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**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board**

In re Alison Raffaele Cosmetics, Inc.

Application No. 77325348
Filed: November 8, 2007

Charles A. LeGrand, LeGrand LLC, for applicant.

Emily K. Carlsen, Trademark Examining Attorney, (Law Office 103, Michael Hamilton, Managing Attorney).

Before Quinn, Zervas, and Mermelstein, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of **FRUTTA DI VITA**, in standard characters, for

Cosmetics and cosmetic preparations; Concealers; Cosmetic facial blotting papers; Cosmetic sun-protecting preparations; Cosmetic sun-tanning preparations

in International Class 3.¹

The examining attorney has refused registration on the ground that registration of applicant's mark would cause a likelihood of confusion with the mark **FRÜT A VIE**, in standard characters, registered for

¹ Filed alleging a *bona fide* intent to use the mark in commerce. Amendment to allege use filed and accepted, alleging first use and use in commerce at least as early as April 2008.

Cosmetic creams for skin care; Cosmetic preparations for skin renewal; Skin and body topical lotions, creams and oils for cosmetic use; Wrinkle removing skin care preparations

in International Class 3.²

I. Likelihood of Confusion — Legal Standard

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

II. Discussion

A. The Similarity or Dissimilarity and Nature of the Goods or Services

We begin with a comparison of the goods at issue. In doing so, we are con-

² Registration No. 3861217, issued October 12, 2010, based on use in commerce, and alleging first use and use in commerce as of January 4, 2010. The registration includes a statement that “[t]he English translation of the word ‘A VIE’ in the mark is ‘of life.’”

strained to consider the goods as they are identified in the subject application and in the cited registration:

The issue in an opposition is the right of an applicant to register the mark depicted in the application for the goods identified therein. The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Sys. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant's identification of goods begins with "cosmetics and cosmetic preparations," and goes on to list "concealers; cosmetic facial blotting papers; cosmetic sun-protecting preparations; [and] cosmetic sun-tanning preparations." But since we must construe "cosmetics and cosmetic preparations" to include *all* such goods without limitation, we can ignore the following four items, each of which is a type of cosmetic or cosmetic preparation. The cited prior registration likewise lists four items, at least three³ of which are cosmetics or cosmetic preparations. Thus it is clear that applicant's "cosmetics and cosmetic preparations" are legally identical —

³ The registrant's first three goods are explicitly stated to be cosmetics. Although it seems likely, it is not entirely clear whether the remaining item — "wrinkle removing skin care preparations" — is a type of cosmetic or cosmetic preparation. Nonetheless, it is apparent that such "wrinkle . . . preparations" are at least related to cosmetics. The examining attorney has made of record a number of third-party trademark registrations based on use in commerce identifying both cosmetics and wrinkle preparations. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785–86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd*, No. 88–1444 (Fed. Cir. Nov. 14, 1988) (not precedential).

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at least in part — to the specific cosmetic items identified in the cited registration, to the extent that applicant’s goods encompass the registrant’s.

A finding that the goods at issue are identical in whole or in part strongly supports a finding of likelihood of confusion.

B. The Similarity or Dissimilarity of Established, Likely-to-Continue Trade Channels

Unless explicitly limited in the application, it is a fundamental principle of registration practice that identified goods are presumed to move in all channels of trade normal for such items. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)). Further, to the extent that goods in an application and registration are identical, we must assume that the respective purchasers and channels of trade for such goods are likewise identical. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”); see *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

We conclude that applicant's identified goods are sold in all channels of trade as are usual for such goods. It is common knowledge that cosmetics and cosmetic preparations are sold in a range of settings, from salons and fancy department store cosmetic counters, to drug stores, discount retailers, supermarkets, and over the internet.

C. The Conditions Under Which and Buyers to Whom Sales are Made

As was the case in determining the relevant channels of trade, we look again to the application—and specifically to the identified goods—to determine the relevant purchasers. Again, we must presume that the relevant purchasers of the applicant's and the cited registrant's respective goods include all of the usual purchasers for goods of the type identified. And again, because applicant's and the registrant's goods are partially identical, we must assume that the purchasers of their respective goods are likewise identical. Given the goods at issue in this case (“cosmetics and cosmetic preparations” without limitation), this is a particularly large and diverse class of consumers, comprising most adult (and young adult) women, and probably a good number of men, as well. This group likely includes people from their teenage years on, and is not limited by education, social status, income, or sophistication.

