

**This Opinion is Not a
Precedent of the TTAB**

Mailed: August 18, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nino Salvaggio Fruit & Vegetable Market, Inc.

Serial No. 88138756

Amber M. Underhill and R. Scott Keller of Warner Norcross & Judd LLP,
for Nino Salvaggio Fruit & Vegetable Market, Inc.

J. Ian Dible, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

Before Taylor, Lynch and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Nino Salvaggio Fruit & Vegetable Market, Inc. (“Applicant”) seeks registration on the Principal Register of the mark BOCCA DOLCE (in standard characters) for “chocolate confections” in International Class 30.¹ The Trademark Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the goods

¹ Application Serial No. 88138756 was filed on October 1, 2018, based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as November 1, 2003. The Application contains the following translation statement: “The English translation of ‘BOCCA DOLCE’ in the mark is ‘SWEET MOUTH’.”

identified in the Application, so resembles the mark BOCCA for “caramels in the nature of candy; chocolates” in International Class 30² on the Principal Register as to be likely to cause confusion, to cause mistake, or to deceive.³

During the prosecution of the Application, the Examining Attorney also required Applicant to enter the following disclaimer into the record: “No claim is made to the exclusive right to use ‘DOLCE’ apart from the mark as shown.”⁴ Applicant traversed the Examining Attorney’s disclaimer requirement,⁵ and Applicant maintains its objection to the disclaimer requirement on this appeal.⁶

When the refusal and disclaimer requirement were made final,⁷ Applicant requested reconsideration.⁸ After the Examining Attorney denied the request for reconsideration,⁹ Applicant appealed. Applicant and the Examining Attorney filed briefs. We affirm the disclaimer requirement and the refusal to register.

² Registration No. 5337516, was issued on November 21, 2017. The Registration contains the following translation statement: “The English translation of ‘BOCCA in the mark is ‘MOUTH’.”

³ Office Action of January 11, 2019, at TSDR 2. Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

⁴ *Id.*, at TSDR 3-4.

⁵ Office Action Response of July 11, 2019, at TSDR 8.

⁶ Applicant’s Brief, 4 TTABVUE 16-18.

⁷ Final Office Action of July 30, 2019, at TSDR 2-5.

⁸ Request for Reconsideration of December 4, 2019, at TSDR 14-20.

⁹ Denial of Request for Reconsideration of January 6, 2020, at TSDR 2-3.

I. Evidentiary and Procedural Issues

Before proceeding to the merits of the refusal, we address an evidentiary matter and a procedural issue. Both concern the documents collectively filed as Applicant's Reply Brief.¹⁰ Not counting the ESTTA cover page, the first fourteen pages of what was filed as Applicant's Reply Brief purport to be evidentiary matter; some of which already was made of record during prosecution, and some of which was submitted for the first time.

We discourage the practice of attaching to a brief on appeal copies of the same exhibits that already were submitted with an Applicant's Office action responses. *In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015). Moreover, "[t]he 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." Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also, In re ADCO Industries – Technologies, L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (evidence submitted for the first time in supplemental brief not considered). Therefore, we have not considered the materials submitted as part of Applicant's Reply Brief, unless those materials already were submitted during prosecution.

Applicant's Reply Brief itself is two pages, single-spaced. "Text in an electronic submission [filed through ESTTA] must be filed in at least 11-point type and double-spaced." Trademark Rule 2.126(a)(1), 37 C.F.R. § 2.126(a)(1). *See also In re Cordua Restaurants LP*, 110 USPQ2d 1227, 1229 n.2 (TTAB 2014) ("The Board notes that

¹⁰ Reply Brief, 7 TTABVUE 2-17.

applicant's appeal brief was single-spaced. Trademark Rule 2.126(b) 37 C.F.R. § 2.126(b) requires all briefs submitted to be double-spaced.”), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). *But see In re University of Miami*, 123 USPQ2d 1075, 1077 n.2 (TTAB 2017) (Board exercised its discretion to consider applicant's appeal brief and reply that were not double-spaced because it appeared that they would fall within the applicable page limits had they been double-spaced). Here, even though Applicant violated the Board's rules on brief formatting, we exercise our discretion to accept Applicant's Reply Brief because it appears that the Brief would fall within the applicable page limits¹¹ had it been double-spaced.




II. Disclaimer Requirement regarding the Term DOLCE

The Examining Attorney argues that Applicant must disclaim DOLCE from Applicant's mark BOCCA DOLCE as a whole because its English translation “sweet” is merely descriptive of a characteristic or feature of Applicant's identified goods: “chocolate confections.” *See* Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) §§ 1213, 1213.03(a) (October 2018). We agree. Non-English wording that is merely descriptive in connection with the identified goods is an unregistrable component of a mark that is subject to disclaimer. TMPEP §§ 1213.03(a), 1213.08(d); *see Bausch &*

¹¹ “A reply brief from the appellant, if any, shall not exceed ten pages in length in its entirety.” Trademark Rule 2.142(b)(2), 37 C.F.R. § 2.142(b)(2).

