

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: November 12, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Fertinagro Biotech International, S.L.
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Serial No. 79328903
—

Arturo Perez-Guerrero of Perez Guerrero LLC,
for Fertinagro Biotech International, S.L.

Daniel L. Flint, Trademark Examining Attorney, Law Office 116,¹
Elizabeth Jackson, Managing Attorney.

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Before Goodman, Thurmon, and Elgin,
Administrative Trademark Judges.

Opinion by Elgin, Administrative Trademark Judge:

Fertinagro Biotech International, S.L. (“Applicant”) seeks registration on the

Principal Register of the composite mark



for “Soil fertilizers;

fertilizers,” in International Class 1.²

¹ The application was reassigned from Examining Attorney Kristina Morris to Daniel L. Flint for purposes of appeal.

² Application Ser. No. 79328903 was filed on November 16, 2021 based upon a request for extension of protection of International Registration No. 1586025 (registered February 12, 2021) under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a). The mark is described

The Examining Attorney refused registration of the subject mark, *inter alia*, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that, as applied to the goods identified in the application, it so resembles the standard character mark FERTUM in standard characters for “chemical preparations for use in agriculture, horticulture and forestry, namely, chemical additives for use in the manufacture of fertilizer; fertilizers; manures,” in International Class 1³ as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration and the appeal was resumed. Applicant and the Examining Attorney filed briefs.⁴

For the reasons set forth below, we **affirm** the refusal to register.

as consisting of: “a globe within a circle to the left of the stylized wording FERTIUM above the stylized wording MAXIMA within a rectangle.”

³ Registration No. 4777932 issued July 21, 2015 on the Principal Register; Combined Declaration of Continuing Use and Incontestability under Trademark Act Sections 8 and 15, 15 U.S.C. §§ 1058 and 1065, accepted and acknowledged.

⁴ Applicant’s Brief is at 8 TTABVUE. The Examining Attorney’s Brief is at 10 TTABVUE. Applicant did not file a Reply Brief.

Citations in this opinion to the briefs on appeal are to the Board’s TTABVUE docket system. *See In re Integra Biosciences Corp.*, Ser. No. 87484450, 2022 TTAB LEXIS 17, *6. Page references to the application record refer to the downloaded .pdf version of USPTO’s Trademark Status & Document Retrieval (TSDR) system. The citation form in this opinion is in a form provided in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (June 2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion employs citation to the LEXIS database.

I. Likelihood of Confusion Test

Section 2(d) of the Trademark Act prohibits the registration of a mark that

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the [services] of the applicant, to cause confusion, or to cause mistake, or to deceive.

We base our determination under Section 2(d) on all the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”); *see also Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1319 (Fed. Cir. 2018) (“Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.”) (citations omitted). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997) and *DuPont*, 476 F.2d at 1361).

“Two key *DuPont* factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because 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.’” *In re Embiid*, Ser. No. 88202890, 2021 TTAB LEXIS 168, *10 (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976)); *see also In*

re i.am.symbolic, llc, 866 F.3d 1315, 1322 (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, 1164-65 (Fed. Cir. 2002)).

Applicant discusses only the first *DuPont* factor relating to similarity of the marks; the Examining Attorney discusses this factor, as well as the second and third *DuPont* factors relating to similarity of the goods and channels of trade. Applicant raises its three active registrations for FERTINAGRO formative marks, which we discuss under the thirteenth *DuPont* factor.⁵

II. *DuPont* Factors

A. Similarity or Dissimilarity of Goods

We commence our analysis with the second *DuPont* factor, which “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361).

The Examining Attorney argues Registrant’s goods “fertilizers” are in-part identical to Applicant’s goods “fertilizers” and encompass Applicant’s narrower “soil

⁵ Applicant made two of these registrations of record during prosecution, and attached the certificate of registration for the third, which matured from an application previously made of record, to its brief. *See* 8 TTABVUE 11. Because the Examining Attorney addresses the evidence in his brief, we have considered it here. *See In re 1st USA Realty Profs.*, Ser. No. 78553715, 2007 TTAB LEXIS 73, *2-3 (Board considered applicant’s own registration, provided for the first time on appeal, because it had been referred to during prosecution and the examining attorney addressed the issue without objection).

fertilizers.”⁶ It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods or services within a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 TTAB LEXIS 166, *37.

We find that Applicant’s and Registrant’s identified goods are in-part identical (i.e., both identify “fertilizers”). Again, Applicant does not argue otherwise. The second *DuPont* factor favor a finding of likelihood of confusion.

