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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brack

Serial No. 85412101

Luke Brean of Breanlaw LLC for John Michael Brack.

Jessica Powers Ludeman, Trademark Examining Attorney, Law Office 104
(Chris Doninger, Managing Attorney).

Before Cataldo, Ritchie and Hightower,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, John Michael Brack, filed an application to register on the Principal Register the mark FLORIDA'S BEST ORANGECELLO (standard characters)¹ for "prepared alcoholic cocktail" in International Class 33. During prosecution of the involved application, Applicant disclaimed "ORANGECELLO" apart from the mark as shown.

¹ Application Serial No. 85412101 was filed August 31, 2011, based upon applicant's allegation of his bona fide intent to use the mark in commerce.

The Trademark Examining Attorney issued a refusal of registration of the application under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), on the basis that FLORIDA'S BEST ORANGECELLO is primarily geographically descriptive of applicant's goods. The Examining Attorney further refused registration of the application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the basis of likelihood of confusion with the mark CARAVELLA ORANGECELLO (typed drawing, precursor and equivalent of standard characters)² for "alcoholic beverage, namely, orange flavored liquer" in International Class 33.³

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs.

During prosecution of the involved application, Applicant and the Examining Attorney submitted evidence in support of their respective positions. We find the evidence excerpted below to be particularly probative on the issues before us on appeal.

With her December 20, 2011 Office Action, the Examining Attorney submitted the following definitions:

Florida – a state of the southeast United States bordering on the Atlantic Ocean and the Gulf of Mexico. ... Tallahassee is the

² Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term "typed" drawing with "standard character" drawing. A mark depicted as a typed drawing is the legal equivalent of a standard character mark.

³ Registration No. 3203224 issued on January 30, 2007. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

capital and Jacksonville the largest city. Population 17,000,000.⁴

Best – surpassing all others in excellence, achievement, or quality, most excellent.⁵

With his June 19, 2012 response to the first Office Action, Applicant asserted that “ORANGECELLO has no recognized meaning other than as a source identifier for Applicant’s product. It is a clever, suggestive term coined by Applicant.”⁶ However, Applicant submitted numerous evidentiary exhibits to his response, including Exhibit F, consisting of “different Orangecello recipes published by the Food network, acclaimed authors, prominent publications:”⁷

Orangecello
Recipe courtesy Giada De Laurentis
Show: Giada at Home Episode: Cucina Capri
Recipe categories: Fruit, Oranges
Foodnetwork.com/recipes

Making Homemade Orangecello (or Limoncello)

Even though we had snow last night, it’s still March. ... With that in mind, Chicagoist opened the doors to our Bubbly Creek distillery and tasting room to prepare some homemade orangecello for those hot summer nights. Orangecello – for that matter, limoncello – requires some patience.

The basic recipe for orangecello/limoncello is as follows:

- 1 to 1.5 liters vodka
- Zest of 5 to 7 navel oranges or 15 to 20 lemons
- Four cups water
- Five cups sugar

⁴ Education.yahoo.com/references/dictionary

⁵ *Id.*

⁶ Applicant’s June 19, 2012 Response to Office Action, p. 7.

⁷ *Id.* at 52-9.

Limoncello (Italian Lemoncello) or Orangecello

Got this from a family I stayed with in Sorrento, Italy. Don't want to lose it. Can be made with either lemons or oranges.

How to Make Orangecello

Orangecello is a simple alcoholic beverage made from oranges that is great for dinner parties and summer gatherings. With a few ingredients from your local grocery store, you can have a glass of this refreshing citrus drink after a few days of preparation.

The Examining Attorney further made the following evidence of record with her March 26, 2013 Office Action:

Orangecello Orange Liqueur Recipe

Serving the Orangecello

Orangecello is served chilled as an after dinner drink. It's usually served in a small glass like a cordial glass. The glass is usually chilled as well.

Goodcocktails.com/liqueur

Happy Hour Friday: Orangecello Cocktails

Two weeks ago I made a batch of orangecello that has been sitting in my fridge, neglected.