Applicant submitted the declaration of Alison Raffaele Tatem (Raffaele Decl.), applicant's founder and Chief Creative Officer. Ms. Raffaele indicates that applicant uses the applied-for mark on applicant's “exclusive anti-aging, anti-oxidant, complex,” Raffaele Decl. ¶ 2 (Sept. 15, 2011), and that “given the nature of Applicant's

goods, confusion is highly unlikely” because applicant’s goods are “‘prestige’ cosmetics,” “sold at mid to high price points and, especially with a consumer’s first purchase of the particular product, are ordinarily purchased from knowledgeable sales staff and beauty consultants,” and because purchasers of all cosmetics are “highly particular regarding the products they use — both for aesthetic and safety reasons.”

Id. at ¶ 7.

Applicant complains that the examining attorney did not give sufficient weight to the Raffaele declaration. *E.g.* Reply Br. at 8. While the examining attorney’s characterization of the declaration as “self-serving,” Ex. Att. Br. at 21, was not helpful,⁴ the examining attorney was correct to discount this evidence. As we have explained, for purposes of registration, we must consider applicant’s goods to be those goods which are identified in the application. The issue before us is applicant’s right to a trademark registration, and it is the application that defines the scope of the registration applicant seeks. The fact that in reality, applicant uses its mark only on “exclusive” or “prestige” cosmetics sold at moderate to high prices by well-trained sales staff is irrelevant because none of those limitations appear in the application.

⁴ Of course the Raffaele declaration is self-serving, although it is no surprise that applicant submitted an affidavit which supported its case. “Deposition testimony, affidavits, responses to interrogatories, and other written statements by their nature are self-serving. [But] . . . the term ‘self serving’ must not be used to denigrate perfectly admissible evidence through which a party tries to present its side of the story. . . .” *Hill v. Tangherlini*, — F.3d —, No. 12–3447, slip op. at 4–5 (7th Cir. Aug. 1, 2013) (citation omitted). Despite an applicant’s obvious interest in its own application, an applicant’s declaration should not be discounted on that ground alone. Although we doubt that it was the examining attorney’s intent to do so, we will not impugn applicant’s declaration merely because it was made by applicant.

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To the contrary, applicant seeks registration for use of its mark on goods identified broadly as “cosmetics and cosmetic preparations.” Accordingly, we must consider the subject application to cover *all* cosmetics and cosmetic preparations of whatever nature, sold in *all* places where cosmetics are normally sold, at *all* price points for such products, and to *all* usual purchasers of such goods.

As for the notion that purchasers of cosmetics are “highly particular” about their purchasing decisions, Ms. Raffaele’s statement again appears to focus on applicant’s actual goods and customers, rather than the goods identified in its application and the customers and channels of trade they entail. For purposes of this application, potential purchasers of the identified goods include uneducated people, people in a hurry, people looking for a bargain on a cheap product, people who may have only a hazy memory of the product they bought last time or the one a friend recommended, and even people whose reading skills are less than perfect. While the group likely also includes some who exercise a great deal of care in their cosmetic purchases, it stretches the bounds of credulity to accept that all—or even the majority—of these ordinary people are immune from source confusion. And even if some consumers are sophisticated, “we must base our decision on the least sophisticated potential purchasers.” *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1600 (TTAB 2011), *appeal docketed*, No. 11–01174 (N.D.N.Y. Sept. 30, 2011) (citing *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1027 (TTAB 2009)). And as we have often noted, even careful purchasers can be confused by similar marks. *In re Wilson*, 57 USPQ2d 1863, 1865–66 (TTAB 2001); *In re Decombe*, 9

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USPQ2d 1812, 1814–1815 (TTAB 1988). As our primary reviewing court put it, “[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. ‘Human memories even of discriminating purchasers . . . are not infallible.’” *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)).