B. Similarity or Dissimilarity of Likely-to-Continue Trade Channels

“[T]he third *DuPont* factor considers ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *In re Embiid*, 2021 TTAB LEXIS 168, *29 (quoting *Detroit Athletic Co.*, 903 F.3d at 1308). Where, as here, the relevant goods are in-part identical, we must presume that the channels of trade and classes of purchasers for these goods and services are the same. *See In re Viterra*, 671 F.3d 1358, 1362 (Fed. Cir. 2012), cited in *In re Info. Builders Inc.*, Ser. No. 87753964, 2020 TTAB LEXIS 20, *12. Applicant does not challenge this argument. The third *DuPont* factor also favors a conclusion that confusion is likely.

C. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial

⁶ 10 TTABVUE 3-4.

impression.” *In re Inn at St. John’s, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, *12 (citing *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Davia*, Ser. No. 85497617, 2014 TTAB LEXIS 214, *4). When the goods are at least in-part identical, as is the case here, “the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992) (citations omitted).

The proper test regarding similarity “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 [Applicant and Registrant].” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (internal citation omitted). Although the marks must be viewed in their entireties, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); *see also Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1321 (Fed. Cir. 2014).

“The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, Ser. No. 85916778, 2018 TTAB LEXIS 281, *11. Further, the similarity or dissimilarity of marks “is not a binary factor but is a matter

of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (internal quotation omitted)).



Applicant’s composite mark is . The cited mark is FERTUM in standard characters. Applicant first argues the literal terms FERTUM and FERTIUM MAXIMA are different in that the first has two, and the second has five, syllables.⁷ Applicant points to the different pronunciations of the marks, which it claims are (phonetically written) FERTOOM and FERTEEUM MAXIMA.⁸ Applicant also asserts that the additional term MAXIMA in its mark is distinctive and at least as prominent as the term FERTIUM and that it adds a different appearance, sound, and meaning to the mark.⁹

The Examining Attorney counters that the dominant term of Applicant’s mark is FERTIUM, which is nearly identical in appearance, sound, meaning, and commercial impression to the cited mark FERTUM.¹⁰ Further, he contends that the addition of the term MAXIMA (for “maximum,” meaning “[t]he greatest possible quantity or degree”) in Applicant’s mark is suggestive and does not diminish likelihood of confusion.¹¹ As to the design elements and stylized text of Applicant’s composite

⁷ 8 TTABVUE 4-5.

⁸ *Id.* at 5.

⁹ *Id.* at 4-5.

¹⁰ 10 TTABVUE 5.

¹¹ *Id.* at 6-7. The Examining Attorney submitted dictionary evidence supporting this definition. See June 12, 2023 Final Office Action, at TSDR 6. Applicant agrees to this definition. 8 TTABVUE 4.

mark, the Examining Attorney argues the cited mark is in standard characters and thus is not limited to any particular display or rendition.¹²

The first literal term in Applicant's mark and Registrant's mark are highly similar, and we think that most purchasers will not notice or remark upon the added letter "T" in the term FERTIUM. The shared meaning of the shared "FERT" prefix in both marks is clear, referring to both Applicant's and Registrant's fertilizer goods.

We also believe that the added term MAXIMA in the composite mark



, which is smaller and less noticeable, is subordinate to more dominant initial term FERTIUM. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 369 F.3d 1369, 1372 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, Opp. No. 91074797, 1988 TTAB LEXIS 60, *8 ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

Merely adding a term such as MAXIMA to a registered mark generally does not obviate the similarity between the compared marks. *See, e.g., Stone Lion*, 746 F.3d at 1322 (affirming the Board's finding that applicant's mark STONE LION CAPITAL

¹² 10 TTABVUE 7-8.

incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties' marks); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557-58 (CCPA 1975) (finding BENGAL and BENGAL LANCER and design to be confusingly similar). The MAXIMA term, which both the Examining Attorney and Applicant agree is indicative of the term "maximum" for "the greatest possible or degree," also is less dominant because it is somewhat suggestive of the power or efficacy of Applicant's products. The term does not alter the meaning of Applicant's mark.


Consumers also have a tendency to shorten marks, making it reasonable to assume that at least some consumers will "drop the [suggestive] term[s] [MAXIMA] when calling for" Applicant's goods. *In re Bay State Brewing Co.*, Ser. No. 85826258, 2016 TTAB LEXIS 46, *9 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 815 (CCPA 1978) (Rich, J., concurring) ("the users of language have a universal habit of shortening full names – from haste or laziness or just economy of words.")). And, "[Registrant's] mark would appear to prospective purchasers ... [as] a shortened form of [Applicant's] mark." *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010) (quoting *In re U.S. Shoe Corp.*, Ser. No. 446404, 1985 TTAB LEXIS 23, *6).

