

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

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Armstrong Vineyards & Winery

Serial No. 78849329

Mark G. Falkin for Armstrong Vineyards & Winery.

Brian Neville, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Bucher, Drost and Zervas, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Armstrong Vineyards & Winery seeks registration on the
Principal Register of the mark shown below:



Luz de Estrella

for "wines" in International Class 33.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the mark **STARLITE VINEYARDS** (*in standard character format*) for "wine"² also in International Class 33, as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have filed briefs in the case. We affirm the refusal to register.

The Trademark Examining Attorney contends that there is a likelihood of confusion inasmuch as the goods are legally identical and the marks are confusingly similar. As to the similarity of the marks, the Trademark Examining Attorney argues that the literal portion of applicant's mark,

¹ Application Serial No. 78849329 was filed on March 29, 2006 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. The mark consists of a green star with red white and blue shapes within, a point of which is a purple bunch of grapes; underneath appears the stylized words LUZ DE ESTRELLA in blue. Applicant claims the color white, blue, green and purple as a feature of the mark. The foreign wording in the mark translates into English as "Star light."

² Registration No. 3083639 issued on April 18, 2006.

Luz de Estrella, a Spanish language term, translates into the English language as "Star light," while "Starlite" is the leading and dominant portion of registrant's mark.

In arguing for registrability, applicant argues that it would be inappropriate even to invoke the doctrine of foreign equivalents in this case. In the alternative, applicant contends that if one employs the doctrine herein, there is clearly no likelihood of confusion because of the profound differences in the commercial impressions of these marks when compared in their entireties, and because these terms are not exact foreign equivalents. Applicant also argues that wine purchasers tend to be discriminating and will not likely be confused.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. 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 Co., 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 any likelihood of

confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Goods, Trade Channels and Conditions of Sales

As seen above, the goods are identical. Applicant has submitted no arguments to the contrary. Where the goods are identical, and neither identification of goods has any limitations as to expensive wines or exclusive channels of trade, we must presume that the respective goods would move through the same trade channels to all the same classes of ordinary purchasers. We agree with the Trademark Examining Attorney on this point inasmuch as some wines can be obtained relatively inexpensively, and hence may be bought without a great deal of purchasing care or deliberation. *See In re Elbaum*, 211 USPQ 639 (TTAB 1981). Hence, these three *du Pont* factors favor the position of the Trademark Examining Attorney herein.

Similarity of the marks

We begin this part of the analysis mindful of the fact that when marks would appear on identical goods, the degree of similarity in the marks 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, 1700 (Fed. Cir. 1992).

Applicability of the Doctrine of Foreign Equivalents

The Trademark Examining Attorney contends that under the doctrine of foreign equivalents, the ordinary purchaser in the United States "who is knowledgeable in the foreign language" will translate the term "Luz de Estrella" into "Star light," its English-language equivalent. See *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006).

Applicant agrees with the general proposition that under the doctrine of foreign equivalents, foreign words from common languages are usually translated into the English language to determine similarity of connotation in order to ascertain confusing similarity with English word marks. See *Sarkli*, 721 F.2d 353, 220 USPQ 111, 112-13 (Fed. Cir. 1983).

On the other hand, applicant argues that when it is unlikely that the average American consumer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied, citing to *In re Tia Maria Inc.*, 188 USPQ 524 (TTAB 1975) [finding it unlikely that a person who had purchased AUNT MARY'S canned

fruits and vegetables from a supermarket, upon dining at the TIA MARIA restaurant surrounded by Mexican décor and being served Mexican food, would translate "Tia Maria" into "Aunt Mary" and then mistakenly assume that both goods and services originated from the same source]. However, we find nothing in this record to indicate the cited mark would not be translated because of marketplace circumstances or the commercial setting in which the mark is used. See also *In re Pan Tex Hotel Corp.*, 190 USPQ 209, 210 (TTAB 1976) [given the circumstances of this case, it is unlikely that purchasers would stop and translate **LA POSADA** into its equivalent, "the inn"].

Applicant highlights the manner in which our primary reviewing court used this same "stop and translate" language in its decision of *Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Based on its interpretation of *Palm Bay*, applicant argues that the Trademark Examining Attorney has erroneously applied the doctrine of foreign equivalents to the facts of the instant case. We turn then to applicant's arguments based upon its view of *Palm Bay*, which applicant argues compels a finding that the doctrine of foreign equivalents does not apply in this case.

Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine similarity of connotation in order to ascertain confusing similarity with English word marks. Applicant is correct in quoting the language from *Palm Bay* that the doctrine should be applied "when it is likely that the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Palm Bay*, 73 USPQ2d at 1696.

