

**This Opinion is Not a
Precedent of the TTAB**

Mailed:
November 21, 2014

United States Patent and Trademark Office
Trademark Trial and Appeal Board

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In re The Biltmore Company

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Serial No. 85561663

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J. Bennett Mullinax of J. Bennett Mullinax, LLC, for The Biltmore Company.
Kevin A. Mittler, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop,
Managing Attorney).

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Before Kuhlke, Wolfson, and Masiello, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

The Biltmore Company (“Applicant”) seeks registration on the Principal Register of the mark CENTURY (in standard characters) for “wine” in International Class 33.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), contending that

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¹ Application Serial No. 85561663 was filed on March 6, 2012, based on an allegation of first use and first use in commerce on December 31, 1999.

Applicant's use of its mark for its identified goods is likely to cause confusion with the mark SECOLO (in typed form)² for "table wine" in International Class 33.³

When the refusal was made final, Applicant appealed and filed a request for reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imp., 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); *In re Dixie Rests. 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 and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

² Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (Oct. 2014).

³ Reg. No. 3136475; registered August 29, 2006; Sections 8 and 15 combined declaration accepted and acknowledged. The registration includes the following statement: "The English translation of SECOLO is 'century.'"

Comparison of the Goods; Trade Channels; Classes of Purchasers

We begin with the *du Pont* factor of the relatedness of the goods. We base our evaluation on the goods as they are identified in the cited registration and application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The identified goods in Applicant's application and the cited registration are legally identical. Applicant's goods are "wine" and Registrant's goods are "table wine," which is a type of wine.⁴ As such, Registrant's goods are encompassed by Applicant's broader identification. Applicant does not argue against a finding that the goods are legally identical.

There are also no limitations in the identifications of goods with respect to channels of trade or classes of customers. Accordingly, we must presume that both Applicant and Registrant offer at least table wine for consumption to the same classes of consumers through identical distribution channels. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items

⁴ Applicant does not explain what "table wine" is, but we note the definition of "table wine" in the *Merriam-Webster* dictionary as "a wine that is not very expensive and that is used for ordinary meals" followed by "an unfortified wine containing not more than 14 percent alcohol by volume and usually suitable for serving with food." At www.merriam-webster.com.

could be offered and sold to the same classes of purchasers through the same channels of trade”). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). Since the goods are broadly offered to the general public, potential customers include ordinary purchasers. The second and third *du Pont* factors heavily favor a finding of likelihood of confusion.

Comparison of the Marks

We turn now to the first *du Pont* factor, i.e., whether the marks are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. *In re Viterra Inc.*, 101 USPQ2d at 1908; *Palm Bay*, 73 USPQ2d at 1692 (quoting *du Pont*, 177 USPQ at 567). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006) (holding MARCHE NOIR for jewelry likely to be confused with the cited mark BLACK MARKET MINERALS for retail jewelry and mineral store services); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). 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 commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the

recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014). Moreover, the issues concerning the similarity of the marks and the similarity of the goods and services are interrelated. *Thomas*, 79 USPQ2d at 1024 (citing *Shen Manufacturing Co., Inc. v. The Ritz Hotel Limited*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004) (When goods and services are highly related, “the degree of similarity necessary to support a conclusion of likely confusion declines.”)).

“Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay*, 73 USPQ2d at 1696. The doctrine is applicable when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Id.* “The ‘ordinary American purchaser’ in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language.” *In re Thomas*, 79 USPQ2d at 1024; J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:26 (4th ed. 2014) (“The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.”). Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. *See In re Thomas*, 79 USPQ2d at 1021; *In re Am. Safety Razor Co.*, 2 USPQ2d 1459, 1460 (TTAB 1987) (finding BUENOS DIAS for soap confusingly similar to GOOD

MORNING for shaving cream); *In re Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986) (holding applicant's mark LUPPO for men's and boys' underwear likely to be confused with the cited registration for WOLF and design for various clothing items, where LUPPO is the Italian equivalent of the English word "wolf").

