Hearing: December 7, 2011

Mailed: May 29, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Bueno Alimentos, S.A. de C.V.

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Serial No. 76676618

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Theodore A. Breiner of Breiner & Breiner, L.L.C. for Bueno Alimentos, S.A. de C.V.

S. Michael Gaafar, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

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Before Kuhlke, Bergsman and Wellington, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Bueno Alimentos, S.A. de C.V. ("applicant") filed an intent-to-use application for the mark COCO LOCO, in standard character form, for "fruit juices," in Class 32. Applicant provided an English translation for "Coco Loco" as "The Crazy Coconut."

The examining attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when used in connection with the fruit juices, so resembles the registered mark THE CRAZY COFFEE COMPANY COCO LOCO ESRESSO

and design, shown below, for "coffee; tea," in Class 30, as to be likely to cause confusion.[1]

The registration includes the following translation statement: "The foreign wording in the mark [COCO LOCO ESPRESSO] translates into English as 'CRAZY COFFEE.'" Also, registrant disclaimed the exclusive right to use "Coffee," "Coco," and "Espresso."

Preliminary Issue

In the first Office action (August 24, 2007), the examining attorney noted two prior filed applications listed below that may be a Section 2(d) bar to registration:

1. Serial No. 77012018 for the mark THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO and design for "coffee; tea," in Class 30, and "coffee shops," in Class 43, filed on October 2, 2006;[2] and

[1] Registration No. 3589548, issued March 17, 2009. The registration also includes "coffee shops," in Class 43, but the examining attorney did not include the services in the likelihood of confusion refusal.

[2] The mark in this application was ultimately cited as a Section 2(d) bar to registration and is the subject of this appeal.

2. Serial No. 78382691 for the mark COCOLOCO, in standard character form, for "alcoholic liquors, namely, coconut liqueur," in Class 33, filed on March 11, 2004.

In its February 25, 2008 response, applicant argued that the marks in the noted applications do not so resemble applicant's mark as to be likely to cause confusion.

In the next Office action (March 11, 2008), the examining attorney suspended action in the application pending the disposition of application Serial No. 78382691 (the earliest filed application). The examining attorney did not reference application Serial No. 77012018.

On July 16, 2009, applicant notified the examining attorney that application Serial No. 78382691 was abandoned and requested that its application be approved for publication.

In an Office action dated August 17, 2009, the examining attorney notified applicant that application Serial No. 77012018 had been registered as Registration No. 3589548 and cited the mark THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO and design as a Section 2(d) bar to registration.

In applicant's February 17, 2010 response, applicant argued that when the examining attorney suspended action in the application based on the disposition of application

Serial No. 78382691 without referencing application Serial No. 77012018, the examining attorney implicitly "withdrew the possible citation to the mark in the '548 registration in the Office action mailed March 11, 2008. Accordingly, the trademark attorney had previously considered the issue and agreed that there is no likelihood of confusion between applicant's mark and the mark in the '548 registration."[3] The examining attorney did not address this argument in his next Office action (March 17, 2010). Applicant renewed the argument in its September 17, 2010 response. The examining attorney did not address the argument in his October 14, 2010 Office action. Applicant renewed the argument in its brief and the examining attorney addressed the issue, for the first time, in his brief.

Trademark Rule 2.83(a), 37 CFR § 2.83(a), provides that "[w]henever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the *Official Gazette* for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register."

[3] February 17, 2010 Office action, p. 4.

Trademark Rule 2.83(c) provides that "[a]ction on the conflicting application which is not published in the *Official Gazette* for opposition … will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned."

The Trademark Manual of Examining Procedure (8th ed. 2011) discusses in general terms the process examining attorneys should follow when there are pending applications of marks that may be likely to cause confusion, but it does not explicitly direct examining attorneys to identify all such applications in the suspension order.[4]

In the circumstances before us, application Serial No. 78382691 had a filing date of March 11, 2004 and application Serial No. 77012018 had a filing date of October 2, 2006. When the examining attorney suspended action in the application at issue pending the disposition of Serial No. 78382691, without referencing the other pending application, the examining attorney may have just listed the first filed application. Moreover, the examining attorney may have determined that applicant's mark was more likely to cause confusion with COCOLOCO for coconut liqueurs than with THE CRAZY COFFEE COMPANY COCO

[4] *See* TMEP §§ 716.02(c), 1208.01 and 1208.02.

