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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

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*In re Lettuce Entertain You Enterprises, Inc.*

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Application No. 85291663  
Filed: April 11, 2011

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Antony J. McShane, Neal Gerber & Eisenberg LLP, for applicant.

Rebecca Miles Eisinger, Trademark Examining Attorney, Law Office 102, Mitchell Front, Managing Attorney.

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**Before Holtzman, Mermelstein, and Hightower, Administrative Trademark Judges.**

**Opinion by Mermelstein, Administrative Trademark Judge:**

Lettuce Entertain You Enterprises, Inc., seeks registration of STELLA ROSSA PIZZA BAR (in standard characters) to be used in connection with “restaurant and bar services,” alleging a *bona fide* intent to use the mark in commerce. Registration has been finally refused on the ground that applicant’s mark is likely to cause confusion in view of the mark depicted below, registered for “restaurant and tavern services.”<sup>1</sup> Trademark Act § 2(d), 15 U.S.C. § 1052(d).



The examining attorney also finally refused registration based on applicant’s

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<sup>1</sup> Registration No. 2755922, issued August 26, 2003, based on use in commerce, with a disclaimer of “TAVERN.” Trademark Act § 8 filing accepted.

failure to comply with her requirements (1) to supply a translation statement for “STELLA ROSSA,” Trademark Rule 2.32(a)(9); and (2) to submit a disclaimer of “PIZZA BAR,” Trademark Act § 6(a), 15 U.S.C. § 1056(a).

## **I. Disclaimer**

We begin with the requirement to disclaim “PIZZA BAR,” because our determination of that issue affects our analysis of the likelihood of confusion.

### **A. Legal Standard**

“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Trademark Act § 6(a), 15 U.S.C. § 1056(a). Merely descriptive or generic terms are unregistrable under Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Registration may be refused for failure to comply with a valid disclaimer requirement. *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

The examining attorney asserts that “PIZZA BAR” is descriptive. A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the products for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the products are will understand the mark to

convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316–1317 (TTAB 2002); *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Ass’n of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

## **B. “PIZZA BAR” is Descriptive and Must be Disclaimed**

The examining attorney maintains that “PIZZA BAR,” as used in applicant’s mark, is descriptive of applicant’s services, and must be disclaimed. Applicant disagrees,<sup>2</sup> arguing that its entire mark is unitary, that it is not generic, but merely “suggestive of an Old World Italian-style restaurant where consumers may gather to enjoy a meal or socialize,” and that “the phrase ‘pizza bar’ is not found in the dictionary and thus cannot have a denotative meaning.” App. Br. at 12.

In support of her position, the examining attorney has made of record printouts from the websites of a number of establishments which use the term “PIZZA BAR” in their name in a descriptive manner:

- **McKinners Pizza Bar**  
[advertising upcoming musical performances]  
Late Night Happy Hour  
...  
Pizza: A Good Choice for A Healthy Diet, Read Why

www.mckinners.com (accessed July 15, 2011).

- **Urbano Pizza Bar is open downtown**  
Urbano Pizza Bar opened on Friday at 6th and Hope streets downtown—a corner pizzeria dressed in reclaimed wood and exposed brick with a couple of wood-

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<sup>2</sup> While applicant presses the merits of the disclaimer issue, it has submitted a conditional disclaimer, to be entered if the Board upholds the examining attorney’s requirement. App. Br. at 12-13 n. 4 (“No claim is made to the exclusive right to use “PIZZA BAR” apart from the mark as shown.”).

burning ovens and a list of Italian wines and Italian beers too, the latter all on tap.

Los Angeles Times, *Daily Dish* (June 14, 2011), available at <http://latimesblogs.latimes.com/dailydish/2011/06/urbano-pizza-bar-is-open-downtown.html> (accessed July 15, 2011).

- **Kapp's  
Pizza Bar & Grill**  
A Unique Dining Establishment  
Welcome to Kapp's Pizza Bar and Grill, we are dedicated in providing family, friends, and businesses a place to gather to enjoy lunch, dinner, crinks [*sic*] and appetizers in a warm and friendly atmosphere....

[www.kappspizza.com](http://www.kappspizza.com) (accessed July 15, 2011).

- **Michael's Pizza Bar**  
(412) 381-6102  
...  
Pizza, European and Italian  
\$ Under \$10 per entree  
...  
Critic Reviews for Michael's Pizza Bar  
Pittsburgh Post Gazette  
March 27, 2008  
There is gourmet pizza, best with a bottle of Italian red, or a Belgian ale; delivered pizza, perfect for a lazy...

