

This Opinion is Not a  
Precedent of the TTAB

Mailed: August 28, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Daboub and Giner*

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Serial No. 87351674

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John Alunit of Alunit IP,  
for Rolando Javier Siman Daboub and Ricardo Ramón Ernesto Gonzalez Giner.

Yocheved Bechhofer, Trademark Examining Attorney, Law Office 114,  
Laurie R. Kaufman, Managing Attorney.

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Before Wellington, Lykos, and Heasley,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Rolando Javier Siman Daboub and Ricardo Ramón Ernesto Gonzalez Giner  
("Applicants") seek to register on the Principal Register the composite mark displayed  
below for "preserved, frozen, dried, and cooked fruits" in International Class 29.<sup>1</sup>

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<sup>1</sup> Application Serial No. 87351674, filed February 27, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The portrait shown in the mark does not identify a particular living individual. As originally filed, the application included other goods in International Class 29. Insofar as the refusal did not apply to those goods, on February 14, 2018, Applicant filed a Request to Divide, which was granted on February 22, 2018. Those goods were moved to a separate application, Child Application Serial No. 87976902. See Trademark Rule 2.87; 37 C.F.R. § 2.87.



The colors green, light green, dark green, orange, red, white and black are claimed as a feature of the mark. According to the translation statement, “LA CHULA” means “the beautiful one” or “the show-off”. In the application, Applicants claimed ownership of two incontestable registrations, including Registration No. 3371547, which registered on January 22, 2008,<sup>2</sup> for the mark displayed below for various goods in International Class 29, including “fruit conserves.”<sup>3</sup>



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<sup>2</sup> Combined Section 8 & 15 affidavit accepted and acknowledged on March 18, 2014; renewed on January 22, 2018.

<sup>3</sup> The other prior registration claimed by Applicants is Registration No. 3377138 for the same composite mark for “rice, sauces, salad sauces” in International Class 30.

Unlike the applied-for mark, color is not claimed as a feature of Applicants' previously registered composite mark. The translation statement, however, is the same.

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicants' applied-for mark so resembles the registered mark on the Principal Register CHULA BRAND in standard characters (BRAND disclaimed) for "Fresh fruits and vegetables, namely, citrus, lemons, avocados, coconuts, papayas, pineapples" in International Class 31,<sup>4</sup> that it is likely to cause confusion or mistake or to deceive. According to the translation statement in the cited registration, "CHULA" means "sparkling."

When the refusal was made final, Applicant filed a notice of appeal which is now briefed.

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 Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012); and *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). "Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). There is no mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *du Pont*, 177 USPQ at 567.

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<sup>4</sup> Registration No. 5080567, registered on November 15, 2016.

As a general proposition, two key considerations are the similarities between the marks and the similarities between the goods, the first and second *du Pont* factors. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Insofar as the applied-for mark and cited mark share the dominant, arbitrary term LA CHULA, the marks overall are similar in sound, appearance, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). *See also In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999) (when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods; therefore, the word portion is normally accorded greater weight in determining whether marks are confusingly similar). This is so despite the different translation statements. In addition, the Examining Attorney has demonstrated that the involved goods are commercially related and may emanate from the same source by submitting excerpts from various third-party business-to-consumer (B2C) websites advertising for sale both Applicants' and Registrant's products under the same brand name.<sup>5</sup> *See Harry & David* offering for sale fresh "handpicked citrus" including mandarins and red grapefruits; a variety of dried fruits such as dried apricots, pineapples and

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<sup>5</sup> Applicants' reliance on *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) is inapposite here since that case involved a comparison of restaurants versus food and beverages. *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1061 (TTAB 2017) (quoting *In re Coors Brewing Co.*, 68 USPQ2d at 1063 ("the fact that restaurants serve food and beverages is not enough to render food and beverages related to restaurant services for purposes of determining the likelihood of confusion. Instead, ... 'to establish likelihood of confusion a party must show previous something more than that similar or even identical marks are used for food products and for restaurant services.'").

mangos; and marionberry preserves;<sup>6</sup> Dole offering for sale fresh fruit such as coconuts and avocados and preserved mixed fruit,<sup>7</sup> Earthbound Farm offering for sale navel oranges, lemons, and Valencia oranges as well as dried plums, dried mangos, and dried cranberries.<sup>8</sup> Typically, this would suffice to find a likelihood of confusion. However, in some instances, a single *du Pont* factor may be pivotal, and such is the case here.