We conclude that the channels of trade and potential purchasers of applicant’s identified goods are identical to those of the cited registrant, and that the relevant goods are sold to ordinary consumers and frequently under conditions of sale in which no greater than ordinary care is exercised. The identity of the channels of trade and potential purchasers supports the finding of a likelihood of confusion, and the degree of care is neutral.

D. The Similarity or Dissimilarity of the Marks in Their Entireties

In comparing the marks at issue, we consider their appearance, sound, meaning, and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. While we must consider the marks in their entireties, it is not inappropriate to consider the components of the marks. “[I]t is these individual aspects that collectively create a difference in the overall impressions made by the marks.” *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010).

1. Meaning of the Marks — Doctrine of Foreign Equivalents

Under the doctrine of foreign equivalents, words from common, modern lan-

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guages are translated into English to determine similarity of connotation with English words in a likelihood of confusion analysis. *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647–48 (TTAB 2008). Applicant has applied to register **FRUTTA DI VITA**; the examining attorney maintains that applicant’s mark is similar to the mark in the cited prior registration, **FRÜT A VIE**. There is no dispute that applicant’s mark is in Italian, and that it means “Fruit of Life.” Application (Nov. 8, 2007); *see also* App. Br. at 4 (unnumbered); Raffaele Decl. ¶ 8.

On the other hand, the meaning of the prior registrant’s mark (and its similarity to applicant’s mark) has been a subject of contention. The examining attorney first argued that “applicant’s mark and the registrant’s mark translate into English as FRUIT OF LIFE,” Ofc. Action (March 15, 2011), a position she adhered to in her Final Office Action. Final Ofc. Action (Sept. 23, 2011). The examining attorney’s only evidence of this statement appears to have been the translation statement in the cited registration. However, the translation in the cited registration indicates only that “[t]he English translation of the word ‘**A VIE**’ in the mark is ‘of life.’” Applicant contends that the term **FRÜT** in the prior registration is not actually a word in any language, although it looks as if it might be German because of the umlaut, which is a feature typical of German. *THE NEW OXFORD AMERICAN DICTIONARY*, 1834 (2001) (“umlaut”). Applicant’s evidence supports its claim that **FRÜT** is not a word. It does not appear in the relevant excerpts from the Italian, German, or French dictionaries applicant submitted, and the examining attorney submitted no dictionary evidence at all. *See* LeGrand Decl. Exh. D–F (Resp. to Ofc. Action (Sept. 15, 2011)). We are

not aware that **FRÜT** has any meaning in English, and we conclude that — at least on this record — it is not a word in any language.

Applicant also questions the meaning of “**A VIE**” as used in the cited registration, submitting a letter from Barry Saxon, President of Cosmetictranslation.com (a firm that specializes in translation exclusively for the cosmetics industry). Raffaele Decl. Exh. D. Mr. Saxon briefly indicates that in French,⁵ “of life” would be written “de la vie.” *Id.* On appeal, the examining attorney admits that “‘a vie’ does not possess the literal translated meaning ‘of life’ in French,” but argues that “the mark should not be dissected into three distinct terms for purposes of translation. Rather, the phrase ‘FRUT A VIE’ should be evaluated for its meaning.”⁶ Ex. Att. Br. at 12. In light of Mr. Saxon’s statement, we conclude that “A VIE,” as used in the cited registration is ungrammatical French. Whether it would nonetheless be recognized

⁵ Applicant’s dictionary evidence indicates that “vie” means “life” in French, but means something completely different in Italian, and does not appear in the German dictionary at all.

⁶ As authority for this proposition, the examining attorney cites *In re Trimarchi*, a non-precedential decision of the Board. Citation of non-precedential opinions is permitted, *Citation of Opinions to the Trademark Trial and Appeal Board*, Official Gazette (Jan. 23, 2007), although not recommended.