Listing, Urbanspoon Pittsburgh, available at <http://www.urbanspoon.com/r/23/271100/restaurant/South-Side/Michaels-Pizza-Bar-Pittsburgh> (accessed July 15, 2011).

- **PIZZA BAR**  
Boca's Best  
Many years ago my grandfather used to say *Per essere il miglior*, which simply means to BE THE BEST!  
Here at Boca's Best Pizza Bar, our mission is to provide you with the best experience possible.

From our Classic Italian dishes to our delicious hand tossed pizza, the menu is full of the finest and freshest ingredients.

<http://bocasbestpizzabar.com> (accessed July 15, 2011).

- **Adrienne's Pizza Bar**  
\$\$\$ Pizza, Italian

Listing, Menupages, available at <http://www.menupages.com/restaurants/adriennes-pizza-bar/> (accessed July 15, 2011).

- **Goodnights Pizza Bar + Patio**  
Bar • Omaha, Nebraska

Listing, Facebook, available at [www.facebook.com/pages/Goodnights-Pizza-Bar-Patio/208527573635](http://www.facebook.com/pages/Goodnights-Pizza-Bar-Patio/208527573635) (accessed July 15, 2011).

- **Scioli's**  
Established December 31, 2009, Scioli's Pizza Bar in Milford is a Pub style restaurant featuring a 50 seat bar with 6 50" Plasma HD TV's.... Along with Nana Scioli's famous thin crust pizza we also have a pub style menu that has a homemade taste with the freshest ingredients. ...

[www.sciolis.com/](http://www.sciolis.com/) (accessed July 15, 2011).

- **Slyce**  
PIZZA BAR  
...  
Welcome to Slyce Pizza Bar, proudly serving the area's finest stone-baked pizzas and top-shelf cocktails. Come check us out. This ain't your daddy's pizzeria.

[www.slycepizzabar.com](http://www.slycepizzabar.com) (accessed July 15, 2011).

- **aperiTIVO**  
PIZZA BAR  
Aperitivo's Pizza Bar is an Italian, family restaurant conveniently located in Midtown Manhattan. We are known by our loyal locals as simply "TIVO". We serve New York City's Best Pizza. ...

www.aperitivonyc.com (accessed July 12, 2011).

Based on this evidence, the examining attorney maintains that PIZZA BAR is used by others in the restaurant business “simply to indicate that they serve both alcoholic beverages and pizza.” Exam. Att. Br. at 7–8. We agree. The establishments in the examining attorney’s internet evidence (with the possible exception of *Boca’s Best*) all offer pizza and alcoholic beverages. There is no indication from this evidence that the terms PIZZA and BAR, used together in this manner carry anything but their usual meaning, or that potential customers would view PIZZA BAR as a distinctive indicator of source. Because applicant’s services — identified as “restaurant and bar services” — include the services of establishments which offer pizza and alcoholic beverages, “PIZZA BAR” is merely descriptive of them.

Applicant argues that its mark is “unitary because consumers view Applicant’s STELLA ROSSA PIZZA BAR [mark] at once and in its entirety; therefore, the mark’s display and visual impression creates a unitary whole.” App. Br. at 12. Applicant has applied an incorrect test. The fact that the relevant public would view a mark “at once and in its entirety” has nothing to do with whether a mark is unitary. (Under applicant’s theory, virtually all trademarks would be considered unitary.) To the contrary, a mark (or a part of it) is unitary “if the elements are so merged together that they cannot be regarded as separable elements.” *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981). Elements can be joined physically, *e.g. In re Uniroyal, Inc.*, 215 USPQ 716, 719 (TTAB 1982) (FIRSTIER for banking services), or conceptually, *e.g., In re Symbra’ette, Inc.*, 189 USPQ 448 (TTAB 1975)

(SHEER ELEGANCE for panty hose), but they must be joined together in some way with the other elements said to form a unit.

Here, applicant's mark is STELLA ROSSA PIZZA BAR. Applicant argues that its mark is "suggestive of an Old World Italian-style restaurant where consumers may gather to enjoy a meal or socialize." But applicant has not offered any evidence of such a meaning, or any logical reason why the mark "cannot be regarded as separable elements." Applicant does not argue that the words "PIZZA BAR," when appended to "STELLA ROSSA" result in a different meaning than those two elements have individually, and it does not appear to us that it does. Nor are the words physically joined, for instance by hyphens or by the removal of separating spaces. Thus, applicant's mark is no more and no less than the sum of its parts, "STELLA ROSSA" and "PIZZA BAR."<sup>3</sup>

Seizing on some loose wording in the first Office action,<sup>4</sup> applicant argues that "PIZZA BAR" is not generic. That is, of course, irrelevant. Under Trademark Act § 6, the Director may require disclaimer of an unregistrable component of a mark. Terms which are merely descriptive under Trademark Act § 2(e)(1) are unregistrable, and therefore must be disclaimed. Terms which are generic are also unregistrable, and must be disclaimed. But while all generic marks are merely descriptive, not

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<sup>3</sup> To be clear, it does not appear that "PIZZA BAR" is a unitary element in and of itself, but that's irrelevant for our purposes, since that phrase is descriptive, whether unitary or not.

