

This Opinion is Not a
Precedent of the TTAB

Mailed: November 29, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vermutería de Galicia, S.L.

Serial No. 90385649

Louis S. Ederer, Matthew Salzmann, and Hafeez Khan of Arnold & Porter Kaye
Scholer LLP, for Vermutería de Galicia, S.L.

Jaime Batt, Trademark Examining Attorney, Law Office 125,
Robin Mittler, Managing Attorney.

Before Lynch, Larkin and Johnson,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background¹

Vermutería de Galicia, S.L. (“Applicant”) seeks registration on the Principal



Register of the mark for “vermouth” in International Class

33.² According to the mark description in the application: “The mark consists of the stylized wording ‘ST PETRONI’ in garnet appearing in front of a gray duck design with the feather tips in white and the neck and head replaced with a gray and white

¹ Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, *4 n.1 (TTAB 2020). 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.

As part of an internal Board pilot citation program on broadening acceptable forms of legal citation, this order cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this order employs citations to the LEXIS legal database and cites only precedential decisions. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024). Proceeding and serial numbers also are included for decisions of the Board. Those Board decisions that issued on or after January 1, 2008 may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available through USPTO.gov in the TTAB Reading Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

² Application Serial No. 90385649 was filed December 16, 2020. On February 26, 2022, the filing basis of the application was amended to Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e). The application also includes a claim of priority under Section 44(d), 15 U.S.C. § 1126(d).

forearm and hand design holding a gray pen emerging from a gray and white set square design. Below is the stylized gray wording ‘VERMUTERÍA DE GALICIA.’”

The colors gray, garnet and white are claimed as a feature of the mark.

The Examining Attorney has finally refused registration on the following grounds:

(1) under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the previously registered standard character mark PETRONI for “wine” in International Class 33;³

(2) under Trademark Rules 2.32(a)(9) and 2.61(b), 37 C.F.R. §§ 2.32(a)(9) and 2.61(b), based on Applicant’s failure to comply with the requirement for an English translation of VERMUTERÍA DE GALICIA; and

(3) under 15 U.S.C. § 1056(a), based on Applicant’s failure to comply with the requirement for a disclaimer of VERMUTERÍA DE GALICIA as merely geographically descriptive.

After the Examining Attorney issued a final refusal on two of the three grounds above, Applicant filed a request for reconsideration and appealed. The Examining Attorney denied reconsideration, and the appeal proceeded with Applicant filing a brief. The Examining Attorney then requested and received a remand to include the second ground above, the translation requirement, among the grounds for refusal. Following further prosecution after the remand and a subsequent final refusal, the

³ Registration No. 5155865 issued March 7, 2017 on the Principal Register, with a claim of acquired distinctiveness. The USPTO has accepted and acknowledged Registrant’s combined Sections 8 and 15 declaration.

appeal proceeded. It is fully briefed, including a supplemental brief (following the remand) and a reply brief from Applicant.

For the reasons set forth below, we affirm the refusal to register based on the translation requirement and likelihood of confusion. As a result, we need not reach the disclaimer requirement.

II. Translation Requirement

Trademark Rule 2.32(a)(9) provides in part that, in an application, “[i]f the mark includes non-English wording, an English translation of that wording” is required. This translation requirement arises from the need to understand the meaning of any non-English words for proper examination of a mark. For example, the examination of a mark with foreign language terms includes consideration that “the foreign equivalent of an English term may be regarded in the same way as the English term for purposes of determining descriptiveness, requiring a disclaimer, and citing marks under § 2(d) of the Act.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 809.01 (May 2024). “The translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language.” TMPEP § 809.02.

In this case, Applicant did not submit a translation with its application. When the Examining Attorney inquired as to any meaning in a foreign language of VERMUTERÍA DE GALICIA,⁴ Applicant responded that the “phrase has no meaning

⁴ June 23, 2021 Office Action at TSDR 5-6.

in a foreign language.”⁵ Instead, Applicant asserted that it refers only to Applicant’s “legal business name.”⁶

However, the Examining Attorney’s research indicated that the wording “VERMUTERÍA DE GALICIA” means “vermouth maker from Galicia,” where GALICIA is a region of Spain.⁷ Therefore the Examining Attorney declined to accept Applicant’s representation that the wording lacks meaning in a foreign language. Instead, the Examining Attorney reiterated the requirement for a translation, this time with a suggested translation of “vermouth maker from Galicia.”⁸

