

This Opinion is Not a  
Precedent of the TTAB

Mailed: January 3, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Monterey Tile DE, Inc.*

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Serial No. 87627828

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Daniel R. Pote of Jennings, Strouss and Salmon, PLC for Monterey Tile DE, Inc.

Alexandria N. Bryant, Trademark Examining Attorney, Law Office 113,<sup>1</sup>  
Myriah A. Habeeb, Managing Attorney.

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Before Bergsman, Larkin, and Lebow,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Monterey Tile DE, Inc. (“Applicant”) seeks registration on the Principal Register  
of the mark shown below

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<sup>1</sup> The application was examined by two other Trademark Examining Attorneys prior to its assignment to Ms. Bryant, who filed the brief of the United States Patent and Trademark Office (“USPTO”). We will refer to all three of the examining attorneys as “the Examining Attorney.”



for “Indoor and outdoor floor tiles, wall cladding, countertops being building material for further installation, and pavers made from ceramic, granite, slate, quartz, natural stone, glass, and porcelain; non-metal tiles for countertops, walls, sinks, and floors in bathrooms and kitchens; pavers in landscaping; non-metal tile for barbeque grills” in International Class 19.<sup>2</sup>

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<sup>2</sup> Application Serial No. 87627828 was filed on September 29, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark and first use of the mark in commerce at least as early as April 1, 2016. Applicant has disclaimed the exclusive right to use COLLECTION apart from the mark as shown. The English translation of “Vita Bella” in the mark is “beautiful life.”

Applicant describes the mark as follows: “The mark consists of the black, cursive wording ‘VITA BELLA’, above a royal blue horizontal line, above the black all-caps wording ‘COLLECTION’, all superimposed on a background of a Spanish-style house with a yard and sky, with the royal blue cursive wording ‘ELEGANCE IN TILE DESIGN’ in the lower right corner of the yard. The background consists of a light blue sky with white clouds above a Spanish-style house with beige walls and a terracotta red tile roof with the tiles outlined in black. The eaves of the roof cast a gray shadow on the tops of the walls, and the windows have light blue panes with dark gray sash bars, except the window above the doorway, which has terracotta red curved bars across the front [sic] the light blue pane. The arched doorway is composed of tan tiles featuring designs shown by dark brown lines, around a brown door featuring an ornate design shown by beige lines, and the walkway is composed of tan pavers with white edges. The lawn features grass in shades of dark green and light green, and lining [sic] bottom of the house is brown mulch, on which yellow-green bushes alternate with tan planting pots holding light green plants. Yellow-green tree branches appear in [sic] to the right of the house and in the back right and back left of the house. Along the left of the house, in the front are green plants and yellow-green low bushes on brown mulch, in the middle are tall cylindrical olive green trees behind which are low yellow-green bushes, and in the back are dark green grasses. The other white in the mark is background and is not claimed as a feature.” The colors black, royal blue, beige, light blue, white, terracotta red, gray, dark gray, tan, brown, dark brown, dark green, light green, yellow-green, olive green, and green are claimed as features of the mark.

The Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles each of the four registered trademarks described below as to be likely, when used in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive:

(1) the standard-character mark BELLAVITA TILE (TILE disclaimed), registered on the Principal Register for "Non-metal tiles for walls and floors; ceramic tiles; porcelain tiles; glass tiles" in International Class 19;<sup>3</sup>

(2) the mark shown below

The logo for Bellavita Tile features a stylized lowercase 'b' icon to the left of the word 'bellavitatile' in a lowercase, sans-serif font.

registered on the Principal Register for "Non-metal tiles for walls and floors; ceramic tiles; porcelain tiles; glass tiles" in International Class 19;<sup>4</sup>

(3) the mark shown below

The logo for Casavita Bella Artisan Cement Tile consists of the words 'CASAVITABELLA' in a large, uppercase, serif font, with 'ARTISAN CEMENT TILE' in a smaller, uppercase, sans-serif font below it. The entire logo is enclosed within a thin rectangular border.

registered on the Principal Register for "Non-metal tiles for walls, floors, or ceilings; Cement tiles in the nature of hydraulic cement tiles and encaustic cement tiles for walls and floors" in International Class 19;<sup>5</sup> and

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<sup>3</sup> Registration No. 4303500 issued on March 19, 2013 and has been maintained.

<sup>4</sup> Registration No. 5742363 issued on May 7, 2019.

<sup>5</sup> Registration No. 5160144 issued on March 14, 2017. The registrant has disclaimed the exclusive right to use ARTISAN CEMENT TILE apart from the mark as shown.

(4) the standard-character mark CASAVITABELLA registered on the Principal Register for “Non-metal tiles for walls, floors or ceilings; Cement mortar roofing tiles” in International Class 19.<sup>6</sup>

The first and second registrations are owned by one registrant, and the third and fourth registrations are owned by a different registrant.

Applicant appealed when the Examining Attorney made the refusal final and denied Applicant’s request for reconsideration. Applicant and the Examining Attorney have filed briefs.<sup>7</sup> We affirm the refusal to register.

