

Hearing:
February 6, 2008

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
May 13, 2008
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

American Italian Pasta Company

v.

Barilla Alimentare S.p.A.

Opposition No. 91161373
against Serial No. 78136703

Thomas H. Van Hoozer and Cheryl Burbach of Hovey Williams
LLP for American Italian Pasta Company.

G. Franklin Rothwell, Brian E. Banner and Carla C. Calcagno
of Rothwell Figg Ernst & Manbeck PC for Barilla
Alimentare S.p.A.

Before Walters, Bucher and Bergsman, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Barilla Alimentare S.p.A. (applicant) seeks
registration on the Principal Register of the mark **BARILLA –
AMERICA'S FAVORITE PASTA**, *in standard character format*, for
goods identified in the application as "pasta, pasta
products, namely meals consisting primarily of pasta,
macaroni salad, pasta salad, [and] sauces for pasta" in
International Class 30.¹

¹ Application Serial No. 78136703 was filed on June 18, 2002
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce. No claim is made to the words "America's
Favorite Pasta" apart from the mark as shown.

American Italian Pasta Company (opposer or AIPC) timely filed its opposition to the application. As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used marks which are the subjects of the following applications pending before the United States Patent and Trademark Office:

AMERICA'S FAVORITE PASTA (*in standard character format*) for "pasta" in International Class 30;² and



for "pasta" in International Class 30,³ as to be likely to cause confusion, to cause mistake or to deceive, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). In particular, opposer alleges that the goods are the same and

² Serial No. 76497489 was filed on March 14, 2003 based upon claims of first use anywhere and first use in commerce at least as early as September 1997. No claim is made to the word "Pasta" apart from the mark as shown. Applicant claims acquired distinctiveness for the entire mark.

³ Serial No. 76497190 was filed on March 14, 2003 based upon claims of first use anywhere and first use in commerce at least as early as May 2002. No claim is made to the word "Pasta" apart from the mark as shown. Applicant claims acquired distinctiveness for the words "America's Favorite Pasta." Both of these pending applications have been suspended pending the disposition of the instant Barilla application.

that applicant's mark is confusingly similar to opposer's marks.

As a second ground for opposition, opposer alleges that at the time applicant filed the opposed application, it did not have a *bona fide* intention, under circumstances showing the good faith of applicant, to use the mark in commerce.

Applicant, in its answer, denied all the salient allegations of these claims. Applicant has asserted as affirmative defenses that opposer's claimed term, "America's Favorite Pasta," is merely descriptive or deceptively misdescriptive, is incapable of acquiring distinctiveness as a trademark, and has not acquired distinctiveness as a trademark.

Applicant's earlier motion for summary judgment was granted in part as to the affirmative defense that the term "America's Favorite Pasta" is merely descriptive, but was denied in part as to the affirmative defenses that the term "America's Favorite Pasta" is incapable of acquiring distinctiveness as a trademark and has not acquired distinctiveness as a trademark. See Board order of July 11, 2006 at 10.

I. THE RECORD

By operation of Trademark Rule 2.122, 37 CFR § 2.122, the record includes the pleadings and the file of the involved application.

The record also includes the following testimony and evidence:

A. Opposer's Evidence

1. Opposer's Notice of Reliance filed on August 25, 2006, introducing into the record certified copies of third-party registrations containing the words "America's Favorite ..." and copies of the file wrappers of the four applications applicant filed on June 18, 2002;
2. Opposer's Notice of Reliance filed on November 13, 2006, introducing into the record certified copies of the applications and file histories of opposer's two pending applications [Ser. Nos. 76497489 and 76497190] discussed above; and a certified copy of applicant's U.S. Registration No. 2790465 for ITALY's #1 PASTA.
3. Opposer's Notice of Reliance filed on November 13, 2006, pursuant to Rule

- 2.120(j)(5), introducing into the record applicant's complete responses to opposer's interrogatories and requests for admission;
4. the testimonial deposition of Andrew John Lericos, vice president marketing, AIPC, taken on November 3, 2006, and exhibits thereto;
 5. the testimonial deposition of Anne Willoughby, President and CEO of Willoughby Design Group, taken on November 3, 2006, and exhibits thereto; and
 6. the testimonial deposition of Timothy Scott Webster, former president and CEO of AIPC from 1992 to December 2005, taken on November 9, 2006, and exhibits thereto.

