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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Van Es Home B.V.

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Serial No. 79114008

Mary Catherine Merz and Jennifer A. Widmer of Merz & Associates, P.C. for Van Es Home B.V.

Keri-Marie Cantone, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

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Before Kuhlke, Wellington, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Van Es Home B.V. (“Applicant”) has requested an extension of protection of its International Registration of the mark ESSENZA in standard characters for the goods set forth below:

Textiles and textile goods, not included in other classes, namely, household linen, bed linen, bath linen, bed sheets, pillow shams, pillow cases, bed blankets, comforters, quilts, bedspreads, bed covers, coasters of textile, duvet covers, duvets, dust ruffles, mattress covers, towels, bath towels, beach towels, traveling rugs, face cloths, shower curtains, table linen, table covers of textile, table cloths of textile, fabric table runners, table napkins of textile, place mats of textile material, curtains,

draperies, unfitted fabric furniture covers, fabric flags, handkerchiefs, cloth labels, floor towels, curtain tie-backs in the nature of textile curtains holders, net curtains, upholstery fabrics, wall hangings of textiles, in International Class 24.¹

The Trademark Examining Attorney refused registration under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with Applicant's goods, so resembles the registered mark shown below as to be likely to cause confusion, or to cause mistake, or to deceive.



The cited mark is registered for goods and services in International Classes 3, 5, 14, 16, 25, 41, 44, and the following goods in Class 24:

Textile fabrics; textile goods, namely, napkins, cotton fabrics, damask, linen for diapers, linen cloth, flannel, jersey, jute cloth, rayon fabric, silk, fustian, crepe, taffeta, tulle, velvet, woolen fabrics, zephyr, friction cloths in the nature of hemp cloth, crepe chiffon, chenille fabrics, hemp fabric; goods of elastic textiles, namely, bands of elastic fabric to be stretched around luggage for the purpose of luggage identification; fabric of imitation animal skins; fiberglass fabrics for textile use; goods made of textile materials, namely, textile napkins; curtains of textile for windows; textiles for wall hangings and for furniture; flags not made of paper; bed covers; bedding, namely, bed

¹ Application Serial No. 79114008, filed May 21, 2012 under Section 66A of the Trademark Act, 15 U.S.C. § 1141f, on the basis of International Registration No. 1069947, issued November 9, 2010. The application includes the following translation: "The English translation of ESSENZA in the mark is ESSENCE."

sheets; counterpanes, namely, bedspreads that extend to cover the legs of the bed; paper bedspreads, pillow cases, tablecloths, table throws and covers; household linen, textile hand towels, washing mitts, bath linen; handkerchiefs of textile; tissues, of textile, for removing make-up; fabric for boots and shoes; bed covers, plastic table covers, in International Class 24.²

The registration contains the following statements:

The English translation of “ESSENZA AUTENTICA” is authentic essence. The English translation of “dal 1876” is since 1876.

The mark consists of the wording "PAGLIERI ESSENZA AUTENTICA" below a design of a rose with the wording "dal 1876" placed vertically in the upper right corner.

Color is not claimed as a feature of the mark.

When the refusal was made final, Applicant filed a notice of appeal. Applicant and the Examining Attorney have filed briefs.

1. Evidentiary matter.

We turn first to an evidentiary matter. Applicant submitted with its brief, for the first time, results of a search of the USPTO’s TESS database along with records of several registrations and applications. The Examining Attorney objected to this evidence on the ground that it is untimely.³

The Board has not considered the evidence attached to Applicant’s brief. “The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.”

² Reg. No. 3728500 issued December 22, 2009.

³ Examining Attorney’s brief, 6 TTABVUE 4.

37 C.F.R. § 2.142(d). *See also* TBMP § 1207.01. An applicant has the responsibility to make sure that the record is complete prior to filing a notice of appeal. *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n. 32, 1769 (TTAB 2011).

2. Refusal under Section 2(d).

Our determination 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 issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also submitted arguments regarding trade channels and the strength or weakness of components of the marks.

a. The goods and services; Trade channels.

We will first consider the similarity or dissimilarity of the goods as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant's goods are, in part, identical to those of Registrant. Both the application and the registration cover bed sheets, bath linen, household linen, and pillow cases. They also include the following legally identical goods:

<u>Application</u>	<u>Registration</u>
table napkins of textile	textile napkins
table cloths of textile	tablecloths
fabric flags	flags not made of paper
curtains	curtains of textile for windows
handkerchiefs	handkerchiefs of textile

We need not address the similarity of each item in the identifications of the application and registration. For purposes of our analysis, it is sufficient if likelihood of confusion is found with respect to use of Applicant's mark in connection with any good in a particular Class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). Accordingly, the *du Pont* factor relating to the similarity or dissimilarity of the goods weighs in favor of a finding of likelihood of confusion.

As Applicant's goods are, in part, identical to those of Registrant, we must presume that those goods of Applicant and Registrant move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, the *du Pont* factor relating to trade channels also weighs in favor of a finding of likelihood of confusion.

b. The marks.