Applicant does not address the stylization of the literal elements or the design elements in its mark. The Examining Attorney argues that they do not distinguish the marks.¹³ First, we do not believe that the stylization of letters in Applicant's mark is sufficient to distinguish the marks. As Registrant's mark is in standard characters,

¹³ 10 TTABVUE 7-8.

it may be presented in any number of fonts, including the font or stylizations used in Applicant's mark. *See Viterra*, 671 F.3d at 1363 (citations omitted); *Mighty Leaf Tea*, 601 F.3d at 1348 (rejecting an argument that the specific style of a registered mark could serve to distinguish the applicant's mark in standard character form).

We cannot similarly assume, however, that a display of Registrant's mark may be accompanied by the design elements in Applicant's composite mark, because when "we are comparing a standard character mark to a word + design mark for Section 2(d) purposes, we will consider variations of the depictions of the standard character mark only with regard to 'font style, size, or color' of the 'words, letters, numbers, or any combination thereof.'" *In re Aquitaine Wine USA, LLC*, Ser. No. 86928469, 2018 TTAB LEXIS 108, at *15-16 (citing *Viterra*, 671 F.3d at 1363 and *Citigroup Inc. v. Cap. City Bank Grp.*, 637 F.3d 1344, 1349 (Fed. Cir. 2011)).

We find, however, that consumers are unlikely to perceive the black rectangle design element or the circle in Applicant's composite mark  as source identifiers as they are common geometric shapes that serve merely as an outline or carrier for the literal element MAXIMA and the globe design in Applicant's mark. *In re Ocean Tech., Inc.*, Ser. No. 87405211, 2019 TTAB LEXIS 382, *17 (TTAB 2019) (circular design around wording in proposed mark found to be "a common geometric shape that consumers likely would perceive as a background design or carrier to the enclosed wording, rather than as a separable design element with trademark significance"); *see also In re Dixie Rests.*, 105 F.3d 1405, 1407 (Fed. Cir.

1997) (DELTA was the dominant portion of applicant's mark THE DELTA CAFE and design in part because "the design is an ordinary geometric shape that serves as a background for the word mark."), *cited in Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 TTAB LEXIS 464, *40 ("The rectangular exterior shape outlined in the mark . . . is nothing more than a non-descript 'carrier' for the words and design.").

The globe design in Applicant's composite mark is a point of difference, but it also does not sufficiently distinguish it from the cited mark. It is well-established that, when a mark consists of both words and a design, the literal portion of a mark generally is the dominant feature because it is the element by which consumers will refer to and call for the goods or services. *See, e.g., In re Viterra*, 671 F.3d at 1362 ("the verbal portion of a word and design mark likely will be the dominant portion"); *In re Appetito Provisions Co.*, Ser. No. 423405, 1987 TTAB LEXIS 47, *3-4 ("if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services" and "because applicant's mark shares with registrant's mark that element responsible for creating its overall commercial impression, the marks are confusingly similar"). As mentioned above, Applicant does not contend that the design is the dominant portion of the mark, nor has it presented any evidence that the globe design has any significance with regard to its goods that would distinguish them from Registrant's in-part identical goods. To the extent consumers are likely to perceive the globe design as something indicative of, for example, the international

availability of Applicant's goods, that same meaning may be applied equally to the goods under the cited mark.

Finally, Applicant's arguments as to dissimilarity of appearance and sound of the marks are not persuasive. A determination of likelihood of confusion also is not made on a purely mechanical basis, counting the number of words, syllables or even letters that are similar or different. *See In re John Scarne Games, Inc.*, 1959 TTAB LEXIS 31, *1 (no number in original) ("Purchasers . . . do not engage in trademark syllable counting[;] they are governed by general impressions made by appearance or sound, or both."). Moreover, there is no evidence of record as to how consumers will pronounce these terms, and "[t]here is no correct pronunciation of a trademark that is not a recognized word." *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1331-32 (Fed. Cir. 2014). FERTIUM, the dominant portion of Applicant's mark, and FERTUM in the cited mark are not recognized English words, so we have considered "all the reasonable possibilities" for their pronunciation. *Inter IKEA Sys. B.V.*, 2014 TTAB LEXIS 166, *18 n.19 (citations omitted). Here, it is reasonable to assume that some consumers will pronounce these almost identical terms almost identically, e.g., FUR-TEE-UMM and FUR-TUMM.

In sum, we find that Applicant's applied-for composite mark is far more similar to Registrant's cited mark than it is different, favoring a finding of likelihood of confusion.