### **I. Evidentiary Issue**

Before proceeding to the merits of the refusal, we address an evidentiary matter. The Examining Attorney argues that “Applicant submitted new evidence with its appeal brief,” specifically, “five screenshots, three with incomplete URLs purporting to show the public undertake [sic] a variety of activities on a whim to support its argument that the relevant consumers in this case are sophisticated.” 6 TTABVUE 6 (citing 4 TTABVUE 11-13). The Examining Attorney “objects to this evidence and requests that the Board disregard it.” *Id.*

We sustain the objection. Evidence “submitted with Applicant’s appeal brief that Applicant did not previously submit during prosecution is untimely and will not be

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<sup>6</sup> Registration No. 5161683 issued on March 14, 2017.

<sup>7</sup> Citations in this opinion to the briefs refer to TTABVUE, the Board’s online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant’s brief appears at 4 TTABVUE and the Examining Attorney’s brief appears at 6 TTABVUE.

considered.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018) (citing Trademark Rule 2.142(d), 37 C.F.R. § 2.412(d)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019)).

## II. Record on Appeal<sup>8</sup>

The record on appeal includes Applicant’s specimen of use, USPTO electronic records regarding the cited registrations;<sup>9</sup> dictionary definitions of the words “collection” and “elegance;”<sup>10</sup> a translation of the Italian words “vita” and “bella” into English and a translation of the English phrase “beautiful life” into Italian, dictionary definitions of the words “life” and “beautiful,” a Wikipedia entry regarding the song “Bella Vita,” and webpages on which the term “Bella Vita” is used and translated into English;<sup>11</sup> a dictionary definition of, and a Wiktionary entry regarding, the word “casa;”<sup>12</sup> webpages in which the word “collection” is used to describe groupings of tiles with similar characteristics;<sup>13</sup> webpages regarding the use of ceramic and porcelain tiles and wall cladding;<sup>14</sup> USPTO electronic records in the form of a list from the

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<sup>8</sup> Citations in this opinion to the application record are to pages in the USPTO’s Trademark Status & Document Retrieval (“TSDR”) database.

<sup>9</sup> January 16, 2018 Office Action at TSDR 2-12; September 30, 2019 Office Action at TSDR 2-4; December 30, 2020 Final Office Action at TSDR 2-12. The cited Registration No. 5742363 issued during prosecution.

<sup>10</sup> January 16, 2018 Office Action at TSDR 16; May 2, 2021 Denial of Request for Reconsideration at TSDR 2.

<sup>11</sup> December 30, 2020 Final Office Action at TSDR 13-21.

<sup>12</sup> *Id.* at TSDR 22-24.

<sup>13</sup> *Id.* at TSDR 17-19.

<sup>14</sup> January 16, 2018 Office Action at TSDR 13-15; September 30, 2019 Office Action at TSDR 5-8; December 30, 2020 Final Office Action at TSDR 25-43.

Trademark Electronic Search System (“TESS”) database of “Live” registrations of marks containing the word BELLA or VITA, or both;<sup>15</sup> USPTO electronic records regarding third-party registrations of marks including or consisting of the words “Bella” or “Vita” for various goods and services,<sup>16</sup> and third-party registrations of marks for both the goods identified in the cited registrations and the goods identified in the application;<sup>17</sup> and webpages regarding the process of purchasing in home renovation and the price of landscaping pavers, tiles, and tile installation.<sup>18</sup>

### **III. Analysis of Refusal**

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We

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<sup>15</sup> March 19, 2020 Response to Office Action at TSDR 2-71.

<sup>16</sup> *Id.* at TSDR 74-143. Only two of the registrations contain both words. *Id.* at TSDR 120-21, 142-43.

<sup>17</sup> December 30, 2020 Final Office Action at TSDR 44-111.

<sup>18</sup> *Id.* at TSDR 112-14; May 2, 2021 Denial of Request for Reconsideration at TSDR 3-21.

consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

We will confine our *DuPont* analysis to the standard-character mark BELLAVITA TILE in Registration No. 4303500 (the “500 Registration”) for “Non-metal tiles for walls and floors; ceramic tiles; porcelain tiles; glass tiles.” If we find a likelihood of confusion as to this cited mark and the goods identified in the ’500 Registration, we need not find it as to the other cited marks and the goods identified in the respective registrations. Conversely, if we do not find a likelihood of confusion as to this cited mark, we would not find it as to the other cited marks. *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*3 (TTAB 2020) (citing *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010)).

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*29 (TTAB 2021) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). Applicant argues that “[t]he dissimilarity of the marks is the dispositive *du Pont* factor in this matter.” 4 TTABVUE 15. The Examining Attorney addresses both key *DuPont* factors, 6 TTABVUE 8-25, as well as what she describes as “an implied sophisticated purchaser argument” made by Applicant. *Id.* at 25.

### A. Similarity or Dissimilarity of the Goods and Channels of Trade

The second and third *DuPont* factors respectively consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” and “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). “Apparently conceding the issue, Applicant does not address these *du Pont* factors in its brief, so we offer only a brief explanation of our conclusion.” *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1740 (TTAB 2016).