Here are three cocktails using the homemade Orangecello from 2 weeks ago: Orangecello Cosmopolitan, Orangecello Sunrise, and an Orangecello Creamsicle. I got these recipes from Caravella's [Registrant's] website.

Inthelandofspice.com

Finally, Applicant made of record with his December 28, 2013 request for reconsideration screenshots from the following third-party internet websites showing use of ORANGECELLO in marks for Applicant's and Registrant's goods: fusionary.com; prohibition-spirits.com; and pikmal.com.

Geographic Descriptiveness

The test for determining whether a mark is primarily geographically descriptive is whether (1) the mark (or a portion thereof) is the name of a place known generally to the public; and (2) the public would make a goods/place association, that is, believe that the goods identified in the application originate in that place. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ 1852 (TTAB 2014); and *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006). If the goods do in fact originate from the place named in the mark, the requisite goods/place association can be presumed. See *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

We find, first, that the word FLORIDA'S in Applicant's mark is the name of a place known generally to the American public, i.e., the State of Florida. As discussed above, the term FLORIDA is defined as a state in the Southeastern USA bordering on the Atlantic Ocean and Gulf of Mexico. The primary significance of FLORIDA to the American purchasing public thus is a known geographic area. Further, there is nothing in the record to suggest that FLORIDA is either obscure or remote. Cf. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 3 USPQ2d 1450 (Fed. Cir. 1987).

Next, we find that the term ORANGECELLO in Applicant's mark is, at best, highly descriptive, if not generic, for Applicant's "prepared alcoholic

cocktail.” The evidence of record, excerpted above, establishes that term “ORANGECELLO” is an alcoholic beverage made from vodka infused with orange peels. Further, as defined above, the term BEST in Applicant’s mark is a laudatory term denoting orangecello that surpasses all others in quality and excellence.

We next turn to the question of whether FLORIDA’S BEST ORANGECELLO in Applicant’s mark is primarily geographically descriptive. “Under the first prong of the test – whether the mark’s primary significance is a generally known geographic location – a composite mark such as applicant’s proposed mark must be evaluated as a whole...It is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.” *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (citations omitted). In this connection, it is well settled that “the presence of generic or highly descriptive terms in a mark which also contains a primarily geographically descriptive term does not serve to detract from the primary significance of the mark as a whole.” *In re JT Tobacconists*, 59 USPQ2d 1080, 1082 (TTAB 2001); *see also In re Bacardi & Co. Ltd.*, 49 USPQ2d 1301 (TTAB 1997). As discussed above, the term ORANGECELLO is highly descriptive, if not generic, for Applicant’s goods.

For the reasons set forth above, we find that the word FLORIDA’S in Applicant’s mark is a reference to a well-known geographic place, and that

the term BEST ORANGECELLO is laudatorily descriptive of Applicant's "prepared alcoholic cocktail." We further find that the presence of the laudatorily descriptive wording BEST ORANGECELLO in Applicant's mark does not detract from the primary geographical significance of the mark as a whole. See *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989); and *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986). Furthermore, there is no evidence of any cogent alternative for the primary significance.

In sum, we find under the first prong of the Section 2(e)(2) test that the primary significance of Applicant's mark is that of a well-known geographic place, i.e., the State of Florida. We next turn to the second prong of the test, whether purchasers would make a goods/place association between Applicant's goods and the place named in the mark.

In its appeal brief, Applicant acknowledges that its goods originate in Florida.⁸ Because Applicant's goods originate from the place named in the mark, namely, Florida, we may presume that purchasers would make a goods/place association between Applicant's goods and "FLORIDA'S," denoting a geographic location that is neither obscure nor remote. *In re Chalk International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991); and *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988).

⁸ Applicant's brief, p. 11.

