use of sophisticated disk antennae aimed at the communications satellite and associated equipment. See, *Eastern Microwave, Inc. v. Doubleday Sports, Inc.*, 691 F.2d 125, 216 USPQ 265 (2nd Cir. 1982), where the process is described. Thus, if mere use of a mark in restaurant services advertising created rights in the United States, without a filing somewhere on a Register capable of being searched, the adoption of a restaurant mark in the United States would be extremely hazardous. n6

n6 Even under the treaty power, priority based on foreign activities has been recognized or proposed only where based on a filing of a regular national application, (e.g. Paris Convention) or an application for international registration (e.g. Madrid Agreement for the International Registration of Marks; Trademark Registration Treaty). See Allen, "Trademark Registration Treaty, Its Implementing Legislation" 21 IDEA, THE JOURNAL OF LAW AND TECHNOLOGY 161 (PTC Research Foundation of the Franklin Pierce Law Center, 1980).

As for the possibility that protection might be accorded in the United States to a restaurant name which, although not used in the United States commerce, is, nevertheless, well-known in this country, it seems to me that the *Vaudable* decision according protection to the famous "MAXIM's" restaurant name in the United States, cited by the majority, is inapplicable to this case since that decision was based on a theory of unfair competition, namely misappropriation, under the law of the State of New York. *Vaudable*, 123 USPQ at 358 ; See discussion in 2 LADAS, PATENT, TRADEMARKS AND RELATED RIGHTS, 1560, 61 (1975). Under Federal law, it seems to me that application of the well-known marks doctrine depends upon whether the applicable text of the Paris Convention, in this case, the 1934 London text, and, in particular, Article 6 bis of that Convention, n7 is self-executing. See, *Vanity Fair Mills, Inc. v.*

Eaton Co., 234 F.2d 622, 109 USPQ 438 (2d Cir. 1956), cert. denied 352 U.S. 871; See generally, 1 LADAS, PATENTS, TRADEMARKS, AND RELATED RIGHTS, 220-226 (1975). n8 However, we need not deal with this matter since the facts in the record of the instant case clearly do not support an inference that either "MOTHER'S" or "MOTHER'S PIZZA PARLOUR & SPA [*1052] GHETTI HOUSE" were ever well-known marks in the United States. Even the New York Courts have declined to apply the Vaudable decision in such circumstances. Falmouth Corporation v. Soloweys Heroine, Inc., 168 USPQ 314 (N.Y. Sup. Ct. 1970).

n7 Paragraph (1) of Article 6 bis reads: "The countries of the Union undertake * * * to refuse * * * the registration of a trademark which constitutes a reproduction, imitation or translation, liable to create confusion, of a mark considered by the competent authority of the country of registration to be well-known in that country as being already the mark of a person entitled to the benefits of the present convention and used for identical or similar goods. * * *" Paris Convention, Act of London, 1934, 53 Stat. 1748, T.S. No. 941. The London text is the most recent Act to which both the United States of America and Canada are bound. INDUSTRIAL PROPERTY, Jan. 1, 1983 (W.I.P.O. 1983)

n8 Another treaty question is whether the article even applies to service marks under the London text. The first reference to service marks in the Paris Convention was in the Lisbon Act of 1958, to which Canada has not acceded.

Having no prior United States rights in "MOTHER'S," the only remaining issue is whether "MOTHER'S PIZZA PARLOUR" and "MOTHER'S OTHER KITCHEN" are confusingly similar marks. I disagree with the majority's conclusion as to this issue. Admittedly, applicant's record is virtually devoid of any meaningful evidence on the question whether purchasers are likely to be confused because the term "MOTHER'S" is common to both marks. However, I do not think we can ignore the obvious fact that "mother" has in our society a very close and intimate relationship with the preparation and serving of food which is, after all, the primary purpose of restaurant services. The Courts and reviewing authorities of this Office have fairly consistently accorded very narrow protection to marks comprising the term "mother" or "mother's". Nebraska Consolidated Mills Co. v. Penn, 121 USPQ 94 (Comm'r Pats. 1959) ["MOTHER BESSIE'S" for pone bread not likely to be confused with "MOTHER'S BEST" for wheat flour, prepared mixes, and corn meal]; Creamette Co. v. Kientzel Noodle Co., 119 USPQ 222 (Com'r Pats. 1958) ["MA'S BRAND" for noodles, soup mixes, etc. held not likely to be confused with "MOTHER'S" for noodles etc.]; Nebraska Consolidated Mills Co. v. Quaker Oats Co., 118 USPQ 454 (Com'r Pats. 1958) ["MOTHER'S BEST" for wheat flour not confusingly similar with "MOTHER'S" for the same goods, long concurrent use having produced no instances of confusion.] Nebraska Consolidated Mills Co. v. Shawnee Milling Co., 99 F. Supp. 70, 90 USPQ 303 (W.D. Okla. 1951), aff'd, 198 F.2d 36, 94 USPQ 19 (10th Cir. 1952) ["MOTHER'S PRIDE" and "MOTHER'S BEST," both applied to bread, held not confusingly similar due to dissimilarity of the second words and of their labels.] In Nebraska Consolidated v. Shawnee, the oldest of the cited decisions, Chief Judge Vaught of the District Court had the following comments about the word "mother":

The word or identity "mother" is just as old as the human race. It had its origin in the Garden of Eden when Eve became the first mother. The name mother is so intimately associated with the home and the family that one is never thought of without the other. In our modern commercial life the word mother has become so attached to everything connected with the home that the name has taken on commercial significance and has been applied or attached to almost every home article or device which would appeal to the buying public. There is not only mother's flour, but mother's oats, mother's cocoa, mother's mayonnaise, mother's salad dressing, mother's sandwich spread, mother's meal, mother's syrup, mother's extracts, and many other articles for home use. The word, therefore, has become so universal in meaning and in use that its exclusive use for any commercial purpose has been judicially prohibited. 90 USPQ at 306 .

Accordingly, I do not believe we need any evidence to conclude that purchasers would look to other words in the respective marks of the parties herein as having considerable importance in distinguishing the parties' services. These other words are patently dissimilar in sight, sound and (it seems to me) meaning.

I also do not share the majority's view that the two marks herein involved have similar commercial impressions. The idea that "MOTHER'S PIZZA PARLOUR" is "mother's other kitchen", i.e. the other kitchen where she makes pizza is too strained, in my view, to result in purchaser confusion. Accordingly, I would dismiss the opposition.