

This Opinion is not a
Precedent of the TTAB

Mailed: January 20, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Big Heart Wine LLC

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Serial No. 86376188

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Tiffany L. Schwartz of Dentons US LLP for Big Heart Wine LLC.

James T. Griffin, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

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Before Cataldo, Wellington and Masiello,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Big Heart Wine LLC (“Applicant”) seeks registration on the Principal Register of the mark 100 PERCENT WINE (in standard characters, “WINE” disclaimed) for “dessert wines; fortified wines; fruit wine; grape wine; red wines; rose wines; sparkling wines; still wines; table wines; white wines; wines” in International Class

33.¹

¹ Application Serial No. 86376188 was filed on August 25, 2014 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant’s assertion of a bona fide intent to use the mark in commerce.

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 100 PERCENT WINE, as intended to be used in connection with Applicant's identified goods, is likely to cause confusion with the mark CENTO PER CENTO (in typed or standard characters)² for "wine" in International Class 33.³

When the refusal was made final, Applicant appealed. We affirm the refusal to register.

Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant attached what appears to be a second copy of its evidentiary record to its appeal brief. Trademark Rule 2.142(d) reads as follows:

The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.

To the extent that any of the evidence attached to the appeal brief was not previously submitted, it is not timely and we give it no consideration. Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence

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. 1794406 issued September 21, 1993. The English translation of the words "CENTO PER CENTO" in the mark is "100 percent." Section 8 affidavit accepted; Section 15 affidavit acknowledged. Second renewal.

to a brief and citing to the attachments, rather than to the original submission, is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether materials attached to the brief are properly of record, citation thereto necessarily requires an attempt to locate the same evidence in the record developed during the prosecution of the application. This, of course, requires more time and effort than would have been necessary if citations were made directly to the prosecution history.

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).

Relatedness 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 goods of Applicant and Registrant are identical. Applicant's goods include "wines" and Registrant's goods are "wine." Furthermore, Applicant's "dessert wines; fortified wines; fruit wine; grape wine; red wines; rose wines; sparkling wines; still wines; table wines; white wines" are encompassed by Registrant's more broadly identified "wine."

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 various wines for consumption to all typical 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 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). Because the goods are broadly offered to the adult 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, when marks would appear on virtually identical goods, the degree of similarity necessary to support a conclusion of likely confusion declines. *Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In considering the meaning of the marks, we find that WINE, as it appears in Applicant's mark, is a generic term for Applicant's goods. While descriptive, generic, or otherwise disclaimed matter is not removed from the mark, and we must consider the marks in their entireties, the "descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion." *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)). Although WINE remains part of Applicant's mark, we must also recognize that it possesses little source-identifying capacity. We accordingly consider 100 PERCENT to be the dominant element in Applicant's mark.

According to a translation introduced into the record by the Examining Attorney, "CENTO PER CENTO" in Italian means "hundred percent" in English.⁴ The gravamen of the Examining Attorney's argument regarding the similarity of the marks is his contention that CENTO PER CENTO means 100 PERCENT in Italian.

"Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as

⁴ December 10, 2014 first Office action at 6, retrieved from translate.google.com.

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. 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 LUPO for men’s and boys’ underwear likely to be confused with the cited registration for WOLF and design for various clothing items, where LUPO is the Italian equivalent of the English word “wolf”).

In its brief Applicant presents the following argument as to why the doctrine of foreign equivalents should not be applied in this case:

While the Examining Attorney asserted that Italian is one of the more commonly spoken languages in the U.S. after English; this does not equate to Italian being commonly spoken by the ordinary American purchaser, especially when the goods at issue are wines. In 2000, according to U.S. Census data, Italian was the 7th most common language spoken in American homes after English, but that equated to only 0.4% of the population speaking Italian. By 2007, Italian had fallen to the 9th and, of those Italian speakers, nearly 50% resided in only 4 metropolitan areas (New York, Boston, Chicago, and Philadelphia).⁵

⁵ 4 TTABVUE 6.

More recent census data shows that the number of Italian speakers in the U.S. over 5 years old is only 0.25% of the population. Some of this population is too young to be included in the “ordinary American purchaser” group when the relevant goods are wine. Consumers under the age of 21 are clearly not “ordinary purchasers of wine”; in 2010, census data showed that 71.6% of the population was age 21 or older. According to the U.S. Census Population Clock on September 6, 2016, the U.S. population is approximately 324,417,570 people. Extrapolating the age data from the general population, about 232,282,980 Americans are old enough to purchase wine legally. Assuming that 0.25% of those people speak Italian, there are approximately 580,700 Americans that are both old enough to purchase wine and have the ability to translate the Cited Mark CENTO PER CENTO from Italian to English. This is about 0.18% of the U.S. population. For perspective, that is approximately the population of Albuquerque, New Mexico. This means that more than 99.7% of the Americans old enough to purchase wine are unable to translate Italian into English and, thus, will simply view the cited mark as “Cento per Cento” without any further consideration of the meaning of the phrase. Even for those Americans with some grasp of Italian, translation of “cento per cento” requires a facility with the language and Italian grammar to translate the single word “cento” into the separate translated English words “hundred” and “cent”. As such, it is not likely that the ordinary American purchaser would stop and translate the Cited Mark. For all of these reasons, the doctrine of foreign equivalents should not be applied in this case.⁶

We have no need to determine in this likelihood of confusion case whether Italian is familiar to an appreciable segment of American consumers, as Applicant urges. It is well-established that in considering descriptiveness, genericness, or likelihood of confusion, the doctrine of foreign equivalents applies to “words from common, modern languages.” *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647–48 (TTAB 2008) (citing *Palm Bay*, 73 USPQ2d at 1696). Historically, the doctrine of foreign equivalents has been applied to Italian in a number of cases with little or no discussion of how many Americans speak the language. “[I]t does not require