B. Applicant's Evidence

1. Applicant's notice of reliance filed on January 12, 2006, introducing into the record the following:
 - a. Opposer's Answers to Applicant's First Requests for Admissions;
 - b. Opposer's Answers to Applicant's Second Requests for Admissions;
 - c. Opposer's Answers to Applicant's Third Set of Requests for Admissions Nos. 15-20;
 - d. Opposer's Answers to Applicant's Fourth Set of Requests for Admissions Nos. 21-37;

e. Opposer's Answers to Applicant's Fifth Set of Requests for Admissions Nos. 38-82;
f. Opposer's Supplemental Answers to Applicant's Fifth Set of Requests for Admissions Nos. 38-82;
g. Opposer's Answers to Applicant's First Set of Interrogatories;
h. Opposer's Answers to Applicant's Second Set of Interrogatories;
i. Opposer's Answers to Applicant's Third Set of Interrogatories;
j. Opposer's Answers to Applicant's Fourth Set of Interrogatories; and
k. Opposer's Confidential Attorneys' Eyes Only Supplemental Answers to Applicant's Fourth Set of Interrogatories.

2. the testimonial deposition of Sergio Pereira, vice president of marketing for Barilla America, taken on December 19, 2006, and exhibits thereto;
3. the testimonial deposition of Prof. Kenneth B. Germain, partner at Thompson Hine, LLP, taken on December 20, 2006, and exhibits thereto; and
4. the testimonial deposition of Joslyn Nicole Poquette, client services account manager for NameProtect, Inc., taken January 9, 2007, and exhibits thereto.

Consistent with the parties' protective agreement executed by the parties during November and December 2004 and filed with the United States Patent and Trademark Office

on February 7, 2005, both parties have designated testimony and evidence as confidential, and portions of some testimony and evidence have been filed with the TTAB under seal.

II. PRELIMINARY MATTERS:

Opposer has asked that the reports and testimony of Prof. Kenneth B. Germain be stricken from the record because they have no probative value to us in this proceeding. Prof. Germain proffered opinions related to the following issues: whether opposer's "America's Favorite Pasta" term has acquired distinctiveness; the overall credibility of opposer's witnesses; and whether or not BestFoods conveyed to opposer any interest it may have had in the "America's Favorite Pasta" term.

We do not look to the testimony of this highly-qualified expert for ultimate questions of law, nor, on the other hand, do we dismiss his judgments about the distinctiveness of opposer's claimed source-indicator because he is a frequently-used "hired gun." His testimony is admissible and has been considered, as reflected in our opinion herein.

Opposer has also asked that the testimony deposition of Joslyn Poquette, an investigator with NameProtect, be stricken from the record. Ms. Poquette was attempting to refute the impact of almost a hundred trademark

registrations having marks beginning with "AMERICA'S FAVORITE" Inasmuch as we find that such marks are generally capable of acquiring distinctiveness, while we have considered Ms. Poquette's testimony, we find it to be of limited probative value.

Conversely, applicant has asked that we give limited weight to the testimony and report of opposer's witness, Ann Willoughby. We accord her testimony the weight of an expert in the design aspects of product packaging and advertising. While we find Ms. Willoughby's timeline of Mueller's history to be useful as a context for the current dispute, we do not place significance on any single piece of this timeline not otherwise authenticated or corroborated in this record.

III. FACTUAL FINDINGS

The record establishes all of the following facts in this case.

- Opposer is the current owner of the Mueller's brand of pasta. Mueller's pasta products have been sold in the U.S. for over 140 years.
- The term "America's Favorite" first appeared on Mueller's pasta packaging in the mid-1950's. Opposer's predecessor-in-interest began using the expression "America's Favorite

Pasta" on promotional materials for the Mueller's line of pasta products at least as early as May 31, 1989.

