

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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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 Tri Vin Imports, Inc.

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Serial No. 86257453

Paulette R. Carey of Buchman Law Firm, LLP for Tri Vin Imports, Inc.

Sani Khouri, Trademark Examining Attorney, Law Office 110
(Chris A. F. Pedersen, Managing Attorney).

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Before Ritchie, Masiello, and Pologeorgis, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Tri Vin Imports, Inc. (“Applicant”) filed an application for registration on the Principal Register of the mark VINA DEL PASO in standard characters for “wines,” in International Class 33.¹ Applicant disclaimed the exclusive right to use VINA apart from the mark as shown. The application stated that “The English translation of ‘vina del paso’ in the mark is ‘vineyard of steps.’”

¹ Application Serial No. 86257453 was filed on April 21, 2014 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant’s *bona fide* intention to use the mark in commerce. Applicant subsequently filed a statement of use alleging January 2015 as the date of first use and first use in commerce.

The mark was published for opposition and, after the opposition period had run, Applicant submitted a statement of use under Trademark Act Section 1(d), 15 U.S.C. § 1051(d). The statement of use included an amendment of the mark to VINO DEL PASO and a specimen of use showing the mark in this new form. The Trademark Examining Attorney rejected the proposed amendment of the mark on the ground that it constituted a material alteration of the mark as originally filed; and refused registration on the ground that the mark on the specimen of use was not the mark for which Applicant sought registration,² thereby failing to comply with the requirements of Section 1(d). The Examining Attorney required Applicant to submit an appropriate specimen of use.³ Applicant, in response, argued that its amendment to the mark in the application should be deemed permissible, but did not submit any additional specimens of use.⁴ Ultimately, the Examining made his refusal final, and Applicant appealed to this Board. Applicant and the Examining Attorney have filed briefs.

Applicant argues that the USPTO should allow Applicant to amend the mark in its application to VINO DEL PASO, in order to match the specimen of use. The Trademark Rules allow an applicant to amend its mark “only if: ... The proposed

² 37 C.F.R. § 2.51(b) provides, “In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under § 2.76 or a statement of use under § 2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.”

³ Office Action of October 7, 2015.

⁴ As the Examining Attorney noted in his Office Action, withdrawal of a statement of use is not a permissible option for one in Applicant’s predicament. 37 C.F.R. § 2.88(f).

amendment does not materially alter the mark.” 37 C.F.R. § 2.72(b)(2). The rule further provides that “The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.” *Id.* “The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark.” *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997) (quoting with approval *Visa Int’l Serv. Ass’n v. Life-Code Sys., Inc.*, 220 USPQ 740, 743-44 (TTAB 1983)). “The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition; if republication is required, this indicates a material alteration.” *In re Thrifty Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1123 (Fed. Cir. 2001). If there are material differences between the published mark and the mark that is later substituted for it, potential opposers would have been deprived of proper notice of the proposed registration of the new mark. Also, as has often been stated, the addition of any element that would require a further availability search in the USPTO records generally will constitute a material alteration; however, this is merely one factor to be considered, and not necessarily a controlling factor. *In re Guitar Straps Online LLC*, 103 USPQ2d 1745, 1747 (TTAB 2012). The Board has observed that the question of whether republication is required and whether a new search is required are distinct questions. *Id.* at 1747 n.2.

Applicant has submitted a statement that VINA DEL PASO means “vineyard of steps.”⁵ The Examining Attorney has demonstrated that VINO is the Spanish word for “wine.”⁶ Applicant contends that VINO DEL PASO retains the essence of the original mark VINA DEL PASO, pointing out that VINO is a generic term and VINA is a descriptive term, so that “[t]he dominant portion of both marks is the same, creating the same commercial impression.”⁷ Applicant argues that “VINA and VINO have no trademark significance”;⁸ and that “both VINO and VINA are terms related to wine and the production thereof and both are common elements of trademarks for use on wine. Thus the overall commercial impression created by both terms is essentially the same when used on wine.”⁹

The Examining Attorney argues that the change in meaning from VINA to VINO “does indeed change the entire commercial impression of the marks”; and points out that an examining attorney would have to perform a new search “because the English translation of the words ‘vina’ and ‘vino’ ... are two different words with different meanings.”¹⁰ A complete availability search of the USPTO records would include a search for the English translation of any foreign words in the mark, because examining attorneys are expected to at least consider whether the foreign-

⁵ Application filed April 21, 2014. The record contains no other evidence of the meaning of the original mark.