Applicant rejected the Examining Attorney’s proposed translation, and repeatedly declined to provide any translation. As Applicant states in its Supplemental Brief:

Applicant’s response to this requirement has remained the same throughout the application process. Just as Applicant submitted in its Response to the Non-Final Office Action, filed on December 8, 2021, and echoing the arguments above, Applicant again submits that the wording “VERMUTERÍA DE GALICIA” has no meaning in a foreign language. Applicant further submits that “DE GALICIA” can mean, among other things, “of Galicia” as translated from Spanish to English; however, in submitting this definition, Applicant does not in any way concede—for the reasons outlined above with respect to not disclaiming “DE GALICIA”—that “DE GALICIA” is primarily geographically descriptive.⁹

⁵ December 8, 2021 Response to Office Action at TSDR 12.

⁶ *Id.*

⁷ March 1, 2022 Office Action at TSDR 1.

⁸ *Id.*

⁹ 14 TTABVUE 25.

The Examining Attorney has supported the translation requirement (as well as the disclaimer requirement) with the following:

- An official translation stating: “The original language of the non-English wording “ST PETRONI, VERMUTERÍA DE GALICIA’ is ‘Spanish.’ The English translation of the non-English wording in the mark is ‘St. Petroni, vermouth maker from Galicia.” The official translation comes from the USPTO’s Scientific and Technical Information Center by “a translator proficient in [Spanish] employed by the U.S. Patent and Trademark Office.”¹⁰
- A lengthy Wikipedia article on Galicia, Spain that includes a discussion of Galician wines: “Galicia produces a number of high-quality Galician wines, including Albariño, Ribeiro, Ribeira Sacra, Monterrei and Valdeorras.”¹¹
- An entry for “Galicia” in the Columbia Gazetteer, stating in part that Galicia has a population of 2.9m.¹²
- Galicia Guide, with an entry for “Padron Galicia,” the town Applicant provided as its address.¹³
- The Rusticae website, with an article discussing boutique hotels in Galicia, that refers to Applicant’s town as “located in a unique tourist enclave that is

¹⁰ January 22, 2024 Office Action at TSDR 2.

¹¹ March 1, 2022 Office Action at TSDR 2-8.

¹² June 23, 2021 Office Action at TSDR 29.

¹³ June 23, 2021 Office Action at TSDR 30-31.

located within the Costa de Galicia and that every year is a very popular destination for all types of tourists.”¹⁴

- Proof that Applicant’s address is located in the Galicia region of Spain.¹⁵
- The VinoVi website describing Applicant as “based in Padron, Galicia,” and “dedicated to the production of the St. Petroni vermouth, from quality Albarino wines with denomination of origin and following the traditional formula.”
- Online Spanish-English dictionary entries for “vermut” as Spanish for “vermouth”¹⁶ and “de” as Spanish for “from” or “of.”¹⁷
- A blog “dedicated to helping people learn Spanish language, grammar, and culture” about the Spanish suffix -ERÍA as “very common” and used to indicate “the place where __ is made/bought.”¹⁸
- An article on the Food & Wine magazine website titled “Katie Button Is Bringing Spain’s Vermuterías to the U.S.,” discussing “vermuterías, or vermouth bars” and describing a chef’s vermutería in Asheville, North Carolina.¹⁹

¹⁴ June 23, 2021 Office Action at TSDR 32-34.

¹⁵ June 23, 2021 Office Action at TSDR 35; *see also* January 22, 2024 Office Action at TSDR 49 (Wikipedia article on Padron, identifying it as in the “Province of A Coruna, in Galicia (Spain).”

¹⁶ January 22, 2024 Office Action at TSDR 10.

¹⁷ January 22, 2024 Office Action at TSDR 15.

¹⁸ January 22, 2024 Office Action at TSDR 12.

¹⁹ June 23, 2021 Office Action at TSDR 12-13.