- BestFoods, opposer's predecessor-in-interest, used "America's Favorite Pasta" on the packaging of Mueller's brand of dried pasta beginning in 1997. In September 1997, opposer became the exclusive producer of the Mueller's brand of pasta, and in November 2000, opposer purchased the Mueller's trademarks. In mid 2002, opposer incorporated Mueller's historic old "flag brand" symbol into a new composite design on the packaging, further emphasizing the "American-ness" of Mueller's pasta:



- Sellers of pasta in the U.S. market have devoted limited resources to media advertising.⁴ The focus for AIPC/Mueller's promotional efforts has been on the packaging, on aggressive coupon campaigns in major markets, and on the visual "brand block" on designing the shelves of retail markets. [Lericos Declaration, ¶¶ 5 and 6].

⁴ A notable exception for opposer has been the print and radio advertising campaigns featuring Rachel Ray, a famous television personality, who offers cooking tips using Mueller's pasta.

- Applicant filed the involved intent-to-use trademark application for BARILLA — AMERICA'S FAVORITE PASTA on June 18, 2002, motivated by its express desire to mark the fact that Barilla brand pasta products had become the highest selling brand of pasta in the United States. Applicant stated that it filed this application in order to "notify consumers that contrary to Mueller's false claim, Barilla was the leading brand of pasta in terms of market share in the United States." [Barilla's Response to Interrogatory No. 2, Opposer's Notice of Reliance, Ex. 219].
- At the insistence of the Trademark Examining Attorney, applicant disclaimed the term "America's Favorite Pasta" during the prosecution of its application.
- On the same date that the current application was filed, applicant filed three other intent-to-use applications covering the same goods: BARILLA — AMERICA'S PREFERRED PASTA; BARILLA — AMERICA'S #1 PASTA; and BARILLA — AMERICA'S BEST PASTA.⁵

IV. ANALYSIS

A. Standing

Opposer's standing is a threshold inquiry made by the Board in every *inter partes* case. In *Ritchie v. Simpson*,

⁵ On November 25, 2004, Barilla permitted its application for BARILLA —AMERICA'S BEST PASTA to go abandoned.

170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit has enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be (is) damaged by the registration is reasonable and reflects a real interest in the case. *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Opposer has submitted substantial evidence of its use for years of the term "America's Favorite Pasta." We consider this evidence as sufficient to establish opposer's interest and, therefore, standing in this proceeding.

B. Priority

The earliest date on which applicant can rely is the filing date of its application, June 18, 2002.

Opposer is not relying on a registration, and has admitted that the term "America's Favorite Pasta," is not inherently distinctive. Based upon all of the evidence in this record, we find that, at best, the term "America's Favorite Pasta," in all three of the marks involved herein, is merely descriptive when used in connection with pasta and pasta products. Accordingly, with respect to opposer's pleaded common law use of the term "America's Favorite Pasta," opposer's claim of priority turns upon opposer's

demonstrating that this term had acquired distinctiveness prior to June 18, 2002, when applicant filed its intent-to-use application for **BARILLA – AMERICA’S FAVORITE PASTA**.

Perma Ceram Enterprises Inc. v. Preco Industrial Ltd.,
23 USPQ2d 1134, 1136 (TTAB 1992).

C. Is the term “America’s Favorite Pasta” capable of achieving trademark significance?

Applicant has taken the position that the term “America’s Favorite Pasta” is incapable of acquiring distinctiveness as a trademark. While opposer does not dispute that this term is a generally laudatory phrase, laudation does not *per se* prevent a mark from being registrable. See *In re Bush Brothers & Co.*, 884 F.2d 569, 12 USPQ2d 1058, 1060 (Fed. Cir. 1989).

