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PRECEDENT OF THE TTAB

Mailed: March 25, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Centruro, S.A. de C.V.

Serial No. 77946053

Vivian Ortiz-Ponce of Marcas Estados Unidos,
for Centruro, S.A. de C.V.

Ronald McMorrow, Trademark Examining Attorney, Law Office 118,
Michael W. Baird, Managing Attorney.

Before Cataldo, Pologeorgis, and Coggins,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Centruro, S.A. de C.V. (“Applicant”) seeks registration on the Principal Register of the mark ALACRAN (in standard characters) for “Alcoholic beverages except beers; distilled blue agave liquor” in International Class 33.¹

¹ Application Serial No. 77946053, filed on February 26, 2010, based upon an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application includes the following translation statement: “The English translation of ‘ALACRAN’ in the mark is ‘SCORPION.’”

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the following two marks registered on the Principal Register and owned by the same registrant: (1) SCORPION MEZCAL (in standard characters; MEZCAL disclaimed) for "alcoholic beverages, namely, Mezcal" in International Class 33,² and (2) SCORPION and design, as displayed below, for "Alcoholic beverages, namely, Distilled Spirits" in International Class 33.³



When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the refusal to register.⁴

² Registration No. 3841502, registered on August 31, 2010; renewed.

³ Registration No. 4340359, registered on May 28, 2013; renewed. The description of the mark reads as follows: "The mark consists of a rectangle, having an upper concave portion in the color RED and a lower larger convex portion in the color YELLOW. The word 'SCORPION' in the color BLACK appears in the red portion of the rectangle. A drawing of a scorpion in the color BLACK appears in the YELLOW portion of the rectangle. A scroll border in the color BLACK surrounds the rectangle." The colors red, black and yellow are claimed as a feature of the mark.

⁴ The TTABVUE and Trademark Status and Document Retrieval ("TSDR") citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

I. Preliminary Issue – Applicant’s Request to Amend Identification of Goods

In its appeal brief, Applicant requests for the first time a proposed amendment of its identification of goods. By way of the proposed amendment, Applicant seeks to restrict the identification to “distilled blue agave liquor” only.⁵ If Applicant wished to amend its identification of goods, it should have filed with the Board a request for suspension of the appeal and, upon showing of good cause, a request to remand its application for consideration of the proposed amendment by the Examining Attorney.

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1209.04 (2018) (“Requests for remand are generally filed by applicants because they wish to make additional evidence of record, or because they wish to amend the application.

... No matter what the purpose, the request for remand must include a showing of good cause.”). Applicant did not do so. Accordingly, Applicant’s untimely request to amend its identification of goods, as set forth in its appeal brief, will be given no consideration. Our determinations herein are based on Applicant’s identification of goods, as amended prior to this appeal.⁶

⁵ We note that Applicant’s identification of goods, as originally filed, read as follows: “Alcoholic beverages except beers; Tequila.” In his July 5, 2017 Office Action, the Examining Attorney noted that the word “tequila” was previously included in the USPTO’s U.S. ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL, but on June 20, 2017, the USPTO registered the certification mark TEQUILA for “distilled spirits, namely, spirits distilled from the blue tequilana weber variety of agave plant.” July 5, 2017 Office Action; TSDR p. 1. As such, the Examining Attorney required Applicant to either delete the word “tequila” from its identification of goods or, alternatively, provide the common commercial or generic name of the goods. *Id.* In its February 8, 2018 Response, Applicant requested that the term “tequila” be deleted from its identification and replaced with the wording “distilled blue agave liquor,” *see* February 8, 2018 Response, TSDR p. 4, which was eventually approved and entered by the Examining Attorney.