While we generally do not comment at length on non-precedential decisions, we note that *In re Trimarchi* does not support the examining attorney’s position. In that case, a mark comprising the words ALLEZ FILLES! had been refused registration in view of a previous registration for the mark GO GIRL. Despite evidence that the literal translation of ALLEZ FILLES! was “go girls,” the Board reversed the refusal, finding that the marks were dissimilar because ALLEZ FILLES! did not carry the idiomatic connotation of “go girls.” The panel in *Trimarchi* thus focused on the meaning of the foreign terms at issue; the case is not authority for looking at the mark as a whole in an attempt to divine a general impression, *despite* the meaning (or lack of it) in the foreign tongue. *In re Trimarchi*, App. No. 77222086, slip op. at 8–12 (TTAB May 14, 2009). Indeed, the Board remarked that “it is not clear that French speakers would even stop and translate this phrase because it is grammatically incorrect and they may simply “take it as it is.” *Id.* (citing *Palm Bay*, 73 USPQ2d at 1696).

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by a French speaker as meaning “of life” is not clear.

The examining attorney also admits in her brief that “‘früt’ is not a term that can be translated,” contending instead that “the doctrine of foreign equivalents is not necessarily inapplicable simply because the registered mark is not solely comprised of foreign wording.” Ex. Att. Br. at 13 (citing TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(b)(vi)(A) (April 2013)). She suggests that because **FRÛT** could be pronounced like the English word “fruit,” that phonetic equivalence, plus the translation of “**A VIE**” as “of life” yields the meaning “fruit of life” for the cited registration, Ex. Att. Br. at 8, corresponding exactly with the translation of applicant’s mark.

While it has often been said that foreign words are not registrable if their English equivalents would not be, *e.g. Mary Kay Cosmetics, Inc. v. Dorian Fragrances, Ltd.*, 180 USPQ 406, 407 (TTAB 1973), the doctrine of foreign equivalents is not unlimited, and it is not an absolute rule. We have characterized the doctrine as a “guideline” to be applied in appropriate cases, *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1569 (TTAB 2005), and precedent counsels caution in its application. For instance, we will only apply the doctrine when the foreign wording in the mark has a direct and exact English translation, *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 112–13 (Fed. Cir. 1983) (“second chance” is not the direct translation of “repechage”), and even then, only “when it is likely that the ordinary American purchaser would ‘stop and translate [the foreign wording] into its English equivalent.’” *Palm Bay*, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110

(TTAB 1976)). Moreover — and of particular relevance to this case — the Board has been reticent to apply the doctrine of foreign equivalents to compare a mark in one foreign language to a mark in different one, although this is not a hard-and-fast rule either. *Compare Safeway Stores Inc. v. Bel Canto Fancy Foods Ltd.*, 5 USPQ2d 1980, 1982 (TTAB 1987) (“[T]his Board does not think it proper to take the French expression “bel air” and the Italian expression “bel aria” and then convert both into English and compare the English translations to determine whether there is similarity as to connotation. . . .”), *with Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 USPQ2d 2018, 2020–21 (TTAB 1998) (“[I]n this case, we do not believe that purchasers and prospective purchasers need be *fluent* in Spanish and Italian to readily understand the connotations of these marks.”). And finally, we are not aware of any precedent on the application of the doctrine to a phrase like the one at hand, comprised in part of foreign wording and in part of a non-word, the sound of which is the phonetic equivalent of an English word.

There is no contention that the wording in applicant’s mark is obscure or vague or would otherwise be inappropriate for consideration under the doctrine of foreign equivalents. Applicant and the examining attorney appear to agree that the direct translation of **FRUTTA DI VITA** is “fruit of life,” and there is no argument that speakers of Italian would not recognize it as such.

But the translation of the cited registrant’s mark is less certain. Part of the mark appears to be in French, although that may not be clear at first glance. Accepting for the sake of argument the examining attorney’s contention that **A VIE**

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means “of life” (albeit in ungrammatical French), the registrant’s mark has the appearance of a phrase, but only partly French. The first word in the phrase, **FRÛT**, is neither French nor English, although because of the umlaut, it might appear at first glance to be German, so even French speakers might not immediately realize that “**A VIE**” is in French.