In some cases, a phrase or slogan can be so highly laudatory and descriptive as to be incapable of acquiring distinctiveness as a trademark. *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) [THE BEST BEER IN AMERICA was a common claim of superiority used descriptively by others before applicant’s claimed usage]. However, we do not find “America’s Favorite Pasta” to be so highly laudatory and descriptive of the qualities of opposer’s product that the slogan could not function as a trademark to distinguish AIPC’s goods and serve as an indication of

origin. Although the record contains a reference to a book having a similar title, the record does not show that this is a common phrase used descriptively by others. Moreover, opposer's use of the word "Favorite" in the context of this phrase cannot be said to be a clear claim of superiority. Unlike THE BEST BEER IN AMERICA, the phrase involved herein is a bit more ambiguous, and could be perceived by some as indicating that the involved manufacturer leads in sales, to others that it is a national brand, and to yet others that people prefer it because of its taste, or other positive characteristics. See *American Italian Pasta Co. v. New World Pasta Co.*, 371 F.3d 387, 71 USPQ2d 1046 (8th Cir. 2004) [in a false advertising claim under Section 43(a) of the Trademark Act of 1946, the appellate court affirmed the district court's finding that the phrase "America's Favorite Pasta" standing alone is not a statement of fact].

In fact, opposer has demonstrated through dozens of third-party registrations that the Supplemental Register is home to a myriad of composite marks containing an identical construction, i.e., "America's Favorite"

D. Has opposer demonstrated acquired distinctiveness as of June 18, 2002?

Certainly, no opposition based upon Section 2(d) of the Lanham Act can be sustained unless the opposer has proven that the allegedly conflicting trademark actually identifies it as the source of the goods. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44-45 (CCPA 1981). Accordingly, the most critical and hotly-contested issue before us is whether or not opposer has demonstrated that the term "America's Favorite Pasta" had acquired distinctiveness as a source indicator prior to the time applicant filed the involved application. Having found that this term is indeed capable of acquiring distinctiveness as a trademark, we turn, then, to take a closer look at all of the evidence in the record bearing on this question.

In order to place the voluminous evidence making up this record into context, we search for the historical and marketing background of these pasta-makers. The record shows that applicant and opposer are industry leaders in the retail pasta market in the United States. This litigation represents the latest chapter in the "pasta wars" in this country dating back at least to the early 1980's. Employing martial language, opposer AIPC/Mueller cites to applicant Barilla's "calculated attack on AIPC's trademark rights," while applicant Barilla points to opposer AIPC's/Mueller's

continuing "false claim" of being the leading pasta brand in the U.S.

Opposer is a vertically-integrated U.S. firm having several decades in the domestic pasta-making business. In late-2000, opposer became the owner of the Mueller's trademarks. Its "Muellerland" area of retail sales is largely in the portion of the country located east of the Mississippi River.

In the mid-1990's, Barilla, a leading Italian pasta-making company, entered the U.S. market in a big way, including establishing a large manufacturing plant in the Midwest. Unlike Mueller's, Barilla sells pasta in the U.S. from coast-to-coast.

Over the past dozen years, the competition between the parties for market share has been intense. Before the dawn of the new century, Barilla appears to have passed Mueller's earlier share as market-leader in the U.S., and it was several years after achieving this level of market penetration that Barilla submitted four different intent-to-use trademark applications on the same day in June 2002:

BARILLA — AMERICA'S PREFERRED PASTA, BARILLA — AMERICA'S #1 PASTA, BARILLA — AMERICA'S BEST PASTA and BARILLA — AMERICA'S FAVORITE PASTA.

When the involved application was published for opposition, opposer brought the current action.

Having been imbued with the "American-ness" of the Mueller's tradition, opposer stresses the marketing gestalt into which its posture in June 2002 should be viewed. Its branding expert points out the continuity from a flag design on Mueller's pasta (1914) to the present stars-and-stripes design; the decades of continuous red-white-and-blue packaging (since the 1930's); packaging from the 1940's touting "FACTORY - Modern, Clean, American"; the promotional uses of "America's favorite" on product packaging in conjunction with the Mueller's brand in the mid-1950's; the fact that generations of family members responsible for food preparation have known of Mueller's as an "American" brand; that opposer's predecessor-in-interest began using "America's Favorite Pasta" on promotional materials in 1989, and on packaging in 1997; and since 1997, the packaging of more than a billion pounds of Mueller's pasta has been prominently marked with this term. In fact, the record shows that in the years immediately before applicant filed the involved applications, opposer was selling annually over 100 million pounds of Mueller's pasta in its signature packaging, containing in a prominent manner the term "America's Favorite Pasta." Opposer's Confidential Attorneys' Eyes Only Supplemental Answers to Applicant's

Fourth Set of Interrogatories (filed under seal),
Interrogatory No. 35.