The goods identified in the ’500 Registration are “Non-metal tiles for walls and floors; ceramic tiles; porcelain tiles; glass tiles.” The goods identified in the application include “non-metal tiles for countertops, walls, sinks, and floors in bathrooms and kitchens.” The goods broadly identified in the ’500 Registration as “Non-metal tiles for walls and floors” encompass the goods more narrowly identified in the application as “non-metal tiles for . . . walls . . . and floors in bathrooms and kitchens.” As a result, the goods are legally identical in part.<sup>19</sup> *See, e.g., Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*6 (TTAB 2019) (“tires” identified

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<sup>19</sup> “The Examining Attorney need not prove, and we need not find, similarity as to each product listed in the description of goods.” *St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*3-4. “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.” *Id.* (quoting *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015)). *See also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). In addition, because we have found that certain of the goods identified in the ’500 Registration are legally identical to certain of the goods identified in the application, “there is no need for us to further consider the relatedness of the goods,” *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018), based on evidence made of record by the Examining Attorney.



in respondent's registration "encompass, and thus are legally identical to, at least the 'vehicle wheel tires,' 'automobile tires,' and 'tires for vehicle wheels' identified in [petitioner's] registration."); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.>"). "[T]he second *DuPont* factor thus strongly supports a finding of a likelihood of confusion." *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at \*4 (TTAB 2020).

"Because the goods are legally identical, and there are no limitations in the respective identifications as to the channels of trade or classes of consumers, we must also presume that the channels of trade and classes of consumers are identical." *Id.* (citing *FabFitFun*, 127 USPQ2d at 1672 (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012))). "The third *DuPont* factor thus also strongly supports a finding of a likelihood of confusion." *Id.*

### **B. Similarity or Dissimilarity of the Marks**

"Under the first *DuPont* factor, we consider 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *In re Embiid*, 2021 USPQ2d 577, at \*11 (TTAB 2021) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005)). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *Id.* (quoting *Inn at St. John's*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1801, 1812 (TTAB 2014))).

“The proper test regarding similarity ‘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.’” *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than a specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)). The average customer here is a consumer seeking to purchase non-metal wall and floor tiles.

Where, as here, the goods are identical, “the degree of similarity between the marks necessary to support a determination that confusion is likely declines.” *i.am.symbolic*, 127 USPQ2d at 1630 (citing *Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

The marks must be compared in their entirety, but “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.” *Detroit Athletic Co.*, 128 USPQ2d at 1050 (quoting *In re Nat’l Data*

*Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)). We will begin by determining the dominant portion of each mark.

Applicant argues that the “Examining Attorney has placed undue emphasis on the wording in the cited marks, indicating that wording in a composite mark must be treated as the dominant portion of the mark, regardless of how dominant or conspicuous design elements may be,” and that the “refusal appears to be based on the Examining Attorney’s mistaken belief that wording in a composite mark must always be treated as the dominant portion,” a position that Applicant claims “is wrong as a matter of law.” 4 TTABVUE 15. These arguments are largely inapplicable to the cited marks because two of them, including the one on which we focus, are standard-character marks, and in a third, the word CASAVITABELLA is simply enclosed within two parallel horizontal lines. Only the stylized BELLAVITATILE mark has a design element, which consists merely of the fanciful display of its first letter. Applicant’s arguments are more applicable to its own composite word-and-design mark.

Applicant further argues that “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *Id.* (quoting *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990)). Applicant notes that “in appropriate circumstances, the Board gives greater weight to a design component of a mark that comprises both words and a design,” and that “[t]his is particularly the case where the design component is so visually prominent that it immediately engages the user’s

attention before relatively smaller wording in the mark is noticed, such as the design elements in [Applicant’s] mark.” *Id.* at 14-15. Applicant cites *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987), *In re White Rock Distilleries, Inc.*, 92 USPQ 2d 1282 (TTAB 2009), and *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014), as examples of cases in which the Board found that design elements were the dominant portions of composite word-and-design marks, *id.* at 16, and argues that *Covalinski* is the case most analogous to this one. *Id.* Applicant claims that the “Examining Attorney’s mistaken conclusion that the word portion of the marks must dominate is inconsistent with the Board’s repeated findings that no likelihood of confusion exists when a prominent design element dominates over common wording between marks.” *Id.* at 16.

Applicant cites “the tastefully colored image of the stately home” in its mark, stating that it “is a significant – if not dominant – component of [the] mark, and dramatically distinguishes the mark from the cited marks.” *Id.* at 17. Applicant concludes that its “mark is dominated by the design elements of the stately manor house, not by the improperly dissected, somewhat similar text elements of the mark and the cited marks.” *Id.* at 19.<sup>20</sup>

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<sup>20</sup> Applicant notes the Examining Attorney’s requirement during prosecution that Applicant amend its original description of its mark, January 16, 2018 Office Action at TSDR 1; May 29, 2020 Office Action at TSDR 1, and argues that the Examining Attorney’s suggested detailed description, which Applicant accepted, November 30, 2020 Response to Office Action at TSDR 1, “illustrates the richly detailed and prominent design feature of [Applicant’s] mark,” and that the “degree and level of detail, as laid out by the Examining Attorney, sharply contrasts the notion that the design is somehow ‘muted’ or anything other than the dominant element of the mark.” 4 TTABVUE 9. Applicant further argues that “the Examining Attorney’s repeated focus on the specific design elements of the mark, and required correction to most accurately capture the rich color and detail of same, directly

