

**This Opinion is Not a
Precedent of the TTAB**

Mailed: June 18, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Gamila Company
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Serial No. 85748352
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Milena S. Mishev and Peter D. Aufrichtig of McCarthy Fingar LLP,
for Gamila Company

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Before Mermelstein, Wellington and Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Gamila Company (“Applicant”) seeks registration on the Principal Register of
the mark IMPRESS (in standard characters) for:

aerated beverage making machines; coffee extracting
machines; non-aerated beverage making machines in
International Class 7; and

non-electric coffee makers; non-electric coffee pots; tea
infusers; tea pots; thermal insulated containers for food or
beverages in International Class 21.¹

¹ Application Serial No. 85748352 was filed on October 8, 2012, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

The Trademark Examining Attorney has 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 registered mark IMPRESSA, in typed format,² for "electric coffee machines, espresso coffee machines and automatic espresso coffee machines" in International Class 11.³

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

Evidentiary Issue.

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant submitted approximately 64 pages of evidence with its appeal brief. While most of the documents had been submitted during prosecution, several of the documents were not.⁴ Evidence submitted after an appeal is untimely and will not ordinarily be considered. Trademark Rule 2.142(d); 37 CFR § 2.142(d). Therefore, to the extent that the documents were not submitted prior to the appeal, they were not considered.

² Prior to November 2, 2003, standard character drawings were known as typed drawings. Trademark Manual of Examining Procedure § 807.03(i) (April 2014).

³ Registration No. 2695561 issued on March 11, 2003 and was renewed.

⁴ Documents filed with a Request for Reconsideration are considered filed during prosecution.

Likelihood of Confusion.

A. Comparison of the marks.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We start our analysis with the first du Pont factor, the similarity or dissimilarity of the marks IMPRESS in standard characters and IMPRESSA in typed format, which we determine by comparing them “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (*quoting du Pont*, 177 USPQ at 567). “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.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

As acknowledged by Applicant, the only difference between its mark and the cited mark is the additional letter “A” at the end of the cited mark. Applicant argues that its deletion of the letter “A” distinguishes its mark from Registrant’s making it dissimilar in appearance, sound and meaning. We disagree.

Applicant relies on a number of cases to support its argument. All of these cases can be distinguished from the current case. In *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), the only *similarity* between



the marks FROOT LOOPS and  was the first words, FROOT and FROOTEE (stylized). The *Kellogg* case is distinguishable since the only *difference* between the marks at issue in this case is the letter “A” at the end of the cited mark. With the exception of the letter “A,” the marks are identical.

The other cases upon which Applicant relies are infringement actions in which trade dress was an element taken into consideration by the Courts when determining the similarity between the marks. For example, in *McGregor-Doniger, Inc. v. Drizzle Inc.*, 599 F.2d 1126, 202 USPQ 81, 89 (2d Cir. 1979), the Second Circuit affirmed the District Court’s finding that

[t]he setting in which a designation is used affects its appearance and colors the impression conveyed by it. Thus while observing that the typewritten and aural similarity of the two marks “approaches identity,” the district judge noted that the contexts in which the respective marks are generally presented reduces the impact of this similarity. The court observed that the

label in each Drizzler jacket prominently features the McGregor name, which is printed in striking plaid letters.

Similarly, in *H. Lubovsky, Inc. v. Esprit de Corp*, 627 F.Supp 483, 228 USPQ 814, 817 - 818 (SDNY 1986), the District court found that

Likelihood of source confusion from parties' contemporaneous use of "Esprit" mark is diminished in light of parties' differences of presentation, of merchandise (shoes/clothes), of style, of clientele, of marketplace, and of image, with plaintiff's logo being in stylized semi-script that suggests calligraphy of high-fashion design, and defendant's being modern, broken stencil block print.⁵

And, in *Vitarroz Corporation v. Borden, Inc.*, 644 F.2d 960, 209 USPQ 969, 976-977 (2d Cir. 1981), the Second Circuit affirmed the District Court, stating

The Court's finding that the marks are virtually identical is not disputed. We agree with the District Court, however, that the potential for confusion inherent in the similarity of the marks is reduced by the differing contexts in which the marks are presented. Vitarroz's cracker box subordinates the BRAVO'S mark to the VITARROZ mark, which appears to be the only mark of any commercial significance to Vitarroz or its special market. Likewise, Borden's chips bag prominently displays both the BORDEN mark and the familiar Wise owl, and these marks probably have a greater significance for snack food customers than the name BRAVOS. When similar marks are always presented in association with company names, the likelihood of confusion is reduced.

In this case, the marks at issue are word marks. "Ordinarily, for a word mark we do not look to the trade dress, which can be changed at any time." *Vornado, Inc. v.*

⁵ In the *Lubovsky* case, the Court found that Esprit de Corp. infringed on Lubovsky's ESPRIT mark with respect to shoes, however, because of extrinsic factors did not find likelihood of confusion between Esprit de Corp.'s use of its mark in connection with clothing.