Lomb Optical Co. v. Overseas Fin. & Trading Co., 112 USPQ 6, 8 (Comm’r Pats. 1956).¹²

In support of the disclaimer requirement, the Examining Attorney made of record the Italian-to-English translations of BOCCA DOLCE meaning “sweet mouth,” and DOLCE meaning “sweet.”¹³ The Examining Attorney also made of record copies of the U.S. trademark registrations excerpted below for marks including the term DOLCE, in which this term was disclaimed:¹⁴







Mark	Disclaimer / English Translation	Reg. No./ App. No.	Goods
 (DOLCE AMORE)	DOLCE Disclaimed DOLCE AMORE = sweet love	2916100	Sorbet and ice cream, Cl. 30
 (DOLCE GUSTO)	DOLCE GUSTO Disclaimed DOLCE GUSTO = sweet taste	3573978	Coffee; prepared coffee and coffee-based beverages; cocoa and cocoa-based beverages; chocolate based beverage mixes in powder or liquid concentrate form, Cl. 30
PRIMO DOLCE	DOLCE Disclaimed PRIMO DOLCE = first sweet	3318299	Candies; cookies; crackers; wafers, Cl. 30
 (GHIOTTOLO DOLCE FARCITO CON CREMA AL	DOLCE FARCITO CON CREMA AL CAFFE and CAFFE Disclaimed GHIOTTOLO DOLCE FARCITO CON CREMA AL CAFFE MANUEL CAFFE = Ghiottolo sweet filled with coffee cream Manuel coffee	4381811	Cake as “panettone” with coffee and dark chocolate, Cl. 30

¹² Examiner’s Brief, 6 TTABVUE 11.

¹³ Translations submitted with Office Action of January 11, 2019, at TSDR 7.

¹⁴ Third-party DOLCE registrations made of record with Denial of Request for Reconsideration of January 6, 2020, at TSDR 4-43.


Mark	Disclaimer / English Translation	Reg. No./ App. No.	Goods
<p>CAFFE MANUEL CAFFE)</p>  <p>(DOLCE GELATO)</p>	<p>DOLCE GELATO Disclaimed DOLCE = sweet</p>	<p>5019721</p>	<p>Pastries, peanut butter confectionery chips, cocoa-based beverages, coffee-based beverages, chocolate-based beverages, tea-based beverages, cookies, petit-beurre biscuits, puddings for use as desserts, flavorings for beverages, namely, coffee flavorings, waffles, chocolate, fruit coulis, candy decorations for cakes, pastry dough, cake doughs, ice cream; thickening agents for use in cooking, icing, namely, cake frosting, almond paste, dessert mousses, pasta, petits fours, sauces, sherbets, confectionery ices, namely, frozen yoghurt, Cl. 30</p>
<p>POCO DOLCE</p>	<p>DOLCE Disclaimed POCO DOLCE = little sweet</p>	<p>3977406</p>	<p>Caramels; chocolate and chocolates; chocolate bars; chocolate candies; chocolate covered nuts; chocolate covered roasted coffee beans; chocolate truffles; chocolates and chocolate based ready to eat candies and snacks; confectioneries, namely, snack foods, namely, chocolate; filled chocolate; nougat; snack foods, namely, chocolate-based snack foods; toffees, Cl. 30</p>
 <p>(POCO DOLCE)</p>	<p>DOLCE Disclaimed POCO DOLCE = little sweet</p>	<p>4097893</p>	<p>Caramels; chocolate and chocolates; chocolate bars; chocolate candies; chocolate covered nuts; chocolate covered roasted coffee beans; chocolate truffles; chocolates and chocolate based ready to eat candies and snacks; confectioneries, namely, snack foods, namely, chocolate; filled chocolate; nougat; snack foods, namely, chocolate-based snack foods; toffees, Cl. 30</p>

Mark	Disclaimer / English Translation	Reg. No./ App. No.	Goods
 (DOLCE NECTAR)	DOLCE Disclaimed DOLCE = sweet	5205208	Agave syrup, Cl. 30
 (DOLCE TUSCANO)	DOLCE Disclaimed DOLCE = sweet	4594448	Cakes; chocolate; chocolate covered nuts; chocolate-based spread also containing nuts; cinnamon-coated nuts; coffee; cookies; crackers; cream puffs; eclairs; golden syrup; maple syrup; molasses syrup; pancake syrup; pastries; starch syrup; sugared nuts; trail mix consisting primarily of granola, and also including dried fruit, chocolate, processed nuts; trail mix consisting primarily of pretzels, popcorn, and crackers, and also including dried fruit, chocolate, processed nuts, Cl. 30
 (DOLCE GELATO)	DOLCE GELATO Disclaimed DOLCE = sweet	4846784	Gelato, gelato ingredients, namely, flavorings and gelato mixes, Cl. 30
 (ROBA DOLCE)	DOLCE Disclaimed ROBA DOLCE = sweet stuff	4843976	Frozen desserts, namely, gelato, flavored water ice, ice cream, ice milk, non-dairy ice cream substitute, sorbet, Cl. 30
DOLCE NETTARE	DOLCE Disclaimed DOLCE NETTARE = sweet nectar	5060445	Gourmet vinegars; salad dressings; chili oil for use as a seasoning or condiment, Cl. 30
 (DOLCE KITCHEN DK)	DOLCE KITCHEN Disclaimed DOLCE = sweet	5012470	Rice pudding; flan; cookies; cakes; baklava, Cl. 30
 (ERBA DOLCE)	ERBA DOLCE Disclaimed ERBA DOLCE = sweet grassa	5299563	Agave syrup for use as a natural sweetener; corn syrup; honey; iced tea; maple syrup; molasses syrup; natural sweeteners; sugar substitutes, Cl. 30