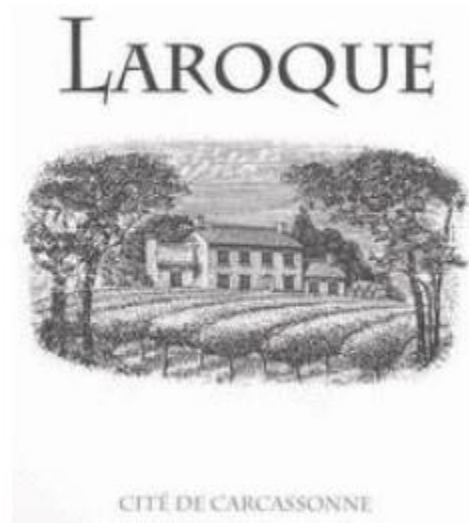
The Examining Attorney responds that in Applicant's mark, "consumers are likely to focus on VITA BELLA for source-identification and differentiation." 6 TTABVUE 11. She argues that the house design in Applicant's mark, "which contains roofing tiles, also merely echoes the wording TILE DESIGN in the mark and the identified goods, and thus, too, does not change the commercial impression of the mark." *Id.* She rejects Applicant's claim that she is invoking a rigid per se rule in finding that the words VITA BELLA are the dominant elements of Applicant's composite word-and-design mark, *id.* at 11-12, and argues that *Steve's Ice Cream*, *White Rock Distilleries*, and *Covalinski* are distinguishable because "Applicant's design element appears as faded or partially opaque background behind large black wording, in sharp contrast with the referenced cases," and because "[n]one of the cases cited by applicant feature an analogous background design; thus, this argument is unpersuasive and unsupported." *Id.* at 13.

"In the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods." *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB

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contradicts his dismissal of the importance of these key details." *Id.* at 15. The Examining Attorney responds that the "requirement that applicant provide an accurate mark description, and the examiner's provision of such, is not dispositive of the dominant element of the mark, as applicant is required to describe all aspects of the marks [sic]." 6 TTABVUE 12. We agree with the Examining Attorney. A description of a mark, no matter how detailed, "cannot be used to restrict the likely public perception of [the] mark" because "[a] mark's meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey." *In re Dimarzio, Inc.*, 2021 USPQ2d 1191, at \*20-21 (TTAB 2021) (citing TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") Section 808.02 (July 2021)).

2018) (citing *Viterra*, 101 USPQ2d at 1908; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because “[t]he word portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Id.* (quoting *Viterra*, 101 USPQ2d at 1911). We display below the applicant’s mark in *Aquitaine Wine USA* for ease of reference in following our discussion:



The Board found in *Aquitaine Wine USA* that the word LAROQUE was the dominant portion of this mark because “[d]isplayed in a large, bold typeface, it comprises the largest literal portion of the mark in terms of size, position, and emphasis,” and “[i]t is also the first term in the mark, further establishing its prominence.” *Id.* at 1184-85. The Board found that the other literal element of the mark, Cité de Carcassonne, was less significant as a source-identifier because it “is a geographically descriptive term, is in significantly smaller lettering, and has been disclaimed.” *Id.* at 1185.

The general principle discussed in *Aquitaine Wine USA*, and the Board’s analysis of the composite mark in that case, guide us in our determination of the dominant

portion of Applicant's mark, which we reproduce again below for ease of reference in following our discussion:



The words “Vita Bella” in Applicant’s mark appear in a distinctive bold font, are “the largest literal portion of the mark in terms of size, position, and emphasis,” *id.*, are separated from the word “COLLECTION” and the phrase “Elegance in Tile Design” by underscoring, and are the first words in the mark, “further establishing [their] prominence.” *Id.* The word “COLLECTION,” which in the context of the mark as a whole identifies “a group of things,”<sup>21</sup> which are associated with “Vita Bella,” appears in smaller block letters and has been disclaimed, while the phrase “Elegance in Tile Design” appears at the bottom of the mark in much smaller script that is barely legible. Unlike the house design in the mark in *Aquitaine Wine USA*, which was set off from the words in the mark, the house design in Applicant’s mark is partially obscured by the words “Vita Bella” and “COLLECTION.” “In sum, because of the position, size, and bolding of [“Vita Bella”], this single term dominates the commercial impression of Applicant’s mark.” *Id.*

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<sup>21</sup> January 16, 2018 Office Action at TSDR 16 (OXFORD LIVING DICTIONARIES).