Breuer Electric Mfg. Co., 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968). *See also Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984).

Applicant also relies on several Board cases, i.e., *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS as applied to shoes has different connotation than PLAYERS as applied to men's underwear) and *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSSOVER as applied to ladies' sportswear has a different connotation than CROSS-OVER as applied to ladies' brassieres). In this case, however, the marks IMPRESS as applied to "aerated beverage making machines; coffee extracting machines; non-aerated beverage making machines; non-electric coffee makers; non-electric coffee pots; tea infusers; tea pots; thermal insulated containers for food or beverages" and IMPRESSA as applied to "electric coffee machines, espresso coffees machines and automatic espresso coffee machines" do not have different meanings or connotations. In fact, they may have identical or at least highly similar meanings because the English translation of the Italian word "impressa" is

Adjective: graven, carved, engraved; and

Verb: impress, imprint, engrave, print.

"babylon" (translation.babylon.com/Italian/to-English); Office Action dated April 9, 2013.⁶ Applicant argues that the doctrine of foreign equivalents does not apply

⁶ Applicant submitted a translation from the site "webtranslation.paralink.com/Italian-English-Translation/# which provides a translation from the "Babylon translator." Request for Reconsideration dated October 8, 2013. This translation of "impressa" only includes the

because “impressa” has more than one meaning in English⁷ and because “less than one-half of one percent of the population of the United States speaks Italian at home ... [it is] less likely that ordinary consumers would choose the Italian translation of ‘impress.’”⁸ (Appeal Brief, p. 9). This argument is irrelevant since the translation was not submitted by the Examining Attorney to establish that “impress” and “impressa” are foreign equivalents rather:

to bolster [the argument] that the applied-for mark, in addition to consisting in its entirety of the root word of the registered mark and carrying the impression of being an English version of registrant’s mark, shares the same meaning as applicant’s mark and may be interpreted by consumers as a translated version of registrant’s mark because IMPRESSA may be translated to mean IMPRESS.

In other words, the Examining Attorney is looking at the similarity of the root of both marks (IMPRESS) to establish that consumers may view the marks as having the same meaning, rather than relying on the fact that they may actually have the same meanings. Moreover, the marks are also highly similar in both sound and appearance.

adjectives (graven, carved, engraves) does not include any of the verbs (impress, imprint, engrave, print).

⁷ The doctrine of foreign equivalents may apply when there is more than one English translation for a foreign term. *See In re Perez*, 21 USPQ2d 1075, 1076 - 1077 (TTAB 1991).

⁸ The doctrine applies to words or terms from common, modern languages, which encompasses all but dead, obscure, or unusual languages. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). As has been found a number of times, Italian is a common, modern language. *E.g., 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.”). *See also Bart Schwartz Int’l Textiles, Ltd. v. Fed. Trade Comm’n*, 289 F.2d 665, 129 USPQ 258, 260 (CCPA 1961).

Accordingly, the first *du Pont* factor favors a finding of likelihood of confusion.

B. Comparison of the goods.

We turn next to the second *du Pont* factor and look at the relationship between the goods at issue. When determining the relationship of the goods,

[i]t is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers.

In re Total Quality Group Inc., 51 USPQ 1474, 1476 (TTAB 1999). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, ___ F.3d ___, 110 USPQ2d 1157, 1161 - 1162 (Fed. Cir. 2014). The goods set forth in the application are “aerated beverage making machines; coffee extracting machines; non-aerated beverage making machines; non-electric coffee makers; non-electric coffee pots; tea infusers; tea pots; thermal insulated containers for food or beverages,” and the goods set forth in the cited registration are “electric coffee machines, espresso coffees machines and automatic espresso coffee machines.” The question is whether these goods, *as identified*, are related.

To make this determination, we note that the goods need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken

belief that [the goods] emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). Evidence submitted by the Examining Attorney establishes that the goods are the type that emanate from the same source. For example,

- BODUM - products include: electric French press coffee makers, non-electric tea presses, travel mugs [thermal insulated containers] (Exhibit to Office Action dated February 6, 2013 (pages 9- 14) – www.bodum.com, accessed on February 5, 2013;
- FETCO - products include: electric brewers and thermal dispensers (Exhibit to Office Action dated February 6, 2013 (pages 19- 26) – www.fetco.com, accessed on February 5, 2013;
- CUISINART - products include: electric coffee makers, espresso makers and non-electric sparkling beverage makers [aerated beverage making machines] (Exhibit to Office Action dated February 6, 2013 (pages 27 - 29) – www.cuisinart.com, accessed on February 5, 2013;
- MELITTA - products include: auto drip coffee makers, espresso makers, and non-electric coffee makers (Exhibit to Office Action dated April 9, 2013 (pages 40 - 45) – www.shoponlinemelitta.com, accessed on March 7, 2013; and
- GEVALIA - products include: electric coffee makers and non-electric French presses (Exhibit to Office Action dated April 9, 2013 (page 50) – www.gevalia.com, accessed on March 7, 2013.

