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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Marchesi de' Frescobaldi Societa' Agricola S.p.A.

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Serial No. 79021733

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Cecelia M. Perry of McGlew and Tuttle, P.C. for Marchesi de' Frescobaldi Societa' Agricola S.p.A.

Simon Teng, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Seeherman, Cataldo and Ritchie de Larena, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Marchesi de' Frescobaldi Societa' Agricola S.p.A. seeks an extension of protection on the Principal Register for the mark AMMIRAGLIA (in standard characters) for the following goods: "wine, sparkling wines, liqueurs" in International Class 33.[1] Registration has been finally

[1] Application Serial No. 79021733 was filed on December 23, 2005 seeking an extension of protection under Trademark Act Section 66(a), as amended, based upon International Registration No. 0879197. The application includes the following translation: The English translation of the foreign word(s) in the mark is FLAG-SHIP.

refused pursuant to Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark in Registration No. 2738831,[2] FLAGSHIP (in typed or standard characters), and the mark shown below in Registration No. 2813426,[3]

[2] Issued on July 15, 2003, based on an application filed February 9, 2001.

[3] Issued on February 10, 2004 with a disclaimer of "PREMIUM RUSSIAN VODKA." The registration includes the following translation: The Cyrillic characters in the mark transliterate to "FLAGMAN." The term FLAGMAN in the mark translates into English as "FLAGSHIP." The registration further includes the following description of the mark: The mark consists of the configuration of [a] bottle featuring a label around the neck containing two back-to-back letter B's enclosed in a circle and surrounded by a sunburst design; a middle circular label containing the wording "PREMIUM RUSSIAN VODKA" above two back to back capital letter "B"s enclosed in a circle, "FLAGMAN" in Cyrillic, "FLAGSHIP" in English, and a sunburst design in the background, all of which are surrounded by a sunburst design etched into the bottle; and a label at the base of the bottle consisting of a black band with a border.

both for "vodka" in International Class 33, as to be likely, if used on or in connection with the identified goods, to cause confusion, to cause mistake, or to deceive. Applicant and the examining attorney have filed main briefs on the issue under appeal.[4] In addition, applicant filed a reply brief.

Likelihood of Confusion

Our determination under Trademark Act §2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *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 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

[4] This case was reassigned to the examining attorney whose name appears above for preparation of the brief on appeal.

[or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

We review the relevant *du Pont* factors as they apply to this case.

The Goods

Turning to our consideration of the recited goods, we must determine whether consumers are likely to mistakenly believe that they emanate from a common source. It is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, as a result of similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's goods are identified as "wine, sparkling wines, liqueurs." Registrant's goods are

identified in the cited registrations as "vodka." As recited, both applicant's and registrant's goods are alcoholic beverages. Thus, the goods appear to be related to that extent on the face of the respective identifications thereof. We further note that applicant does not dispute the relatedness of its goods and those of registrant.

In addition, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark for goods that are identified in both applicant's application and the cited registrations. *See, for example*:

> Registration No. 1064997 for "brandy, wine, and vodka;"
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> Registration No. 1436614 for "brandy, liqueurs, cordials, gin, vodka, Canadian whiskey and scotch whiskey;"
>
> Registration No. 2775036 for "vodka, gin, scotch, whiskey, bourbon, rye whiskey, rum, wine;"
>
> Registration No. 2827201 for "alcoholic beverages, namely wine, vodka, Bloody Mary mix, margarita mix;" and
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> Registration No. 2756070 for "alcoholic beverages, not including beer, namely wine, hard cider, champagne, brandy, cognac, rum, vodka and gin."

Third-party registrations which individually cover a number of different items and which are based on use in commerce

serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). In this case, the evidence of record supports a finding that the same marks are used to identify both applicant's goods and those recited by registrant in both of its cited registrations. This evidence demonstrates the related nature of the goods at issue, and this *du Pont* factor favors a finding of likelihood of confusion.

