

This Opinion is Not a  
Precedent of the TTAB

Mailed: February 21, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Sensi Vigne & Vini SRL*  
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Serial No. 79201501  
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Kathleen A. Costigan of Hedman & Costigan PC,  
for Sensi Vigne & Vini SRL.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 112,  
Renee Servance, Managing Attorney.

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Before Wolfson, Pologeorgis and English,  
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Sensi Vigne & Vini SRL (“Applicant”) seeks registration on the Principal Register of the mark set forth below for “wines; sparkling wines” in International Class 33.<sup>1</sup>

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<sup>1</sup> Application Serial No. 79201501; filed July 7, 2016 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a) based on International Registration 1330957; “FAMILY OF WINEMAKERS SINCE 1890” disclaimed. The application includes the following description of the mark: “The mark consists of a design of a bottle label with a border and bearing a design of a rose and branch with an oval with the stylized wording ‘DOLCE VITA’ above the stylized wording ‘DEI SENSI FAMILY OF WINEMAKERS SINCE 1890’ where the wording ‘WINEMAKERS’ is superimposed over ‘1890’.” Color is not claimed as a feature of the mark. The application also includes the following translation statement: “The English translation of ‘DOLCEVITA’ in the mark is ‘sweet life’ and the English translation of ‘DEI SENSI’ is ‘of the senses’.”



The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the standard character mark DULCE VIDA for “distilled spirits” in International Class 33.<sup>2</sup> When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied Applicant’s request for reconsideration, and the appeal was resumed. We affirm the refusal to register.

### **I. Analysis**

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont*

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<sup>2</sup> Registration No. 3615462; issued May 5, 2009. Section 8 declaration accepted; Section 15 declaration acknowledged. The registration includes the following translation statement: “The English translation of DULCE VIDA is SWEET LIFE.”

factor that is relevant or for which there is evidence of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

#### **A. Similarity or Dissimilarity of the Goods and Trade Channels**

We first address the similarity or dissimilarity of the goods. The respective goods need not be identical or directly competitive for there to be a likelihood of confusion, but the evidence must establish that the goods are related in some manner, or the conditions surrounding their marketing are such, that they could be encountered by

the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003-04 (Fed. Cir. 2002); *see also In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).

The Examining Attorney has introduced: (1) web pages showing thirteen entities each operating as a combined winery and distillery producing and selling both wine and distilled spirits;<sup>3</sup> five of the entities sell wine and distilled spirits under the same mark: BARTLETT, CEDAR RIDGE, MOUNTAIN VIEW, KOENIG, and RANSOME;<sup>4</sup> (2) 20 active third-party, use-based registrations showing that different entities have registered the same marks for both wine and distilled spirits<sup>5</sup>; and (3) web pages showing three retailers selling both wine and spirits.<sup>6</sup> This evidence is sufficient to establish that wine and distilled spirits are related. *In re Country Oven, Inc.*, 2019 USPQ2d 443903 \*5 (TTAB 2019); *L'Oreal S.A. v. Macron*, 102 USPQ2d 1434, 1440 (TTAB 2012) (third-party websites and registrations showed that a single entity may offer both parties' products under the same mark); *In re G.B.I. Tile and Stone*, 92 USPQ2d 1366, 1369 (TTAB 2009) (finding goods related based on third-party

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<sup>3</sup> September 17, 2017 Office Action at TSDR 44-49; March 30, 2018 Final Office Action at TSDR 12-28; Denial of Request for Reconsideration, 5 TTABVUE 8-19.

Citations to the prosecution record are to the Trademark Status & Document Retrieval ("TSDR") system by page number in the downloadable .pdf versions of the documents. All other citations are to TTABVUE, the Board's online docketing system.

<sup>4</sup> September 17, 2017 Office Action at TSDR 44-45 and 48-49; March 30, 2018 Final Office Action at TSDR 20-24; Denial of Request for Reconsideration, 5 TTABVUE 10-11.