Applicant argues that BOCCA DOLCE “is a unitary mark or phrase, with ‘dolce’ or ‘sweet’ modifying ‘bocca’ or ‘mouth,’ and is not acting independently to describe Applicant’s product. In the unitary phrase ‘sweet mouth,’ the word ‘sweet’ is not descriptive of the product and thus ‘Dolce’ should not need to be disclaimed.”¹⁵

In support of its argument against the disclaimer requirement, Applicant calls to our attention its prior U.S. Registration No. 2962342 for the mark BOCCA DOLCE for “staple foods, namely chocolate confections,” in which “no disclaimer was required even though the ‘sweet mouth’ translation statement was required.”¹⁶ U.S. Registration No. 2962342 expired for failure to renew, and the USPTO cancelled it in January 2016.¹⁷

Applicant also made of record copies of the following U.S. trademark registrations excerpted below for marks including the term DOLCE, in which this term was not disclaimed:¹⁸

Mark	Disclaimer / English Translation	Reg. No./ App. No.	Goods
 (DOLCE NEVE LOCAL - ITALIAN – GELATO)	LOCAL ITALIAN GELATO Disclaimed DOLCE NEVE = sweet snow	4515797	Gelato; ice cream; ice cream desserts; ice cream drinks; ice cream floats; ice cream sandwiches; ice cream substitute; ice creams; ice cream; ice-cream cakes; ices and ice creams; soy-based ice cream substitute; starch-based

¹⁵ Applicant’s Brief, 4 TTABVUE 17.

¹⁶ *Id.*, at 18.

¹⁷ Applicant submitted a TSDR database copy of cancelled U.S. Registration No. 2962342 with its Request for Reconsideration of December 4, 2019, at TSDR 38-39.

¹⁸ Third-party DOLCE registrations and applications made of record with Request for Reconsideration of December 4, 2019, at TSDR 61-63, 72-80, 84-85 and 88-90.

Mark	Disclaimer / English Translation	Reg. No./ App. No.	Goods
DOLCE FEDERICA	DOLCE = sweet	4907419	binding agents for ice cream, Cl. 30 Chocolates; candy; chocolate-based ready to eat candies and snacks; chocolate confections; baked goods, namely, pastries, tarts, macaroons, cookies, pies, and cakes; cocoa; cocoa mixes; hot chocolate mixes; snack foods, namely, snack cakes, chocolate-based snacks, and chocolate, Cl. 30
DOLCE MARE	DOLCE MARE = sweet sea	5096891	Candy; ice cream; confectionery made of sugar, candy, chocolates, and chocolate candy; frozen confections; chocolate confections; popcorn; gelato, sorbet; ice cream cakes; bakery goods, namely, cakes, cookies, waffles, crepes, and brownies; bakery desserts; ice cream desserts; coffee; gift baskets containing candy, bakery goods, coffee, chocolates, gelato, chocolate, confections, Cl. 30
PAPA DOLCE	PAPA DOLCE = sweet father	5097206	Biscuits and bread; breadsticks; cookies; cookies and crackers, Cl. 30
DOLCE BROOKLYN	BROOKLYN Disclaimed DOLCE = sweet	5277455	Gelato, Cl. 30
 (POP A DOLCE POP)	POP Disclaimed DOLCE = sweet	5231622	Kettle corn; popcorn; candy-coated popcorn; caramel popcorn; chocolate covered popcorn; flavor-coated popped popcorn; glazed popcorn; kettle corn; popped popcorn; processed popcorn, Cl. 30

Modern notions of today's disclaimer practice originate with the Supreme Court's decision in *Estate of Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538 (1920), in which the applicant applied to register the mark DOE-WAH-JACK ROUND OAK MOISTAIR HEATING SYSTEM and Design for hot air and hot water heaters and

furnaces cast into metal. The Office of the Commissioner of Patents stated it would allow registration of the mark if the words MOISTAIR HEATING SYSTEM were removed from the drawing of the mark as registered, “but that the filing of a disclaimer would not suffice to secure registration.” *Id.* at 540. Finding this practice to be improper, the Supreme Court stated:

[A] disclaimer on the part of applicant that no claim is made to the use **of the words** “Moistair Heating System” **apart from the mark as shown** in the drawing and as described, would preserve to all others the right to use these words in the future to truthfully describe a like property or result of another system, provided only that they be not used in a trade-mark which so nearly resembles that of the petitioner “as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers” when applied “to merchandise of the same descriptive properties[.]”

Id., at 546 (emphasis added) (quoting Section 5 of the Trademark Act of 1905).

Today, the disclaimer practice exercised by the USPTO is authorized by statute. Trademark Act Section 6(a), 15 U.S.C. § 1056(a) (“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.”). Registration may be refused if an applicant does not comply with a requirement for a disclaimer made by the examining attorney. *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089-90 (Fed. Cir. 2005).

