

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Bodegas Eduardo Garrido, S.L.
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Serial No. 87334693
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for Bodegas Eduardo Garrido, S.L.

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Before Wolfson, Lykos and Coggins,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Bodegas Eduardo Garrido, S.L. (“Applicant”) seeks registration on the Principal Register of the mark depicted below for “wine,” in International Class 33.¹



**G EDUARDO
GARRIDO
GARCÍA**

¹ Application Serial No. 87334693 was filed on February 14, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified goods, so resembles the mark shown below, registered on the Principal Register for "wine, red wine" in International Class 33,² as to be likely to cause confusion, mistake or deception.



When the refusal was made final, Applicant appealed and requested reconsideration. Upon the denial of the request for reconsideration, the appeal was resumed. The appeal is now fully briefed. We affirm the refusal to register.

I. Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Even within the *du Pont* list, only factors that are "relevant and of record" need be considered. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark*

² Registration No. 3435079, issued on May 27, 2008, renewed. The phrase "TINTO SUPERIOR" is disclaimed. "The mark consists of [t]he wording MANSION GARRIDO in different stylized fonts, with a line below these words and the wording TINTO SUPERIOR under the line." Color is not claimed as a feature of the mark. "The foreign wording in the mark translates into English as SUPERIOR RED."

Brands Inc. v. GFA Brands, Inc., 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Similarity of the Goods/Channels of Trade/Consumers

We turn first to a comparison of the goods 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 Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant’s application is for “wine” and the cited registration is for “wine, red wine.” Therefore, the goods are identical. Because the goods are identical, 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) (even though there was no evidence regarding channels of trade and classes of purchasers, the Board was entitled to rely on the legal presumption that identical goods travel in the same channels of trade to the same classes of purchasers in determining likelihood of

confusion). Accordingly, the second and third *du Pont* factors weigh in favor of finding a likelihood of confusion.

B. Similarity/Dissimilarity of the Marks

The crux of this appeal turns on the first *du Pont* likelihood of confusion factor, under which we compare Applicant's and Registrant's marks "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). "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). It is well-settled that where the goods are identical, typically less similarity between the marks is needed in order to find a likelihood of confusion. *See, e.g., Viterra*, 101 USPQ2d at 1908; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines."). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980);

Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975). Because the goods are “wine” without any restrictions or limitations as to price point or classes of consumers, the average customer is an ordinary adult consumer.

Applicant contends that the marks are so different in appearance, pronunciation, connotation and commercial impression that the first factor “is dispositive of the issue of likelihood of confusion.”³ Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, 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 Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Nonetheless, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat’l Data*, 224 USPQ at 751. Looking at the marks in their entirety, and considering Registrant’s mark first in terms of appearance and pronunciation, we find the marks are somewhat similar. The term GARRIDO stands out as the most dominant element, conveying the strongest commercial impression, in Registrant’s mark. It is presented in the largest letters, centered in position and depicted in a bold font. The term

³ Appeal Brief, 4 TTABVUE 5. All citations to the prosecution history for the application are to the downloadable PDF versions of the documents in the TSDR (Trademark Status and Document Retrieval) database. Citations to the appeal record are to TTABVUE. *See, e.g.*, Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 1203.01 (June 2017).

MANSION is less significant, as it modifies GARRIDO and suggests wine that comes from an estate or large house.⁴ The descriptive, disclaimed wording TINTO SUPERIOR also does not serve to distinguish the marks, as it merely describes the type of wine being sold, that is, a superior red wine.⁵ The stylization of the wording of the mark, including the large “G” and “O” in GARRIDO and the underline separating MANSION GARRIDO from TINTO SUPERIOR, do not overshadow or detract from the prominence of Registrant’s surname GARRIDO. If anything, the underline attracts the eye to the GARRIDO surname and as noted, the use of MANSION evokes a wine-labeling practice whereby terms, such as “maison,” “palacio,” and “chateau,” are used in connection with surnames and other words to identify a particular winery and refer to the location where the wine is produced.⁶

As regards Applicant’s mark, looking at the mark in its entirety, it consists of a large, bold letter “G” alongside the name EDUARDO GARRIDO GARCIA. To the extent the marks share the term “Garrido,” they are similar in appearance and

⁴ The term “mansion” is defined as “a large imposing residence” or “manor house.” MERRIAM-WEBSTER at <https://www.merriam-webster.com>, accessed May 10, 2018. The Board may take judicial notice of dictionary definitions, including definitions or entries from references that are the electronic equivalent of a print reference work. *See Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imps. Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009).