⁶ Even assuming that Applicant had requested a remand of its application that was granted

II. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of 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 Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Similarity of the Goods

We initially turn to the comparison of the goods at issue, the second *du Pont* factor. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant’s application and the cited registrations. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“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

by the Board and the Examining Attorney, in turn, had approved the limitation to the identification of goods as requested by Applicant, it would not affect our decision for the reasons explained infra.

may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.")); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Applicant's identified goods are "Alcoholic beverages except beers; distilled blue agave liquor." The goods identified in the cited registrations are (1) "alcoholic beverages, namely, Mezcal" (Registration No. 3841502) and (2) "Alcoholic beverages, namely, Distilled Spirits" (Registration No. 4340359). In this case, the broadly worded "alcoholic beverages except beers" identified in Applicant's application encompasses all of Registrant's identified goods, i.e., Mezcal and distilled spirits, and, therefore, the parties' goods are legally identical in part. Further, Registrant's "Alcoholic beverages, namely, Distilled Spirits" is worded broadly enough to include Applicant's "distilled blue agave liquor." Accordingly, these specific goods are also legally identical in part.

Finally, the Examining Attorney has submitted numerous active third-party registrations demonstrating that third-parties have registered marks identifying both "tequila" and Registrant's "Mezcal."⁷ Although such registrations are not

⁷ May 12, 2017 Office Action; TSDR pp. 10-41.

As noted *supra*, "tequila" is no longer an acceptable identification because it has been registered as a certification mark to a third-party. We assume therefore that the third-party registrations submitted by the Examining Attorney issued prior to this change in identification policy. Notwithstanding, we take judicial notice of the definition of "tequila" which is defined as "a Mexican liquor made chiefly from the fermented sap of the blue agave that has been subjected to two separate distillations." See www.merriam-webster.com. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010). In view of this definition, we find that

evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have some probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

The second *du Pont* factor therefore strongly favors a finding of likelihood of confusion.

B. Similarity of Trade Channels and Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third *du Pont* factor. Because the identifications of Applicant's goods and Registrant's goods are legally identical in part and have no restrictions as to channels of trade or classes of customers, it is presumed that the trade channels and classes of purchasers are the same for these legally identical in part goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *In re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1158 (TTAB 2018).

"tequila," as identified in the third-party registrations, is a good identical to Applicant's "distilled blue agave liquor." As such, these third-party registrations demonstrate that Applicant's "distilled blue agave liquor" and Registrant's "Mezcal" may emanate from a single source under the same mark.

Thus, the third *du Pont* factor also weighs in favor of finding a likelihood of confusion.

C. Similarity of the Marks

We consider next the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)) (internal quotation marks omitted).

Applicant’s mark is ALACRAN in standard characters. The cited marks are



SCORPION MEZCAL in standard characters and [REDACTED]. When viewing Registrant’s SCORPION MEZCAL mark, the term SCORPION is likely to be accorded more weight by consumers because the remaining wording MEZCAL is generic for Registrant’s goods, i.e., Mezcal, and has been appropriately disclaimed. As such, MEZCAL is less likely to make an impact in the minds of consumers. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (disclaimed matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant when comparing marks); *see also In re Nat'l Data Corp.*,

753 F.2d 1056, 224 USPQ 749, 753 (Fed. Cir. 1985). Similarly, when viewing



Registrant's mark, consumers are likely to afford the literal term SCORPION more significance since “the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.” *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). Greater weight is often given to the wording because it is the wording that purchasers would use to refer to or request the goods or services. See, e.g., *In re Viterra, Inc.*, 101 USPQ2d at 1911. Notwithstanding,



the fact the design element of Registrant's mark includes the pictorial depiction of a scorpion only reinforces the dominant nature of the literal term SCORPION in this mark. The rectangular border and colors similarly appear as background for the word SCORPION and design of a scorpion and, as such, possess limited source-identifying capacity separate therefrom. Accordingly, we find that the term SCORPION is the dominant element in both of the cited marks.

