

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 4, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Hormel Foods, LLC

v.

Empacadora Dilusa de Aguascalientes S.A. de C.V.

Opposition No. 91275380

Cynthia A. Moyer and Tracy L. Deutmeyer of Fredrikson & Byron, P.A., for Hormel Foods, LLC.

Felipe Rubio of Rubio & Associates, for Empacadora Dilusa de Aguascalientes S.A. de C.V.

Before Adlin, English and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Empacadora Dilusa de Aguascalientes S.A. de C.V., seeks a Principal



Register registration for the mark for “Butter; Chicharron; Compotes; Eggs; Lard; Milk; Pork; Canned fruits and vegetables; Edible oils and fats; Meat extracts; Milk shakes; Milk beverages, milk predominating; Pork steaks;

Jellies, jams, compotes; Meat, fish, poultry and game, not live; Preserved, dried and cooked fruit and vegetables; Unflavored and unsweetened gelatins” in Int’l Class 29.¹

Opposer, Hormel Foods, LLC, has opposed the Application, alleging in its notice of opposition that use of Applicant’s mark for the identified goods will cause a (1) likelihood of confusion with, and (2) dilution by blurring and tarnishment of, Opposer’s mark DI LUSSO.² Opposer claims prior use of and ownership of registrations for, DI LUSSO (in standard character and typed format³) covering the following goods, respectively:

- “Dry sausage,” in Int’l Class 29;⁴
- “Dry sausage, poultry, beef, pork, cheese,” in Int’l Class 29;⁵ and

¹ Application Serial No. 90125062 (“the Application”) was filed on August 19, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. The Application describes the mark as “consist[ing] of the term DILULSA and design; the term DILUSA appears in white inside a waving blue flag; there are two curved horizontal lines that appear below the waving flag design with the larger one appearing above the small smaller one; the top curved horizontal line is red and the bottom curved horizontal line is green; the remaining white in the drawing is background and is not part of the mark.” The colors blue, white, red and green are claimed as a feature of the mark.

² 1 TTABVUE. Citations in this opinion to the briefs and evidence refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

³ “A typed mark is the legal equivalent of a standard character mark.” *Advanced Magazine Publ’rs., Inc. v. Fashion Elecs., Inc.*, 2023 USPQ2d 753, at*25 n.19 (TTAB 2023), citing *In re Vitterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“[U]ntil 2003, ‘standard character’ marks formerly were known as ‘typed’ marks,”).

⁴ Registration No. 1028047 (the “047 Registration”), in typed format; renewed.

⁵ Registration No. 2654912 (the “912 Registration”), in typed format; renewed. The registration includes the following translation statement: “The English translation of DI LUSSO is ‘luxurious’ or ‘the luxury.’”

- “Horseradish; mustard; sauces,” in Int’l Class 30.⁶

Applicant denies the salient allegations in its answer to the notice of opposition.⁷

Both parties filed briefs. For the reasons discussed below, we sustain the opposition.

I. The Record

The record consists of the pleadings, the file of the Application by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and additional evidence introduced by Opposer, including a first notice of reliance on plain copies of its pleaded registrations, along with printouts from the USPTO’s Trademark Status & Document Retrieval (TSDR) database showing their current status and title;⁸ a second notice of reliance on Internet evidence, including printouts from social media, Applicant’s website, and various third-party websites;⁹ and the testimony declaration of Jeffrey R. Baker, Group Vice President of Marketing – Value Added Meats of Hormel Foods Corporation, Opposer’s parent company, with exhibits.¹⁰ Applicant did not introduce any evidence or testimony.

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter

⁶ Registration No. 5237187 (the “187 Registration”), in standard characters; Section 8 & 15 declaration accepted/acknowledged. The registration includes the following translation statement: “The English translation of DI LUSSO is ‘luxurious’ or ‘the luxury.’”

⁷ 6 TTABVue. In addition, Applicant asserted two purported “affirmative defenses,” which we construe as mere amplifications of its denials to the allegations in the notice of opposition.

⁸ 9 TTABVue.

⁹ 12 TTABVue.

¹⁰ 11 TTABVue (“Baker Test. Decl.,” public version); 11 TTABVue (confidential version).

partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark when such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark*, 572 U.S. at 129, 132); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020).