The examining attorney argues that **FRÛT** could be pronounced the same as the English word, “fruit,” and we agree. But we think it is a stretch to conclude that prospective purchasers would, upon seeing the prior mark, readily understand the meaning of its phrase to be cobbled together from the (English) phonetic equivalent of the first word, together with the translation (from French) of the ungrammatical next two words. Then, with that connotation of the prior mark in mind, and upon seeing applicant’s mark, translate applicant’s mark from Italian into English, and compare the two.

We conclude that application of the doctrine of foreign equivalents to the prior registration in this situation would go too far. Given the limited application of the doctrine in our case law, it is too speculative to assume that prospective purchasers would “stop and translate” these marks and compare their meaning. We conclude instead that for purposes of comparison with applicant’s mark, purchasers would likely perceive the previously-registered mark, **FRÛT A VIE** as it is, and without translating it into English. Therefore, although there is no dispute that **FRUTTA DI VITA** means “fruit of life,” even those familiar with Italian and French and likely to “stop and translate” applicant’s mark into English are not likely to consider the

marks to be equivalent in meaning.

Although we have rejected its application in this case, it is important to recognize that the doctrine of foreign equivalents concerns only one aspect (meaning) in the comparison of the marks. And just as important, our finding that the doctrine of equivalents should not be applied does not by itself compel a conclusion that the marks are significantly different or that confusion is not likely. *Cf. Sarkli*, 220 USPQ at 113 (“[S]uch similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.” (quoting *Sure-Fit Prods. v. Saltzson Drapery Co.*, 254 F.2d 158, 160, 117 USPQ 295, 297 (CCPA 1958))).

2. Visual Similarity

Applicant argues that “[t]he marks are . . . visually distinct in that they have differing lengths, differing numbers of letters in their component words, and one features a German language umlaut.” App. Br. at 8–9. While we agree that the marks are clearly not identical in appearance, we nonetheless find that they are visually similar.

Again, applicant’s mark is **FRUTTA DI VITA**, while the mark in the cited registration is **FRÜT A VIE**. Each mark consists of three words which are (or appear to be) in a foreign language. The first word of both marks⁷ begins with the letters F-

⁷ It is often said that the first word of a mark is most significant, as it is frequently the mark’s most “prominent feature.” *Palm Bay*, 73 USPQ2d at 1692. In this case, both the first and the last words of the marks share substantial similarities, and we find it unnecessary to determine which of the two is more prominent. By contrast, the middle term of both

(continued...)

R-U-T, although in applicant's mark the first word includes the additional letters T-A, and the cited mark includes an umlaut. Likewise, the last word of both marks is a short word beginning with the letters V-I, although they differ in that the word in applicant's mark again ends in T-A, while the mark in the cited registration ends in an E. Both marks include a short middle word, although there is no other visual similarity between applicant's **DI** and the registrant's **A**.

While we must ultimately consider the marks in their entireties, we can and should consider their individual features. But in determining similarity, the test is not whether the marks can be distinguished when subjected to a painstaking side-by-side comparison, but rather whether the marks are sufficiently similar in their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

As applicant argues, its mark is indeed longer than the cited registrant's (fourteen characters—including spaces—compared with ten characters in the cited mark) and applicant's mark comprises twelve letters compared with the registrant's eight. But these differences are unremarkable, and in any event, we think it highly unlikely that consumers under the relevant market conditions would notice, let alone retain an accurate memory of the number of characters in the marks or their

marks is short and insignificant in both appearance and sound.

comparative length, and thereby be able to distinguish them. Moreover, it is worth noting that both marks are in “standard character” form, *i.e.*, “without claim to any particular font style, size, or color.” Trademark Rule 2.52(a). Thus the words in both marks could be used in any manner, including one that makes them look more similar in size than they might appear from a comparison of the drawings in the application and registration. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258–59 (Fed. Cir. 2011) (a standard character mark is not limited as to its display). Likewise, the marks could be displayed in identical fonts or color schemes.

We acknowledge that the umlaut in the cited registration and the differences in the letters comprising the two marks present points by which the marks could be visually distinguished when examined side-by-side. Nonetheless, these differences are less likely to distinguish the marks in commerce. To many—especially those who do not speak either Italian or French—both marks are likely to be perceived simply as similar-looking foreign phrases of unknown meaning.