⁵ Applicant does not challenge this translation, which appears on the cited registration.

⁶ The Examining Attorney submitted copies of 32 registrations for marks containing either the term MAISON, PALACIO, or CHATEAU in combination with other terms to show that it is common for wine trademarks to contain a word that refers to a winery as a “house,” “palace,” or “castle,” similar in connotation to “mansion.” May 22, 2017 final Office Action at 50-129. Applicant also submitted four registrations for marks for wine that contain the term MANSION, which further illustrate the use of the term as referring to a location where wine is produced. July 5, 2017 Request for Reconsideration, Exhibit A, at 16-18; 20-21.

pronunciation. Applicant argues that GARRIDO is not the dominant portion of its mark because the letter “G” is equally large, and as prominent as, the “stacked” words. In the alternative, Applicant argues that the term EDUARDO dominates, because it is “the first term in Applicant’s stacked design” and because “there are *no* registered or pending trademarks containing ‘EDUARDO’ in connection with wine.”⁷ To the contrary, the Examining Attorney submitted copies of four registrations of wine marks that contain the term EDUARDO or its English variation EDWARD,⁸ along with copies of five registrations for marks for the term GARCIA that are also for wine, and a USPTO XSearch report summary showing that the cited registration is the only registration containing the term GARRIDO in International Class 33. This evidence shows that “Garrido” appears less often in registrations than “Garcia” and “Eduardo,” supporting the conclusion that GARRIDO will be a focus of Applicant’s mark. Moreover, because the initial letter “G” and the final letter “O” of GARRIDO are larger than the other letters in Registrant’s mark, this deepens the similarity in appearance and pronunciation with Applicant’s mark, given that Applicant’s mark also includes a large letter “G,” stacked initial letters “G,” and final letters “O.”

Continuing with the analysis, it is in connotation and overall commercial impression that the marks share the greatest similarity. The literal portion of Applicant’s mark is the Spanish-language name EDUARDO GARRIDO GARCIA. In

⁷ 4 TTABVUE 15-16.

⁸ May 22, 2017 final Office Action at 10-35.

the name, both GARRIDO and GARCIA are surnames.⁹ Personal names in Spanish typically contain a given name, followed by two family names; “[t]he first surname is usually the father’s first surname, and the second the mother’s first surname.”¹⁰ The Examining Attorney argues that as the first surname, GARRIDO would be accorded greater weight in Applicant’s mark. Based on the record, we agree. As explained by the Wikipedia entry submitted by the Examining Attorney: “A man named Jose Antonio Gomez Iglesias would normally be addressed as either señor Gomez or señor Gomez Iglesias instead of señor Iglesias, because Gomez is his first surname.”¹¹ Thus, it would be more likely to refer to Eduardo Garrido Garcia as Sr. Garrido, and not as Sr. Garcia. Because consumers are likely to perceive Applicant’s mark as identifying a person whose primary surname is GARRIDO, the similarity between the marks is increased. The Board has regularly affirmed Section 2(d) refusals where a mark containing a person’s full name has been compared to a mark containing just the surname. *See, e.g., In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (JOSE GASPARGOLD confusingly similar to GASPARGOLD’S ALE); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1139 (TTAB 2015) (BRADLEY HUGHES confusingly similar to H HUGHES FURNITURE MOTION EAZE

⁹ In a Lexis search, the Examining Attorney located 13,928 public record references for persons with the surname GARRIDO and 1748457 surname entries for GARCIA. At <https://w3.lexis.com>, attached to May 22, 2017 final Office Action at 136-37. Applicant submitted a copy of a page from the Lexis Advance Public Records that located more than 3000 results for individuals in the U.S. with the surname GARRIDO. May 11, 2017 Response at 18.

¹⁰ Wikipedia, *Spanish Naming Customs*, <https://en.wikipedia.org>, attached to May 11, 2017 Office Action at 10-11.