<sup>5</sup> September 17, 2017 Office Action at TSDR 9-40; March 30, 2018 Final Office Action at TSDR 37-59.

<sup>6</sup> March 30, 2018 Final Office Action at TSDR 29-36.

registrations and Internet evidence showing the goods originating from a common source); *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009) (finding goods related based on third-party Internet evidence showing applicant's and registrant's goods sold by a single source and twenty-one third-party use-based registrations covering both applicant's and registrant's goods). Applicant has not attempted to refute this evidence.

Because neither the application nor the cited registration includes limitations as to trade channels or classes of purchasers we presume that the goods move in all the normal channels of trade for such goods – liquor stores, bars, and restaurants – and flow to the same classes of purchasers.<sup>7</sup> See *Schieffelin & Co. v. Molson Cos., Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“[S]ince there are no restrictions with respect to channels of trade in either applicant’s application or opposer’s registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages” including “bars, restaurants, and liquor stores”); see also *In re*

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<sup>7</sup> Applicant makes a passing argument in its Appeal Brief that purchasers of Applicant’s and Registrant’s alcoholic beverages are likely to exercise a “level of care” that will make confusion unlikely. Appeal Brief, 17 TTABVUE 10. There is, however, nothing in the record showing that purchasers of wine or distilled spirits are particularly sophisticated, or would exercise a greater degree of care in making a purchase than the general public. *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (no evidence that wine, in general, is expensive, or that purchasers are sophisticated and careful in making purchasing decisions). Because the identifications of goods do not include restrictions on the classes of consumers or conditions of sale, we must presume that the purchasers of Applicant’s wine and Registrant’s distilled spirits include casual consumers of inexpensive or moderately-priced wine and distilled spirits. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 765 (TTAB 1986) (rejecting the applicant’s arguments regarding the high cost and quality of its wine and the sophistication of its purchasers where application identified goods merely as “wine”); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 (TTAB 2018) (“The relevant purchasers are ordinary consumers in the United States who purchase wine[.]”).

*Chatam Int'l Inc.*, 71 USPQ2d at 1947-48 (tequila and beer and ale sold in similar trade channels); *In re Majestic Distilling Co.*, 65 USPQ2d at 1204 (malt liquor and tequila “similar by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers”); *Monarch Wine Co. v. Hood River Dist., Inc.*, 196 USPQ 855, 857 (TTAB 1977) (whisky, vodka, rum, brandy, wine and champagne travel in same channels of trade to the same classes of purchasers); *In re AGE Bodegas Unidas, S.A.*, 192 USPQ 326 (TTAB 1976) (“[T]here is clearly a relationship between wine and whiskey, both of which alcoholic beverages are sold through the same specialized retail outlets to the same purchasers, and are frequently bought at the same time[.]”).

Accordingly, the relatedness of the goods, trade channels, and classes of purchasers weigh in favor of finding a likelihood of confusion.

### **B. Similarity or Dissimilarity of the Marks**

We now consider the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *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) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The issue 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 terms of

their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 688 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d at 1438; *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entirety. *Stone Lion*, 110 USPQ2d at 1160; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). But one feature of a mark may be more significant than another, and it is not improper, for rational reasons, to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Chatam Int’l Inc.*, 71 USPQ2d at 1946; *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000).

Applicant disputes that “Dolcevita” is the dominant element of its mark, arguing that its “stylized presentation of ‘**Dolcevita**’ as one word and the additional wording *dei SENSI*, ‘of the senses’, along with the distinctive floral elements and the [wording ‘FAMILY OF WINEMAKERS SINCE 1890’] is very likely to make a significant and

lasting impression on the purchaser’s memory.”<sup>8</sup> In arguing the differences between the marks, Applicant cites *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009) where the Board found that the standard character mark VOLTA for energy vodka infused with caffeine was not confusingly similar to the registered mark



for “wines.” In that case, the term common to both marks (“VOLTA”) was displayed in the registered mark in substantially smaller font than the term “TERZA” and below a prominent design element. *Id.* at 1284 (describing the term TERZA as “dominant” and the design feature as “prominent”).