Opposer’s entitlement to oppose registration of Applicant’s mark on the ground of likelihood of confusion is established by its pleaded registrations, which are of record.¹¹ See, e.g., *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *13-14 (TTAB 2022) (valid and subsisting pleaded registration establishes opposer’s direct commercial interest in the proceeding and its belief in damage) (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)). Opposer may therefore also pursue its claim of dilution. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987) (“Once [entitlement to a statutory cause of action] is established, the opposer is entitled to rely on any of the grounds set forth in section 2 of the Lanham Act which negate applicant’s right to its subject

¹¹ 9 TTABVue (Opposer’s First Notice of Reliance).

registration.”).

III. Likelihood of Confusion

“Trademark Act Section 2(d) permits opposition on the basis of ownership of ‘a mark or trade name previously used in the United States ... and not abandoned.’” *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1181 (TTAB 2017). Priority of use is therefore “a necessary element of any claim under Section 2(d).” *Id.* “Because Opposer relies on its asserted [DI LUSSO] registrations that have been made of record, and Applicant has not challenged these registrations by way of any cancellation counterclaim(s), Opposer’s priority ... is not at issue with respect to the goods identified” therein. *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *19-20 (TTAB 2021) (citing *King Candy Co. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

We focus our analysis on the typed mark DI LUSSO in Opposer's pleaded '047 and '912 Registrations for goods identical in part to those in the Application. If we find confusion likely between Applicant's mark and Opposer's mark in these two registrations, we need not consider the likelihood of confusion between Applicant's mark and Opposer's standard character mark in Opposer's pleaded '187 Registration; if we do not find confusion likely based on these registrations, we would not find it likely based on the '187 Registration. *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *2 (TTAB 2020); *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015).

A. Relatedness of the Goods, Channels of Trade, and Purchasing Conditions

We begin with the second through fourth *DuPont* factors, which respectively consider the similarity or dissimilarity and nature of the goods, the similarity or dissimilarity of established, likely-to-continue trade channels, and the conditions under which and buyers to whom sales are made, i.e., impulse versus careful, sophisticated purchasing. *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19, *40 (TTAB 2021) (citing *In re Detroit Athl. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) and *DuPont*, 177 USPQ at 567).

The Application identifies “meat, ... not live” in Class 29, which encompasses the

“dry sausage” listed in the ’047 Registration, and the “dry sausage, poultry, beef, [and] pork” listed in the ’912 Registration. The parties’ goods are therefore legally identical in part. *See Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *15-16 (TTAB 2023) (“If an application or registration describes goods or services broadly, and there is no limitation as to their nature, it is presumed that the ‘registration encompasses all goods or services of the type described.’”) (quoting *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). “It is sufficient for a finding on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in the application.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *11 (TTAB 2020) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

Additionally, because the parties’ goods are legally identical in part and unrestricted as to channels of trade, we must presume that they travel in the same ordinary trade and distribution channels and will be marketed to the same classes of potential consumers. *In re Viterro Inc.*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *New Era Cap v. Pro Era*, 2020 USPQ2d 10596, at *13 (“Because the goods are in-part identical and unrestricted as to trade channels, we must also presume that these particular goods travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers.”).

Further, we must presume that the parties’ identified goods include “all goods of

the type identified, without limitation as to their nature or price,” *Sock It to Me v. Fan*, 2020 USPQ2d 10611, at *8, including goods that are relatively inexpensive. In this regard, Opposer made of record printouts from the website of HyVee supermarket showing that Opposer’s DI LUSSO smoked turkey, honey mesquite turkey, cracked pepper turkey, and golden browned turkey deli products are advertised for \$10.99 per pound, which is relatively inexpensive.¹² “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Id.* (quoting *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000),

The second and third *DuPont* factors weigh heavily in favor of finding a likelihood of confusion, and the fourth *DuPont* factor weighs slightly in favor of finding a likelihood of confusion.

B. Strength of Opposer’s Mark

The fifth *DuPont* factor is “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. The fame or strength of a mark is not a binary factor; rather, it varies along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015). A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis, *Tao Licensing, LLC v.*

¹² 12 TTABVUE 40 (Opposer’s Second Notice of Reliance).

