

This Opinion is Not a  
Precedent of the TTAB

Mailed: August 19, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board

—  
*In re Folino Estate, LLC*

—  
Serial No. 86356824

—  
Frank J. Bonini Jr. of Harding, Earley, Follmer & Frailey PC,  
for Folino Estate, LLC.

April Roach Trademark Examining Attorney, Law Office 115,  
Dan Brody, Managing Attorney.

—  
Before Lykos, Adlin and Lynch,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Folino Estate, LLC (“Applicant”) seeks registration on the Principal Register of  
the mark displayed below



for the following goods and services, as amended:<sup>1</sup>

Wine; beverages, namely, wine and liquor in International Class 33;

Weddings, namely, hosting of events, namely, entertainment services in the nature of planning and coordinating wedding receptions in International Class 41;

Bar and restaurant services, namely, providing food and beverages in the nature of wine, beer and liquor; wine bar services; cocktail lounge services in International Class 43; and

Catering services; weddings, namely, rental of banquet facilities for wedding receptions in International Class 45.

The description of the mark is as follows:

The mark consists of the following: the wording “FOLINO ESTATE” in brown, the wording “WINERY NEL VINO C'E LA VERITA” in black, and a design of green grapes, green leaves, and green decorative scrolls, all within a tan rectangle.

The colors tan, brown, green and black are claimed as a feature of the mark. The application includes a disclaimer of ETATE WINERY and the following translation statement:

The English translation of “Nel Vino C’e la Verita” in the mark is “In Wine There is Truth”.

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) as to the goods and services in International Classes 33, 43 and 45, on the ground that Applicant’s applied-for mark so resembles the registered mark displayed below for “grape wine; red wine; table wines; white wine; wine; wines” in

---

<sup>1</sup> Application Serial No. 86356824, filed August 4, 2014, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

International Class 33 that, when used on or in connection with Applicant's identified goods and services, it is likely to cause confusion or mistake or to deceive:<sup>2</sup>



The description of the cited mark is as follows: “The mark consists in part of a stylized letter ‘F.’” The stippling in the stylized letter ‘F’ is for shading purposes.” Color is not claimed as a feature of the mark, and CELLARS is disclaimed.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Trademark Examining Attorney denied the Request for Reconsideration, the appeal resumed and is now briefed.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

---

<sup>2</sup> Registration No. 3293230, registered September 18, 2007 on the Principal Register; Section 8 affidavit accepted.

We turn first to a comparison of the goods and services as identified in the application and cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Both the application and cited registration include “wine.”<sup>3</sup> Because the goods are identical in part, we must presume that these goods travel in the same channels of trade to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). In addition, the Examining Attorney introduced evidence showing that it is not uncommon for restaurants and bars to sell wine under the same mark and for wedding reception facilities to offer wine under the same brand name. *See* excerpts from the third-party web sites <https://coopershawkwinery.com>, [www.taborhill.com](http://www.taborhill.com), [www.castelgrisch.com](http://www.castelgrisch.com), [www.littlehillswinery.com](http://www.littlehillswinery.com), [www.lavendercrest.com](http://www.lavendercrest.com), [www.callawaywinery.com](http://www.callawaywinery.com) attached to November 13, 2014 and June 8, 2015 Office Actions. This evidence suffices to show that Applicant’s International Class 43 and 45 services are related to Registrant’s goods. Thus, the second and third *du Pont* factors weigh in favor of finding a likelihood of confusion as to each refused international class of goods and services.

---

<sup>3</sup> Applicant did not address the second and third *du Pont* factors in its brief. Nonetheless, it is still the Examining Attorney’s burden to establish that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009).

That being said, a single *du Pont* factor may be dispositive, and we find that to be the case here, where the marks are so dissimilar that confusion is unlikely. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). The first *du Pont* factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and 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). “The proper test 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 the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *See Stone Lion*, 110 USPQ2d at 1161; *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also 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”).

The Examining Attorney argues that the disclaimed wording and design elements of the marks are of lesser significance, focusing on the fact that the first term in both Applicant’s and Registrant’s mark share the same initial letter string F-O-L-I-N.