¹¹ *Id.*

RECLINERS and design); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1446-47 (TTAB 2014) (BRUCE WINSTON confusingly similar to WINSTON and also to HARRY WINSTON). “This is especially true given the legally identical nature of goods at issue.” *In re Hughes*, 114 USPQ2d at 1139.

In addition, the Examining Attorney points to Applicant’s manner of use of its mark to prove that consumers would focus on the surname GARRIDO. First, the Examining Attorney points to a page from Applicant’s website,¹² showing that in other versions of the mark, Applicant emphasizes the GARRIDO surname:¹³

¹² Material obtained from an applicant’s website is acceptable as competent evidence. *See Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (internet printouts “on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein”); *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240, 244 (TTAB 1985) (“Evidence of the context in which a particular mark is used on labels, packaging, etc., or in advertising is probative of the significance which the mark is likely to project to purchasers.”); *cf. In re N.V. Organon*, 79 USPQ2d 1639, 1642-43 (TTAB 2006) (printouts from applicant’s website show that applicant touts the taste of its product); *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006) (using printouts as evidence that the mark is merely descriptive of applicant’s services); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1898 (TTAB 2001) (using printouts to show a distinct commercial market for “Russian art”).

¹³ At <http://www.bodegaeduardogarrido.es/index.html>, attached to May 11, 2017 Office Action at 9.



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Secondly, the Examining Attorney points to applicant's trade name, Bodegas Eduardo Garrido, S.L., and Applicant's website address, <http://www.bodegaeduardogarrido.es/>, as supporting the contention that consumers will focus on the term GARRIDO in Applicant's mark, because the second surname GARCIA is omitted in each. As illustrated by the advertisement, and as supported by

¹⁴ The Examining Attorney states that the webpage "discusses three generations of wine makers, all of which are identified with the surname Garrido: Vicente Garrido, Eduardo Garrido, and Amelia Garrido." 10 TTABVUE 9. While that may be, the webpage as submitted is in Spanish. The Board does not take judicial notice of translations of text appearing in a foreign language on a website, even in a common modern language such as Spanish. The better practice would have been to download the English language version via the link provided on the webpage.

the trade name and address usage, it is likely that when recalling Applicant's wine, consumers will focus on the surname "Garrido."

We find that overall Applicant's mark is similar in sound and appearance, as well as in connotation and commercial impression, to the cited registered mark. Accordingly, the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

C. Third-Party Use of Similar Marks

Under the sixth *du Pont* factor, we consider "[t]he number and nature of similar marks in use on similar goods." *du Pont*, 177 USPQ at 567. Evidence of third-party use bears on the strength or weakness of a registrant's mark. *In re i.am.symbolic, llc* 123 USPQ2d at 1751. If the evidence establishes that the consuming public is exposed to third-party uses of similar marks for similar services, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1693.

The Examining Attorney argues that Registrant's mark is strong because there are no other marks that use GARRIDO for wine. To show weakness, Applicant submitted a copy of Registration No. 3724707 for the mark depicted below for "wholesale distributorships of foods and beverages, including groceries and spirits."¹⁵

¹⁵ Reg. No. 3724707 issued on December 15, 2009, Section 8/15 combined declaration accepted and acknowledged. Attached to July 5, 2017 Request for Reconsideration at 25.



Applicant contends that the existence of this registration “demonstrates that consumers are exposed to marks containing the common surname ‘GARRIDO’ and that they have come to recognize smaller differences.”¹⁶ Suffice it to say, the fact that a single registration exists for services only tangentially, if at all, related to wine does not support a finding that Registrant’s mark is weak. *See Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (single use proffered by applicant insufficient to establish that opposer’s mark is weak); *American “76” Co. v. National Brewing Co.*, 158 USPQ 417, 420 (TTAB 1968) (single registration insufficient). This factor is neutral.

II. Balancing of Factors

When we consider that the goods, channels of trade and consumers are identical, and the marks are overall similar based on the shared word GARRIDO, despite the presence of other elements in Applicant’s and Registrant’s marks, we find that confusion is likely.

Decision: The refusal to register Applicant’s mark under Trademark Act Section 2(d) is affirmed.

¹⁶ 4 TTABVUE 25.