While the involved phrase is certainly viewed as a tag-line that is consistently part of opposer's branding image, opposer has to concede that it has not demonstrated any usage of the term "America's Favorite Pasta" as a stand-alone brand, or shown usage of the term on packaging apart from opposer's house mark, Mueller's.

A specific, long-used sentence on the back of the product packaging was highlighted by both parties for conflicting propositions. Prof. Germain critiques opposer's ending a paragraph of prose with "Taste why Mueller's is America's favorite pasta!" as detracting from the source-indicating capability of the term "America's Favorite Pasta" located elsewhere on the packaging. By contrast, opposer seems to spin this into something akin to "look for" advertising, not unlike "Ask your grocer for 'America's Favorite Pasta'."

Certainly, there is no testimony or polling evidence suggesting that any consumers ask for "America's Favorite Pasta." On the other hand, in consumer preference and brand awareness polling done over the years by opposer for business reasons (i.e., not in preparation for litigation), the term "America's favorite" scores higher for pasta

products from opposer than for the competing products from applicant. By contrast, applicant's Barilla brand scores significantly higher on "Italy's #1" and "Authentic Italian." This is consistent with the way these respective products have been branded (packaged and promoted) over the years. Nonetheless, amidst the twenty-five or more characteristics of pasta products evaluated by consumers, the "America's favorite" attribute is clearly not one of the strongest attributes of opposer's/Mueller's brand pasta revealed in these surveys. See Synovate study "AIPC Brand Health Tracking Study, March 2004, Opposer's Ex. 79, Applicant's Ex. 17B, Bates No. A011351, Confidential, Attorneys' Eyes Only. One proposed packaging re-design emphasizing a patriotic flag design (NB: in the wake of "September 11") did not appeal to consumers as much as did the traditional Mueller's design or a proposed "plate design."

There are admittedly no bright lines to guide our decision-making on this complex, factual issue. Nonetheless, our finding of acquired distinctiveness is supported by substantial evidence, including testimony, sales figures, surveys and other evidence.

For good or for ill, at the time applicant filed this application, opposer and its predecessors in interest had

spent more than 135 years building the goodwill of a branding image tied to the "American-ness" of the Mueller's brand of pasta. Evidence of this fact is not tied to extensive media advertising, but is tied first and foremost to the packaging on more than a hundred million pounds of pasta a year, and supported by aggressive coupon campaigns distributing many millions of coupons to markets throughout Muellerland.

By contrast, applicant's branding image has been linked to the continuing perception that truly authentic pasta is associated with its Italian roots. Applicant/Barilla, since arriving here in 1995, through its pasta promotion and pasta product packaging - adorned in red, white and green, the colors of the Italian flag - has unapologetically embraced its Italian heritage. In fact, applicant has a federal trademark registration for its own long-used tag-line, ITALY'S #1 PASTA. [Webster Dep. at 73].

Accordingly, applicant's/Barilla's brand identity is connected to Italy in much the same way opposer's/Mueller's brand identity has been tied to the U.S. To the extent that these parties are such fierce competitors in a field of basic food commodities where price/value is a primary factor in consumers' purchasing decisions, product differentiation may well turn on subtle nuances. We are convinced by this

record that opposer has strengthened an American-themed brand identity that Mueller's owners has been building for more than 130 years, and which should not be subject to taking by the new market leader - whose success in this market has been built on a very different brand-identity.

As to applicant's arguments that whatever rights opposer's predecessor-in-interest may have had in this phrase was not conveyed to opposer, it is true that the listing of trademarks named in the agreement's schedule of marks is most abbreviated, and certainly does not include this phrase. Nonetheless, the entire agreement makes clear the intentions of the parties, and we are satisfied that whatever rights opposer's predecessor had in this phrase - along with the explicitly-named terms like "Mueller's," and including the other reputation-based components of Mueller's trade dress and overall branding image - conveyed to opposer, along with the goodwill that passed to opposer as a result of this agreement.