We agree with the Examining Attorney that Applicant's reliance on the *Steve's Ice Cream*, *White Rock Distilleries*, and *Covalinski* cases is misplaced. In *Steve's Ice Cream*, the Board considered the likelihood of confusion between the composite mark shown below for "restaurant services"

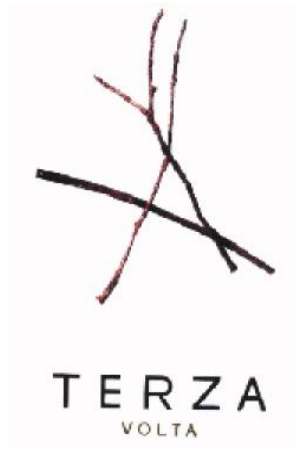


and the registered standard-character mark STEVE'S for "ice cream for consumption on and off the premises." The Board noted that the "design portion of applicant's mark is extremely suggestive of the fact that applicant's restaurant's feature hot dogs," *Steve's Ice Cream*, 3 USPQ2d at 1478-79, and found that the "highly stylized depiction of human frankfurters, prancing arm in arm to musical notes, creates a distinctive commercial impression." *Id.* at 1479. The Board also noted that market research in the record showed that more than 200 restaurants and food stores operated in the United States under a STEVE'S-formative mark, *id.*, which the Board found "demonstrate[d] that the purchasing public has become conditioned to recognize that many businesses in the restaurant and food store fields use the term, or something



closely related to it, and that this purchasing public is able to distinguish between these businesses based on small distinctions among the marks.” *Id.* Here, the design element of Applicant’s mark is nowhere near as large, eye-catching, or distinctive as the design element in the applicant’s mark in *Steve’s Ice Cream*, and, as discussed below, there is no evidence of the use of a VITA BELLA-formative mark for tiles and thus no evidence that the cited mark lacks commercial strength.

In *White Rock Distilleries*, the Board considered the likelihood of confusion between the registered composite mark shown below for “sparkling fruit wine; sparkling grape wine; sparkling wine; wines”



and the applicant’s standard-character mark VOLTA for “energy vodka infused with caffeine.” The Board found that “the prominent design feature and the term TERZA in the registered mark serve to distinguish the registered mark visually from applicant’s mark” because “the term TERZA clearly dominates over the term VOLTA in the registered mark as TERZA appears in large bold letters above VOLTA.” *White Rock Distilleries*, 92 USPQ2d at 1284. The Board also noted that the words in the registered mark “appear[ed] in a plain block style of lettering under the more

prominent design.” *Id.* Here, the stylized words “Vita Bella” appear in larger lettering superimposed above the non-source-identifying word “COLLECTION,” and the words together partially obscure the less prominent design, which is faded or blurry in contrast to the literal elements.

Finally, in *Covalinski*, the case that Applicant argues is most closely analogous on its facts to this one, 4 TTABVue 16, the Board considered the likelihood of confusion between the applicant’s composite mark shown below for various types of clothing



and the registered standard-character mark RACEGIRL for the same goods. The Board found that “the overall commercial impression of Applicant’s mark is dominated by its design features, particularly the large double-letter RR configuration, and that this weighs heavily against a conclusion that confusion is likely.” *Covalinski*, 113 USPQ2d at 1169. The Board based its finding on the following characteristics of the applicant’s mark:

Applicant’s design mark includes the very large, prominently displayed letters RR. The bodies of the Rs are filled with a checkerboard pattern resembling a racing flag. To each R an elongated horizontal ‘leg’ of gradually increasing thickness is appended, each of which ends in a heart design. Inside the legs appear the rest of the letters (i.e., the letter strings ‘edneck’ and ‘acegirl’), in a form in which the initial letters of each string are displayed in relatively tiny typeface and subsequent letters are displayed in increasing thickness. Together, these graphic devices serve not only to draw attention to the RR letters

apart from the wording, but also make the letters that form the ‘a-c-e’ of the word ‘RACEGIRL’ difficult to notice.

*Id.* at 1168.

Applicant’s mark here shares none of the key characteristics of the applicant’s mark in *Covalinski*. In Applicant’s mark, the words “Vita Bella” and “COLLECTION” are plainly visible, and together they make the house design somewhat “difficult to notice.” *Id.* Applicant’s mark here is not dominated by its design feature, which is recessed and subordinate to the source-identifying words “Vita Bella.”

We find that the stylized words “Vita Bella” are the dominant portion of Applicant’s mark, that is, the portion that is “likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Aquitaine Wine USA*, 126 USPQ2d at 1184.

The word BELLAVITA is the dominant portion of the standard-character mark BELLAVITA TILE in the ’500 Registration because BELLAVITA is the first word in the mark, and the second word TILE is the generic name of the goods identified in the ’500 Registration and has been disclaimed. *See, e.g., Chutter*, 2021 USPQ2d 1001, at \*36 (“DANTANNA’S is the dominant portion of the mark DANTANNA’S TAVERN because the word ‘tavern’ is a generic term for . . . restaurant and bar services, and [the applicant] has accordingly disclaimed the exclusive right to use the word ‘tavern.’”).

We turn now to the required comparison of the marks in their entirety, giving greater weight in that comparison to the words “Vita Bella” in Applicant’s mark, and the word “BELLAVITA” in the cited mark, than to the other elements of the marks.

Applicant argues that the “marks are not confusingly similar” because the “only common elements, the words ‘VITA’ and ‘BELLA’ are phonetically, visually, and aurally different between [Applicant’s] and the cited marks.” 4 TTABVUE 16-17. According to Applicant, “[a]verage purchasers would immediately perceive striking differences between the appearance, sound, and commercial impression of the cited and [Applicant’s] marks, and confusion is unlikely.” *Id.* at 17.