Disclaimers are particularly apt for so-called, “composite marks,” such as BOCCA DOLCE, guided by the following general principles:

A “**composite**” mark may consist of a word or words combined with a design or designs; it may consist solely of words, when there are separable word elements; or it may consist solely of separable design elements. An unregistrable component of a composite mark is subject to disclaimer. However, if a composite mark (or portion thereof) is

“**unitary**,” an individual component of the mark (or of the unitary portion) that would otherwise be unregistrable need not be disclaimed.

TMEP § 1213.02 (emphasis added). *See also* TMEP § 1213.03(b) (same).

“A mark or portion of a mark is considered ‘unitary’ when it creates a commercial impression separate and apart from any unregistrable component.” TMEP § 1213.05. The test for unitariness inquires whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable.” *See In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981); *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983). The inquiry focuses on “how the average purchaser would encounter the mark under normal marketing of such goods and also ... what the reaction of the average purchaser would be to this display of the mark.” *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (quoting *In re Magic Muffler Serv., Inc.*, 184 USPQ 125, 126 (TTAB 1974)). The following are the elements of a unitary mark:

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.

Dena Corp., 21 USPQ2d at 1052. As noted above, if the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic, or otherwise, is required.

A number of factors should be considered in determining whether matter is part of a single or unitary mark: (1) whether it is physically connected by lines or other design features; (2) the relative location of the respective elements; and (3) the

meaning of the words, including how the meanings relate to each other and to the goods. *Dena Corp.*, 21 USPQ2d at 1052.

Here, the elements of Applicant's mark, BOCCA and DOLCE, are not physically connected by lines or other design features. The two words are read horizontally, from left to right, separated by a space. DOLCE ("sweet" in English) identifies a characteristic or feature of Applicant's identified goods, "chocolate confections." The two elements (words) of the mark are separable, physically and in meaning. Applicant has not submitted evidence showing, or argument persuading us, that the two elements combine such that the BOCCA DOLCE mark as a whole has a distinct meaning of its own independent of the meaning of its constituent parts.

Although it is possible for "the whole [of a mark to] be greater than the sum of its parts," *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1831 (Fed. Cir. 2015), we do not find that to be true of Applicant's mark. Rather, "the entire formulation does not add any meaning." *See In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1421 (Fed. Cir. 2005). We find, in other words, that BOCCA DOLCE is not a unitary mark that creates a single and distinct commercial impression.

We also do not find the third-party registrations of "...DOLCE..." marks submitted by Applicant (with no disclaimers of DOLCE) and the Examining Attorney (showing such disclaimers) to be particularly helpful in this case. We additionally do not find the USPTO's prior registration of Applicant's BOCCA DOLCE mark without

a disclaimer¹⁹ particularly persuasive. In *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), the U.S. Court of Appeals for the Federal Circuit affirmed the USPTO's refusal to register the mark LOAD LLAMA THE ULTIMATE BIKE RACK and Design (for bicycle racks and accessories), absent a disclaimer of "The Ultimate Bike Rack," stating:

The record in this case contains many prior registrations of marks including the term ULTIMATE. These prior registrations do not conclusively rebut the Board's finding that ULTIMATE is descriptive in the context of this mark. As discussed above, the term ULTIMATE may tilt toward suggestiveness or descriptiveness depending on context and any other factor affecting public perception. **The Board must decide each case on its own merits.** (citation omitted). Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.

Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks. Nonetheless, **the Board** (and this court in its limited review) **must assess each mark on the record of public perception submitted with the application.** Accordingly, this court finds little persuasive value in the registrations that Nett Designs submitted to the examiner or in the list of registered marks Nett Designs attempted to submit to the Board.

Id. at 1566 (emphasis added).

Because we find that the BOCCA DOLCE mark is not unitary, and that the term DOLCE is merely descriptive of a characteristic or feature of Applicant's identified

¹⁹ Particularly with respect to Applicant's prior registration of the BOCCA DOLCE mark, any presumptions flowing from that registration "[do] not carry over from registration of the older mark to a new application for registration of another mark that happens to be similar (or even nearly identical)." *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016)

goods, we affirm the Examining Attorney's requirement for a disclaimer of DOLCE apart from the BOCCA DOLCE mark as a whole.

III. Likelihood of Confusion: Applicable Law

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must 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). However, "each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect registrants from damage caused by registration of confusingly similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d

1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of the goods. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)).

IV. Analysis

The likelihood of confusion factors Applicant focused on in this appeal are the strength of the cited BOCCA mark and the similarity or dissimilarity of the BOCCA DOLCE and BOCCA marks. The Examining Attorney focused too on these factors, but also addressed the relatedness of the goods associated with the respective marks, and the channels of trade and prospective purchasers therefor.

A. The Similarity or Dissimilarity and Nature of the Goods

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods ... as described in an application or registration...” *DuPont*, 177 USPQ at 567. “This factor considers whether ‘the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods ...’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)).