<sup>4</sup> In her first Office action, the examining attorney required a disclaimer of "the descriptive wording 'PIZZA BAR'...." However, after discussing her evidence, she concluded that "the wording is generic for applicant's bar and restaurant services...." Office action (July 15, 2011). In her final Office action, the examining attorney again required a disclaimer of "the descriptive wording," and concluded that "PIZZA BAR" is "descriptive and/or generic for applicant's services...." Final Ofc. Action (Feb. 2, 2012).

all merely descriptive marks are generic. And because genericness is much harder to prove than descriptiveness, it is both unnecessary and unwise to set the bar at genericness when a showing of descriptiveness is all the law requires.<sup>5</sup>

Nonetheless, the examining attorney correctly stated the applicable legal standard throughout prosecution (and in her brief), and we understand her mention of “PIZZA BAR” as being generic (in the first Office action) or “descriptive and/or generic” (in the final) to be nothing more than an assertion that she had more than enough evidence to meet the descriptiveness standard. Accordingly, we have considered whether a disclaimer is required as a question of descriptiveness, not genericness. While the examining attorney’s terminology was unfortunate, we very much doubt that applicant’s experienced trademark counsel was in any way misled.

Finally, applicant argues — without citation to authority — that PIZZA BAR “cannot have a denotative meaning” because counsel could not find the phrase in a dictionary. Applicant’s assertion is not merely unsupported; it is indisputably contrary to clear and long-standing precedent holding that the absence of a word or phrase from the dictionary is *not* determinative of whether it is descriptive or even generic, although again, none of these authorities was cited. *E.g.*, *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111–12 (Fed. Cir. 1987); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005); *In re Planalytics Inc.*, 70 USPQ2d 1453, 1456

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<sup>5</sup> Applicant here seeks registration on the Principal Register. Disclaimer practice is different with respect to marks on the Supplemental Register, which allows registration of merely descriptive matter, so long as it is “capable of distinguishing applicant’s goods or services.” See Trademark Act § 23. Thus, for applicants seeking registration on the Supplemental Register, a disclaimer is only required if a component of the mark is *incapable* of becoming a trademark, *e.g.*, generic. *In re Carolyn’s Candies, Inc.*, 206 USPQ 356, 359–60 (TTAB 1980).



(TTAB 2004); *In re Mine Safety Appliances Co.*, 66 USPQ2d 1694, 1696 (TTAB 2002); *In re Zanova Inc.*, 59 USPQ2d 1300, 1305 (TTAB 2001); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977); see TRADEMARK MANUAL OF EXAMINING PROCEDURE, (TMEP) § 1209.03(b) (Oct. 2012); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §§ 11:20 n.3, 11:29, 11:69 (4th ed. Updated March 2013).

We therefore conclude that “PIZZA BAR” is merely descriptive of applicant’s identified services, and must accordingly be disclaimed.

## **II. Likelihood of Confusion**

### **A. 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).

## **B. Discussion**

### **1. The Similarity or Dissimilarity and Nature of the Goods or Services**

Applicant's services are identified as "restaurant and bar services," while the cited registrant's services are "restaurant and tavern services." Applicant's "restaurant ... services" are obviously legally identical to the same services recited in the cited registration. Moreover, it is clear that applicant's "bar services" are likewise identical or overlap with the registrant's "tavern services." The examining attorney submitted definitions of "tavern" as "a place where liquors, beer, etc. are sold to be drunk on the premises; saloon; bar," Your Dictionary.com (available at [www.yourdictionary.com/tavern](http://www.yourdictionary.com/tavern) (accessed July 15, 2011)); *see also* Wordsmyth *tavern* (available at <http://www.wordsmyth.net> (accessed July 15, 2011)); Cambridge Dictionaries Online (available at <http://dictionaries.cambridge.org/> (accessed July 15, 2011)). We conclude that the registrant's identified "tavern services" are identical — at least in part — to applicant's "bar services."

Applicant's services are identical (at least in large part) to the services in the cited registration. This factor favors a finding that confusion is likely.