LOCO ESPRESSO and design mark. However, when application Serial No. 78382691 was abandoned, the examining attorney determined that the mark in the other application remained a valid Section 2(d) bar.

In spite of the examining attorney not identifying application Serial No. 78382691 as a basis for suspension, applicant was not harmed by this omission. While the better practice is for an examining attorney to list all pending applications in the suspension order that may form a basis for refusal, applicant was given an opportunity to argue against a refusal based on the application that matured into the cited registration. In sum, applicant was not prejudiced by the omission of the application serial number in the suspension order and there is no reason to reverse the ultimate refusal to registration. Under these circumstances, there is no reason to prohibit the examining attorney from continuing to prosecute the application. In other words, there is no estoppel. *See In re Recorded Books Inc.*, 42 USPQ2d 1275, 1280 n.5 (TTAB 1997).

During the prosecution of the application in *Recorded Books Inc.*, the examining attorney refused to register applicant's mark on the ground that it was merely descriptive, but invited applicant to amend its application to the Supplemental Register. When applicant amended its

application to the Supplemental Register, the examining attorney refused registration on the ground that the mark was generic. The applicant in that case argued that the examining attorney was estopped from refusing registration on the ground that the mark is generic because the examining attorney invited applicant to amend its application to the Supplemental Register. Acknowledging the inconsistency in examination, the Board declined to find an estoppel where the examining attorney changed her mind after further research. Likewise, in this case, the examining attorney adapted to the changing circumstances and issued what he thought was an appropriate refusal. In this regard, the USPTO has a duty to issue valid registrations and has broad authority to correct errors made by examining attorneys. *See Last Best Beef LLC v. Dudas*, 506 F.3d 333, 340, 84 USPQ2d 1699, 1704 (4th Cir. 2007) ("[F]ederal agencies, including the USPTO, have broad authority to correct their prior errors."); *see also BlackLight Power Inc. v. Rogan*, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002) (affirming that USPTO officials acted within their authority in a reasonable manner to withdraw a patent from issuance in order to fulfill the USPTO's mission to issue valid patents, even after Notice of Allowance, payment of the issue fee, and notification of

the issue date, and with publication of the drawing and claim in the *Official Gazette*). Thus, if the examining attorney discovered that a mistake made during examination would result in issuance of a registration in violation of the Trademark Act or applicable rules, the examining attorney must issue any necessary requirements or refusals, even if they could or should have been previously raised. Accordingly, we find that the examining attorney followed proper examination procedure and the USPTO is not estopped from refusing registration on the basis of likelihood of confusion.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In analyzing the similarity or dissimilarity of 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 overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1835, 1741 (TTAB 1991), *aff'd unpublished,* No. 92-1086 (Fed. Cir. June 5, 1992). In making this determination, we must consider the recollection of the average purchaser who normally retains only a general, rather than a specific,

impression of the marks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average purchaser is an average consumer who purchases fruit juices, coffee and tea and frequents coffee shops.

The marks are similar to the extent that they both include the term COCO LOCO. In fact, registrant's mark, THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO and design, incorporates the entirety of applicant's mark. While the mere fact that the marks share common elements does not compel us to find that the marks are similar, it is a factor in comparing the overall commercial impressions engendered by the marks as perceived by consumers. *See Helga, Inc. v. Helga Howie, Inc.*, 182 USPQ 629 (TTAB 1974) (junior party's mark HELGA so resembles the senior party's mark HELGA HOWIE as to be likely to cause confusion).

As indicated above, applicant translates COCO LOCO as "The Crazy Coconut" and registrant translates COCO LOCO ESPRESSO as "Crazy Coffee." In the August 24, 2007 Office action, the examining attorney submitted dictionary definitions of the word "Coco" that is defined as "Plants Food: *Same as* **coconut**."[5] The word "Loco" is defined as a

[5] *Encarta.msn.com/dictionary. See also Merriam-Webster OnLine (m-w.com)*.

slang term for "an insane person; maniac."[6] We do not know how registrant derived its translation of the term "Coco Loco Espresso" as "Crazy Coffee" because "coffee" in Spanish is "café."[7] Because "Crazy Coffee" is not a literal translation of the term "Coco Loco Espresso," we presume that the "Crazy Coffee" translation is the commercial impression that registrant seeks to engender with consumers. In any event, the term COCO LOCO ESPRESSO, as part of registrant's mark, used in connection with coffee, tea and coffee shops and the term COCO LOCO used in connection with fruit juices are distinctive, memorable terms when used in connection with their respective goods and services and comprise strong elements of both marks.