To determine the relationship between the goods, we are bound by the identifications in Applicant's involved Application and the cited Registration. *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("Likelihood of confusion must be determined based on an analysis of the marks as applied to the ... [goods] recited in applicant's application vis-à-vis the ... [goods] recited in [a] ... registration, rather than what the evidence shows the... [goods] to be.") (citing *Canadian Imperial Bank v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)).

In this case, Registrant's broadly described goods ("caramels in the nature of candy; chocolates") encompass all goods of the type described, including Applicant's more narrowly defined goods ("chocolate confections"). *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-14 (TTAB 2018). We find that "chocolate confections" is identical to "chocolates." Thus, Applicant's and Registrant's goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981)). In neither its Appeal Brief nor its Reply Brief does Applicant contest the Examining Attorney's contentions during prosecution²⁰ and on appeal²¹ that Applicant's identified goods and Registrant's recited goods are legally identical.

²⁰ Office Action of January 11, 2019, at TSDR 3; Office Action of July 30, 2019, at TSDR 3; Denial of Request for Reconsideration of January 6, 2020.

²¹ Examiner's Brief, 6 TTABVUE 5.

We therefore find the second *DuPont* factor, the similarity and related nature of the goods as described in the BOCCA DOLCE Application and the BOCCA Registration, supports a conclusion that confusion is likely.

B. The Similarity or Dissimilarity of Trade Channels and Classes of Purchasers

Under the third *DuPont* factor, we must base our determination regarding the similarities or dissimilarities between channels of trade and classes of purchasers for the goods as they are identified in the application and the cited registration at issue. *Octocom Sys., Inc. v. Hous. Comp. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank*, 1 USPQ2d at 1815; *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1471 (TTAB 2016). Neither the BOCCA DOLCE Application nor the BOCCA Registration has any limitations as to trade channels or classes of customers, nor may we read any limitation into them. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958)).

As we noted above, the goods in the BOCCA DOLCE Application and the BOCCA Registration are legally identical in part. Thus, it is presumed that the channels of trade and classes of purchasers for these respective goods are presumed to be the same. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)).

Thus, the third *DuPont* factor, channels of trade and classes of purchasers, weighs in favor of a finding a likelihood of confusion.

C. Comparison of the Marks

1. Strength of the Registered Mark, BOCCA

Under the fifth and sixth *DuPont* factors, we consider the strength of the cited registered mark, and the extent to which that strength may be attenuated by “[t]he number and nature of similar marks in use on similar ... goods.” *DuPont*, 177 USPQ at 567. “A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace [or commercial] strength (secondary meaning).” *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). For likelihood of confusion purposes, a mark’s strength “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (“likelihood of confusion [strength] ... ‘varies along a spectrum from very strong to very weak.’”) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003))).

Applicant argues that:

The mere fact that both Applicant’s Mark and the Cited Registration contain the word “BOCCA” is not enough to find a likelihood of confusion. **The common element “Bocca” (and its alternative spelling “Boca” that is pronounced, looks and means the same) is diluted** and Applicant’s Mark has the additional term “Dolce”.

* * *

A consumer’s ability to differentiate between the two marks is particularly strengthened due to **the number of other similar marks**

containing “Bocca,” “Boca” or their English translation “Mouth” for candy or other similar food products. ... [F]or comparison purposes, “Bocca” and “Boca” must be viewed the same because they look virtually the same, have exactly the same pronunciation, derive from highly similar languages, and have the same meaning. Consumers will not differentiate between “Bocca” and “Boca”. However, they will distinguish between marks that have this word in common based on additional wording as is illustrated by the coexistence of the large number of these marks for identical or highly similar goods. “Bocca” or “Boca” and their English translation “Mouth” are commonly used for candies, sweets and other related food products.²² (Emphasis added).

In support of its argument that the term BOCCA (or BOCA), or the English equivalent MOUTH is diluted (and thus weak), Applicant made of record the following third-party uses from Internet websites:

Mark	Goods
BELLA BOCA	Belgian chocolate
BOCA BLOKS	Guava based snack foods
BOCA	Veggie burgers, crumbles and falafel bites
BOCA FREEZE	Soft serve ice cream substitute
BOCA SUNRISE	Coffee
BOCA TRASH	Gift bucket containing assorted pretzels, Oreos and marshmallows covered in white, milk and dark chocolate
COTTON MOUTH CANDY	Fruit flavored candy
FAT MOUTH	Combination platter of chicken fingers, jalapeno poppers, mozzarella sticks, french fries, mayo, ketchup, lettuce, tomato and onions
FOWL MOUTH	Turkey burger with BBQ sauce mayo, pickles, onions and raw jalapenos
MEGA MOUTH	Filled bubble gum balls
MOUTH PARTY	Caramel chews
SMART MOUTH	Sugar free mints
SOUTH MOUTH	Sauce ²³

²² Applicant’s Brief, 4 TTABVUE 11-12.

²³ Third-party uses of BOCA and MOUTH marks made of record with Request for Reconsideration of December 4, 2019, at TSDR 130-142.