### **2. The similarity or dissimilarity of Established, Likely-to-Continue Trade Channels**

The fact that applicant's services are identical to those of the cited registration also means that we must assume that purchasers and channels of trade for such services are also 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 Viterro 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).

This factor also favors a finding that confusion is likely.

### **3. 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. While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

#### **a. Appearance and Sound**

Applicant’s mark is STELLA ROSSA PIZZA BAR in standard characters. The

mark in the cited registration comprises the words RED STAR TAVERN and a five-pointed star, with a thin line separating RED STAR and TAVERN, all inside a rectangular “carrier.” The words are displayed in an ordinary roman serif font.<sup>6</sup>

Because applicant seeks registration of its mark in standard characters, the application is not limited to any particular stylization of the mark. Trademark Rule 2.52(a). We must therefore assume that applicant’s mark could be used in any manner, *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258–59 (Fed. Cir. 2011) (standard-character mark not limited to “reasonable” display), including the same font, color, or size letters as that used by the prior registrant. But as far as appearance goes, that is the extent of the similarities between the marks at issue; they otherwise share no common wording or design.

We also conclude that the marks do not sound alike in any meaningful way. Although STELLA ROSSA begins with the same two letters as RED STAR, the words are switched in order, and — unlike some foreign words and their translations — STELLA ROSSA and RED STAR are not otherwise similar in spelling or pronunci-

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<sup>6</sup> The mark in the prior registration includes a design element — a plain five-pointed star — although we need not consider it at length. While the star adds a visual component lacking in applicant’s mark, it is simply the graphic equivalent of the word STAR, which is part of the wording in the prior mark. As such, the star design does not significantly alter the meaning or the commercial impression of the words in the cited mark. “[A] picture and the word that describes that picture are given the same significance in determining likelihood of confusion.” *In re Rolf Nilsson AB*, 230 USPQ 141, 142 (TTAB 1986) (citing *In re Serac, Inc.*, 218 USPQ 340 (TTAB 1983)).

Likewise, we will not discuss further the rectangular carrier and internal separator line in the cited registration. While part of the mark, they are very unlikely to be perceived as source-indicators and do little to distinguish the marks. *In re Dixie Rests. Inc.*, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (ordinary geometric background shapes of little significance); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1885 (TTAB 2011) (plain square carrier design is “of little significance”).

ation. The examining attorney does not disagree, conceding that the marks are different in appearance as well as sound. Ex. Att. Br. at 13 (unnumbered).

**b. Similarity in Meaning — Doctrine of Foreign Equivalents**

In considering the meaning of the marks, we return to our finding that PIZZA BAR, as it appears in applicant’s mark, is merely descriptive of applicant’s services. While descriptive, generic, or otherwise disclaimed matter is not removed from the mark, and we must consider the marks in their entirety, the “descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)). *See also In re N.A.D. Inc.*, 57 USPQ2d 1872, 1873–74 (TTAB 2000) (“[t]hese descriptive, if not generic, words have little or no source-indicating significance”). Similarly, the cited mark was registered with a disclaimer of TAVERN, most likely because it is descriptive of the registrant’s “tavern services.” While these descriptive elements remain part of the marks at issue, we must also recognize that they have little or no source-identifying capacity.<sup>7</sup> We accordingly consider STELLA ROSSA and RED STAR to be the dominant element in the respective marks.

The gravamen of the examining attorney’s argument on the similarity of the marks is her contention that STELLA ROSSA means RED STAR in Italian. *See*

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<sup>7</sup> As previously noted, BAR in applicant’s mark means essentially the same thing as TAVERN in the registrant’s. Although these terms are similar in meaning, because they are generic for the identified bar and tavern services respectively, their similarity in meaning does not make confusion more likely in any significant respect.

translations submitted as exhibits to the first Office action, Yahoo! Babel Fish, *red star* (available at [http://babelfish.yahoo.com/translate\\_txt](http://babelfish.yahoo.com/translate_txt) (accessed July 15, 2011)); Google Translate, *stella rossa* (available at <http://translate.google.com> (accessed July 15, 2011)). Applicant does not dispute the examining attorney's translation, but argues that the marks will not be considered to be equivalent by relevant purchasers.

Under the doctrine of foreign equivalents, foreign words from common, modern languages 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) (citations revised). Applicant argues that the doctrine should not be applied here because the examining attorney failed to show that Italian is “a language familiar to an appreciable segment of American consumers.” App. Br. at 4 (citing *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009)).