E. Likelihood of Confusion

Having found that opposer has demonstrated that the term "America's Favorite Pasta" had acquired distinctiveness as a source indicator prior to the time applicant filed the involved application, we turn our attention to the question of whether or not there is a likelihood of confusion herein.

Specifically, the focus of our determination is on the issue of whether or not applicant's mark, **BARILLA – AMERICA'S FAVORITE PASTA**, when used in connection with "pasta, pasta products, namely meals consisting primarily of pasta, macaroni salad, pasta salad, sauces for pasta," so resemble opposer's **AMERICA'S FAVORITE PASTA** mark for pasta, as to be likely to cause confusion, to cause mistake or to deceive as to source or sponsorship.


Our determination must be based upon our analysis of all 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 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). 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." *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 examine first the *du Pont* factor focusing on the relatedness of the goods as described in applicant's

application and the goods on which opposer has demonstrated use of the term "America's Favorite Pasta." Both parties are selling pasta, and applicant does not argue otherwise. Hence, we conclude that the respective goods are legally identical, and this factor heavily favors opposer.

As to channels of trade and classes of consumers, both are selling pasta at retail to ordinary consumers, so these related *du Pont* factors also favor opposer.

Finally, we turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). We also begin this discussion of the similarity of the marks mindful of black letter trademark case law that where, as here, the marks are applied to "virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) [finding CENTURY LIFE OF AMERICA for insurance underwriting services confusingly similar to opposer's CENTURY 21 mark for insurance brokerage services]; and *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d

1698, 1700 (TTAB 2006) [finding  and ICE SHINE confusingly similar for floor-refinishing preparations].

Applicant has essentially taken opposer's tag-line in its entirety and simply added its house mark to the front of it. As a general rule, likelihood of confusion is not obviated between identical marks merely by adding one's house mark. To the contrary, the purchaser of Mueller's brand pasta products who associates "America's Favorite Pasta" with opposer, upon seeing "Barilla - America's Favorite Pasta," will likely assume incorrectly that there is some relationship, sponsorship or affiliation between Mueller's and Barilla. See e.g., *In re The U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) [CAREER IMAGE for clothing likely to be confused with CREST CAREER IMAGES for uniforms]

CAREER IMAGE
CAREER IMAGE

v.

Crest
Career Images ;

In re Apparel Ventures, Inc., 229 USPQ 225 (TTAB 1986)


by sassafra

for clothing
likely to be
confused with


for footwear;



In re Riddle, 225 USPQ 630 (TTAB 1985)

[**RICHARD PETTY'S ACCU-TUNE** for automotive service stations likely to be confused with **ACCUTUNE** for automotive testing equipment];

and *In re C. F. Hathaway Co.*, 190 UPSQ 343 (TTAB 1976)

[**HATHAWAY GOLF CLASSIC** for men's knitted sport shirts likely to be confused with **GOLF CLASSIC** for men's hats; e.g., the addition of the house mark is an "aggravation rather than a justification"]. Because we have found that the phrase "America's Favorite Pasta" has acquired distinctiveness, it functions as a trademark indicating that opposer's phrase is uniquely associated with a single source. Therefore, the addition of applicant's house mark, **BARILLA**, to the beginning of opposer's phrase only adds to the likelihood of source confusion, were applicant to use this mark.

Accordingly, based upon all of the relevant *du Pont* factors, we find that there is a likelihood of confusion herein.

F. Applicant's bona fide intention to use this phrase

Finally, we note that opposer also charges that applicant lacked the requisite *bona fide* intention to use this phrase in commerce at the time the application was filed. However, given our determination that opposer has

priority of use and that there is a likelihood of confusion herein, we find it unnecessary to reach a determination on the question of whether or not applicant has demonstrated during this proceeding its *bona fide* intention to use the involved mark in the ordinary course of trade, consistent with the definitional language of § 45 of the Lanham Act.

Decision: The opposition is sustained on the basis of opposer's priority and a likelihood of confusion with opposer's marks, and registration to applicant is hereby refused.