However, the similarities stop there. When we compare the marks as a whole, we find them to be dissimilar in sound, appearance, connotation and commercial impression. The terms FOLIN and FOLINO project different connotations and commercial impressions. The “O” at the end of FOLINO gives it more of an Italian look and sound, particularly given that FOLINO is accompanied by the tag line in Italian “NEL VINO C’E LA VERITA.” The use of other Italian wording contributes to FOLINO having the impression of an Italian word or name, suggesting to the consumer some connection to Italy. By contrast, the cited mark is devoid of any such connotation.

The Examining Attorney, relying on the principles that “there is no correct pronunciation of a mark” and because “it is impossible to predict how the public will pronounce a particular mark,” asserts that we must assume that the “marks” could be pronounced in the same manner by consumers. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterro Inc.*, 101 USPQ2d at 1912). We agree that FOLIN and FOLINO could both be pronounced with a long letter “o” vowel sound and /ee/ sound for the letter “i.” However, FOLINO includes the “O” at the end, creating an additional syllable and a different sound. In addition, these words do not form the entirety of either Applicant’s or Registrant’s marks. While we are mindful of the often cited principles that disclaimed matter and design elements are generally considered subordinate, we are also guided by the anti-dissection rule. The prominent design of the green grapes, leaves, and decorative scrolls overlaying the words FOLINO ESTATE in Applicant’s mark “catches the eye.” *See Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007) (“...the

design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN.”). Likewise, the stylized darker letter “F” superimposed over the entirety of the cited mark is the largest component of the mark and makes a significant impression. These distinct design features contribute to the different appearances and impressions of the marks.

In summary, we have carefully considered all of the evidence of record and arguments pertaining to the *du Pont* likelihood of confusion factors, including any evidence and arguments not specifically addressed in this opinion. We treat as neutral any *du Pont* factors for which there is no evidence or argument of record.<sup>4</sup>

---

<sup>4</sup> Applicant maintains that term FOLIN in the cited mark is diluted and weak in the wine industry. In support thereof, Applicant has made of record various third-party registrations purportedly to show that the cited mark is entitled to only a narrow scope of protection. Many of these registrations have been cancelled. The remaining third-party registrations are for the following marks FOLIE BOX, FOLIE A DEUX, DOLIN, and FOLONARI to identify wine. These registrations are of minimal, if any, probative value due to the obvious differences with the cited mark. Furthermore, while third-party registrations may be used to show that a term has a meaning or significance in the same way that dictionaries are used, we cannot determine from the face of the registrations whether the term FOLIN is descriptive or geographically descriptive of the identified goods and services and therefore weak or deserving of a lesser degree of protection. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (quoting *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976)). *See also The Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (“third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.”) (internal citations omitted). Finally, because third-party registrations of marks are not evidence that the registered marks are in use, they are of limited probative value for demonstrating weakness of the marks. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). In view thereof, the sixth *du Pont* factor, the number and nature of similar marks in use on similar goods and services, is neutral.

In addition, Applicant argues that because the USPTO permitted the registration of various marks sharing the same term to identify wines or related goods and services, consumers are unlikely to confuse Applicant’s and Registrant’s marks. In support thereof, Applicant relies solely on listings and copies of applications and registrations obtained from the USPTO database. *See* December 8, 2015 Request for Reconsideration. We are unable to determine,

“No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *Mighty Leaf*, 94 USPQ2d at 1259. In this case, the record evidence shows that the dissimilarity of the marks in appearance, sound, connotation and commercial impression is so great as to outweigh the other *du Pont* factors. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed Board finding of no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where Board relied solely on dissimilarity of marks). For these reasons, we find confusion to be unlikely and reverse the Trademark Examining Attorney’s Section 2(d) refusal.

**Decision:** The Section 2(d) refusal to register Applicant’s mark is reversed.

---

however, from the face of the listings and registration certificates the context under which these third-party registrations were permitted. Cf. *In re Nett Designs, Inc.*, 263 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Design’s application, the PTO’s allowance of such registrations does not bind the Board or this court.”). Furthermore, none of the marks referenced by Applicant are for marks that are similar to the applied-for mark or the cited mark. (i.e., TEN ACRE, ONE ACRE, LONE ACRE, HUNDRED ACRE, and SECRET ACRE). And lastly, copies of third-party applications have no evidentiary value other than to show that the applications were filed. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1494 (TTAB 2007). For these reasons, Applicant’s evidence is of limited utility.