Here, the “Dolcevita” part of Applicant’s mark is dominant because it is the first word to appear on Applicant’s bottle label, and it is prominently displayed in the top center of the design, in large font, against a blank oval background with a double outline. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (first word in the mark and on the label “remains a ‘prominent feature’”). The term “SENSI” is also displayed

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<sup>8</sup> Appeal Brief, 17 TTABVUE 12.

in large font and in bold, but it is less prominent because it is displayed at the bottom of the design and the letters “NSI” blend into the floral background design. The wording “FAMILY OF WINEMAKERS SINCE 1890” is merely descriptive or informational and has been disclaimed so it is entitled to less weight in the likelihood of confusion analysis. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 985)); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). Similarly, the floral design serves as a decorative background and does little to distinguish Applicant’s mark from the cited mark.

The dominant part of Applicant’s mark “Dolcevita” is similar in both appearance and sound to the cited mark DULCE VIDA. The terms are spelled similarly with the difference of only the second vowel, “o” vs. “u,” the last consonant “t” vs. “d,” and the addition of a space in the cited mark. The letters “t” and “d” are often pronounced similarly,<sup>9</sup> the space in the cited mark is inconsequential, and the different pronunciation of the initial vowels “o” and “u” is minor. Accordingly, it is foreseeable

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<sup>9</sup> The letters “d” and “t” produce similar sounds because both letters are “alveolar stops.” Encyclopedia Britannica, <https://www.britannica.com/topic/stop-speech-sound> (last visited February 20, 2020). The Board may take judicial notice of information from online encyclopedias that are available in printed format. *See, e.g., In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.3 (TTAB 2016); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.24 (TTAB 2013).

that consumers will pronounce the dominant portion of Applicant's mark similarly to the cited mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir.) (“[T]here is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner.”); *Schieffelin & Co.*, 9 USPQ2d at 2073 (recognizing that the marks BRADOR for malt liquor beer and ale and BARS D'OR for Cognac brandy “can be pronounced in different ways” but that “they are susceptible of being pronounced in the identical manner”).

The similarity in sound between the “Dolcevita” portion of Applicant's mark and the cited mark DULCE VIDA is significant. Restaurant and bar patrons are likely to place verbal orders for Applicant's and Registrant's alcoholic beverages, and because customers have a propensity to shorten marks when referring to them, it is foreseeable that consumers will use the dominant term “Dolcevita” to request or refer to Applicant's wine. *In re Aquitaine Wine*, 126 USPQ2d at 1188 (“[C]onsumers often have a propensity to shorten marks when ordering [goods] orally[.]”); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (finding ML likely to be perceived as a shortened version of ML MARK LEES when used on the same or closely related skin care products); *Big M Inc. v. U.S. Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks and[.]”); *see also In re Viterra Inc.*, 101 USPQ2d at 1908 (“In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.’”). Bar and restaurant patrons also are unlikely to see Applicant's label before ordering, and

may never see the label if Applicant's wine is served by the glass, as wine often is served in bars and restaurants. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016).

The marks also engender similar connotations and commercial impressions based on the dominance of the term "Dolcevita" in Applicant's mark. "Dolce vita" (two words) is defined in an American English dictionary as meaning "sweet life."<sup>10</sup> Consumers are likely to attribute this meaning to the term "Dolcevita" in Applicant's mark even though it is displayed as one word. Applicant has added a translation statement to its mark description, stating that the term DOLCEVITA means "sweet life." Because of the similarity in spelling, the cited mark DULCE VIDA conveys a similar meaning and commercial impression; likewise, Registrant has indicated in its registration that the English translation of DULCE VIDA is "sweet life." Moreover, because distilled spirits and wine are related, when consumers familiar with the cited mark encounter Applicant's mark, they are likely to perceive Applicant's mark as denoting an extension of Registrant's brand from distilled spirits to wine. *See, e.g., Schieffelin & Co.*, 9 USPQ2d at 2073 ("Those consumers who do recognize the differences in the marks may believe that applicant's mark is a variation of opposer's mark that opposer has adopted for use on a different product."); *cf. In re Toshiba Medical Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN "more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices"); *In re*

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<sup>10</sup> February 22, 2017 Office Action at TSDR 7.