Applicant argues that “the term ‘FLORIDA’ is merely incorporated in the mark to suggest or hint at a desirable aspect of the [goods].”⁹ However, Applicant has not made of record any evidence to support his argument that FLORIDA has any readily recognized significance other than that of the State of Florida, either in general or as used in connection with the recited goods. Applicant further argues that

purchasers or potential purchasers of Applicant’s goods would not likely believe the goods or services originate in Florida as oranges are grown and the fermenting of such oranges into Orangecello would include ingredients and include services that are sourced from around the country.¹⁰

However, Applicant has not submitted any evidence to support this argument. Simply put, Applicant has not presented evidence to rebut the presumption of a goods/place association which arises from the fact that Applicant is located in, and its goods originate from, the place named in the mark.

In summary, we find that the wording FLORIDA’S BEST ORANGECELLO in Applicant’s mark identifies a well-known geographic location, and that purchasers would make a goods/place association between Applicant’s goods and the place named in the mark. Because both elements of the Section 2(e)(2) refusal have been established, we find that the Examining Attorney has established, *prima facie*, that Applicant’s mark is

⁹ *Id.*

¹⁰ *Id.*

primarily geographically descriptive of Applicant's goods. Applicant's arguments to the contrary are not persuasive.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *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). In any likelihood of confusion analysis, two key, though not exclusive, considerations are the similarities between the marks and the similarities between the services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Goods and Their Trade Channels

We turn now to our consideration of the identified goods, noting that it is not necessary that the services 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 services are such that they would or could be encountered by the same persons under circumstances that could, because

of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In making our determination under the second *du Pont* factor, we look to the goods as identified in the involved application and cited registration. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”). *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.”).

In this case, Registrant’s goods are identified as an “alcoholic beverage, namely, orange flavored liquer.” Applicant’s goods are identified as a “prepared alcoholic cocktail.” Applicant’s goods are broadly identified, namely, prepared alcoholic cocktails without any limitations as to type. As such, they must be presumed to include Registrant’s more narrowly identified

orange flavored liquer. Further, where the goods in the cited registration and/or application are broadly identified as to their nature and type (as is the case herein with respect to the involved application), such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). The presumption that Applicant's goods encompass those of Registrant, and the presumed overlap in trade channels and classes of purchasers are factors that weigh in favor of a finding of likelihood of confusion.

The Marks

We turn then to the first *du Pont* factor, i.e., whether Applicant's mark, FLORIDA'S BEST ORANGECELLO, and the mark in the cited registration, CARAVELLA ORANGECELLO, are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first *du Pont* factor 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 or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In this case, Applicant's mark consists of the geographically descriptive term FLORIDA'S, the laudatory term BEST and the highly descriptive or generic term ORANGECELLO. Registrant's mark consists of the term CARAVELLA, and the highly descriptive or generic term ORANGECELLO. As is readily apparent, the only similarity between the marks is the presence in both of the term ORANGECELLO which, as discussed above, is at best highly descriptive of the goods identified in the involved application and cited registration. The remaining wording in Applicant's FLORIDA'S BEST ORANGECELLO mark and Registrant's CARAVELLA ORANGECELLO mark are completely dissimilar in appearance and sound. In addition, Applicant's mark connotes the best orangecello in or originating from the State of Florida, while Registrant's mark connotes orangecello originating from an individual or entity named Caravella. As a result, we find the marks to be more dissimilar than similar in appearance and sound, different in connotation and, viewed as a whole, dissimilar in overall commercial impression.

Balancing the Factors

Neither Applicant nor the Examining Attorney have discussed any of the remaining *du Pont* factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them.

Based upon the foregoing, we find that the dissimilarities between Applicant's mark and the mark in the cited registrations outweigh the similarities. Thus, the first *du Pont* factor regarding the dissimilarity of the marks strongly favors a finding of no likelihood of confusion. Moreover, we find this factor is determinative and, despite the close relationship or even legal identity of the goods, we conclude that the marks are sufficiently dissimilar that confusion is not likely between Applicant's mark and the mark in the cited registrations.

Decision

The refusal to register the mark FLORIDA'S BEST ORANGECELLO on the ground of likelihood of confusion is reversed.

The refusal to register the mark FLORIDA'S BEST ORANGECELLO on the ground that the mark is primarily geographically descriptive of the identified goods is affirmed. Accordingly, registration of the involved application is refused.