Channels of Trade

Neither applicant's goods nor those of registrant contain any restrictions as to the channels of trade in which they are distributed or the class of purchasers to whom they are marketed. It is settled that in making our determination regarding the channels of trade, we must look to the goods as identified in the involved application and cited registrations. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Because there are no restrictions recited either in the involved application or cited registrations as to channels of trade, applicant's and registrant's goods are presumed to move in all normal channels of trade therefor and be

available to all normal classes of potential consumers. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Because liquor stores sell vodka as well as wine, sparkling wine and liqueurs, the goods must be deemed to be sold in the same channels of trade and encountered by the same classes of purchasers. Accordingly, this d*u Pont* factor further favors a finding of likelihood of confusion.

The Marks

We now turn to the *du Pont* factor to which the applicant and examining attorney have devoted most of their arguments, namely, the similarities or dissimilarities between applicant's mark and those of registrant. In coming to our determination, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, supra*. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

Registration No. 2738831

Applicant argues that its AMMIRAGLIA mark differs in appearance, sound and commercial impression from the registered mark, FLAGSHIP. Applicant further argues that

the similarities in the marks' connotations are outweighed by their differences in appearance and sound. Applicant argues in addition that AMMIRAGLIA is an obscure word in the Italian language, with several possible meanings, that is not known by many people; and that "the doctrine of foreign equivalents should only be applied when it is likely that the ordinary American purchaser would stop and translate the word into its English equivalent" (brief, p. 6).

The examining attorney, while conceding that "the marks at issue are not similar in sight and sound" (brief, p. 2), argues nonetheless that "similarity in meaning and connotation [sic] is sufficient to find a likelihood of confusion" (*Id.*) The examining attorney further argues that there is no evidence either that AMMIRAGLIA is an obscure term or that it is subject to numerous translations. Rather, the examining attorney argues that the evidence of record "clearly shows that AMMIRAGLIA translates *exactly* to 'flagship'" (*Id.*, emphasis in original).

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with English word marks. *See Palm Bay Imports, supra.* The doctrine is

applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Id.* at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976).

The "ordinary American purchaser" in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language. *See* J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:36 (4th ed. 2006). ("The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.") It is further settled that such "ordinary American purchaser" in a case involving a foreign language mark refers to the ordinary purchaser who is knowledgeable in English as well as the pertinent foreign language. *See In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006). *See also In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647-48 (TTAB 2008). In this case, such a purchaser would be knowledgeable in Italian.

In this case, neither applicant nor the examining attorney has introduced any evidence regarding the extent to which the Italian language is spoken in households in the United States. Nonetheless, in *In re Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986), we found that "it does not require any authority to conclude that

Italian is a common, major language in the world and is spoken by many people in the United States" in our determination that the doctrine of foreign equivalents is applicable where the foreign word is in Italian. Further, "we presume that a word in one of the common, modern languages of the world will be spoken or understood by an appreciable number of U.S. consumers for the product or service at issue." *In re Spirits Int'l*, 86 USPQ2d at 1085. While the doctrine of foreign equivalents is not an absolute rule, it is accepted that "words from modern languages are generally translated into English." *Palm Bay Imports*, 73 USPQ2d at 1696.

As noted above, the application at issue includes a translation of applicant's mark, AMMIRAGLIA, as "FLAG-SHIP," which was provided by applicant. In addition, the examining attorney submitted several translations from Internet-based dictionaries, all of which agree with the translation provided in the application at issue, including the following:

ammiraglia (naut, fig) - flagship;[5]

ammiraglia - flagship;[6] and

[5] WordReference.com Dizionario Italiano-Inglese.
[6] Frasi.net dizionari lingue.

ammiraglia s.f. – flagship.[7]