There is no dispute that an appreciable number of purchasers in the U.S. speak and/or understand Italian. (*See, e.g., Ithaca Industries*, 230 USPQ at 703 where the Board said "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.") There is also no dispute that Registrant's mark SECOLO, as indicated in the cited registration, is an Italian word that translates into English as "century."⁵ As our primary reviewing court recognized in *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983), "the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark." Generally, however, applying the doctrine of foreign equivalents is only part of the determination of whether the marks being compared are confusingly similar. Citing *Sarkli*, the Board in *In re Ness & Co.*, 18 USPQ2d 1815, 1816 (TTAB 1991) explained, "As has been stated, 'such similarity as there is in connotation [between the foreign word mark and the English word mark] must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.'" *See also Ithaca Industries*, 230 USPQ at 704 ("We recognize, however, that this equivalency in

⁵ See translations from <http://translate.reference.com> (Office Action of June 21, 2012) and <http://oxforddictionaries.com> (Final Office Action of October 14, 2013).

connotation does not, in and of itself, determine the question of likelihood of confusion in this case.”). In addition to similarity in connotation:

[O]ther factors to be considered are the dissimilarity in overall appearance and pronunciation of the marks, the differences in the goods to which the marks are applied, and the degree of suggestiveness of applicant’s mark and the cited mark as applied to the respective goods.

Id.

Considering such other factors relevant to the case at hand, we find that the marks SECOLO and CENTURY are dissimilar in appearance but somewhat similar in pronunciation. The first letter “c” in “century” is pronounced as an “s” would be, and each term is made up of three syllables. Moreover, the terms SECOLO and CENTURY are arbitrary as applied to table wine, and thus SECOLO is conceptually strong as a trademark. A strong mark “not only entitles the registered mark to a broad scope of protection, but significantly increases the likelihood that the marks, when used in connection with the identical goods, would cause confusion.” *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1479 (TTAB 2007) (citing *Palm Bay*, 73 USPQ2d at 1692 (“VEUVE is an arbitrary term as applied to champagne and sparkling wine, and thus conceptually strong as a trademark.”). *Cf. In re Lar Mor International, Inc.*, 221 USPQ 180 (TTAB 1983) (finding no likelihood of confusion between TRES JOLIE and the registered mark BIEN JOLIE given the highly laudatory meaning of the registered mark). This case is distinguishable from *Sarkli* and *Ness*, where the marks were not considered exact equivalents. (SECOND CHANCE and REPÊCHAGE in *Sarkli*; GOOD-NESS and LABONTÉ in *Ness*). Finally, considering “the differences in the goods to which the marks are applied,”

we note that wine and table wine are overlapping goods sold to the same customers through identical trade channels, which also increases the likelihood of confusion.

Applicant argues that because Registrant, during prosecution of its underlying application, took the position that purchasers would not “stop and translate” SECOLO into “century,” we should find that purchasers would take the mark at face value and not apply the doctrine of foreign equivalents. Registrant took its prior position in response to a refusal of its mark based on a prior registration for the mark CENTURY OF PORT for port wine.⁶ Registrant’s prior position is not an admission, but may be considered as illuminative of shade and tone in the total picture. *See In re Sela Prods., LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) (“Such statements cannot be viewed as binding judicial admissions, since a decision maker may not consider a party’s opinion relating to the ultimate legal conclusion of likelihood of confusion (particularly in another case) as a binding admission of a fact.”) (citing *Interstate Brands Corporation v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978) (“that a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker.”)). In the present case, Registrant’s prior statements cannot be treated as indicating its position with respect to Applicant’s mark and the goods at issue in this appeal because Applicant’s mark differs from the third-party’s mark cited in the underlying application in the prior case, which included the additional terms

⁶ Reg. No. 1595640.

“OF PORT.” SECOLO means CENTURY; it does not directly translate to CENTURY OF PORT. Moreover, as is often stated, each case must stand on its own record and, in any event, the Board is not bound by the actions of prior examining attorneys. *See In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Applicant further argues that wine drinkers are accustomed to viewing wine labels containing foreign terms, and will therefore not translate SECOLO into “century.” Apart from Applicant’s statements, however, there is no evidentiary support for the position. Even assuming some wine labels bear designations in languages other than English does not compel a conclusion that prospective purchasers will not translate any such terms, including SECOLO, into English.

Accordingly, given the equivalency of SECOLO on the one hand and CENTURY on the other, combined with the arbitrary nature of the marks and the legal identity between the goods, we conclude that use of the respective marks in connection with the goods would be likely to cause confusion for purposes of Section 2(d) of the Act.

Decision: The refusal to register Applicant’s mark CENTURY is affirmed.