⁶ Office Action of October 7, 2015.

⁷ Applicant’s brief at 1-2, 4 TTABVUE 5-6.

⁸ *Id.* at 3, 4 TTABVUE 7.

⁹ *Id.* at 2-3, 4 TTABVUE 6-7.

¹⁰ Examining Attorney’s brief, 6 TTABVUE 8.

language mark at issue is confusingly similar to any mark that is its English equivalent. *See* TMEP Section 1207.01(b)(vi) (January 2017).

The two marks at issue are highly similar in appearance, differing only by the substitution of a single vowel. However, we note that they are different in sound and meaning. Although Applicant contends that VINA means “vineyard,” the word “vina” does not appear in CASSELL’S SPANISH-ENGLISH DICTIONARY (1959).¹¹ What does appear in the dictionary is the word “viña,” whose definition is given as “vineyard.” *Id.* at 778. The pronunciation guide of the dictionary indicates that the letter ñ is pronounced “as in the English combination of *ni*, *ny* in *pinion*, *canyon*,” whereas the letter n is pronounced “as in English.” *Id.* at xiv (emphasis in original). Thus, to the extent that VINA is perceived as the Spanish word for “vineyard,” as Applicant contends, its pronunciation would be notably different from the pronunciation of “vino.”

With respect to the meaning of the marks, we have Applicant’s translation of the original mark as “vineyard of steps”; Applicant has not offered a translation of the entire amended mark. The Examining Attorney has shown that VINO means “wine” and contends, plausibly, that the meaning of the amended mark is “wine of steps.” We find that the meanings of the original mark and the amended mark differ substantially. “Vineyard of steps” suggests an agricultural site that is characterized by steps; by contrast, “wine of steps” is an incongruous expression.

¹¹ 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).

Applicant has not explained how the Board should interpret the amended mark. In overall commercial impression, the original mark gives the impression of a particular place, a vineyard with steps; while customers would understand the amended mark to mean wine (vino) that is associated in an arbitrary way with the term DEL PASO.

Because the two marks have different literal meanings and noticeably different pronunciation, we find that they do not create the impression of being essentially the same mark. Moreover, the publication of the mark VINA DEL PASO did not give adequate notice to potential opposers of the proposed registration of VINO DEL PASO. A competitor that did not use the term “vina” or “vineyard” in its mark might have believed that the inclusion of VINA in Applicant’s mark was sufficient to avoid confusing similarity. The same competitor would have to do a different analysis with respect to VINO DEL PASO, especially in view of the differences in meaning and pronunciation that arise from the substitution of VINO for VINA. Finally, as we have noted, the proper availability search for the amended mark would have differed from a proper search for the original mark. We therefore find that that amendment to the mark proposed by Applicant would entail a material alteration of the mark as originally filed.

The case of *In re Larios, S.A.*, 35 USPQ2d 1214 (TTAB 1995), in which the Board allowed substitution of the words VINO DE for the words GRAN VINO, is distinguishable. The mark in *Larios* was a complex “full label” mark that had many distinctive elements, including graphic designs and repeated use of the distinctive

terms LARIOS and MALAGA. The substituted words were in smaller typeface than the more distinctive wording of the mark, were visually a very minor part of the mark, and created only a slight difference in meaning. By contrast, Applicant's mark consists of only three words, and the proposed substitution results in a substantial change in the meaning and sound of the entire mark.

Applicant's proposed amendment to its mark constitutes a material alteration of the mark as originally filed and is impermissible under 37 C.F.R. § 2.72(b)(2). As Applicant may not amend its mark to match the mark on the specimen of use submitted with Applicant's statement of use, we affirm the Examining Attorney's refusal of registration on the ground that the mark on the specimen is not the mark for which Applicant has sought registration.

Decision: The refusal of registration under Section 1(d) is affirmed.