We next consider the similarity or dissimilarity of the marks at issue in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). While we consider each mark in its entirety, 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 that our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We are also mindful that “[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

The Examining Attorney points out that both marks share the term ESSENZA, “which is not disclaimed, nor is it descriptive of the registrant’s goods”; and that “there is no other wording in the applicant’s mark to distinguish it from the registered mark.”⁴ The Examining Attorney argues that customers will likely perceive PAGLIERI as a “house mark,” and ESSENZA AUTENTICA as a

⁴ Examining Attorney’s brief, 6 TTABVUE 6.

“secondary product mark.”⁵ She points out that, because Applicant has requested registration of its mark in standard character form, “it can appear in any stylization, including one similar to the registrant’s.” (*Citing In re Viterra*, 101 USPQ2d at 1909.)

Applicant, for its part, argues:

[T]he word “PAGLIERI” is the dominant feature of the cited registration and should be given the most weight. ...

Consumers will request [Registrant’s] products using “PAGLIERI.” Consumers will request the Applicant’s products using “ESSENZA.”⁶

Applicant also points out the visual prominence of PAGLIERI and the “rose” design in Registrant’s mark; the phonetic differences between the marks; and the differences in meaning between ESSENZA and PAGLIERI. Applicant also argues that the ESSENZA element of Registrant’s mark is weak, and that confusion is not likely to arise as between the marks due to their common use of ESSENZA.⁷

We agree that the two marks are substantially different in appearance. The large term PAGLIERI in cursive script is clearly the most salient and arbitrary component of Registrant’s mark. The “rose” design includes a stylized letter P, which links the design to the term PAGLIERI and draws attention to that term. The element ESSENZA is visually a very minor aspect of Registrant’s mark, being embedded in the midst of the mark. Similarly, despite sharing the term ESSENZA, the two marks are largely different in sound.

⁵ *Id.*, 6 TTABVUE 6-7.

⁶ Applicant’s brief at 6, 4 TTABVUE 7.

⁷ *Id.*, 4 TTABVUE 9, 12.

We acknowledge that the ESSENZA components of the two marks are similar in appearance, sound and meaning. However, customers are not likely to consider ESSENZA, as it appears in Registrant's mark, as an element separable from the phrase ESSENZA AUTENTICA, because of the placement of these two words close together and their presentation in a similar style of lettering. Customers are more likely to perceive these two words as a unitary phrase, distinguishing it to some extent in appearance, sound and meaning from Applicant's mark ESSENZA.

We do not agree with the Examining Attorney's suggestion that ESSENZA AUTENTICA, in Registrant's mark, will be perceived as a sub-brand under the house mark PAGLIERI. It is true, as the Examining Attorney argues, that likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks by the addition of a house mark. However, we find this case distinguishable from cases such as *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007) (CORAZON and CORAZON BY CHICA confusingly similar); *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986) (SPARKS and SPARKS BY SASSAFRAS confusingly similar); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985 (CACHET and LE CACHET DE DIOR confusingly similar). In those cases, the common element was, as compared to the added house mark, of comparable strength and distinctiveness. By contrast, ESSENZA AUTENTICA is less significant as a source-identifier than the remainder of Registrant's mark for a number of reasons. First, the small size and relatively inconspicuous placement of the wording ESSENZA AUTENTICA make it unlikely to be taken as a product

name or sub-brand. It is more likely to be perceived as a slogan or tag-line that relates back to the primary brand, PAGLIERI. Second, the suggestive meaning of ESSENZA AUTENTICA makes it somewhat conceptually weak. The registration indicates that this phrase means “authentic essence.” (Even to a customer who does not understand the meaning of this phrase, its appearance would strongly suggest the words “essence” and “authentic.”) Although the phrase ESSENZA AUTENTICA is rather vague in meaning, we see it as laudatorily suggestive, implying that Registrant’s goods have certain indispensable qualities that are fundamental to goods of the type offered.

With respect to connotation, Applicant’s mark ESSENZA has the same meaning as the term ESSENZA in Registrant’s mark; however, this component of Registrant’s mark is only a small part of the mark as a whole. The primary significance of Registrant’s mark arises from the dominant term PAGLIERI, which is likely to be perceived as a surname or as a meaningless, coined term; in either case, its meaning is distinct from that of ESSENZA.

Overall, we find the two marks to be different in commercial impression. In Applicant’s mark, all focus is on the term ESSENZA. In Registrant’s mark, customers will primarily focus on PAGLIERI and the rose and stylized P design. Applicant’s mark primarily suggests an essential, indispensable quality of the goods; while Registrant’s mark is dominated by the much more arbitrary or fanciful term PAGLIERI. We find that the *du Pont* factor of the similarity or dissimilarity of the marks weighs against a finding of likelihood of confusion.

c. Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. In view of the different commercial impressions created by the marks at issue and the conceptual weakness of the common element, we find that Applicant's mark is not likely to cause confusion, mistake or deception as to the source of Applicant's goods vis à vis the cited registered mark.

Decision: The refusal to register is reversed.