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December 12, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cappuccino's Cafe, Ltd.

Serial No. 76586779

Anthony F. Spina of Spina, McGuire & Okal, P.C. for
Cappuccino's Cafe, Ltd.

James A. Rauhen, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Drost, Walsh and Cataldo, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

Cappuccino's Cafe, Ltd. (applicant) filed an
application on April 12, 2004 to register **Tiramisu by
Isabella** in standard-character form on the Principal
Register for "bakery desserts, namely, tiramisu." The
application claims first use of the mark and first use of
the mark in commerce on January 1, 1992. Applicant has
disclaimed "tiramisu."

The Examining Attorney has refused registration under
Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a

likelihood of confusion with Reg. No. 1887351 for the mark ISABELLA'S in standard-character form for goods identified as "Bakery products; namely, muffins, scones, cookies, bread, teacakes and muffin batter." The registration claims first use of the mark anywhere and first use of the mark in commerce on February 13, 1992. The registration issued on April 4, 1995; it has been renewed and is active.

Applicant argued against the refusal. The Examining Attorney made the refusal final, and applicant appealed. Applicant and the Examining Attorney have filed briefs. We affirm.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion..." Id. The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the

cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Applicant has focused its arguments on points other than those ordinarily raised related to likelihood of confusion. In particular, applicant argues that there would not be confusion because, applicant alleges, applicant and registrant operate in distinct geographical territories. Applicant also argues that the registered mark is not entitled to protection because it is a "personal name." Before addressing applicant's specific arguments, we will address the general question of likelihood of confusion.

The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

While we must consider the marks in their entireties, and we have, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks, here ISABELLA and ISABELLA'S, than to the less distinctive elements in determining whether the marks are similar. As the Court of Appeals for the Federal Circuit observed,

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"... in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case applicant's mark includes "tiramisu" in addition to ISABELLA. Applicant identifies its goods as "tiramisu" and applicant has disclaimed "tiramisu." Applicant has not attempted to argue that "tiramisu" is anything other than a generic term, the name of its goods. Consequently, we conclude that ISABELLA and ISABELLA'S are the dominant elements in each of the marks and that "tiramisu" is not distinctive and, as such, is insufficient to distinguish applicant's mark from the registered mark. In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

For completeness we note that the difference in form in the marks, the possessive, ISABELLA'S, in the registered mark versus the "... by Isabella" form in applicant's mark, in no way diminishes the similarity. Each form conveys the

very same commercial impression, that is, identifying "Isabella" as the source of the goods.

Accordingly, we conclude that applicant's mark is highly similar to the cited registered mark in appearance, sound, connotation and commercial impression.

The Goods

Applicant's goods are identified as "bakery desserts, namely, tiramisu." The goods in the cited registration are identified as "Bakery products; namely, muffins, scones, cookies, bread, teacakes and muffin batter." Applicant has not argued directly that the goods are unrelated or otherwise distinct.

The goods need not be identical to find that the goods are related under Section 2(d) of the Trademark Act. The goods need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from the same source. On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods and the channels of trade for the goods, we must consider the goods as identified in the application and registrations. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir.

1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Applicant's goods and the goods in the cited registration are both baked goods. More specifically, applicant's goods are identified as desserts. Likewise, several of the items in the cited registration are also often served as desserts, for example, scones and cookies. Also, the Court of Appeals for the Federal Circuit and this Board have often found the types of goods at issue here related. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); In re Pan-O-Gold Baking Co., 20 USPQ2d 1761, 1765 (TTAB 1991); Robert A. Johnston Co. v. Ward Foods, Inc., 157 USPQ 204, 206 (TTAB 1968).

Accordingly, we conclude that applicant's goods and the goods in the cited registration are closely related.

As we indicated above, applicant has argued that confusion is not likely because applicant and the registrant operate in distinct geographical territories. Specifically, applicant states, "Applicant fails to see how the average purchaser who normally retains a general rather than a specific impression of trademarks can be confused, mistake (sic) or deceived when the registered mark, to the best of Applicant's knowledge, operates solely in Ohio and

the Applicant operates solely in Illinois. The average purchaser in Ohio would not travel to Illinois just buy (sic) bakery goods specifically Tiramisu and the average purchaser in Illinois would not travel to Ohio for their bakery goods or Tiramisu."

The cited registration is unrestricted and, as such, entitled to the presumption of nationwide rights. In particular, Trademark Act Sections 7(b) and (c), 15 U.S.C. §§ 1057(b) and (c) provide,

(b) A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registered mark, and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

(c) Contingent on registration of a mark on the principal register provided by this Act, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect...

In fact, one of the principal points of federal registration is to secure nationwide rights. Also, as the Examining Attorney pointed out, the application is not restricted to any geographical territory either. Therefore, any registration resulting from the application would also carry with it all of the normal presumptions

federal registration affords, including nationwide rights. Accordingly, we reject applicant's arguments based on the alleged use of the respective marks in distinct geographical territories.

For completeness, we note that applicant has not even alleged that it has any knowledge of the registrant's activities with respect to the mark, whether in Ohio or beyond, nor could we consider such extrinsic evidence in this proceeding. See In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986) (extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected).¹

Applicant also argues that we should reverse the refusal because the registered mark consists of a "personal name" which is not entitled to protection. Applicant states, "... a personal name is not subject to exclusive appropriation as a trademark even though registered as such. *Borden Ice Cream Co. v. Borden's Condensed Milk Co.*, 1912, 201 F. 510, 121 C.C.A. 200."

¹ Here and elsewhere in its brief we note that applicant has both cited and discussed numerous cases from the district courts. These cases involve infringement and similar claims where the focus is the actual use of marks. These cases are of limited relevance here due to our focus in this proceeding on the application and registration, not actual use. In re Bercut-Vandervoort & Co., 229 USPQ at 764.

As the Examining Attorney pointed out, applicant's reliance on the 1912 Borden case is misplaced. It predates the Lanham Act of 1946 which modernized, and substantially "rewrote" U.S. trademark law. See generally J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition § 5:4 (4th ed. 2006). While the current law accords surnames special treatment under Trademark Act Section 2(e)(4), 15 U.S.C. 1052(e)(4), it nonetheless does permit registration of surnames under certain conditions. McCarthy, supra, § 13:27 et seq. However, the Trademark Act in no way restricts the ability of trademark owners to secure rights in and registration for given names, such as ISABELLA, provided the mark meets the requirements which apply generally. Id.

More importantly, applicant's argument that the registered mark is not subject to protection, viewed properly, is an attack on the validity of a registration which is not permitted in an ex parte proceeding. In re Dixie Restaurants, Inc., 41 USPQ2d at 1534. We must accord the cited registration the presumption of validity provided for in Trademark Act Section 7 discussed above. Accordingly, we reject applicant's argument challenging the validity of the registered mark.

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Finally, we conclude that there is a likelihood of confusion between applicant's mark and the mark in the cited registration principally because the marks are highly similar and the goods are closely related.

Decision: The refusal under Trademark Act Section 2(d) is affirmed.