Applicant argues that the term "The Crazy Coffee Company" is the dominant element of registrant's mark. Applicant submitted the specimen of use filed by registrant, shown below, during the prosecution of registrant's application.

[6] The Random House Dictionary of the English Language (Unabridged), p. 1129 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).
[7] Cassell's Spanish Dictionary, p. 900 (1959).

According to applicant, "The wording 'coco loco espresso' are secondary features of the trademark and part of the logo with the parrot design. This wording is merely redundant of the wording 'Crazy Coffee.'"[8]

Applicant's argument assumes that there must be a dominant element in registrant's mark and does not take into account the possibility that registrant's mark is comprised of two memorable and distinctive elements. In this case, we find that registrant's mark is comprised of

[8] Applicant's Brief, p. 9.

two such memorable and distinctive elements: the term THE CRAZY COFFEE COMPANY and the COCO LOCO ESPRESSO logo.

When consumers encounter the memorable and distinctive COCO LOCO marks at issue in this appeal, consumers are likely to believe that the products and services emanate from the same source because they will mistakenly believe that COCO LOCO ESPRESSO is the coffee product line of the COCO LOCO brand of products.

In view of the foregoing, when we compare the marks in their entireties, we find that, despite their differences, they are similar in terms of appearance, sound, meaning and commercial impression.

B. The similarity or dissimilarity and nature of the goods, channels of trade and classes of consumers.

It is well settled that applicant's goods and the registrant's goods do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective products are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source.

In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

To support his position that the applicant's fruit juices and the registrant's coffee and tea products are related, the Examining Attorney has submitted numerous use-based, third-party registrations for goods listed in both the application and registration at issue.[9] Third-party registrations which individually cover a number of different goods that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d at 1785-1786; *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The registrations listed below are representative.[10]

Mark	Reg. No.	Goods/Services
O CO CO	2861019	Coffee; fruit juices
CALIFORNIA PIZZA KITCHEN	3099870	Coffee, tea; fruit juices
ST-MARC CAFÉ	3576853	Coffee; fruit juices
ZAVIDA COFFEE	3593871	Coffee, tea; fruit juices
BERRY BOX	3139964	Coffee; fruit juices
YOVANA	3230950	Coffee, tea; fruit juices

[9] March 17, 2010 Office action.
[10] We have not included the entire description of goods for each of the registrations. Only the goods in both applicant's application and registrant's registration are listed.

The examining attorney also submitted excerpts from various websites advertising the sale of tea and fruit juices under the same mark (*i.e.*, SNAPPLE, AriZona, SoBe, TURKEY HILL, TURNER DAIRY FARMS, OAKHURST, SUNCUP, MAYER BROS., MINUTE MAID, NANTUCKET NECTARS, SCHNEIDER'S, WINS and RUBY KIST).[11] This evidence shows that coffee, tea, and fruit juices move in the same channels of trade and that the goods are sold to the same classes of consumers.

Applicant argues that applicant's fruit juices and registrant's coffee and tea products are completely different. However, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984). We find that the evidence submitted by the examining attorney referenced above shows that the goods of applicant and registrant are sufficiently related that consumers would be likely to assume, upon encountering the goods under the marks at issue, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re*

[11] October 14, 2010 Office action.

Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In view of the foregoing, we find that applicant's fruit juices and registrant's coffee and tea products are related, move in the same channels of trade, and are sold to the same classes of consumers.

D. Balancing the factors.

In view of the facts that the marks are similar, the goods are related, move in the same channels of trade and are sold to the same consumers, we find that applicant's mark COCO LOCO for "fruit juices" is likely to cause confusion with the mark THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO and design for "coffee; tea."

Decision: The refusal to register is affirmed.