

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

Mailed: September 14, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Cielo S.p.A.  
v.  
Austin House of Prayer

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Opposition No. 91166590  
to Application No. 78493020  
filed on October 1, 2004

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Paulette R. Carey of Buchman Law Firm for Cielo S.p.A.

Susan J. Hightower of Pirkey Barber for Austin House of Prayer.

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Before Hairston, Walters and Bucher, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Cielo S.p.A. filed its opposition to the application of Austin House of Prayer to register the mark CIELO in standard character format for "drinking water," in International Class 32.<sup>1</sup> The application includes the

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<sup>1</sup> Application Serial No. 78493020, filed October 1, 2004, based upon use in commerce, alleging first use as of September 2, 2004 and use in commerce as of September 28, 2004.

statement that the foreign wording in the mark translates into English as sky or heaven.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used and registered mark CIELO for "wine"<sup>2</sup> as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Applicant, in its answer, denied the salient allegations of the claim.

*The Record*

The record consists of the pleadings; the file of the involved application; and a certified status and title copy of opposer's Registration No. 2384406 and opposer's requests for admissions,<sup>3</sup> made of record by opposer's notice of reliance. The record also includes the testimony affidavit<sup>4</sup> by opposer of Pierpaolo Cielo, opposer's marketing and sales manager, and the testimony affidavit by applicant of Tom Jones, a member of applicant's board of directors, both with

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<sup>2</sup> Registration No. 2384406, issued September 12, 2000, in International Class 33. The registration includes the statement that the English translation of "CIELO" is "sky" or "heaven." [Sections 8 and 15 affidavits have been accepted and acknowledged, respectively.]

<sup>3</sup> Opposer submitted its requests for admissions by notice of reliance and noted in its brief that the admissions should be deemed admitted in view of applicant's failure to respond thereto. Applicant acknowledges that it did not respond to the requests for admissions and that they are deemed admitted (brief, p. 1). Therefore, we deem the admissions to be admitted by applicant.

<sup>4</sup> The parties filed a written stipulation to the submission of testimony by affidavit.

accompanying exhibits. Both parties filed briefs on the case.

*Factual Findings*

The following admissions, deemed admitted by applicant, are particularly relevant facts:

3. The applied-for mark ... is identical to the registered mark ....
4. The respective products, bottled water and wine, are sold through the same retail outlets in some jurisdictions.
5. Consumers who purchase bottled water may also purchase wine.
6. Bottled water and wine may be served together.

Based on Mr. Cielo's affidavit, we find that opposer sells its wines in the United States through restaurants and retail stores. In the absence of additional evidence, we decline to make factual findings, based only on Mr. Cielo's conclusory statement, about the purchasers and trade channels of bottled water and the extent to which such might be the same as the purchasers and trade channels of wine.

Based on Mr. Jones' affidavit, we find that applicant sells its drinking water through, at least, Whole Foods Market in Texas; and that applicant's annual sales, at the time of the affidavit, were approximately 33,000 gallons of water sold in various-sized bottles.

*Analysis*

Because opposer has properly made its pleaded registration of record, and because opposer's likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and goods covered by said registration. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We add that applicant in its answer admitted opposer's priority of use and registration.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In*

*re Dixie Restaurants 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 also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Turning, first, to the marks, there is no question that the marks are identical, which applicant has admitted. However, applicant argues in its brief that applicant's admission must be construed as pertaining only to the visual appearance of the marks and that the connotations and pronunciations of the marks are different. Applicant's position is not well taken. It is well established that, in considering the similarities of the marks, we consider all of the relevant factors, i.e., sight, sound, connotation and commercial impression. Therefore, the admission that the marks are identical encompasses these relevant factors.

Further, we find the marks identical even if we consider applicant's admission to be limited to the visual appearance of the marks. The marks are identical in connotation in view of the identical translations noted in

both the application and the registration. The fact that opposer's mark may appear on a label that includes the word "famiglia" is not relevant in this case because the registered mark does not include the term "famiglia," opposer is not limited to using the registered mark with the term "famiglia," and opposer has not pleaded or established its use of the unitary mark "Famiglia Cielo." Regarding the pronunciation of the respective marks, applicant correctly admits in its brief (p.8) that there is "no correct pronunciation of any particular mark." See *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (There "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark"). Applicant argues that the additional Italian wording on opposer's wine label, which is in the record, will suggest the Italian pronunciation to consumers, while the references to Austin, Texas, on applicant's bottled water label, which is in the record, will suggest the Spanish pronunciation to consumers due to Austin's proximity to Mexico. Even if applicant could establish, which it has not, that the parties promote their respective marks with different pronunciations and that the word "cielo" is pronounced differently in Spanish and Italian, these facts would be legally insignificant. We find it likely that relevant

consumers in the United States will use either the Spanish or Italian pronunciations if they are different, or altogether different pronunciations, in equal measure with respect to the marks for both products. The factor of the identity of the marks weighs heavily in opposer's favor.