Applicant, for its part, submitted with its brief the following translation of "ammiraglia" in support of its contention that the term has more than one meaning in Italian: ammiraglia (mar.) admiral s.f. // (mar.) admiral (-ship); flag-ship.[8] Applicant also submitted with its June 14, 2007 response to the examining attorney's Office action the following definition of "flagship" in support of its position that such term has more than one meaning:

flagship n. 1. the ship that carries the commander of a fleet or other large naval unit; 2. the largest or most important member or part, as of a group.[9]

Based upon the above evidence and authorities, we find that Italian is a modern language which is not obscure. We further find that every translation made of record, including the translations provided by applicant with the application at issue as well as its brief, agrees that AMMIRAGLIA means flagship. *Cf. In re Sarkli, Ltd.*, 721

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[7] Ultralignua Online Dictionary.

[8] Grande Dizionaria Inglese – Italiano Italiano – Inglese, 1 Edizione: Aprile 1961. We hereby take judicial notice of this translation. The Board may take judicial notice of dictionary entries, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

[9] Webster's New World Compact Dictionary and Style Guide, 2nd Ed.

F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). Applicant appears to argue that the English word "flagship" has two meanings, a nautical meaning and a figurative meaning of the largest, most important member of a group. Even if that is the case, the word AMMIRAGLIA directly translates into the nautical English meaning, and therefore AMMIRAGLIA and FLAGSHIP are equivalents. *Cf. In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987) (Spanish word "paloma" translating to pigeon and dove, and therefore having broader meaning than the English word, "dove," was found not to be the foreign equivalent thereof.) We find in addition that applicant has provided no evidence to support its contention that AMMIRAGLIA is either an obscure term or would be unlikely to be translated by the ordinary American purchaser who is knowledgeable in the English and Italian languages.

We find, in view of the foregoing, not only that the Italian term AMMIRAGLIA is the exact translation of "flagship," but further that the mark would be translated by those who are familiar with the Italian language. This situation, thus, differs from those cases in which it was found that the mark would not be translated because of the inherent nature of the mark. *Cf. In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1984); and *Le Continental Nut Co. v. Le*

Cordon Bleu S.A.R.L., 494 F.2d 1395, 181 USPQ 646 (CCPA 1974) (finding that CORDON BLUE, while literally translated as BLUE RIBBON, would not be translated by the American public because the two terms create different commercial impressions, CORDON BLEU having been adopted into the English language and acquiring a different meaning from BLUE RIBBON).

As a result, we find that the doctrine of foreign equivalents applies. While the marks differ in sound and appearance, the identity in meaning and commercial impression is sufficient to support a finding of likelihood of confusion as used in connection with related alcoholic beverages. The fact that the marks AMMIRAGLIA and FLAGSHIP have the same meaning, resulting in a highly similar overall commercial impression, is sufficient for us to conclude that confusion is likely, despite the differences in their appearance and sound. *See In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987).

Registration No. 2813426

We reach a different result on the question of likelihood of confusion with respect to the mark shown below.

In this case, the only similarity between applicant's mark and the mark in the cited registration is the similarity in meaning between AMMIRAGLIA, which, as noted above, is translated from Italian into English as "flagship," and the term FLAGSHIP as it appears as part of the English wording "BB FLAGSHIP PREMIUM RUSSIAN VODKA" in the registered mark. Such identity of meaning, however, is outweighed in the context of the additional material in the mark, in particular the Cyrillic Russian characters, other English wording, and design elements, all of which are prominently displayed therein. As a result, consumers are not likely to view the marks as similar, despite the presence of the word FLAGSHIP on that label, nor are they likely to believe that applicant's goods sold under the AMMIRAGLIA mark emanate from the same source as registrant's goods sold under this label mark.

Thus, when we compare applicant's mark with the cited label mark, the fact that the word FLAGSHIP appears on the

label, such that in this respect there is a similarity in connotation, is far outweighed by the differences in appearance, pronunciation and commercial impression.

***Decision*:** The refusal to register under Trademark Act § 2(d) is affirmed as to the mark in Registration No. 2738831 and reversed as to the mark in Registration No. 2813426.