Bender Consulting Ltd., 125 USPQ2d 1043, 1056 (TTAB 2017), while a weak mark receives a narrower scope of protection. A mark in the middle of the spectrum receives an intermediate scope of protection. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017) (finding that opposer's marks were entitled to "the normal scope of protection to which inherently distinctive marks are entitled").

In assessing the fame or strength of Opposer's mark, we consider both the inherent or conceptual strength of the mark and its commercial strength, based on its marketplace recognition. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *30 (TTAB 2021).

1. Conceptual Strength

To determine the conceptual strength of Opposer's mark DI LUSSO, we evaluate where it lies "along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum...." *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019).

Because DI LUSSO is registered on the Principal Register without a claim of acquired distinctiveness or disclaimer of wording, it is presumptively valid, inherently distinctive, and at worst, suggestive of the identified goods. Trademark Act Section 7(b), 15 U.S.C. § 1057(b). *See also See Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) ("A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.").

As noted in the translation statement of the '912 Registration and acknowledged by Opposer in its brief, DI LUSSO translates into English as “luxurious” or “the luxury,” which has a laudatory suggestive meaning in connection with Opposer’s meats, but nevertheless requires the exercise of some imagination and perception to reach a conclusion about the products’ nature. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1515 (TTAB 2016), quoting *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (“A suggestive mark requires imagination, thought and perception to reach a conclusion as to the nature of the goods, while a merely descriptive mark forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”) (additional citations and internal quotations omitted).

Opposer’s DI LUSSO mark, as a suggestive, laudatory mark, is not as strong as an arbitrary or fanciful mark. However, “the fact that a mark may be somewhat suggestive does not mean that it is a ‘weak’ mark entitled to a limited scope of protection.” *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985). In addition, as discussed *infra*, consumers may not be aware that DI LUSSO is Italian and that it translates as “luxurious,” thus lessening the impact of the term’s ostensible suggestiveness.

2. Commercial Strength

We next consider the commercial strength of Opposer’s DI LUSSO mark. Commercial strength “may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.”

Bose Corp. v. QSC Audio Prods. Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Other relevant factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” *Coach Servs.*, 101 USPQ2d at 1720.

Opposer’s witness, Jeffrey R. Baker, testified that Opposer’s DI LUSO-branded goods are “largely sold through Hy-Vee, Inc. ... a grocery retail store chain company that operates more than 280 stores in eight Midwestern states, including Illinois, Iowa, Kansas, Minnesota, Missouri, Nebraska, South Dakota, and Wisconsin,” as well as through other distributors.¹³ Additionally, according to Mr. Baker, “Opposer has sold a high volume of DI LUSO products” and its annual sales of goods under its DILUSO mark has increased over the years.¹⁴ He provided annual sales figures for Opposer’s DI LUSO-branded goods in the United States for the years 2005, 2007, 2008, 2014, 2017, 2018, 2020, and 2022, which appear fairly substantial and show an upward trend over the years.¹⁵ But he did not provide any context for those figures, such as Opposer’s market share, that would allow us to evaluate Opposer’s commercial strength vis-à-vis its competitors.

Ms. Baker also testified that Opposer’s “DI LUSO brand products are heavily advertised” by Hy-Vee “through in-store signage, billboard advertisements, direct mailers, and print advertising....” and that “the associated advertising figures are

¹³ 10-11 TTABVUE 5, 10 (Baker Test. Decl. ¶¶ 17, 22-23).

¹⁴ 10 TTABVUE 5 (Baker Test. Decl. ¶ 16).

¹⁵ *Id.* We discuss sales and advertising figures generally, given their confidential nature.

significant.”¹⁶ In this regard, he provided Opposer’s advertising expenditures (i.e., media, production, and outside costs) for the years 2006 – 2022, but again provided no context for those figures which, in any event, show a decrease in amount expended during the years 2020 – 2022.¹⁷

Finally, as to length of use, Opposer’s witness Mr. Baker testified that “Opposer has sold products under the DI LUSSO Marks for more than 100 years, since as early as 1919.”¹⁸ Although this is quite a substantial length of time, Mr. Baker did not provide any testimony or evidence regarding the extent of use of Opposer’s mark prior to the 2000s.