“Evidence of third-party **use** of similar marks **on similar goods** is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *In re FabFitFun*, 127 USPQ2d 1670, 1674 (TTAB 2018), (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693) (emphasis added). “Internet printouts, such as those offered by Applicant, ‘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.” *Id.* (quoting *Rocket Trademarks Pty Ltd v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011)). While Applicant has not presented specific evidence concerning the extent, exposure, or impact of these uses, “[i]n determining the degree of weakness, if any, of the shared term [BOCCA], we must ‘adequately account for the apparent force of [third-party use] evidence,’ regardless of whether ‘specifics’ pertaining to the extent and impact of such use[s] have been proven.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (mem), (quoting *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015)).




Applicant made of record thirteen (13) third-party uses of the terms BOCA and MOUTH. In considering whether the equivalent, BOCCA, is a weak trademark element, in the absence of any showing by Applicant of the relatedness of the other goods, we only consider those third-party uses that are in connection with goods similar to those recited in the BOCCA registration, namely, “caramels in the nature of candy; chocolates.” *See Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d




1315, 128 USPQ2d 1686 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *In re i.am.symbolic, llc*, 123 USPQ2d at 1751 (disregarding third-party registrations for goods in other classes where the proffering party “has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, ... support a finding that registrants’ marks are weak with respect to the goods identified in their registrations”). We therefore eliminate from consideration six (6) third-party uses from Applicant’s list.

As the U. S. Federal Circuit Court of Appeals has explained, “extensive evidence of third-party registration and use is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin*, 116 USPQ2d at 1136 (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). The third-party use evidence here “reflects a more modest amount of evidence than that found convincing in *Jack Wolfskin* and *Juice Generation* wherein ‘a considerable number of third parties’ use [of] similar marks was shown.” *FabFitFun*, 127 USPQ2d at 1674 (quoting *Juice Generation*, 115 USPQ2d at 1674).

Applicant also made of record the following third-party registrations:²⁴

²⁴ Third-party BOCCA/BOCA/MOUTH registrations and applications made of record with Request for Reconsideration of December 4, 2019, at TSDR 21-37, 40-60, 64-71, 81-83, 86-87 and 91-110.

Mark	Disclaimer / English Translation	Reg. No./ App. No.	Goods
FRESH MOUTH		1593261	Candy coated chewing gum, Cl. 30
BOCA BONS	BOCA = mouth	1871485	Candies and chocolates, Cl. 30
BOCA TRASH	BOCA = mouth	2263226	Confectionery, namely, candy and assorted sweets, and sweets in a gift basket, Cl. 30
BOCA FREEZE	BOCA = mouth	3436806	Naturally sweetened soft serve ice cream substitute, and mixes for making naturally sweetened soft serve ice cream substitute, Cl. 30
SMART MOUTH		3465675	Non-medical mouth rinse, toothpaste, Cl. 3
MEGA-MOUTH		3050087	Chewing gum, Cl. 30
BOCA JAVA	JAVA disclaimed BOCA = mouth	3246634	Coffee; tea; coffee beans; cocoa, Cl. 30
BOCA SUNRISE	BOCA = mouth	3612459	Coffee, Cl. 30
	BELLA BOCA = beautiful mouth	3940041 (cancelled)	Chocolate, candy, biscuits, confectionery made of sugar, Cl. 30
		4161151	Candy with caramel; [Caramel topping for ice cream;] Caramels, Cl. 30
LA BOCA ROJA	LA BOCA ROJA = the red mouth	4261211 (cancelled)	Hot sauce, Cl. 30
FOWL MOUTH		4492259	Hamburger sandwiches, Cl. 30
COTTON MOUTH CANDY	CANDY disclaimed	4377995 (Supplemental Register)	Candy, Cl. 30
MOUTH PARTY		4777696	Candy, candy with caramel, caramel topping for ice cream, caramel sauce for baking, Cl. 30
SOUTH MOUTH		4928640	Hot sauce; sauces, Cl. 30
 (BOCA JAVA ATOMIC)	JAVA disclaimed	5624992	Coffee; coffee beans, Cl. 30

Mark	Disclaimer / English Translation	Reg. No./ App. No.	Goods
FAT MOUTH		5199961	Sandwiches, Cl. 30
BOCA	BOCA = mouth	5349866	Frozen entrees, meals, sides and snacks consisting of vegetables, beans and/or cheese, Cl. 29; Frozen entrees, meals, sides and snacks consisting of rice, quinoa, and/or processed grains, Cl. 30
 (BOCA JAVA)	JAVA disclaimed	5378239	Coffee; tea; coffee beans; cocoa, Cl. 30
 (BOCCA BREAD)	BREAD Disclaimed BOCCA = mouth	5548512	(Based on Use in Commerce) Bread; Bread flavored with spices; Flat bread; Gluten-free bread; Multigrain bread; Naan bread; Sandwich wraps; Sandwich wraps made of flour; Whole wheat bread; Wholemeal bread (Based on 44(d) Priority Application) Bread; Bread flavored with spices; Flat bread; Gluten-free bread; Multigrain bread; Naan bread; Sandwich wraps; Sandwich wraps made of flour; Whole wheat bread; Wholemeal bread, Cl. 30
BAOMOUTH		5891830	Buns, Cl. 30
 (BOCCA PRODOTTI NATURAL! SECOLI QUALITA PREMIUM QUALITY)	DI PRODOTTI NATURAL" and PREMIUM QUALITY Disclaimed BOCCA, PRODOTTI NATURAL! and SECOLIDI QUALITA = mouth, natural products, and centuries of quality	88240899 (Abandoned)	Blended oil for food; Olive oil for food; Olive oils for food; Olive pastes; Extra virgin olive oil for food; Flavored olive oil for food; Processed olives; Tinned olives, Cl. 29
MOUTH OFF		88291997	Chewing gum; Functional chewing gum, namely, chewing gum for breath freshening that dissolves, Cl. 30