Citing the U.S. Census Bureau, the Examining Attorney points out that in 2005, 800,000 Americans spoke Italian, and that in 2011, 780,000 Americans spoke Italian. However, in doing so, the Examining Attorney noted that there are 52 million Americans that speak a language other than English and made of record that the total population in the United States is over 268 million people. *Id.* Thus, American individuals that speak Italian represent less than 1.5% of non-English speaking persons, and less than 3%<sup>[8]</sup> of the total U.S. population. Accordingly, the evidence does not support the Examining Attorney's conclusion that an appreciable amount of the U.S. population speaks Italian.

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<sup>8</sup> Actually, according to applicant's 2011 figures, Italian speakers comprise approximately .3% of the total United States population.

App. Br. at 4–5 (citation omitted).

We find that *Spirits International* is not applicable to this case as applicant argues. At issue in this case is the examining attorney’s refusal to register applicant’s mark on the ground that it is likely to cause confusion under Trademark Act § 2(d). By contrast, *Spirits International* arose from a refusal to register pursuant to Trademark Act § 2(e)(3), on the ground that the applicant’s mark was primarily geographically deceptively misdescriptive of the identified goods. The difference is significant.

In *In re California Innovations*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), the Federal Circuit held that amendments to the Trademark Act made pursuant to the United States’ adherence to the North American Free Trade Agreement (NAFTA), changed the standard by which registration may be refused under Trademark Act § 2(e)(3), on the ground that a mark is primarily geographically deceptively misdescriptive. The Court found that the effect of the NAFTA amendments was to make the standard by which registrability is considered under Trademark Act § 2(e)(3) consistent with the test for geographic deceptiveness under § 2(a). *Id.*, 66 USPQ2d at 1856. As a result, the Federal Circuit found that a post-NAFTA § 2(e)(3) refusal was appropriate only if—in addition to the previously-recognized test<sup>9</sup>—it could be shown that the applied-for mark would deceive poten-

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<sup>9</sup> Pre-NAFTA precedent held that a mark was primarily deceptively geographically misdescriptive if:

- (1) The primary significance of the mark is a known geographic location;
- (2) The goods or services do not come from the place identified in the mark;
- (3) Relevant purchasers are likely to believe—in incorrectly—that the geographic location

tial purchasers, *i.e.*, that the geographic misrepresentation of source would be a *material factor* in the consumer’s decision to purchase, as was already required for geographically deceptive marks under Trademark Act § 2(a).<sup>10</sup> *Id.* at 1857.

In *Spirits International* the Court of Appeals for the Federal Circuit again considered a refusal to register on the ground that the mark was primarily geographically deceptively misdescriptive, this time involving a mark with foreign wording. In doing so, the Court addressed a question left unanswered in *California Innovations*:

*California Innovations* did not address the question of whether the materiality test of subsection (e)(3) embodies a requirement that a significant portion of the relevant consumers be deceived. We hold that subsection (e)(3) does incorporate such a requirement, and that the appropriate inquiry for materiality purposes is whether a substantial portion of the relevant consumers is likely to be deceived, not whether any absolute number or particular segment of the relevant consumers (such as foreign language speakers) is likely to be deceived.

*Spirits Int’l*, 90 USPQ2d at 1493. The Court held that in the context of a refusal to register under Trademark Act § 2(e)(3), the third *California Innovations* factor—addressing the materiality of the geographic misdescription—requires that “the mark or advertising must deceive a *substantial portion* of the relevant consumers.”

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indicates the origin of the goods or services.

See *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889, 893 (CCPA 1982). *California Innovations* added a requirement:

- (4) The misrepresentation of origin would be a material factor in the consumer’s decision to purchase the goods or services.

*Cal. Innovations*, 66 USPQ2d at 1856–57.

<sup>10</sup> Geographically misdescriptive marks which acquired distinctiveness prior to the enactment of NAFTA remain registrable under Trademark Act § 2(f), but the exception is not applicable to applicant’s mark.



*Spirits Int'l*, 90 USPQ2d at 1495 (emphasis added) (citing *Johnson & Johnson \* Merck Consumer Pharms. Co. v. Smithkline Beecham Corp.*, 960 F.2d 294, 22 USPQ2d 1362, 1366 (2d Cir. 1992) (requiring deception of “a statistically significant part of the commercial audience”)). Thus, with regard to a refusal to register under Trademark Act § 2(e)(3), where the alleged deception depends on an understanding of foreign terms in the mark, it must be shown that a “substantial portion of the intended audience” would understand the foreign language at issue, before they could be deceived. *Id.* at 1496 (remanding to the Board to determine “whether Russian speakers were a ‘substantial portion of the intended audience’”).