With respect to appearance, Applicant seems to rely exclusively on its claim that its mark “is dominated by the design elements of the stately manor house, not by the improperly dissected, somewhat similar text elements of the mark and the cited marks,” *id.* at 19, which we have rejected above. As to sound and meaning, Applicant argues that “even if, *arguendo*, VITA BELLA COLLECTION ELEGANCE IN TILE DESIGN did not sound different from” BELLAVITA TILE, *id.* at 17, Applicant’s mark “yields a significantly different commercial impression.” *Id.* Applicant does not explain the alleged different commercial impression.

Applicant also argues that “numerous ‘VITA’ and ‘BELLA’ marks coexist on the Principal Register, apparently without conflict, as submitted in the text of [Applicant’s] March 19, 2020 Response, with copies of the cited registrations included as evidence with the response.” *Id.* at 18. Applicant argues that “[t]hird-party registrations alone may be relevant ‘to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.’” *Id.* (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015)).

The Examining Attorney responds that Applicant's mark is similar to each of the cited marks because "the marks share wording that is similar in sound and commercial impression of the Italian wording for 'beautiful life.'" 6 TTABVUE 8. She further argues that "[c]onfusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions." *Id.* at 8-9. With respect to Applicant's third-party registration evidence, the Examining Attorney argues that "the weight of the applicant's evidence is significantly diminished when accounting for the fact that many of the third-party registrations contain either VITA or BELLA, but not this combination as in the cited registrations" because it is "the applicant's use of this combination, not the individual terms that serves as the basis for the instant refusal." *Id.* at 15. She also notes that many of the registrations cover "distinct goods in Class 011 and Class 006, rendering them unpersuasive as evidence of dilution of this wording for the identified goods, which are encompassing in part." *Id.*

In determining the similarity or dissimilarity of the marks in appearance, because the cited BELLAVITA TILE mark is in standard characters, "we must consider that the literal elements of the mark (the words and the letters) may be presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant's mark" because "the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color." *Aquitaine Wine USA*, 126 USPQ2d at 1186 (citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)). Accordingly, we

must assume that the registrant could choose to present its mark with the word BELLAVITA displayed as “BellaVita” in the same font style as the words “Vita Bella” in Applicant’s mark, as shown below,



and that the registrant could choose to position the word BellaVita above (rather than next to) the word TILE displayed in the block letter font in which the word “COLLECTION” is displayed in Applicant’s mark, as shown below



*Id.* (noting that “Registrant could choose to present CHATEAU in a much smaller size type or in a different font or color than the word LAROQUE, so that the latter term would be just as visually dominant as it is in Applicant’s mark.”). *See also In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (holding that the applicant could display its standard character mark JAWS DEVOUR YOUR HUNGER “emphasizing the word ‘jaws’ as shown below: <sup>JAWS</sup> Devour Your Hunger ”).

A consumer with a “general rather than a specific impression,” *i.am.symbolic*, 127 USPQ2d at 1630, of the cited mark BELLAVITA TILE displayed in the manner of the words Vita Bella and COLLECTION in Applicant’s mark, who separately encounters Applicant’s mark would be likely to view the marks as being quite similar in appearance. While there are specific differences in appearance between the marks

resulting from the presence of a background house design and a small script slogan in Applicant's mark, we find that the marks are much more similar than dissimilar in appearance because of the presence of the dominant words VITA BELLA and BELLAVITA in the marks.

With respect to sound, to the extent that Applicant offers anything more than a conclusory claim that the marks sound different, 4 TTABVUE 17, its argument presupposes that its mark would be verbalized as "VITA BELLA COLLECTION ELEGANCE IN TILE DESIGN," *id.*, and that this sounds different from "BELLAVITA TILE," apparently because there are more words and syllables in Applicant's mark. *Id.* This argument ignores "the penchant of consumers to shorten marks." *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: "the users of language have a universal habit of shortening full names — from haste or laziness or just economy of words.")). There is no evidence in the record suggesting that consumers will verbalize Applicant's mark as the mouthful "Vita Bella Collection Elegance in Tile Design,"<sup>22</sup> especially where the slogan "Elegance in Tile Design" is very difficult to read when the mark is viewed, making it unlikely that the slogan will be recalled when the mark is spoken. It is far more likely that consumers will shorten Applicant's mark to "Vita Bella Collection" or "Vita Bella"

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<sup>22</sup> In that regard, the Board has long held that consumers do not focus on minutia such as the number of syllables or words in marks, but instead form general rather than specific impressions of them. See *In re John Scarne Games, Inc.*, 120 USPQ 315, 316 (TTAB 1959) ("Purchasers of game boards do not engage in trademark syllable counting[;] they are governed by general impressions made by appearance or sound, or both.").

alone when it is verbalized, and the cited mark will be verbalized as “Bellavita Tile” or “Bellavita” alone. When the cited mark is verbalized as “Bellavita Tile” or “Bellavita,” and Applicant’s mark is verbalized as “Vita Bella Collection” or “Vita Bella,” the marks are quite similar in sound due to the aural similarity of the dominant portions “Bellavita” and “Vita Bella,” which are mere transpositions of one another.