Moreover, some or all of the “non-electric coffee pots; tea infusers; [and] tea pots,” “aerated beverage making machines” and “thermal insulated containers for beverages” and the “electric coffee and espresso makers” are advertised on websites near each other. For example,

- Sur La Table sells electric coffee and tea makers, tea infusers, and travel press mugs (Exhibit to Office Action dated February 6, 2013 (pages 36 - 38) – www.surlatable.com, accessed on February 6 2013; and
- Williams-Sonoma sells electric coffee makers and grinders, and non-electric coffee makers, tea kettles and tea infusers (Exhibit to Office Action dated February 6, 2013 (pages 39 - 46) – www.williams-sonoma.com, accessed on February 6 2013.

Applicant submitted pages from the Bed Bath & Beyond website in an attempt to establish that manual coffee makers, while sold in the same stores as electric coffee makers, are sold in different departments. Exhibits 3 and 4 to Response to Office Action dated March 5, 2013 (pages 13 – 18) – www.bedbathandbeyond.com accessed on February 11, 2013. The documents reveal that on February 11, 2013, the results of a search of the “kitchen department” for the term “manual coffee” do not appear to include “electric coffee machines.” On the same date another search was conducted of the Bed Bath & Beyond website. This search was for the term “kitchen electronics.” The results consist of depictions of the following products: “Starbucks Verismo 580 Brewer,” “Ninja MEGA Kitchen System 1500,” and “Keurig Vue V700 Single Cup Home Brewing System.” It does not appear that Applicant submitted all of the relevant webpages, however; even if we accept the evidence for the proposition argued by Applicant, the evidence does not establish that the goods are not related. To the contrary, Applicant’s evidence shows that some of the marks for “manual coffee makers,” in particular, BODUM and MELITTA, are also used for “electric coffee makers.”

Accordingly, we find that the goods are related and the second *du Pont* factor favors a finding of likelihood of confusion.

C. Comparison of the channels of trade.

There are no restrictions to the channels of trade in either Applicant's identification of goods or the identification of goods in the cited registration. The evidence establishes that the type of goods identified (manual and electric coffee makers, tea infusers, espresso machines, and machines for making both aerated and non-aerated beverages) are sold in the same channels of trade, e.g., on-line retail stores selling kitchenware (Sur La Table, Williams-Sonoma and Bed Bath & Beyond).

Accordingly, we find that the channels of trade are at least in part identical and thus the third *du Pont* factor favors a finding of likelihood of confusion.

D. Sophistication of customers.

Applicant argues that "Registrant's coffee machines, which are "high-tech' sophisticated electric and automatic coffee machines,"⁹ and cost "from a couple of hundred to a couple of thousand dollars,"¹⁰ would be purchased by customers, who "take particular care in selecting an item."¹¹

As discussed, *supra*, we must determine the class of customers based on the identifications of goods in the application and the cited registration. *See In re Total*

⁹ Appeal Brief, p. 13.

¹⁰ *Id.*, at p. 14.

¹¹ *Id.*

Quality Group Inc., 51 USPQ 1474, 1476 (TTAB 1999); *Stone Lion Capital Partners*, 110 USPQ2d at 1161-1162. Since there are no restrictions in the identifications of goods in either the application or the cited registration, we must assume that both Applicant's and Registrant's goods include all goods of the type identified — not merely the more expensive items. Further, we must also assume that applicant's and the cited registrant's goods are sold to all of the usual purchasers of the type of goods identified — not just those who are knowledgeable, sophisticated, or careful purchasers. Applicant has provided no evidence that the goods identified in its application are not purchased by the same customers who purchase the goods identified in the registration. Nor has Applicant established that any of the customers are sophisticated.

The Examining Attorney has established that the foregoing goods are sold in the same outlets and are promoted next to each other on the same webpages. Moreover, the prices for the goods are similar. For example, on the Bodum website (www.bodum.com), the BODUM Electric French Press coffee maker was advertised for \$60 and the prices of BODUM tea presses ranged from \$20.00 - \$100.00 (Office Action dated February 6, 2014, pp. 9-11). Applicant bases its argument regarding the sophistication of the customers on the prices of the goods identified in the application and the cited registration. Since the goods are not expensive, this argument is not persuasive.

Accordingly, the fourth *du Pont* factor favors a finding of likelihood of confusion.

E. Conclusion.

We conclude, after considering all evidence and arguments bearing on the *du Pont* factors, including the evidence and arguments that we have not specifically discussed herein, that there is a likelihood of confusion between Applicant's mark IMPRESS for "aerated beverage making machines; coffee extracting machines; non-aerated beverage making machines" in International Class 7; and "non-electric coffee makers; non-electric coffee pots; tea infusers; tea pots; thermal insulated containers for food or beverages," and Registrant's mark IMPRESSA for "electric coffee machines, espresso coffees machines and automatic espresso coffee machines."

Decision: The refusal to register Applicant's mark IMPRESS is affirmed.