Against this background, we conclude that the requirement in *Spirits International* that a “substantial portion of the intended audience” understand a foreign term used in a mark is a direct result of the requirement for materiality in Trademark Act § 2(e)(3), as modified by the NAFTA amendments, and as interpreted in *California Innovations*. *Spirits International* clearly did not make the “materiality” standard applicable to any and all cases involving the doctrine of foreign equivalents. To the contrary, it was the materiality requirement which distinguished the pre- and post-NAFTA interpretations of what is now Trademark Act § 2(e)(3), so it would be illogical to conclude that the standard embodied in that requirement now applies to § 2(d) or other subsections of Trademark Act § 2(e), when they were not affected by the NAFTA amendments. Indeed, the Court in *Spirits International* explicitly recognized that “[t]here are cases applying the doctrine of foreign equivalents somewhat differently in other contexts,” and cautioned that it was addressing

“only subsection (e)(3) and its materiality requirement.”<sup>11</sup> *Spirits International*, 90 USPQ2d at 1495 n.5 (“We have no occasion here to decide the scope of the doctrine of foreign equivalents in other contexts.”). We therefore decline to extend the holding in *Spirits International* to other applications of the doctrine of foreign equivalents.

Accordingly, we have no need to determine in this likelihood of confusion case whether Italian is familiar to an “appreciable segment of American consumers,” as applicant urges. App. Br. at 4. For it is well-established that in considering descriptiveness, genericness, or likelihood of confusion, the doctrine of foreign equivalents applies to “words from common, modern languages.” *La Peregrina*, 86 USPQ2d at 1647–48 (citing *Palm Bay*, 73 USPQ2d at 1696). Historically, the doctrine of foreign equivalents has been applied to Italian in a number of cases with little or no discus-

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<sup>11</sup> In fact, it is not clear whether the *Spirits International* panel could have more broadly reinterpreted the doctrine of foreign equivalents as applicant urges. As the panel recognized, the doctrine of foreign equivalents had been applied a number of times by prior panels of the Court of Appeals for the Federal Circuit, and by its predecessor, the Court of Customs and Patent Appeals. See *Spirits Int’l*, 90 USPQ2d at 1495 n.5. To the extent that *Spirits International’s* treatment of foreign equivalents is in conflict with the interpretation of the Court of Customs and Patent Appeals or of a prior panel of the Federal Circuit, the prior decision is controlling precedent and must be followed. *South Corp. v. United States*, 690 F.2d 1368, 215 USPQ 657, 657 (Fed. Cir. 1982) (*en banc*) (prior holdings of CCPA adopted as binding precedent); *Mother’s Rest. Inc. v. Mama’s Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 400 (Fed. Cir. 1983) (precedential holdings of a prior panel of the Federal Circuit are binding on subsequent panel unless overruled *en banc*). See also *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009) (TTAB erred in interpreting a Federal Circuit decision in a way that put it in conflict with prior circuit precedent). The panel deciding *Spirits International* was not itself bound by prior precedent because it was interpreting the subsequent NAFTA amendment. But that amendment was narrow, concerning only marks which are primarily deceptively geographically misdescriptive. The remainder of Trade-mark Act § 2 was unaffected by NAFTA and, except to the extent of the amendment, there is no reason to assume that prior precedent is inapplicable.

sion of how many Americans speak the language.<sup>12</sup> But to the extent there is any question, the examining attorney's evidence is more than sufficient to establish that Italian is a common, modern language. App. Br. at 4–5 (citing the examining attorney's evidence that 780,000 Americans spoke Italian in 2011); *accord In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1310 (TTAB 2006) ("There is no question that Russian speakers living in the United States, according to the record approximately 706,000 in number, would immediately know that BAIKALSKAYA means 'from Baikal.'"). Thus it was unnecessary for the examining attorney to show that a certain percentage of relevant consumers are fluent in Italian or to otherwise satisfy the "materiality" standard discussed in *Spirits International*.<sup>13</sup>

Of course, the doctrine of foreign equivalents is not unlimited, and it is not an absolute rule. In particular, it should only be applied "when it is likely that the ordinary American purchaser would 'stop and translate [the word] into its English

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<sup>12</sup> *E.g.*, *Bart Schwartz Int'l Textiles, Ltd. v. Fed. Trade Comm'n*, 289 F.2d 665, 129 USPQ 258, 260 (CCPA 1961) ("There is no question but that the Italian word "fiocco" is descriptive of "spun rayon" and as such is subject to the general rule that a descriptive word in a foreign language cannot be registered in the United States as a trademark for the described product."); *In re Isabella Fiore LLC*, 75 USPQ2d 1564 (TTAB 2005) (refusal to register FIORE on the ground that it is a surname reversed because "fiore" means "flower" in Italian); *In re Ithaca Indus., Inc.*, 230 USPQ 702, 704–05 (TTAB 1986) ("What applicant, in effect, is arguing is that the doctrine of 'foreign equivalents' is not applicable where the foreign word is in Italian. There is no support for this proposition and it does not require any authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States."); *In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB 1985); *In re E. Martinoni Co.*, 189 USPQ 589 (TTAB 1975); *In re Zazzara*, 156 USPQ 348, 348 (TTAB 1967).

