

This Opinion is not a
Precedent of the TTAB

Mailed: August 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Michael Brack

Serial No. 86660122

Luke Brean of Breanlaw LLC for John Michael Brack.

Amy E. Thomas, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, 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 SIMPLY ORANGECELLO (in standard characters) for “alcoholic beverage, namely, orange flavored liqueur” in International Class 33.¹

The Trademark Examining Attorney 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

¹ Application Serial No. 86660122 was filed July 11, 2015, based upon Applicant’s allegation of his bona fide intent to use the mark in commerce.

ORANGECELLO (typed drawing, equivalent of standard characters)² issued for “alcoholic beverage, namely, orange flavored liqueur” in International Class 33.³

When the refusal was made final, Applicant appealed. We reverse.

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 considerations are the similarities between the marks and the similarities between the goods or 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).

Relatedness of the Goods, Trade Channels and Classes of Consumers

Turning to the *du Pont* factor involving the similarity or dissimilarity of Applicant’s goods and Registrant’s goods, we find that they are identical. Applicant does not argue otherwise.

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.

Because Applicant's goods are identical to those identified in the cited registration, we must presume that the goods of Applicant and Registrant move in the same channels of trade and are available to the same classes of customers for such goods. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). These factors favor a finding of likelihood of confusion.

Similarities and Dissimilarities of the Marks

We now turn to the *du Pont* factor of the similarity or dissimilarity of the marks at issue as to appearance, sound, meaning, and overall commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). We keep in mind that, under this factor, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison; “[i]nstead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely.” *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991); *see also, Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

As noted above, the involved marks are SIMPLY ORANGECELLO and CARAVELLA ORANGECELLO. Both marks are displayed in typed form or the equivalent standard characters so there are no distinctions between them as to stylization. To state the obvious, the marks are similar to the extent that both include ORANGECELLO as their second term, and dissimilar as to their respective first terms SIMPLY and CARAVELLA.

We look to the evidence of record to determine the significance of the terms comprising the marks. With regard to CARAVELLA, the Examining Attorney introduced into the record evidence from Lexis.com and Google.com indicating that CARAVELLA has significance as a surname.⁴ On this record, there is no evidence of another meaning for the term, and Applicant agrees that “the term CARAVELLA appears to be a surname.”⁵

The Examining Attorney introduced into the record the following definition of SIMPLY – *merely; only: it is simply a matter of time.*⁶ The Examining Attorney argues that, based upon this definition, “the term SIMPLY is not arbitrary, but suggestive”⁷ as used in connection with the goods. The Examining Attorney further made of record copies of third-party registrations consisting of the term SIMPLY and a second, disclaimed term for various alcoholic beverages. These include: Registration No. 3397366 for

⁴ July 6, 2015 first Office action at 4-9, 14-33.

⁵ 4 TTABVUE 9.

⁶ July 6, 2015 first Office action at 12. (Ahdictionary.com.)

⁷ 6 TTABVUE 5.

the mark SIMPLY RED for wines; Registration No. 4035652 for the mark SIMPLY CABERNET SAUVIGNON for wine; Registration No. 4018181 for the mark SIMPLY SICILY for wines; Registration No. 4325597 for the mark SIMPLY PEACH for wine; Registration No. 4433885 for the mark SIMPLY CACTUS for distilled liquor and tequila.⁸ Based upon this evidence, the Examining Attorney argues “the term SIMPLY is diluted as a mark for beverages”⁹ and that, as a result, ORANGECELLO is the dominant portion thereof.

The Examining Attorney also argues that inasmuch as “no definition for ORANGECELLO was found in any dictionary”¹⁰ the term is arbitrary. “The applicant’s mark may be a play on the generic term ‘limoncello,’ but there is no evidence that ORANGECELLO is anything other than an arbitrary term.”¹¹ However, Applicant submitted evidence from commercial and informational Internet websites demonstrating that third parties use the term ORANGECELLO in trademarks and trade names to identify products highly similar or identical to those at issue herein, namely, orange flavored liqueurs.¹² Applicant further introduced into the record Internet evidence

⁸ *Id.* at 34-45.

⁹ *Id.* at 4.

¹⁰ 6 TTABVUE 6.

¹¹ *Id.*

¹² Applicant’s August 31, 2015 response to the Examining Attorney’s first Office action at 15-32. The trademarks and trade names include Gioia Luisa Orangecello; Fusionary Orangecello; Jannamico Orangecello; Orangecello di Sonoma; Ventura Blood Orange Orangecello; and Limonce Limoncello.

showing use of ORANGECELLO as a term to describe orange flavored liqueur, akin to the much more common term “limoncello” that identifies a similar lemon flavored liqueur.¹³

Nonetheless, the similarity or dissimilarity of the marks is determined based on the marks in their entirety, and 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. *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 23, 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.”).

Viewing the marks as a whole, we find that SIMPLY ORANGECELLO and CARAVELLA ORANGECELLO significantly differ in appearance and sound. We further find that the mark SIMPLY ORANGECELLO connotes alcoholic beverages consisting only of orange flavored liqueur, whereas the cited mark CARAVELLA ORANGECELLO somewhat differently connotes orange flavored liqueur originating from an individual named Caravella. We observe that neither Applicant nor Registrant has disclaimed ORANGECELLO or sought registration based in whole or in part on a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §

¹³ *Id.* at 32-38, 41-45.

2(f).¹⁴ Nonetheless, on this record we do not agree with the Examining Attorney that ORANGECELLO is an arbitrary term as applied to the identified goods. We also do not agree that ORANGECELLO is the dominant feature of the involved marks. We acknowledge that, on this record, the term CARAVELLA has surname significance and SIMPLY means “merely” or “only.” However, the presence of these utterly dissimilar terms as the first words in the marks CARAVELLA ORANGECELLO and SIMPLY ORANGECELLO results in significant differences between the marks in appearance, sound and meaning. Furthermore, because the terms CARAVELLA and SIMPLY appear first in the respective marks, they are most likely to be impressed in purchasers’ memories. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

While both marks may be viewed as suggestive of the goods, we view the marks in their entireties and find them to be dissimilar. The fact that each mark includes the term ORANGECELLO is simply outweighed by the points of dissimilarity. *In re National Data Corp.*, 224 USPQ at 751 (“[T]here is nothing improper in stating that, for rational reasons, more or less weight

¹⁴ We do not construe either Applicant’s arguments, the Examining Attorney’s arguments, or the evidence adduced by either as an impermissible attack on the validity of the cited registration. In any event, Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant’s ownership of the mark and of the registrant’s exclusive right to use the mark in connection with the goods or services identified in the certificate.

has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”).

In view of the foregoing, we find that when viewed in their entireties, SIMPLY ORANGECELLO and CARAVELLA ORANGECELLO are more dissimilar than similar in appearance, sound, meaning and overall commercial impression.

Conclusion

After considering all of the evidence of record and arguments pertaining to the *du Pont* likelihood of confusion factors, we find that while the goods are identical and thus are presumed to be offered in the same channels of trade, the purchasers of these goods will distinguish the marks which, as discussed above, are more dissimilar than similar in sight, sound, connotation and commercial impression. In view thereof, we find that Applicant’s mark, if used on or in connection with the goods identified in the application, is not likely to cause confusion with the registered mark on or in connection with the goods recited in the registration.

Decision: The likelihood of confusion refusal to register Applicant’s mark is reversed.