D. Thirteenth *DuPont* Factor

One of Applicant’s principal arguments rests on the following active registrations, of which it claims ownership:

FERTINAGRO (Reg. No. 6604460, registered Jan. 4, 2022) for “Soil fertilizers”;

FERTINAGRO BIOTECH and design (“biotech” disclaimed) (Reg. No. 7166424, registered Sept. 19, 2023) for “Soil fertilizers and manures”; and

FERTINAGRO PHOSPHOACTIVE (Reg. No. 7134984, registered Aug. 15, 2023) for “Fertilizers; soil fertilizers.”

Applicant argues that these registrations share the root FERTI with the applied-for mark and cover the same goods, and they co-exist with the cited registration. Further, Applicant contends the shared FERTI term “move[s] and incline[s] consumers’ mind and attention to appellant’s applicant’s prior registered marks”¹⁴ The Examining Attorney argues the prior registered marks are not relevant, as “the focus of a likelihood of confusion analysis in an ex parte case is on the mark applicant seeks to register, rather than other marks applicant has used or registered,” and the marks are not identical to Applicant’s applied-for mark.¹⁵

We address this argument under the thirteenth *DuPont* factor, which examines “any other established fact probative of the effect of use.” *DuPont*, 476 F.2d at 1361. Rarely invoked, the thirteenth factor is intended to accommodate “the need for flexibility in assessing each unique set of facts.” *See In re Strategic Partners*, Ser. No.

¹⁴ 8 TTABVUE 7-8.

¹⁵ 10 TTABVUE 8.

77903451, 2012 TTAB LEXIS 80, *6. This includes the coexistence of an applicant's prior-registered mark with a cited registration: "Where an applicant owns a prior registration and the mark is 'substantially the same' as in the applied-for application, this can weigh against finding that there is a likelihood of confusion." *In re Country Oven*, Ser. No. 87354443, 2019 TTAB LEXIS 381, *19 (citing in *Inn at St. John's*, 2018 TTAB LEXIS 170, *18).

In *Strategic Partners*, the Board found under the thirteenth factor that there was no meaningful difference between a registration that was over five years old for ANYWEAR in standard characters and the applied-for ANYWEARS in slightly stylized format, for identical goods, outweighing any of the other *DuPont* factors. Thus, when determining whether the coexistence of an applicant's prior registration with a cited registration weighs against citing the latter registration in a Section 2(d) refusal of the applicant's mark, we consider: (1) whether the applicant's prior registered mark is the same as applicant's mark or is otherwise not meaningfully different; (2) whether the identifications of goods or services in the application and the applicant's prior registration are identical or identical in relevant part; and (3) the length of time the applicant's prior registration has coexisted with the registration being considered as the basis for the Section 2(d) refusal. *Strategic Partners*, 2012 TTAB LEXIS 80, *9; *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1207.01 (May 2024).

The situation present in *Strategic Partners* is not applicable here because the marks in the subject application and prior registrations are substantially different.

Applicant's composite mark incorporating the term FERTIUM is far more similar to the cited registration FERTUM than Applicant's registered marks, which contain the dissimilar term FERTINAGRO. Two of the prior registrations also have terms (BIOTECH and PHOSPHOACTIVE) that are different from the literal terms of the applied-for mark. *See Inn at St. John's, LLC*, 2018 TTAB LEXIS 170, *18-19 (finding applicant's over five-year-old prior registration of a partially similar mark was a neutral factor because the applied-for mark was more similar to the cited registered mark than applicant's previously registered mark). Moreover, because none of these registrations is over five years old, they are subject to attack by the owner of the cited FERTUM registration on a claim of priority and likelihood of confusion.

Furthermore, prior decisions and actions of other trademark examining attorneys in allowing the cited registrations are not binding on the USPTO or the Board. *See In re Int'l Watchman, Inc.*, 2021 TTAB LEXIS 446, *35 (TTAB 2021) (citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016)). Trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *Id.* (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (CCPA 1982) and *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 56 C.C.P.A. 969 (CCPA 1969)).

We find the thirteenth *DuPont* factor to be neutral in our analysis.

E. Summary of the *DuPont* Factors

Having made considered the evidence of record and made findings on all the relevant *DuPont* factors, our final step is to assess these findings together to

determine if, on balance, confusion is likely. *See, e.g., In re Charger Ventures*, 64 F.4th 1375, 1384 (Fed. Cir. 2023) (Board must weigh and balance factors).

Because we have found that Applicant's composite mark and the cited mark are similar under the first *DuPont* factor, the goods and services are identical in part under the second *DuPont* factor, the channels of trade under the third factor overlap, and the thirteenth factor is neutral, we conclude that confusion between Applicant's mark and the cited mark is likely.

Decision

The refusal to register Ser. No. 79328903 under Trademark Act Section 2(d) is **affirmed**.