Mark	Disclaimer / English Translation	Reg. No./ App. No.	Goods
MOUTH- PUCKERING CANDY	CANDY disclaimed	5862623	Candy, Cl. 30
BOCA BLOKS	BLOCKS disclaimed	88374749 (Abandoned)	Guava paste, namely, a traditional Latin American snack made from guava and sugar, Cl. 29

Third-party **registration** evidence goes not to the commercial strength of the registrant's mark, but rather its conceptual strength. That is, “[u]se evidence may reflect commercial weakness, while third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered **for similar goods or services.**” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) (emphasis added) (citing *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976)). *See also, In re Guild Mortg. Co.*, 2020 USPQ2d 10279 *3 (TTAB 2020) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which . . . a mark is used in ordinary parlance.’”).

Applicant's third-party registration evidence comprises twenty-five (25) third-party registrations and applications for marks consisting wholly of, or comprising partially of, the term BOCCA, BOCA or MOUTH. Only eight (8) of the active third-party registrations recite goods similar to those listed in the BOCCA registration. All of these registrations are for marks that contain additional textual matter distinguishing them from the BOCCA mark.

Unlike cases in which extensive evidence of third-party registrations was found to be “powerful on its face” inasmuch as “a considerable number of third parties use [of]

similar marks was shown,” *Juice Generation*, 115 USPQ2d at 1674, this record presents only a very limited number of such registrations **for similar goods**, well short of the volume of evidence found convincing in *Juice Generation* and *Jack Wolfskin*, 116 USPQ2d at 1136.

Applicant’s evidence also includes three (3) third-party applications, two (2) of which have been abandoned. Third-party applications are evidence only of the fact that they have been filed, and have no probative value. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1365 n.7 (TTAB 2007); *Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1467 n.6 (TTAB 2003). Applicant additionally made of record two third-party registrations that have been cancelled. A cancelled registration is not evidence of any existing rights in the mark. *See Action Temp. Servs. v. Labor Force*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989). An expired or cancelled registration is evidence of nothing but the fact that it once issued. *Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987).

To summarize, there is insufficient evidence of record regarding the purported conceptual or commercial weakness of the cited BOCCA mark. We therefore find the fifth and sixth *DuPont* factors to be neutral factors in the likelihood of confusion analysis. The registered BOCCA mark is presumed to be valid and at the very least inherently distinctive pursuant to Trademark Act Section 7(b), 15 U.S.C. § 1057(b).

2. The Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entirety, taking into account their

appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

“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.” *In re i.am.symbolic, llc*, 123 USPQ2d at 1748. The parties’ marks “must be considered ... in light of the fallibility of memory” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). Therefore, “[t]he focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.” *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007).

Where the goods are legally identical, as they are in this case, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. See *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting *Century 21 Real*

Estate Corp. v. Century Life of Am., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our 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 Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). Therefore, “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 entireties.” *In re Nat'l Data*, 224 USPQ at 751. That is, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

We find the term “BOCCA” to be the dominant portion of Applicant’s BOCCA DOLCE mark. That is in part because BOCCA is the first term, and consumers are generally more inclined to focus on the first literal portion in any mark. *See Palm Bay*

Imps., 73 USPQ2d at 1692. Also, as we discussed above, the other wording in the mark, DOLCE, is merely descriptive of Applicant's goods and should be disclaimed. Merely descriptive or generic matter that has been (or, as here, should be) disclaimed is typically less significant or less dominant when comparing marks. *In re Detroit Athletic*, 128 USPQ2d at 1050 (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)).

Likelihood of confusion is often found where, as here, the entirety of one mark (BOCCA) is incorporated within another (BOCCA DOLCE). *Omega SA v. Alpha Phi Omega*, 118 USPQ2d 1289, 1293 (TTAB 2016) (OMEGA incorporated into ALPHA PHI OMEGA and Design); *Christian Broad. Network, Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1568 (TTAB 2007) (CBN v. ABS-CBN). Where the portion common to both marks (BOCCA) is inherently distinctive, but the additional portion in the incorporating mark (DOLCE) is descriptive or generic, the incorporating mark (BOCCA DOLCE) is apt to retain the basic commercial impression of the other; the additional portion at best merely imparts information about the product and not its source:

If all that a newcomer in the field need do in order to avoid the charge of confusing similarity is to select a word descriptive of his goods and combine it with a word which is the dominant feature of a registered trademark so that the borrowed word becomes the dominant feature of his mark, the registered trademark ... soon becomes of little value

Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 224 USPQ 185, 190 (4th Cir. 1984) (quoting *Bon Ami Co. v. McKesson & Robbins*, 93 F.2d 915, 36 USPQ 260, 261 (CCPA 1938)).