Thus, while in some respects, the marks differ in appearance, their basic structure (including first and last words beginning FRUT— and VI—, respectively) and their general appearance of foreignness are more likely to be recalled by consumers than the more detailed and specific differences between them.

3. Similarity in Sound

Finally, we find that the marks are also similar in their sound or pronunciation. Again, we agree with the examining attorney that the word **FRÜT** in the regis-

trant's mark would most likely be pronounced the same as the English word "fruit." Similarly, the first word in applicant's mark, **FRUTTA** is likely to be pronounced "*fruit-uh*," or possibly "*fruit-tuh*." Either way, the first term of each mark begins with a sound that is identical, or nearly so, the only difference between them being the addition of the "*-uh*" or "*-tuh*" sound in applicant's mark.

The last word in each mark is likewise similar in pronunciation. The term **VIE** in the registered mark is likely to be pronounced "*vee*" (rhyming with bee) or possibly "*vey*" (rhyming with sky), while the term **VITA** in applicant's mark would likely be pronounced "*vee-tuh*" or "*vey-tuh*." **VIE** and **VITA** are therefore highly similar in pronunciation, the only difference being — again — the addition of the "*-tuh*" sound to the end of the final word in applicant's mark.

In sum, although we do not apply the doctrine of foreign equivalents, we nonetheless find that the marks at issue are in their entirety substantially similar in appearance and sound. In doing so, we have not ignored the differences applicant has pointed out, although we find that such differences would be outweighed by the marks' similarities. This factor also supports a finding of likelihood of confusion.

E. The Number and Nature of Similar Marks in use on Similar Goods

Arguing that the matter shared by the marks is weak, applicant relies on a large number of "registrations . . . for marks including the words 'FRUIT,' 'LIFE,' VITA, or VIE and which concern goods in International Class 3," LeGrand Decl., Exh. G–K; App. Br. at 8. While we have considered this evidence, it is entitled to lit-

tle weight.⁸

Although “[t]he number and nature of similar marks in use on similar goods” is a consideration in the determination of likelihood of confusion, *du Pont*, 177 USPQ at 567 (factor # 6), registrations are not evidence of use of the registered marks,⁹ and they are not proof that consumers are familiar with the registered marks so as to be accustomed to the existence of the same or similar marks in the marketplace. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1407, 177 USPQ 268 (CCPA 1973); *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Moreover, the fact that similar marks may have been registered in the past does not entitle an applicant to registration of its own mark. *See Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983) (“the third party registrations relied on by applicant cannot justify the registration of another confusingly similar mark”); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (“Although consistency in examination is a goal of the Office, the decisions of previous Trademark Examining Attorneys are not binding on us, and we must decide each case based on the evidence presented in the record before us.”).

⁸ Along with the registrations, applicant included more than forty pages of TESS results listings for its searches. Such lists are not an appropriate means to introduce evidence of registrations. Because the examining attorney did not object to applicant’s submission, we consider the lists to be of record, *In re District of Columbia*, 101 USPQ2d 1588, 1592 n.5 (TTAB 2012), although they are of no help because they do not indicate the goods or services and other important information for each of the listed registrations.

⁹ We note that some of these marks were registered solely under Trademark Act §§ 44 or 66. Such registrations do not require the applicant to have used its mark in United States commerce prior to issuance.

Third-party registrations may, however, be considered in determining the descriptiveness or suggestiveness of a mark or an element of it. *Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313, 1316 (TTAB 2005); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987). “As to strength of a mark, however, registration evidence may not be given *any* weight.” *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original) (citing *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973)).

Applicant cites *Knight Textile* for the proposition that “[t]he Board can determine that a mark is highly suggestive by looking to the presence of multiple other registrations with common elements in the same class of goods.” App. Br. at 8. In that case, the Board looked to dictionary definitions to determine the meaning of “essentials” with respect to the goods, then noted that this suggestive significance was “corroborated by the third-party registrations.” *Knight Textile*, 75 USPQ2d 1316. But applicant’s argument differs from the logic of *Knight Textile*. While applicant urges that the marks involved in this case are highly suggestive, it does not indicate what the marks are suggestive of, *i.e.*, what suggestive or descriptive meaning the applicant attributes to them.