With respect to meaning, Applicant again offers nothing more than the bald claim that Applicant’s mark “yields a significantly different commercial impression.” 4 TTABVUE 17. We agree with the Examining Attorney that Applicant “offers no evidence in support of this conclusion,” 6 TTABVUE 14, and that the record shows that “VITA BELLA and BELLAVITA appearing in the applied for and registered mark[ ] convey a similar commercial impression of a ‘beautiful life.’” *Id.*

The dominant words “Vita Bella” in Applicant’s mark are a transposition of the compound word BELLAVITA in the cited mark. “[W]here the sole significant difference between marks applied to similar goods or services is the transposition of the words which compose those marks and where the transposition of words does not change the overall commercial impression, confusion has been found.” *In re Wine Soc’y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989). In *Wine Soc’y of Am.*, the Board found that the marks shown below





were “substantially similar” because the “connotation of the cited mark is virtually identical to the connotation of applicant’s mark.” *Id.* See also *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding that “the reversal in one mark of the essential elements of another mark may serve as a basis for a finding of no likelihood of confusion only if the transposed terms create distinctly different commercial impressions,” and finding that “where the goods are legally identical, and where both marks [RUST BUSTER and BUST RUST], when applied to the goods in question, are likely to be perceived as signifying that the produce sold thereunder busts through, or breaks up, rust,” the marks “create substantially similar commercial impressions, and that there is a likelihood of confusion.”); *Bank of Am. Nat’l Trust & Sav. Ass’n v. Am. Nat’l Bank of St. Joseph*, 201 USPQ 842, 845 (TTAB 1978) (finding that “the words ‘BANKAMERICA’ and ‘BANK OF AMERICA’, on the one hand, and ‘AMERIBANC’, on the other, convey the same meaning and create

substantially similar commercial impressions.”); *cf. In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at \*8 (TTAB 2019) (genericness of term VIRTUAL INDEPENDENT PARALEGALS “corroborated by two examples of the terms VIRTUAL, INDEPENDENT, and PARALEGAL used in connection with paralegal services, albeit not necessarily in the same order, but engendering the same commercial impression.”) (citing *Wine Soc’y of Am.*, 12 USPQ2d at 1142)).

The marks here do not have different overall commercial impressions when considered in their entireties. Applicant’s application contains a translation statement that the dominant words “Vita Bella” in Applicant’s mark mean “beautiful life,”<sup>23</sup> and with respect to the word BELLAVITA in the cited mark, the Examining Attorney made of record translations of the English phrase “beautiful life” into Italian as “bella vita” or “la bella vita,”<sup>24</sup> as well as a Wikipedia entry regarding the song *Bella Vita* that states that “Bella Vita’ means *beautiful life* in Italian,”<sup>25</sup> and three webpages that state that the words “Bella Vita” mean “beautiful life” in English.<sup>26</sup> The cited ’500 Registration,<sup>27</sup> and a third-party registration containing the words “Bella Vita” made of record by Applicant,<sup>28</sup> translate the words slightly differently as “good life.” The record shows that the dominant portions of the marks, the words “Vita

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<sup>23</sup> September 29, 2017 Application at TSDR 1. One of the two third-party registrations containing the word VITABELLA made of record by Applicant similarly translates the word as “beautiful life.” March 19, 2020 Response to Office Action at TSDR 142.

<sup>24</sup> December 30, 2020 Final Office Action at TSDR 16.

<sup>25</sup> *Id.* at TSDR 17.

<sup>26</sup> *Id.* at TSDR 18-21.

<sup>27</sup> January 16, 2018 Office Action at TSDR 2-3.

<sup>28</sup> March 19, 2020 Response to Office Action at TSDR 120.

Bella” in Applicant’s mark and the compound word “BELLAVITA” in the cited mark, cause the marks in their entireties to have the same general connotation of a beautiful or good life.

Finally, we address Applicant’s argument that the BELLATIVA portion of the cited mark is weak because “numerous ‘VITA’ and ‘BELLA’ marks coexist on the Principal Register, apparently without conflict, as submitted in the text of Appellant’s March 19, 2020 Response, with copies of the cited registrations included as evidence with the response.” 4 TTABVUE 18.<sup>29</sup> Applicant’s third-party registration evidence goes only to the conceptual weakness of the cited mark. *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*24 (TTAB 2021). As noted above, only two of the marks in the third-party registrations that Applicant made of record contain both BELLA and VITA: (1) Registration No. 4953819 of the mark B Bella Vita and design for “Door casings of metal; Door fittings of metal; Door handles of metal; Ferrules of metal for canes and walking sticks; Furniture fittings of metal; Metal hardware, namely, pulleys; Metal hardware, namely, washers; Metal hinges; Metal keys for locks; Metal locks;”<sup>30</sup> and (2) Registration No. 5927438 of the mark LUXART VITABELLA for “Bath tubs; free standing bath tubs.”<sup>31</sup> Because neither of these registrations covers the legally identical tile goods at issue on this appeal, they have little or no probative value regarding the conceptual weakness of the word BELLAVITA in the cited mark.