In view of the foregoing, we find that Opposer’s DI LUSSO mark has only moderate commercial strength.¹⁹

3. Summary on Strength

In sum, although Opposer’s DI LUSSO mark is suggestive and thus conceptually weaker than a fanciful or arbitrary mark, it is still inherently distinctive, and has

¹⁶ 10-11 TTABVue 7-9 (Baker Test. Decl. ¶¶ 20-21).

¹⁷ *Id.* at 8-9 (¶ 21).

¹⁸ *Id.* at 4 (¶ 14).


¹⁹ In *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988), the Federal Circuit stated that “[t]he fame of a mark cuts both ways with respect to the likelihood of confusion.” *Id.* at 1721. Citing this statement, Applicant argues that, “[t]o the extent that Opposer has a strengthened fifth [*DuPont*] factor, the first [*DuPont*] factor is correspondingly weakened, as relatively minor distinctions become more attention-grabbing to a consumer and amplify any change in connotation in particular.” This argument is unavailing. “The holding of *B.V.D.*, to the extent it treats fame as a liability [to the owner of the famous mark asserting likelihood of confusion], is confined to the facts of that case.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992). Thus, [any] fame of opposer’s [DI LUSSO] mark, and the familiarity of purchasers with the details of that mark, do not weigh in applicant’s favor in our likelihood of confusion analysis.” *Time Warner Entm’t Co. v. Jones*, 65 USPQ2d 1650, 1661-62 (TTAB 2002).

achieved a moderate amount of commercial strength in the marketplace. Further, as discussed *infra*, consumers may not know that DI LUSSO is Italian and/or that it translates as “luxurious” or “of luxury.” We thus accord Opposer’s DI LUSSO mark the usual scope of protection afforded an inherently distinctive mark with moderate commercial strength.

C. Comparison of the Marks

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d at 1812, *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019)); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968).




In comparing Applicant’s mark  and Opposer’s mark DI LUSSO, we are mindful that that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs.*, 101 USPQ2d at 1721; *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046,

103 USPQ2d 1435, 1440 (Fed. Cir. 2012)). We also keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

In addition, where the parties’ goods are partially identical, as they are here, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. See *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).

1. Appearance



Beginning with appearance, we find Applicant’s mark  and Opposer’s mark DI LUSSO quite similar. “In the case of marks, such as Applicant’s, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *Viterra*, 101 USPQ2d at 1908; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because “[t]he word portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Id.* (quoting *Viterra*, 101 USPQ2d at 1911).

As Opposer notes, “the marks are similar in appearance—they both begin with “DILUS” and end with a vowel ... “O” in DI LUSSO versus “A” in DILUSA” We agree with Opposer that the difference in vowel endings is unlikely to make a significant impact on consumer perception of the marks. *See e.g., In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (finding MILTRON and MILLTRONICS (stylized) to be highly similar in appearance); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445 (TTAB 1977) (finding KIKS and KIKI similar in appearance”); *Apple Comput. v. TVNET.net Inc.*, 90 USPQ2d at 1396 (substitution of the letter “v” at the beginning of applicant’s VTUNES.NET mark for the letter “T” in opposer’s ITUNES marks is insufficient to distinguish the dominant portions of the parties’ marks).

In addition, because Opposer’s DI LUSSO mark is in standard characters, it may be depicted in any font, style, size, or color. Trademark Rule 2.52(a), 37 CFR § 2.52(a). For that reason, we must assume that Opposer’s mark could be displayed in a stylization identical or similar to that used with Applicant’s mark. *See SquirrCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party.”); *In re Aquitaine Wine*, 126 USPQ2d at 1186 (“[T]he rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”) (citation omitted).

Applicant disagrees that the marks appear similar, pointing out that the term DILUSA in its mark “is clearly a single word,” whereas “Opposer’s Marks include a

space” which “[i]mportantly ... is presented at the front of the mark, where it will seize the attention of the consumer. This provides a plain difference in appearance.”²⁰

We are not persuaded that the space will “seize the attention of the consumer,” much less distinguish the mark as to source. The presence or absence of a space between the two words is an inconsequential difference that even if consumers noticed or remembered would not serve to distinguish these marks. *See Stock Pot, Inc. v. Stockpot Rest., Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (finding no significant difference between STOCKPOT and STOCK POT); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (“the spaces that respondent places between the words [in DESIGNED TO SELL] do not create a distinct commercial impression from petitioner’s presentation of his mark [DESIGNED2SELL] as one word.”).