<sup>13</sup> Although the doctrine of foreign equivalents is not usually applied to dead or obscure languages, *see Gen. Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 45 USPQ2d 1481, 1492 (SDNY 1997) ("It seems doubtful that prospective purchasers of COHIBA cigars ... would make the association between the mark and a word in a language spoken by the indigenous population of the Dominican Republic."), it is clear that Italian is neither.

equivalent.” *Palm Bay*, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)).

Here, applicant’s mark is STELLA ROSSA PIZZA BAR. Applicant does not dispute that the direct and literal translation of STELLA ROSSA is “red star,” but that does not necessarily mean that relevant purchasers will “stop and translate” the term. As noted above, we find that PIZZA BAR is merely descriptive of applicant’s services, and thus entitled to little weight in comparing the marks. Nonetheless, we must consider applicant’s mark as a whole, and the fact that applicant’s mark comprises both Italian and English words makes it less likely that the STELLA ROSSA part of applicant’s mark will be translated by consumers—even those consumers who speak Italian. That is especially true here because STELLA ROSSA gives the impression of a woman’s name used in English, rather than an arbitrary Italian phrase. App. Br. at 5. We take notice of the fact that “Stella” is a female given name,<sup>14</sup> and when preceded by a given name, “Rossa” could plausibly be taken to be a surname.<sup>15</sup> For potential purchasers considering the mark in this light, STELLA ROSSA PIZZA BAR has the connotation of an establishment serving pizza and drinks, and named after its proprietor. Because the commercial impression of applicant’s mark is at least as likely to evoke the notion of a woman’s name, even those

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<sup>14</sup> “Stella *noun* ... 3. a female given name: from a Latin word meaning ‘star.’” DICTIONARY.COM UNABRIDGED (based on the RANDOM HOUSE DICTIONARY (2013)), available at <http://dictionary.reference.com/browse/stella> (accessed May 16, 2013)). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

<sup>15</sup> There is admittedly no evidence of record that ROSSA is a surname, but the question here isn’t whether ROSSA *is* a surname, only whether people might believe it to be.

familiar with the Italian meaning of the words would be somewhat less likely to translate them than to think of a person's name, rather than an arbitrary phrase in a foreign language.

But even to the extent that potential purchasers would translate STELLA ROSSA as “red star,” it is important to note that the doctrine of foreign equivalents is not conclusive. It is just one way of understanding the meaning of a mark, which is in turn only one of the considerations used in determining the similarity of the marks as a whole. “[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.” *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (quoting *Sure-Fit Prods. v. Saltzson Drapery Co.*, 254 F.2d 158, 160, 117 USPQ 295, 297 (CCPA 1958)).

In this case, applicant's mark and that of the cited registrant are markedly different in sound and appearance. But while the examining attorney argues that the marks have similar meanings by application of the doctrine of foreign equivalents, when the marks are compared in terms of their appearance, sound, meaning, and commercial impression, we find them to be rather dissimilar. Their only similarity — the Italian translation of “STELLA ROSSA” in applicant's mark and the words “RED STAR” in the prior registration — is unlikely to prompt potential customers to believe that the services rendered in connection with the respective marks share a common source.

### **C. Balancing the Factors**

Despite our findings that applicant and the prior registrant identify identical

services (in part), and thus share identical purchasers and channels of trade, we find the marks too dissimilar to support a finding of likelihood of confusion. While all of the relevant *du Pont* factors must be weighed in reaching our decision, the similarity of the marks is the *sine qua non* of likelihood of confusion. Although the degree of similarity necessary to support a finding of likelihood of confusion declines when the marks would be used in connection with identical services, *Hunt Control Sys. Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558 (TTAB 2011) (citing *Century 21 Real Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)), the elasticity of the *du Pont* factors only goes so far. Without some meaningful similarity between the marks at issue, other factors cannot make up the deficit. “Not all of the *du Pont* factors are necessarily ‘relevant or of equal weight in a given case, and any one of the factors may control a particular case.’” *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011) (quoting *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003)) (affirming the Board’s conclusion that confusion was not likely when marks were dissimilar despite identical or highly similar services, customers, and channels of trade); see *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012).