We consider, next, the respective goods of the parties. It is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Opposer argues that "the Board has consistently held that alcoholic beverages and non-alcoholic beverages may be so related as to be likely to generate confusion when similar marks are used thereon" (brief, p. 4), citing *In re Rola Weinbrennerei und Likofabrik GmbH & Co. KC*, 223 USPQ 57

(TTAB 1984). Opposer contends, further, that the trade channels of the respective goods are unlimited and likely to overlap; and that, in view of applicant's admissions, the record establishes that "both products are sold to the same class of purchasers under similar circumstances" (brief, p. 4), citing *Kraft, Inc. v. Country Club Food Industries, Inc.*, 230 USPQ 549 (TTAB 1986).

Citing numerous cases in which no likelihood of confusion was found, applicant argues that there is no *per se* rule that alcoholic and non-alcoholic beverages are related. Applicant also contends that there is no evidence that drinking water and wine are complementary goods; that it is unlikely that these goods are mixed together or served together; and that, if these goods are sold in some of the same stores, there is no evidence that they are sold in proximity to each other within the stores. Applicant notes three marks referenced by Mr. Jones in his affidavit in support of its contention that identical marks for wine and drinking water, owned by different parties, may co-exist on the Principal Register.<sup>5</sup> Applicant also argues that wine and bottled water are dissimilar because they are classified

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<sup>5</sup> Applicant did not properly make these registrations of record. Therefore, this statement is of little probative value as we have no evidence of the ownership or status of the registrations, the identified goods, or other pertinent facts, such as the strength of the respective marks.



in different international classes.<sup>6</sup> Regarding the trade channels, applicant contends that the parties sell their respective goods in different geographic areas; that there is no evidence that opposer sells its wines in grocery stores, which is the only trade channel in evidence with respect to applicant's goods; and that there is no evidence that applicant's goods are sold in restaurants.

We find the noted admissions by applicant sufficient to warrant the conclusion that the trade channels and purchasers of drinking water and wine are, at least, overlapping. The fact that the parties may not presently sell their respective goods in the same geographic areas is not relevant to the issue of registrability, which is national in scope. For the same reason, it is immaterial that the parties' products "are sold through the same retail outlets" in only *some* jurisdictions (admission no. 4). The record shows that applicant sells its product in a grocery store, and this type of store is encompassed within the designation "retail outlets," in which opposer sells its product. The fact that applicant may not sell its drinking water in restaurants is, likewise, immaterial in view of the other overlapping areas of sale. The factors of the trade

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<sup>6</sup> The International Classification system is used by the USPTO for the purpose of administrative ease. It is not relevant and is legally insignificant as a factor in determining what, if any, relationship exists between goods.

channels and classes of purchasers, thus, weigh in opposer's favor.

However, there is little evidence in the record from which the Board can draw conclusions about whether, or the extent to which, there is a relationship between the identified goods. The mere fact that both products are consumable liquids that are sold to some of the same purchasers through some of the same retail outlets is insufficient to reach the conclusion that the goods are sufficiently related such that, as identified by identical marks, confusion as to source is likely. There is no evidence that, in the marketplace, wine and drinking water ever emanate from the same source, or that they are marketed under the same marks, or that the circumstances surrounding the sales of wine and drinking water are such that consumers would believe that they come from the same source. While both wine and water may be consumed at a meal, there is no evidence that they are complementary products. Nor is there evidence that these products are sold in proximity to each other in retail outlets. We agree with applicant that there is no per se rule regarding the relationship between drinking water and wine. In the *Rola* case, *supra*, cited by opposer, the Board emphasized that, while there is precedent finding a relationship between alcoholic and non-alcoholic beverages, it is dependent on the factual circumstances.

The Board, in *Rola*, *supra* at 58, made the following statement:

Decisions of this Board and its reviewing courts have made clear that, *in appropriate factual contexts*, alcoholic beverages and non-alcoholic beverages or non-alcoholic drink mixes may be so related as to be likely to generate confusion when similar marks are used thereon. *[citations omitted; emphasis added.]*

. . . The critical question, however, is not whether these products may be used or mixed together (although that is a factor to be considered) but rather whether, as beverages and beverage derivatives, they bear such a relationship that purchasers would be led to believe that they emanated from or were connected with a common source. Here, the striking similarity of the SUNAPPLE marks plus their common identification with drinks having apple flavoring generates substantial doubt in the Board's mind that likelihood of confusion could be avoided for purchasers confronted with the marks (hyphenated or otherwise) on these products. Under existing case precedent, we are required to resolve such doubt in favor of the prior registrant.

In the case before us, the factual circumstances surrounding the marketing and sale of the respective products are insufficiently developed. We find the lack of an established relationship between the goods to be the determinative factor in this case, despite the identity of the marks and the overlapping channels of trade and common purchasers.<sup>7</sup> Therefore, we conclude that opposer has not established a likelihood of confusion.

*Decision:* The opposition is dismissed.

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<sup>7</sup> Applicant argues that certain *du Pont* factors about which there is no evidence in this record weigh in applicants favor. We note, however, that these factors not relevant herein are, instead, neutral.