- An article in the Madrid Cool Blog titled “The new vermuterías of Madrid for authentic bon vivants (and modern folks).”²⁰
- The webpage of Vermutería Peix d’Or, where customers can have “the best brands of vermouth.”²¹
- An article on the Culinary Backstreets website titled “Vermuteria Lou: Mistress of Croquettes” describes a “tiny, cozy venue” in Barcelona featuring “the Yzaguirre vermouth tap.” The article describes the owner’s idea “to open a vermuteria following the example of Quimet & Quimet, with high-quality preserved food products and just a few cooked dishes to serve with the vermouth.”²²
- An article on the Dotravel Mag website titled “Vermuterías in Barcelona: Where to try sweet & dry” defines vermuteria as “a bar that specializes in vermouth,” noting “many vermuteries [sic] have their own ‘house’ vermouth.” The author “break[s] down Vermuterias in Barcelona into the different neighborhoods.” Under Vermuteria Gracia, the list includes Vermuteria Lou and Vermuteria del Tano; under Vermuteria Raval, Mson Vermuteria is featured; under Vermuteria Girona, La Vermuteria Sant Fliu de Guixols is featured. Other headings in the article include Vermuteria Poblenou, Vermuteria Poble Sec & Sant Antoni, Vermuteria Eixample, Vermuteria

²⁰ June 23, 2021 Office Action at TSDR 16.

²¹ June 23, 2021 Office Action at TSDR 26-27.

²² January 22, 2024 Office Action at TSDR 28-32.

Sants, and Vermuteria Gotic/Born. The article concludes with, “[s]o there you have it, the list of the best vermuterías in Barcelona (and a great one outside the city).”²³

- An online review in Timeout of “La Vermuteria del Tano,” stating that there are “two types of vermouth bars in town: the new and modern, and those that have been around forever,” and that La Vermuteria del Tano is in the latter category, with “vermouth from the Emprada region, which used to be sold from the barrel to take away as well.”²⁴

We note that the sworn translation Applicant provided of its Spanish registration, upon which its Section 44(e) application basis rests, identifies Applicant’s goods as “VERMOUTH FROM GALICIA.”²⁵

Applicant denies that VERMUTERÍA DE GALICIA has a meaning in a foreign language, but the record indicates otherwise. According to TMEP § 809.01, “[i]f the applicant disputes a translation obtained through online resources, the examining attorney should supplement the record with evidence from the Trademark Librarian and/or the Translations Branch.” As noted above, the Examining Attorney did so in this case, and provided an official translation of the wording at issue from Spanish to English.

²³ January 22, 2024 Office Action at TSDR 33-47.

²⁴ January 22, 2024 Office Action at TSDR 51-52.

²⁵ December 8, 2021 Response to Office Action at TSDR 29-30.

The evidence easily convinces us that VERMUTERÍA DE GALICIA has a meaning in a foreign language. The record includes a wide variety of credible sources, including an official translation, and makes clear that Applicant's mark has a meaning in Spanish. Applicant's repeated representations and arguments that VERMUTERÍA DE GALICIA has no meaning in a foreign language are inaccurate, lack credibility and are unpersuasive. *See In re Aquamar, Inc.*, Serial No. 85861533, 2015 TTAB LEXIS 178, at *7-8 (TTAB 2015) ("Applicant's claim that the mark 'is a completely arbitrary designation and coined term with respect to Applicant's associated goods' is inconsistent with the evidence of record and not credible").

We reject Applicant's attempt to characterize the inquiry under this requirement as whether the Examining Attorney's evidence establishes the particular translation "vermouth maker from Galicia."²⁶ For this requirement, we need not decide whether the proposed translation is the correct one (although it does appear to be correct). As noted above, the applicable rule requires Applicant to provide a translation of any non-English wording in the mark. The record clearly reflects that Applicant's mark contains non-English wording, and Applicant refused to provide a translation of it.

The requirement under Trademark Rules 2.32(a)(9) and 2.61(b) for an English translation of the foreign wording was appropriate. The meaning of wording in a mark holds a critical importance for the proper examination of a trademark application. We affirm the refusal to register Applicant's mark for failing to submit the required translation.

²⁶ *See* 17 TTABVUE 4-5 (Applicant's Reply Brief).

III. Likelihood of Confusion

The failure to comply with the translation requirement suffices by itself as a basis to affirm the refusal of registration. However, we also exercise our discretion to address the refusal under Section 2(d) of the Trademark Act. The statute prohibits 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.” 15 U.S.C. § 1052(d).