The evidence of record clearly demonstrates that Applicant's applied-for mark, i.e., ALACRAN, is the Spanish word for the English term “scorpion.”⁸ The evidence of record also establishes that Spanish is the most widely spoken non-English

⁸ February 23, 2018 Office Action; TSDR pp. 20-23.

language in the United States.⁹ Applicant does not deny that “the Spanish language is a common, modern language, spoken by a large number of consumers in the United States.”¹⁰ As such, the Examining Attorney asserts that the “doctrine of foreign equivalents” is applicable in this case in that Applicant’s mark, ALACRAN, is in a common, modern foreign language (Spanish) and that the dominant element of Registrant’s marks, namely, the term SCORPION, is the English equivalent thereof. The Examining Attorney, therefore, concludes that the marks at issue are identical in connotation.¹¹

In traversing the refusal, Applicant argues that the marks are not similar in sound or appearance and, therefore, confusion is unlikely.¹² A refusal based on the doctrine of foreign equivalents, however, does not rely solely on similarity of the appearance or sound of the marks at issue; instead it also includes the connotation or meaning attributed to the mark when the ordinary American purchaser translates the foreign language mark. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127-28 (TTAB 2015) (“even when there are differences in the sound and appearance of two marks, likelihood of confusion can be found when the equivalency in meaning or connotation outweighs the differences in the marks.). Accordingly, Applicant’s argument that the marks are dissimilar in appearance and pronunciation, while

⁹ *Id.*; TSDR pp. 5-19.

¹⁰ Applicant’s Appeal Brief, p. 3; 9 TTABVUE 4.

¹¹ Examining Attorney’s Appeal Brief, 11 TTABVUE 5-6.

¹² Applicant’s Appeal Brief, p. 5; 9 TTABVUE 6.

valid, is unavailing by itself.

Applicant further argues that the most common translation of the English term SCORPION is the Spanish word ESCORPIÓN.¹³ Applicant, however, has not submitted any evidence to substantiate the putative primacy of this translation. Moreover, the evidence of record undercuts Applicant's contention. Specifically, as noted above, Applicant itself, in its application, stated that the translation of its applied-for ALACRAN mark is the English term "scorpion." Furthermore, the Examining Attorney has submitted screenshots from Applicant's website which show a pictorial depiction of a scorpion appearing directly beneath the designation ALACRAN on the label of Applicant's goods.¹⁴ The Examining Attorney also submitted an article reviewing Applicant's goods from the website www.tastetequila.com entitled "Alacran Tequila – Does the Scorpion Have a Bitter Sting?", as well as an article from the website www.distiller.com rating Applicant's product which states "Auténtico Alacrán ("authentic scorpion") was founded in 2010."¹⁵ The foregoing evidence, as well as the dictionary definition of record, clearly establishes that the English translation of Applicant's ALACRAN mark is the term "scorpion."

Finally, Applicant asserts that the doctrine of foreign equivalents is not an absolute rule and cannot be applied automatically and, under the circumstances,

¹³ *Id.*

¹⁴ September 8, 2018 Denial of Request for Reconsideration; 5 TTABVUE 10-13.

¹⁵ *Id.*; 5 TTABVUE 14-17.

should not be applied to this case.¹⁶ We disagree that the application of the doctrine of foreign equivalents in this case is inappropriate for the reasons set forth below.

Whether the doctrine of foreign equivalents is relevant turns upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record. The doctrine may be applied to words or terms from common, modern languages. *Palm Bay Imps. Inc.*, 73 USPQ2d at 1696. Although words from modern languages are generally translated into English, the doctrine of foreign equivalents has evolved into a guideline, not an absolute rule, and is applied only when it is likely that “the ordinary American purchaser would ‘stop and translate’ [the term] into its English equivalent.” *Id.* (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1209.03(g) (Oct. 2018). However, “[w]hen it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied.” *Palm Bay Imps. Inc.*, 73 USPQ2d at 1696 (citing *In re Tia Maria*, 188 USPQ 524 (TTAB 1975) (no likelihood of confusion between TIA MARIA for a Mexican restaurant and AUNT MARY’S for canned vegetables)). The “ordinary American purchaser” includes “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009).