*Fiesta Palms, LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) (affirming refusal to register CLUB PALMS MVP based on prior registration for MVP, finding consumers “likely to believe that the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services”).

Lastly, we keep in mind that although Applicant’s mark is a word and design mark, the cited mark is a standard character mark without limitation on the manner of display. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *In re RSI Sys., LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 1012, 2015 (TTAB 1998). Accordingly, we must assume that Registrant could display its mark in a stylization identical or similar to the literal portions of Applicant’s mark. *In re Aquitaine Wine*, 126 USPQ2d at 1186 (“Since Registrant’s mark is a standard character mark, we must consider that the literal elements of the mark (the words and the letters) may be presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant’s mark. This is because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”) (citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)).

When the marks are compared in their entireties, the additional words and design elements in Applicant’s mark create some differences in appearance and commercial impression and the additional words somewhat distinguish Applicant’s mark in sound. But “Dolcevita” is the dominant portion of Applicant’s mark and for the

reasons discussed above, it weighs more heavily in the overall appearance, sound, connotation and commercial impression of Applicant's mark. Accordingly, we find that the marks, when considered in their entirety, are more similar than dissimilar and this weighs in favor of finding a likelihood of confusion.

### **C. Applicant's Prior Registration**

The thirteenth DuPont factor relates to "any other established fact probative of the effect of use." *DuPont*, 177 USPQ at 567. It is under this factor that we consider Applicant's argument that its mark should be allowed to register because Applicant owned Registration No. 4582150 for "a similar mark" that coexisted on the register with the cited mark.<sup>11</sup>

As an initial matter, Applicant never made its prior registration of record. The Board does not take judicial notice of registrations in Office records, but because both Applicant and the Examining Attorney treat the registration as if it is of record, we do too. *In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017).

Registration No. 4582150 issued August 12, 2014 for the mark set forth below for "wine" and was cancelled September 26, 2016 because the underlying International Registration was cancelled.

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<sup>11</sup> Appeal Brief, 17 TTABVUE 13-14.



Applicant argues that the coexistence of the marks on the register “even for a few years is a relevant consideration as it clearly indicates that the United States Patent and Trademark Office has determined that such marks can co-exist without buyer confusion as to source of the goods.”<sup>12</sup> In support of this assertion, Applicant cites to *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012). In that case, the applicant owned a subsisting registration for a “substantially similar mark for the identical goods” that had “coexisted with the cited mark for over five years.” *Id.* at 1399 (“Purchasers are unlikely to perceive any distinction in overall commercial impression between ANYWEARS and ANYWEAR”). Because the applicant’s prior registration was over five years old, it was not vulnerable to attack by the owner of the cited registration based on a claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act. *Id.* The Board found that this “unique situation” outweighed the other *DuPont* factors and led to a conclusion that confusion was not likely. *Id.* at 1400.

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<sup>12</sup> *Id.*

The circumstances here are entirely different. Applicant's prior registration is cancelled. Cancellation of a registration "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought" and the current record. *In re Hunter Publ'g Co.*, 204 USPQ 957, 963 (TTAB 1979); *see also In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) ("[The Federal Circuit], like the Board must evaluate the evidence in the present record to determine whether there is sufficient evidence ...."); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) ("[E]ach application must be considered on its own merits."); *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (same).

Accordingly, we treat the thirteenth *DuPont* factor as neutral.

## II. Conclusion

The goods are highly related, the trade channels and classes of purchasers are the same, and the marks are more similar than different in appearance, sound, connotation and commercial impression. It is foreseeable that consumers will perceive Applicant's mark as identifying an extension of Registrant's product line from distilled spirits to wine. Accordingly, we find that confusion is likely between Applicant's mark and the cited mark.

**Decision:** The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.