Our perusal of the many registrations applicant made of record includes a number comprising the term “fruit” for cosmetic products, and which include disclaimers of that term, are registered under Trademark Act § 2(f), or on the Supplemental Register. From these registrations we can infer that the term “fruit” is descriptive or highly suggestive of cosmetic products — at least to the extent it is a separable

element of the mark in question.¹⁰ However, neither applicant's mark nor that of the cited registrant feature the word "fruit" (or its foreign equivalent) as a separable element. The word **FRUTTA** in applicant's mark is used as part of a phrase, while **FRÜT** in the cited registration does not mean anything at all (although it has the appearance of being part of a phrase in a foreign language). Thus, the third-party registrations do not indicate that either **FRUTTA** or **FRÜT** is descriptive or suggestive as used in the marks at issue.

Applicant also submitted a number of registrations comprising the words "VITA" or "VIE" or "life" for goods in International Class 3, but none of them seem to use those words descriptively or suggestively. And finally, none of the third-party registrations is for **FRUTTA DI VITA** or **FRÜT A VIE** or close variations of them, so the registrations do not suggest in any way that the involved marks are, as a whole, suggestive or descriptive. Thus, although "fruit" standing alone does appear to be descriptive or suggestive with respect to cosmetics, neither applicant's mark nor that of the cited registrant consists of or comprises the term "fruit" as a separable element.

As for the proffered registrations comprising the terms "life," "VITA," or "VIE," we can conclude nothing more than that those terms have "appealed to others . . . to

¹⁰ It would appear that "fruit" is often disclaimed in registrations claiming use of the mark on cosmetics and the like because the identified goods contain fruit, or ingredients extracted from it. Indeed, applicant's specimen shows use of **FRUTTA DI VITA** in connection with a cosmetic product which includes "lycium barbarum (gogi berry) fruit extract [and] punica granatum (pomegranate) extract," as ingredients. *Amdt. to Allege Use* (June 29, 2012).

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use as a mark.” *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 462–63 (CCPA 1973). They do not demonstrate that those terms are actually descriptive or suggestive, and without evidence of use, the registrations themselves are not evidence of the weakness of the marks at issue. *In re Hub Distrib., Inc.*, 218 USPQ 284, 286 (TTAB 1983) (“third party registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as their weakness in distinguishing source”).

Finally, even if we could consider these registrations to determine whether the mark of the prior registrant is weak, they would not help applicant’s case. Although applicant has mustered an impressive number of registrations from the USPTO’s records—one hundred thirty-one, by our count—the number of registrations is misleading. The relevant *du Pont* factor requires consideration of the number and nature of *similar* marks used on similar goods. While each of the registrations applicant submitted include the words “fruit,” “VITA,” “VIE,” or “life,” none of them share much trademark similarity with the marks at issue here. Again, while we do consider the elements of trademarks, any comparison of them must ultimately rest on consideration of the marks as a whole. The existence of marks like **PASSION FRUIT TINI** (for sun-tanning preparations), **LORD OF THE FRUIT FLIES** (for drain cleaner), **HEALTHY, BEAUTIFUL SKIN FOR LIFE.** (for dermatology services), **VITA-CIMENT** (for shampoos and balms), or **LA VIE EN ROSE** (for cologne), tells us little about how consumers are likely to view the marks at issue

here, nor do they evidence “weakness” of them because when considered as a whole, they do not engender a similar overall impression. Even those registrations arguably closest to the cited mark, *e.g.*, **POUR LA VIE** (for lipstick), **SHEA LA VIE** (skin cream with shea butter), and **C LA VIE COMPLEX** (skin care products with grape-seed extract), share little overall similarity with **FRÜT A VIE**. And none of the marks in the third-party registrations are as similar to the cited registrant’s mark as applicant’s and the registrant’s marks are to each other.