In this case, we agree with the Examining Attorney that the doctrine of foreign

¹⁶ Applicant’s Appeal Brief, p. 3; 9 TTABVUE 4.

equivalents is relevant to this proceeding and the ordinary American purchasers of alcoholic beverages would understand that SCORPION is the English equivalent of Applicant's mark ALACRAN, and vice-versa. The term, whether in English or Spanish, has no demonstrated meaning in the context of alcoholic beverages and will likely be understood as an arbitrary use of the word. Thus, the significance to the alcoholic beverage consumer of the terms ALACRAN and SCORPION will likely be the same.

The *Tia Maria* decision, which Applicant cites in support of its argument that the doctrine of foreign equivalents should not apply in this case,¹⁷ involved an applicant offering restaurant services under the mark TIA MARIA versus a registrant's use of AUNT MARY'S on canned fruit and vegetable products. The Board clearly took into consideration the context in which consumers would encounter the respective marks in connection with the involved goods and services when deciding whether consumers would perceive the marks as equivalents:

But, nevertheless there are foreign expressions that even those familiar with the language will not translate, accepting the term as it is, and situations arise in the marketplace which make it unfeasible or even unlikely that purchasers will translate the brand names or labels appearing on canned foods and other like products. ... That is, insofar as this reasoning applies to the instant case, it is unlikely to expect that a person encountering "AUNT MARY'S" canned fruits and vegetables in a supermarket or other establishment where goods of this type are customarily sold would translate "AUNT MARY'S" into "TIA MARIA", and then go one step further and associate these food products with applicant's restaurant. Likewise, going the other route, it is difficult to perceive that a person who had purchased "AUNT MARY'S" canned fruits and vegetables on the shelves of a supermarket would, upon dining at the "TIA MARIA" restaurant in Mexican decor and surrounded

¹⁷ *Id.* at p. 4; 9 TTABVUE 5.

by a menu of Mexican delicacies, translate “TIA MARIA” into “AUNT MARY” and then mistakenly assume that the “TIA MARIA” restaurant and “AUNT MARYS” canned fruits and vegetables originate from or are sponsored by the same entity.

In re Tia Maria, Inc., 188 USPQ at 526.

In contrast, in this case we must consider the fact that consumers will be encountering the involved marks on legally identical in part goods, i.e., alcoholic beverages. As discussed above, we must also presume that the same consumers will be encountering these marks on alcoholic beverages in the same, usual trade channels for such goods, including liquor stores, online retailers, and bars and restaurants. Thus, unlike *Tia Maria*, the environment in which the marks are encountered is the same and we do not find it “difficult to perceive” that a consumer would stop and translate the two marks upon encountering them on alcoholic beverages. Rather, consumers are likely to view these in-part legally identical goods as emanating from a common source, marketed under marks that share a common term in different languages.

Under the circumstances, we find that the similarity between the marks based on them having the same meaning or connotation outweighs the differences based on sound and appearance, and the *du Pont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion. *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (“the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark”); *see also Bost Bakery, Inc. v. Roland Indus., Inc.*, 216 USPQ 799, 801 (TTAB 1991) (“the principle that similarity between marks in

meaning or commercial significance alone may be sufficient to create a likelihood of confusion is applicable primarily to situations where marks are coined or arbitrary rather than highly suggestive”).

III. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Because we have found that the marks at issue are identical in meaning or connotation based on the application of the doctrine of foreign equivalents; that Applicant’s identified goods are legally identical in part to Registrant’s goods; that the goods are presumed to move in similar or overlapping trade channels and that they would be offered to the same or overlapping classes of purchasers, we conclude that Applicant’s ALACRAN mark, as used in connection with the goods identified in its involved application, so resembles the cited marks SCORPION MEZCAL and SCORPION and design as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The refusal to register Applicant’s mark under Section 2(d) of the Trademark Act is affirmed.