Applicant also suggests that LUSSO is the dominant portion of Opposer’s DI LUSSO mark, as compared to the entire term DILUSA that is dominant in Applicant’s mark, because consumers would immediately recognize that DI is an Italian preposition, a term that would never be considered dominant:

Importantly when separated, “di” is Italian for “of.” This counters Opposer’s assertion that the front portion of Opposer’s Marks is the dominant element for comparison. Plainly, “OF”, or a similar preposition or article in a phrase, would never be the dominant element of an English-language mark. Prepositions and articles are extraordinarily weak and non-identifying in comparison to the noun that follows, notwithstanding placement before the noun at the front of the mark.

...

²⁰ 15 TTABVue 9-10 (Applicant’s Brief).

For the same reasons, the dominant portion of Opposer's Marks is LUSSO, while the dominant portion of (the text elements of) Applicant's mark is the full word, DILUSA. When these are compared, it is immediately apparent that the two marks are different.²¹

The problem with Applicant's argument is that the record does not establish that consumers of the relevant goods would understand that DI LUSSO is Italian, or that "DI" in the mark means "of," and attorney argument is not evidence. *Cai v. Diamond Hong*, 127 USPQ2d at 1799 (citing *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence.")). Although Opposer's '912 Registration (and '187 Registration) includes a translation statement that the English translation of DI LUSSO is "luxurious" or "the luxury,"²² and Opposer acknowledges that translation in its brief,²³ there is no evidence that consumers would be aware of this purported translation and therefore distinguish the marks on that basis. This brings us to connotation and the doctrine of foreign equivalents.

2. Connotation

Applicant contends that the parties' marks have "very different" connotations, since Opposer's mark DI LUSSO is an Italian term that translates into English as "luxurious" or "the luxury" and "provides the impression of high-class Italian products."²⁴ In contrast, Applicant's DILUSA "is 'a coined term without a definition'"

²¹ *Id.* at 10-11.

²² See notes 5-6 *supra*.

²³ 14 TTABVUE 18, 28 (Opposer's Brief).

²⁴ 15 TTABVUE 13 (Applicant's Brief).

and “gives no similar impression, either of the Italian language and culture or of luxury.”²⁵ The word has no meaning in Italian, or any other language, and is plainly not an Italian word.”²⁶ “At minimum,” Applicant asserts, “even a consumer with no knowledge of Italian will recognize that the mark [DI LUSSO] has *some* meaning in Italian, as the ‘di’ article separated from the rest of the mark by a space, and the double-S followed by a vowel, are both well-known characteristics of the Italian knowledge,” which “is itself a connotation, indicating an Italian-style or Italian-source product.”²⁷

For support, Applicant points to the Board’s decision in *In re Joint Stock Co. “Baik,”* 80 USPQ2d 1305 (TTAB 2006) where, as Applicant explains, the Board found “that estimates of 706,000 Russian speakers in the United States was sufficient to invoke the doctrine of foreign equivalents.”²⁸ Here, argues Applicant, similar to the *Baik* case, there are 708,966 Italian speakers in the United States. “The doctrine of foreign equivalents is therefore applicable, barring arguments to the contrary.”²⁹ There are, however, arguments to the contrary.

“Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine ... the similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay Imps.*, 73

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.* at 13-14.

²⁸ *Id.* at 9.

²⁹ *Id.*

USPQ2d at 1696. The doctrine of foreign equivalents applies when it is likely that “the ordinary American purchaser would ‘stop and translate [the mark] into its English equivalent.’” *Id.* (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). However, as Opposer notes (quoting *Palm Bay Imps.*, 73 USPQ2d at 1696), “the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline.”

The problem with Applicant’s argument, as Opposer points out, is that the number of Italian speakers in the United States is not of record and Applicant merely provides a link in its brief to purported census data for this information.³⁰ The Board, however, does not access links to websites. *See TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.14 (TTAB 2018) (“The Board does not accept Internet links as a substitute for submission of a copy of the resulting page.”); *In re Future Ads LLC*, 103 USPQ2d 1571, 1572, n.3 (TTAB 2012) (“[T]he Board will not utilize a link or reference to a website’s internet address to access the site to consider whatever content may appear therein.”); *In re HSB Solomon Associates, LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012).