Thus, while we recognize that the term “fruit” by itself is descriptive of many cosmetic items, applicant’s third-party registrations do not indicate that “fruit” is descriptive as it is used in the Italian phrase **FRUTTA DI VITA** or **FRÜT A VIE** (to the extent that “FRÜT” would be considered the equivalent of “fruit”), nor does this evidence support a conclusion that the marks at issue here are generally weak, or that confusion is not likely. We consider this factor to be neutral.

F. The Nature and Extent of any Actual Confusion

Applicant points out that it is not aware of any instances of confusion arising from its use of the applied-for mark. App. Br. at 10; Raffaele Decl. ¶ 6–7. Although evidence of actual confusion is highly significant, evidence of the *lack* of confusion rarely is, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), and that is especially true in an *ex parte* context.

The statutory issue before us is whether confusion is likely, not whether confusion has actually occurred. *Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (actual confusion not required). A *lack* of con-

fusion is probative of that question only when the evidence establishes that the marks have actually been used under circumstances in which confusion—if it is likely—would have already occurred. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Therefore, a lack of confusion is only relevant when the applicant and the owner of the prior mark have actually used their respective marks in significant volume, for a significant period of time in the same geographical markets and channels of trade, and on goods which are similar in fact. *E.g., Citigroup*, 98 USPQ2d at 1259 (lack of actual confusion a factor where there was no evidence of confusion despite concurrent use in same geographic markets since 1975, with nineteen branches in close vicinity, and heavy advertising of opposer’s renowned marks). While Ms. Raffaele’s declaration includes some general statements about applicant’s sale of goods under the mark, there is very little specific evidence of applicant’s actual business activities in this record, and there is no evidence at all of the prior registrant’s.¹¹

Accordingly, we can conclude nothing from the fact that applicant is unaware of any actual confusion. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1202 (TTAB 2007) (“the evidence in this case is not sufficient to show that a meaningful opportunity for actual confusion has existed”). This factor is likewise neutral.

¹¹ It is also noted that while applicant states that it has heard no complaints indicating confusion, Raffaele Decl. ¶¶ 6-7, we cannot assume that the prior registrant—who is not a party to this proceeding—can say the same. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026–27 (TTAB 1984) (applicant’s lack of knowledge of actual confusion is of little relevance in *ex parte* proceedings).

III. Conclusion: Balancing the Factors

We have carefully considered all of the evidence and argument of record, including any which we have not specifically discussed.

In balancing the *du Pont* factors, we note first that we have found applicant's goods identical, at least in part, to those listed in the cited prior registration. And because the goods are legally identical, we must likewise consider the relevant channels of trade and potential purchasers to also be the same. The fact that the goods are identical is itself a significant factor in our analysis. But in addition, "where . . . the goods at issue are identical, 'the degree of similarity necessary to support a conclusion of likely confusion declines.'" *Viterra Inc.*, 101 USPQ2d at 1908 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

Applicant and the examining attorney focused much of their argument on the similarity of the marks (and correctly so). We decline to apply the doctrine of foreign equivalents as urged by the examining attorney. Nevertheless, and while recognizing that the marks are clearly not identical, we find that they are substantially similar in appearance and sound, and in their overall impression, and that their similarities clearly outweigh their differences. This similarity is significant in light of our findings that the relevant goods include inexpensive, as well as expensive items, and that they are sold to ordinary consumers who exercise an ordinary degree of care in their purchasing decisions, because ordinary purchasers, exercising ordinary care, may be confused when encountering similar marks used on identical goods.

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And while applicant's third-party registrations infer that "fruit," *per se*, is descriptive of cosmetics, that fact alone does not establish that applicant's mark or that of the cited registrant are weak at all, let alone so weak as to make confusion unlikely. And finally, applicant's unawareness of any actual confusion is irrelevant on this record.

The relevant *du Pont* factors weigh in favor of affirming the refusal. We conclude that purchasers familiar with the goods sold under the cited mark, **FRÜT A VIE** are likely, when encountering the goods sold under applicant's mark, **FRUTTA DI VITA**, to be confused or mistaken as to their source or affiliation. Trademark Act § 2(d). To the extent we have any doubt, we must resolve that doubt in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290–1291 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.