### **III. A Translation Statement is Required**

The examining attorney required applicant to amend its application with an acceptable translation of STELLA ROSSA. Applicant has refused to do so<sup>16</sup>; its argu-

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<sup>16</sup> With its brief, applicant has submitted a conditional amendment, to be entered in the event that the examining attorney’s requirement is affirmed: “The English translation of

ment on the issue is stated in one sentence: “[i]n view of Applicant’s foregoing remarks regarding the doctrine of foreign equivalents, Applicant respectfully submits that a translation statement is not warranted.” App. Br. at 12. The examining attorney disagrees, noting that the applicable regulations require a translation of foreign wording as a requirement for a complete application. Trademark Rule 2.32(a)(9). Ex. Att. Br. at 9 (unnumbered). Applicant’s position confuses the doctrine of foreign equivalents with the requirement for a translation, and incorrectly assumes that if the doctrine of foreign equivalents does not apply, a translation is unnecessary. To the contrary, one is not dependent on the other. Application of the doctrine of foreign equivalents is a matter of substantive trademark law, while the requirement for translation of the wording in the mark is an administrative requirement for registration.<sup>17</sup>

Why would the rules explicitly require a formal translation to be inserted in the application when the examining attorney already knows the translation, or if it is ultimately determined not necessary for examination? Because the meaning of words is of critical importance in a trademark application, and that is true even if *ex*

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‘STELLA ROSSA’ in the mark is ‘RED STAR.’” App. Br. at 12 n.3.

<sup>17</sup> In addition, the examining attorney has the authority to require an applicant to provide such information “as may be reasonably necessary to the proper examination of the application,” Trademark Rule 2.61(b), including information about the significance of foreign wording in the mark. While Trademark Rules 2.61(b) and 2.32(a)(9) appear similar to that extent, they serve different purposes. Rule 2.61(b) allows the examining attorney to request information in the hands of the applicant which may be useful for examination. By contrast, Rule 2.32(a)(9) requires a formal amendment to the application to insert a translation, which will become part of (and will be printed on) any registration certificate which may issue to applicant, for the benefit of those considering the scope of rights in such a registration. The requirement for a translation of foreign wording applies even if—as in this case—there is no question about the meaning of the words in the mark, and even if the information is not “reasonably necessary to ... examination of the application.”

*parte* examination does not result in a refusal of registration based on that foreign wording. A translation made part of the application by amendment is public notice of the meaning of the words in the applied-for mark. Although applicant suggests that a translation statement is unnecessary because the doctrine of foreign equivalents does not apply, that argument puts the cart before the horse: the translation of foreign wording in the mark must usually be considered before determining whether the relevant public would “stop and translate” it when considering the mark. Nor is the status of applicant’s mark finally settled by this appeal; our decision today does not prejudice the rights of those who may have grounds to oppose registration, or those who may petition to cancel any registration which may issue to applicant. And finally, if applicant’s mark is registered, the translation statement would allow third parties to assess the scope of applicant’s rights in the mark.<sup>18</sup>

Accordingly, even though there is apparently no controversy as to the exact translation of STELLA ROSSA in this case, and regardless of whether those words would be translated by prospective consumers, the examining attorney’s requirement for applicant’s submission of a translation for the record was appropriate.

#### **IV. Conclusion**

After careful consideration of the argument and evidence of record, we conclude that the mark in the subject application is not likely to cause confusion in view of the cited prior registration. The refusal to register under Trademark Act § 2(d) is

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<sup>18</sup> Of course we do not know the scope of rights applicant would have with respect to any subsequent applicant or user of, say, RED STAR PIZZA BAR for restaurant services. But consideration of the meaning of the words STELLA ROSSA in applicant’s mark is obviously relevant to that determination.



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accordingly reversed.

Because we find PIZZA BAR to be merely descriptive of applicant's identified services, we affirm the examining attorney's requirement for a disclaimer of those words. We accept applicant's conditional disclaimer, and the application will be amended to add the following statement:

No claim is made to the exclusive right to use "PIZZA BAR" apart from the mark as shown.

We likewise find that a translation of the foreign wording in the mark is required, and accept applicant's conditional amendment. The application will be amended to add the following statement:

The English translation of "STELLA ROSSA" in the mark is "RED STAR."

**Decision:** The refusal to register under Trademark Act § 2(d) is REVERSED. The requirement for a disclaimer is AFFIRMED, and the requirement for a translation of the foreign wording in the mark is AFFIRMED. In light of applicant's amendments, the application will be forwarded for publication.