Even if the evidence was of record, it would not make a difference in our evaluation of this factor. As Opposer notes:

Applicant essentially argues that a subset of 708,966 Americans would *not* be confused between DI LUSSO and DILUSA because these individuals will translate DI LUSSO to “the luxury.” But, taking this argument to its logical conclusion means that all remaining American consumers, who do not speak Italian, would take DI LUSSO “as is” rather than translating it. In other words, most American consumers

³⁰ 16 TTABVUE 7 (Applicant’s Brief).

would be unaware of any alleged difference in the commercial impressions of DI LUSSO and DILUSA.³¹

We agree with Opposer that most consumers in the United States will not translate DI LUSSO from Italian. To the extent consumers who do not speak Italian view Opposer's mark as an Italian word, they are just as likely to view DILUSA as an Italian word and may not attribute any particular significance to that fact.

On a related note, Applicant points out that Opposer's pleaded registrations cover "dry sausage," which is "an Italian style of deli meat."³² According to Applicant, "a consumer aware of this origin" will "even more easily recognize that [Opposer's] mark is Italian."³³ "With this context," it asserts, "a consumer will be conscious of the connotation provided by the meaning of DI LUSSO: 'luxury'-quality Italian foodstuffs."³⁴ The problem here is that Applicant's Application identifies "meat" generally, not dry sausage specifically. There is no evidence that Kobe beef, for example, is "an Italian style" of "meat," but it does fall within Applicant's identification of goods.

3. Sound

Opposer argues that the marks are similar in sound. While acknowledging that "there is no correct pronunciation of a trademark" (quoting *In re Viterra*, 101 USPQ2d at 1905), Opposer suggests that "the only difference in the sound of the marks may

³¹ *Id.* at 7-8.

³² *Id.* at 9.

³³ *Id.*

³⁴ *Id.*

come from the last vowel sound” which “is insignificant and not sufficient to obviate a likelihood of confusion.³⁵

Applicant disagrees that this difference is insignificant, asserting that “at minimum, a full syllable out of three is distinct.”³⁶ Applicant emphasizes that “a difference of even a single letter *can* be relevant when ‘the marks would tend to stimulate a different response in the mind of the purchaser,” quoting *Gulf States Paper Corp. v. Crown Zellerbach Corp.*, 417 F.2d 795, 163 USPQ 589, 590-91 (CCPA 1969).

We are not persuaded that the minor difference in sound due to the ending letter being “O” instead of “A” is significant here. In *Gulf States Paper*, the Court found that the applicant’s mark CZ “can only represent initials of some sort,” and that “one seeing or hearing the mark would probably presume that that is what it indicates.” *Id.* at 591. In contrast, it found that the opposer’s mark E-Z “sounds like ‘easy’ and thus generates the idea of an attribute of the goods.” *Id.* This case is thus readily distinguishable from *Gulf States Paper*. While we agree that the marks may sound slightly different due to the difference in their ending vowels (“a” or “o”), we find that difference rather insignificant and note that it tends to lessen when the marks are pronounced quickly.

Having considered the marks in their entirety, we find that they are more similar than dissimilar in overall appearance, sound, connotation and commercial

³⁵ *Id.* at 27-28.

³⁶ 15 TTABVUE 12 (Applicant’s Brief).

impression. The first *DuPont* factor therefore weighs in favor of finding a likelihood of confusion.

IV. Conclusion

Having carefully considered all of the evidence made of record, as well as all of the arguments related thereto, *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023), we find that the marks are similar, the goods are identical in part and subject to impulse purchasers, and the channels of trade and classes of purchasers are the same. Confusion between the mark DI LUSSO in Registration



Nos. 1028047 and 2654912 and Applicant's mark is therefore likely.

Decision: The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).³⁷

³⁷ Because we have resolved this proceeding on Opposer's likelihood of confusion claim, we need not and do not reach Opposer's dilution claim. See *Yazhong Inv. Ltd. v. Multi-Media Tech Ventures, Ltd.*, 126 USPQ2d 1526, 1540 (TTAB 2018); *Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).