⁶ *Id.* at 7.

authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States.” *In re Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986). But to the extent there is any question, Applicant’s evidence is more than sufficient to establish that Italian is a common, modern language. Specifically, Applicant’s Census Bureau evidence establishes that in 2000, over one million Americans spoke Italian⁷ and, in 2007, nearly 800,000 Americans spoke Italian.⁸ *Accord In re Joint-Stock Co. “Baik”*, 80 USPQ2d 1305, 1310 (TTAB 2006) (“There is no question that Russian speakers living in the United States, according to the record approximately 706,000 in number, would immediately know that BAIKALSKAYA means ‘from Baikal.’”). Thus it was unnecessary for the Examining Attorney to show that a certain percentage of relevant consumers are fluent in Italian.

In its reply brief, Applicant also argues:

Consumers familiar with a language will translate a foreign word when the word is descriptive of the goods on which it appears. There is no such natural tendency to translate a phrase that is unrelated to the product. Because the phrase CENTO PER CENTO does not directly describe wine or a characteristic thereof, there is no need to translate it. Consumers accept it as a trademark immediately without thought as to its meaning, just as they would accept an arbitrary or coined term appearing on a wine bottle.⁹

Applicant cites to no authority, and we are aware of none, for its position that the application of the doctrine of foreign equivalents in likelihood of confusion cases is

⁷ Applicant’s June 10, 2015 communication at 9.

⁸ Applicant’s December 14, 2015 communication at 13.

⁹ 7 TTABVUE 4.

restricted to foreign words that are descriptive of the identified goods. Indeed, Applicant's position is contrary to the decisional authorities cited above. *See In re Am. Safety Razor Co.*, 2 USPQ2d at 1460; *In re Ithaca Industries, Inc.*, 230 USPQ at 703.

There is no dispute that Italian is a common language that is spoken by nearly one million people in the United States, and that Registrant's mark CENTO PER CENTO, as indicated in the cited registration and evidence of record, is an Italian term that translates into English as "100 percent" or "hundred percent."¹⁰ This case is distinguishable from *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983) and *In re Ness & Co.*, 18 USPQ2d 1815 (TTAB 1991), where the marks were not considered exact equivalents. (SECOND CHANCE and REPÊCHAGE in *Sarkli*; GOODNESS and LABONTÉ in *Ness*).

As our primary reviewing court recognized in *In re Sarkli, Ltd.*, 220 USPQ at 113, "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 at 1816, explained, "As has been stated, 'such similarity as there is in connotation [between the foreign word mark

¹⁰ It bears noting that, to a consumer who speaks Italian, there is no need to "stop and translate" in order to appreciate that the term 100 in Applicant's mark is identical in meaning to CENTO in Registrant's mark. There is no difference in *language* between the Italian word CENTO and the Arabic numerals 100; such a customer would immediately understand both.

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

other 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 Applicant’s mark, 100 PERCENT WINE, is similar in appearance and sound to the registered mark CENTO PER CENTO to the extent that PERCENT in Applicant’s mark appears and sounds similar to PER CENTO in the registered mark. The other elements, 100 and WINE in Applicant’s mark and the initial term CENTO in Registrant’s mark, are points of visual and phonetic difference. The term CENTO PER CENTO is at worst somewhat suggestive as applied to wines, and thus CENTO PER CENTO 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).

Finally, considering “the differences in the goods to which the marks are applied,” we observe that the goods at issue are identical, and sold to the same customers through identical trade channels, which also increases the likelihood of confusion. In view of the foregoing, we find that 100 PERCENT WINE and CENTO PER CENTO are essentially identical in meaning, somewhat similar in appearance and sound and, overall, convey similar commercial impressions. Accordingly, this *du Pont* factor also favors a finding of likelihood of confusion.

Consumer Sophistication

Applicant’s unsupported argument that the involved goods would be purchased by sophisticated consumers is not persuasive. There is nothing in the identifications of goods to indicate that the wines offered under the respective marks are restricted to fine wines, offered at only high prices and purchased only by consumers with specialized knowledge and discerning palates. “When a buyer class is mixed, the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the least sophisticated consumer in the class.” *Stone Lion Capital Partners*, 110 USPQ2d at 1163, quoting with approval *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 18 USPQ2d 1417 (3d Cir. 1991). In addition, there is nothing in the record to support a finding that the goods and purchasing process are of such a nature that purchasers could distinguish similar marks for virtually or legally

identical goods. *See, e.g., Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (record confirms that opposer's services are expensive and are purchased only by experienced corporate officials after significant study and contractual negotiation and that the evaluation process used in selecting applicant's products requires significant knowledge and scrutiny). As such, we find this *du Pont* factor is, at best, neutral, or slightly favors a finding of likelihood of confusion.

Conclusion

In summary, Applicant's goods are identical to those in the cited registration, and must be presumed to be offered to the same classes of consumers through the same channels of trade. We find that the ordinary consumer of wine who is knowledgeable in the Italian language will translate CENTO PER CENTO to "hundred percent," and that, as a result, Applicant's 100 PERCENT WINE is nearly identical in meaning, and somewhat similar in appearance and sound to CENTO PER CENTO and that, viewed as a whole, the marks convey similar commercial impressions. We further find that the consumers of Applicant's goods and Registrant's goods include ordinary purchasers of wine who will not necessarily exercise a high degree of care or discernment.

Decision: The refusal to register Applicant's mark 100 PERCENT WINE is affirmed.