Applicant argues, however, that inclusion of the term DOLCE in its mark is a sufficient differentiator such that Applicant's mark, BOCCA DOLCE, and Registrant's mark, BOCCA, will not be confused by consumers. Applicant states:

BOCCA DOLCE is from the Italian language. Applicant submitted evidence in its Request that Italian is a dying language in the United States and that very few Americans speak Italian. *See* Applicant's Request for Reconsideration [of December 4, 2019, at TSDR 112-116, 129] As a result, **the vast majority of the US customers for Applicant's goods will not even recognize that "dolce" means "sweet."** Thus, "Dolce" is a much stronger differentiator than if the English word "Sweet" were used. This must be considered when evaluating the differences in the marks and whether confusion will be caused. "Dolce" is a strong, not weak, differentiator. (Emphasis added).

The Examining Attorney argued that Italian is a common foreign language in the United States based on US census data. The Examining Attorney noted that there are over 700,000 Italian speakers in the United States. However, according to the United States Census Bureau, the United States has a current population of 330 million. *See* Applicant's Request for Reconsideration [of December 4, 2019, at TSDR p. 129] That means that only **0.21 percent** of Americans speak Italian. Less than a quarter of one per cent is a very small number of the consuming public. As a result, very few American consumers are going to see "Dolce" as a common or descriptive word, making it a strong differentiating factor. (Emphasis Applicant's).²⁵

The Examining Attorney, on the other hand, contends:

Applicant recognizes its wording "DOLCE" is an Italian word meaning "sweet," but argues the U.S. consuming public will not recognize this wording as a descriptive term for the identified chocolate confections goods. ... However, evidence of record shows that the Italian language is the eighth most spoken language in the United States, and that confections are defined as "sweet" foods.²⁶

²⁵ Applicant's Brief, 4 TTABVUE 15-16.

²⁶ Examiner's Brief, 6 TTABVUE 11.

The Examining Attorney's argument is supported by a WIKIPEDIA article made of record stating that, as of 2015, Italian is the eighth most spoken language in the United States, spoken by over 708,000 people. The Examining Attorney also made of record the definition "confection," Applicant's goods, as meaning a "sweet food."²⁷

We find significant that over 708,000 people in the United States speak Italian for purposes of their knowing the Italian-to-English translation of DOLCE as meaning "sweet." See *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.'").²⁸ We therefore find Applicant's statistical argument not persuasive. The Board previously has held that "it does not require any 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 Indus., Inc.*, 230 USPQ 702, 704-05 (TTAB 1986).

Comparing the marks as a whole, we find that the marks BOCCA and BOCCA DOLCE are similar in appearance, sound, meaning and commercial impression. The dominant portion of Applicant's mark is identical to the entirety of Registrant's mark. In other words, the entirety of Registrant's mark, BOCCA, is incorporated within Applicant's mark, BOCCA DOLCE. Notwithstanding Applicant's protestations to the

²⁷ Office Action of July 30, 2019, at TSDR 6-8.

²⁸ We additionally find incongruous Applicant's argument that a small percentage of the United States population would not know the Italian-to-English translation of DOLCE, yet asks us to consider third-party registered and common law MOUTH marks as the English-to-Italian translation of BOCCA or BOCA.

contrary,²⁹ in finding the marks similar we have not dissected them nor have we ignored the non-identical part of Applicant's mark, DOLCE. The first *DuPont* factor thus supports an ultimate finding that confusion is likely.

D. Conclusion: Likelihood of Confusion

The first, second and third *DuPont* factors favor a finding of likelihood of confusion. The fifth and sixth factors are neutral. Registrant's mark is inherently distinctive; Applicant did not provide sufficient evidence to challenge its conceptual or commercial strength. The marks at issue are similar in sound, appearance, connotation and commercial impression. The respective goods are legally identical. We thus presume as a matter of law that the marks would travel in overlapping trade channels and be provided to the same or overlapping classes of purchasers. We therefore find that Applicant's mark BOCCA DOLCE, used in connection with Applicant's goods, so closely resembles the registered mark BOCCA as to be likely to cause confusion, mistake or deception as to the source of Applicant's goods.

Decision: The Examining Attorney's requirement that the term "DOLCE" be disclaimed apart from Applicant's BOCCA DOLCE mark as a whole, pursuant to Trademark Act Section 6(a), is affirmed. The refusal to register Applicant's mark BOCCA DOLCE on grounds of likelihood of confusion, pursuant to Trademark Act Section 2(d), is affirmed. However, if Applicant intends to appeal our affirmance of Section 2(d) refusal, and is willing to disclaim "DOLCE" apart from the BOCCA DOLCE mark as shown, then Applicant may file the disclaimer within 30 days of the

²⁹ Applicant's Brief, 4 TTABVUE 10.

mailing date of this decision.³⁰ Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g). In the event that the disclaimer is filed, the refusal of registration based on the disclaimer requirement will be set aside. Applicant should note, however, that the filing of the disclaimer will not extend the time to file an appeal. The time for filing an appeal runs from the mailing date of this decision.

³⁰ The standard printing format for the required disclaimer text is as follows: “No claim is made to the exclusive right to use DOLCE apart from the mark as shown.” TMEP § 1213.08(a)(i).