The thirteenth and final *du Pont* factor pertains to “any other established fact probative of the effect of use.” *du Pont*, 177 USPQ at 567. Rarely invoked, this factor “accommodates the need for flexibility in assessing each unique set of facts....” *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012). This includes a variety of circumstances such as an applicant’s ownership of a previously registered mark. Where an applicant owns a prior registration that is over five years old and the mark is “substantially the same” as in the applied-for application, this can weigh against finding that there is a likelihood of confusion. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1748 (TTAB 2018) (citing *In re Strategic Partners Inc.*, 102 USPQ2d at 1399 (no likelihood of confusion found with the registered mark ANYWEAR BY JOSIE NATORI and design where the applicant’s previously registered mark ANYWEARS was substantially similar to the applied-for mark ANYWEAR for identical goods)). Applicants’ Registration No. 3371547 has been registered on the

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<sup>6</sup> January 4, 2018 Final Office Action at 6-7, 11-12. Citations to the prosecution history in the USPTO’s TSDR database are to the downloadable .pdf version. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018).

<sup>7</sup> May 24, 2017 Office Action at 6-7.

<sup>8</sup> *Id.* at 8-9.

Principal Register for over 10 years, meaning that it is impervious to a challenge under Section 2(d). *See* Trademark Act § 14, 15 U.S.C. § 1064. *Compare In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (finding “a key factual distinction from *Strategic Partners*” that applicant’s prior registration was less than five years old, making it still subject to a cancellation action by registrant based on likelihood of confusion). In addition, Applicants’ mark registered prior to the mark in the cited registration.

Applicants’ previously registered composite mark has no color claim, making it not only “substantially the same” as, but more importantly, legally identical to the applied-for mark. That is to say, Applicants are entitled to use their previously registered mark in the precise color scheme as claimed and depicted in the mark under current consideration. By logical extension, the mark at issue here does not “move [any] closer” to the mark in the cited registration. *Compare In re Inn at St. John’s, LLC*, 126 USPQ2d at 1748 (“In this appeal, Applicant’s applied-for mark — 5IVE STEAKHOUSE and design — moves closer to the cited registration — 5IVESTEAK and design — than the mark in Applicant’s prior registration — 5IVE RESTAURANT and design — rendering the new mark more similar in appearance, sound, and meaning to Registrant’s mark, which includes the word STEAK and does not include the word RESTAURANT.”). Furthermore, the goods in the cited registration consisting of “fruit conserves” are by their very nature highly related to, if not virtually identical to, the applied-for goods at issue here, “preserved, frozen,

dried, and cooked fruits.” The totality of these circumstances weigh in favor of finding no likelihood of confusion.

The Examining Attorney contends that the factual circumstances presented here are distinguishable from those in *In re Strategic Partners, supra*, inasmuch as in that case, the applicant’s prior registration had co-existed for at least five years with the cited registration, and that both registrations were immune from a petition to cancel based on the ground of likelihood of confusion. The Examining Attorney takes the position that these precise parameters must exist in order to successfully invoke the thirteenth *du Pont* factor to overcome an ex parte Section 2(d) refusal. In support thereof, the Examining Attorney cites to Section 1207.01 of the Trademark Manual of Examining Procedure (Oct. 2017) discussing the significance of *In re Strategic Partners*.<sup>9</sup> We have reviewed all of the Board’s decisions on this issue and do not interpret the application of the thirteenth factor so narrowly. Again, we emphasize that we must take into account all of the circumstances of a particular case, and in

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<sup>9</sup> According to TMEP § 1207.01:

The decision in *Strategic Partners* may be applied and weighed against a §2(d) refusal in the limited situation where: (1) an applicant owns a prior registration for the same mark or a mark with no meaningful difference from the applied-for-mark; (2) the identifications of goods/services in the application and applicant’s prior registration are identical or identical in relevant part; and (3) the applicant’s prior registration has co-existed for at least five years with the registration being considered as the basis for the Section 2(d) refusal. *See Id.* at 1400; *cf. In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (distinguishing *Strategic Partners* and finding that the 3½-year coexistence of applicant’s prior registration and the cited registration was a relevant consideration but did not outweigh the other relevant *du Pont* factors).

doing so, we have found that the fact that the cited registration is not over five years old is not fatal.

We have also considered the argument that prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Board. We agree with that legal principle. *See In re Davey Products Pty. Ltd.*, 92 USPQ2d 1198, 1206 (TTAB 2009). However, we conclude that under the unusual circumstances here, where the Applicants own a prior registration for essentially the same mark covering highly related, if not almost identical goods, and that prior registration cannot be challenged under Section 2(d), we must consider this in our likelihood of confusion analysis. Thus, even though the first and second *du Pont* factors weigh in favor of finding a likelihood of confusion, we find that the thirteenth factor outweighs them all, making confusion unlikely.

**Decision:** The Section 2(d) refusal to register Applicants' mark is reversed.