

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Barbera 1870 S.p.A.
v.
Barbera Caffè' S.p.A.

Opposition No. 91201113
to application Serial No. 85190355

John Alunit of Law Offices of Alunit IP for Barbera 1870 S.p.A.

Miriam D. Trudell of Sheridan Ross PC for Barbera Caffè' S.p.A.

Before Bucher, Kuhlke and Wolfson, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Barbera Caffè' S.p.A., seeks registration of the mark shown below¹ for “cafeterias; catering of food and drinks; restaurant services; self-service restaurants; snack bars,” in International Class 43 on the Principal Register.

¹ Serial No. 85190355, filed on December 3, 2010, based on a foreign registration under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126.



Opposer, Barbera 1870 S.p.A., has opposed registration of applicant's mark on the ground of priority and likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Opposer pleaded ownership of pending application Serial No. 77350105 for the mark BARBERA ... DAL 1870 and design for, "providing of food and drink," in International Class 43 and Registration No. 3064211 for the mark MISCELA BARBERA CAFFE BARBERA DAL 1870 IL MAGO DEL CAFFE and design for "staple food products; namely, coffee" in International Class 30. Opposer also alleges that it "has earlier common law rights in" its pleaded marks.

Opposer also brought the opposition on the ground of false suggestion of a connection under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

By its answer, applicant denied the salient allegations, including the allegations pertaining to opposer's pleaded application, registration and common law rights.

By operation of the Trademark Rules the pleadings herein and the file of the opposed application are of record. Trademark Rule 2.122, 37 C.F.R. § 2.122. In addition, opposer submitted under a notice of reliance:

- 1) An excerpt from Wikipedia on the wine grape Barbera;

2) Printouts from online databases showing translations for various words; and

3) TESS printouts of third-party registrations.

Applicant did not submit any evidence or take testimony, but did file a brief.

Although opposer pleaded its pending application and registration, opposer did not introduce into the record any registrations. In view thereof, opposer did not prove its ownership and the validity of the registrations. To the extent opposer may have relied on the data it input into the ESTTA protocol, the Board's online filing system, opposer is advised that this does not make the registrations of record. *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1540 (TTAB 2010) (“[M]ere inputting of a registration number when prompted by ESTTA ... is insufficient to make the pleaded registrations of record”).² There is no testimony or other evidence from which to adduce opposer's ownership and the validity of the pleaded application and registration or to establish prior common law rights. Nor are there any admissions upon which opposer may rely to establish its ownership of the registration or prior common law rights, as applicant has denied these allegations in its answer.

In view thereof, opposer has not established its standing or priority over applicant's filing date. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496

² Pleded registrations may be made of record by submitting “a current printout of information from the electronic database records of the USPTO [TARR], showing the current status and title of the registration.” Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d).

F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, opposer's claim of likelihood of confusion under Section 2(d) must fail.

Similarly, while an opposer need not establish proprietary rights in a trademark to support a false association claim, *Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1424 (TTAB 2008), the first element an opposer must prove is that "applicant's mark is the same or a close approximation of opposer's *previously used* name or identity." *Boston Red Sox Baseball Club Limited Partnership v. Brad Frances Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008) (emphasis added); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956 (TTAB 2007). As discussed above, there is no evidence to establish a "previously used name or identity." In addition, to establish a false suggestion claim under Section 2(a), a plaintiff must prove that its name or identity "is of sufficient fame or reputation" that when used in connection with a defendant's goods or services "a connection would be presumed." *Boston Red Sox*, 88 USPQ2d at 1593. There is nothing in the record to support a finding that opposer's alleged name is of sufficient fame to presume a connection.

In view thereof, because opposer has not established its prior rights or use, opposer has not carried its burden to prove priority and likelihood of confusion under Section 2(d) or a false suggestion of a connection under Section 2(a).

Decision: The opposition is dismissed.