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<sup>29</sup> Applicant does not rely on the TESS list of registrations that it made of record, but cites only the specific registrations discussed in its March 19, 2020 Response to Office Action, for which it submitted copies of USPTO electronic records.

<sup>30</sup> March 19, 2020 Response to Office Action at TSDR 120-21.

<sup>31</sup> *Id.* at TSDR 142-43.

*Sabhnani*, 2021 USPQ2d 1241, at \*25 (citing *Inn at St. John's*, 126 USPQ2d at 1745). The other third-party registrations have no probative value because they do not involve VITA BELLA or BELLA VITA marks.

The Examining Attorney cited two registrations of CASAVITABELLA marks for tiles that are owned by an entity other than the owner of the BELLAVITA TILE mark shown in standard characters in the '500 Registration and in stylized form in another cited registration. To the extent that we consider these two commonly owned CASAVITABELLA marks to be third-party marks, they are “a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both” *Juice Generation and Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). *Sabhnani*, 2021 USPQ2d 1241, at \*25-26 (quoting *Inn at St. John's*, 126 USPQ2d at 1745). Simply put, the record does not support a showing that the cited mark is conceptually weak, and we thus accord it “the normal scope of protection to which inherently distinctive marks are entitled.” *Id.*, at \*26 (quoting *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017)).

The marks are much more similar than dissimilar in appearance, and quite similar in sound, and connotation and commercial impression. The first *DuPont* factor supports a finding of a likelihood of confusion, “particularly taking into account that the identity of the goods with which the marks are used ‘reduces the degrees of similarity between the marks necessary to find a likelihood of confusion.’” *Id.*, at \*39

(quoting *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*14 (TTAB 2020)).

### C. Purchasing Conditions and Degree of Consumer Care

The “fourth *DuPont* factors examines both ‘the conditions under which and buyers to whom sales are made, i.e., ‘impulse vs. careful sophisticated purchasing.’” *Id.*, at \*29 (quoting *DuPont*, 177 USPQ at 577). As noted above, the Examining Attorney addresses Applicant’s “implied sophisticated purchaser argument” in which the Examining Attorney states that Applicant “note[s] the expensive and involved nature of building, remodeling, and construction projects.” 6 TTABVUE 25 (citing 4 TTABVUE 10).<sup>32</sup>

The Examining Attorney argues that record evidence “demonstrates that the public undertake [sic] building remodeling and construction projects on a whim, and costly projects of this type are so when labor service costs are involved.” *Id.* at 26. She further argues that “Applicant’s argument conflates the cost of *services* involving labor with the cost of materials, which are relatively inexpensive.” *Id.* (emphasis supplied by the Examining Attorney). She concludes that consumers of what she describes as the involved “low-cost, every-day consumer items” are “generally more likely to be confused as to the source of the goods.” *Id.* (citations omitted).

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<sup>32</sup> The cited portion of Applicant’s brief is part of Applicant’s recapitulation of the prosecution history of the application, and Applicant does not mention or allude to the fourth *DuPont* factor in the argument portion of its brief. Nevertheless, because the Examining Attorney addresses the factor, and there is some record evidence that may be probative of consumer sophistication and the likely degree of purchaser care, we will address it as well.

The portions of the record cited by the Examining Attorney do not support her arguments that building remodeling and construction projects are commonly undertaken “on a whim,” or that the involved goods are “low-cost, every-day consumer items” that may be subject to impulse purchase. Three online articles, one entitled “That Time We Renovated a Bathroom on a Whim,”<sup>33</sup> and the others stating that “My master bathroom makeover sort of happened on a whim,”<sup>34</sup> and that a blogger’s DIY subway tile backsplash was done “on a whim a couple of weeks ago,”<sup>35</sup> which discuss the unique experiences of individual homeowners, are insufficient to show that such projects are routinely undertaken on impulse. Similarly, the evidence regarding the per-unit prices of the goods<sup>36</sup> is insufficient to show that tiles are purchased on impulse because a large number of tiles may be required for a particular project, which increases the overall cost to the consumer, and because price alone is likely not the determinant of consumer care when aesthetic choices regarding tile style are also involved. Our decision must be based on the least sophisticated potential consumer of tiles, *see Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014), but on this record, even the least sophisticated such purchaser is likely to exercise ordinary care. We find that the fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

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<sup>33</sup> May 2, 2021 Denial of Request for Reconsideration at TSDR 3-7.

<sup>34</sup> *Id.* at TSDR 8.

<sup>35</sup> *Id.* at TSDR 10.

<sup>36</sup> *Id.* at TSDR 11-21.

**D. Summary**

The first, second, and third *DuPont* factors collectively strongly support a finding of a likelihood of confusion because the goods, channels of trade, and classes of consumers are legally identical and the marks are quite similar, and the fourth *DuPont* factor is neutral. On the basis of the mark BELLAVITA TILE registered for “Non-metal tiles for walls and floors; ceramic tiles; porcelain tiles; glass tiles,” we find that there is a likelihood of confusion arising from Applicant’s use of its mark for the “non-metal tiles for countertops, walls, sinks, and floors in bathrooms and kitchens” identified in the application.

**Decision:** The refusal to register is affirmed.