The "ordinary American purchaser" in this case refers to the ordinary U.S. purchaser of wine who also reads and speaks the Spanish language. See *In re Thomas*, 79 USPQ2d at 1024 [the "ordinary American purchaser" in a case involving a foreign language mark refers to the ordinary American purchaser who is knowledgeable in the pertinent foreign language]. Inasmuch as Spanish is a common, modern foreign language, we must consider that an appreciable segment of the buying public will speak or understand Spanish. In fact, among all the non-English languages spoken in the United States, Spanish has the largest number of foreign-language speakers in the country. *Id.*

Nonetheless, Applicant argues that the Trademark Examining Attorney's position flies in the face of well established case law as discussed in *Palm Bay* (i.e., since


" ... it is improbable that the average American purchaser would stop and translate 'VEUVE' into 'widow.'" We disagree with applicant's interpretation of the Federal Circuit's holding in the *Palm Bay* case, and note that a recent Board decision responded thoroughly to much the same argument. See *In re Spirits International N.V.*, 86 USPQ2d 1078 (TTAB 2008). The Court in *Palm Bay* identified contradictory findings by the Board in its earlier ruling, but the Court did not address the definition of the "ordinary American purchaser." Applicant's interpretation of *Palm Bay* conflicts with long-established case law involving the doctrine of foreign equivalents that has consistently focused on the relevant consumer who speaks or understands the foreign language. *Id.*

Equivalency of the translation

Alternatively, applicant argues that even if the average purchaser in the United States would stop and translate the term "Luz de Estrella," the translation that applicant itself supplied for the record (i.e., "Star light") does not match or denote the cited mark, **STARLITE VINEYARDS**. Rather, applicant argues that the unitary term "Starlite" in registrant's mark is a coined term without any translation into the Spanish language. Hence, the Spanish-

speaking consumer would neither recognize nor understand STARLITE as the equivalent of "Luz de Estrella." *Contra In re Thomas*, 79 USPQ2d at 1025 [**MARCHE NOIR** is the exact French equivalent of the English idiom **BLACK MARKET**].

Applicant argues that the present case is more like the facts of *Sarkli*, 220 USPQ at 112 - 13, where the Court of Appeals for the Federal Circuit found that **REPÊCHAGE** is not an exact equivalent of **SECOND CHANCE**. Applicant goes on to argue that such similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source. *Id.*

In looking to our precedent on this question, we do not agree with all of applicant's representations of what previous cases have held. For example, in the case of *In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987), the translation of **PALOMA** includes a "pigeon," so  is not an exact synonym, and the goods were found to be related, but not identical. Also, contrasted with the facts of the present case, the Board in the case of *In re L'Oreal S.A.*, 222 USPQ 925 (TTAB 1984), characterized both marks **HAUTE MODE** and **HI-FASHION SAMPLER** as "suggestive" in connotation, and hence entitled to a narrower scope of

protection, and that these respective marks were being used in connection with "disparate" goods.

The Trademark Examining Attorney is correct in noting that "Starlite" and "Luz de Estrella" / "Star light" have the same literal connotation. The critical issue is whether this is sufficient to establish confusing similarity in the overall evaluation of likelihood of confusion in the instant case.

Comparing the marks in their entirety

Applicant focuses on the cumulative differences in these two marks:



However, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a

side-by-side comparison, but rather whether the marks create the same commercial impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). We must take into consideration the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. *Chemtron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979).

Of course, there are obvious differences in the appearance of the two marks. Moreover, if one sounds out the entire wording in registrant's mark in English, and contrasts this with the pronunciation of applicant's mark in Spanish, the aural differences are unmistakable.

As to connotation, the Trademark Examining Attorney has correctly pointed out that in the world of source indicators, the terms "light" and "lite" are virtually interchangeable. And whether or not there is a space between the word "Star" and the words "Lite/Light" is of minimal significance in trademark law. If prospective consumers were to even notice these differences, it is unlikely any tribunal would find these differences alone sufficient to obviate a likelihood of confusion. This part of the analysis is not affected by the fact we are dealing with a case of foreign equivalents.

To the extent we find that the ordinary purchaser in the United States knowledgeable in the Spanish language will readily translate "Luz de Estrella" into "Star light," we also find that applicant's mark creates a connotation most similar to registrant's mark. "Star light" and "Starlite Vineyards" will have exactly the same connotation for registrant's wines and for applicant's wines, as identified. The "Star light" connotation of applicant's composite mark is accentuated by the applicant's choice of a "star" design, and having a bunch of grapes replacing one point of the star suggests a "vineyard."

Similarly, to focus on the leading term "Starlite" in registrant's cited mark is not a dissection of the mark nor was the Trademark Examining Attorney ignoring the second word in this phrase. Inasmuch as the term "Vineyards" in the registered mark is disclaimed inasmuch as it is at least merely descriptive of the goods, it is rational to accord it less significance when comparing the marks in their entireties.

Similarly, as to the commercial impressions created by these respective marks, there is nothing improper when articulating reasons for reaching a conclusion on the issue of similarity of the marks, to conclude that one feature of a mark may be more significant in creating a commercial

impression. *In re Dixie Restaurants Inc.*, 41 USPQ2d at 1533 - 34.

Accordingly, when comparing commercial impressions of the respective marks, we agree with the quite rational position of the Trademark Examining Attorney that more weight is to be accorded to the two literal portions of the marks, "Luz de Estrella" and "Starlite," while giving less weight to other features of the composite marks (e.g., a disclaimed term, suggestive imagery, trade dress colors, etc.).

In conclusion, in spite of the dissimilarities in the sound and appearance of the two marks, we must weigh this against the strong similarity in connotations and commercial impressions before reaching a conclusion on the similarity of the marks. *See Sure-Fit Products v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958).

Accordingly, we find after weighing all the types of similarities and dissimilarities of the marks, that this *du Pont* factor too weighs in favor of the position of the Trademark Examining Attorney.

These similarities in connotations and commercial impressions of the marks become even more significant to our finding of likelihood of confusion given that we have

legally-identical goods moving through the same trade channels to the same ordinary consumers.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby affirmed.