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). A likelihood of confusion analysis often particularly focuses on the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

A. The Goods

In analyzing the relatedness of the goods under the second *DuPont* factor, we look to the identifications in the application and cited registration. *Octocom Sys., Inc. v. Houston Comp. Servs., Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990). The application identifies “vermouth,”²⁷ and the cited registration identifies “wine.” As discussed below, Applicant and the Examining Attorney dispute whether vermouth should be considered a wine, or a “mixed spirits product.”

We agree with the Examining Attorney that the goods overlap. We must construe the cited registration’s unrestricted “wine” to encompass all types of wine, including fortified wine such as vermouth. *See, e.g., In re Hughes Furniture Indus., Inc.*, Serial No. 85627379, 2015 TTAB LEXIS 65, *10 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *In re Linkvest S.A.*, Serial No. 74005053, 1992 TTAB LEXIS 48, *2 (TTAB 1992) (“Registrant’s goods are broadly identified as computer programs recorded on magnetic disks, without any limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant’s services encompass all such computer programs including those which are for data integration and transfer.”).

During prosecution, Applicant conceded its “understand[ing] that these goods are typically considered to be related for purposes of a likelihood of confusion analysis.”²⁸

²⁷ *See infra* at pp. 13-15 for a discussion of what “vermouth” is, based on evidence in the record.

²⁸ December 8, 2021 Response to Office Action at TSDR 12.

However, Applicant also has argued that vermouth “is a mixed spirits product, while the goods covered by the Cited Mark are ‘wine.’”²⁹ Applicant asserts that “consumers of goods of this nature are generally quite sophisticated and understand the differences between wine and a high-end mixed spirits product such as vermouth, which must go through a very specific process in order to be produced.”³⁰ However, as we explained above, whether consumers discern a difference between wine and vermouth is not the standard for relatedness. *See Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods”). Also, Applicant’s unrestricted identification of “vermouth” controls the analysis, so we cannot consider Applicant’s characterization of its goods as “high-end.” *See In re Aquitaine Wine USA, LLC*, 2018 TTAB LEXIS 108, at *29 (TTAB 2018) (“Wine purchasers are not necessarily sophisticated or careful in making their purchasing decisions, and where, as here, the goods are identified without any limitations as to trade channels, classes of consumers or conditions of sale, we must presume that Applicant’s and Registrant’s wine encompasses inexpensive or moderately-priced wine”).

To establish that vermouth is a type of wine, such that Applicant’s “vermouth” would be considered legally identical to Registrant’s “wine,” the Examining Attorney provided an AMERICAN HERITAGE DICTIONARY entry for “vermouth,” defining it as “[a]

²⁹ May 8, 2023 Response to Office Action at TSDR 16.

³⁰ 14 TTABVUE 18 (Applicant’s Supplemental Brief); May 8, 2023 Response to Office Action at TSDR 16.

sweet or dry fortified wine flavored with aromatic herbs and used chiefly in mixed drinks.”³¹ The record also includes a Wikipedia entry for “Vermouth” stating that “Vermouth is an aromatized fortified wine, flavoured with various botanicals (roots, barks, flowers, seeds, herbs, and spices) and sometimes colored.”³² According to The Alcohol Professor webpage on California Vermouth, “Vermouth is an aromatized wine, meaning it has a shelf life, and needs to be treated less like a bottle of booze and more like a bottle of wine.”³³ An article on the DOTRAVEL MAG site responds to the question “What is Vermouth” with “essentially a mix of wine flavored with herbs.”³⁴ And the Carpano website answers the question “What is Vermouth” with, “Vermouth Is a Valuable Aromatized Wine,” and “one of the most interesting and typical Italian luxury wines.”³⁵ This article also mentions that pursuant to European regulations, vermouth is “obtained from one or more wines with the addition of alcohol,” and “must be composed of at least 75% of [sic] wine.”³⁶ The Matthiasson website states, “our vermouth is primarily about the wine – the base wine before the herbs, spices, and fruit extracts [sic] are added,” concluding that “This wine is reserved for wine club members.”³⁷

³¹ June 23, 2021 Office Action at TSDR 11.

³² March 1, 2022 Office Action at TSDR 70.

³³ January 22, 2024 Office Action at TSDR 42.

³⁴ January 22, 2024 Office Action at TSDR 22.

³⁵ January 22, 2024 Office Action at TSDR 41.

³⁶ *Id.*

³⁷ January 22, 2024 Office Action at TSDR 43.

The record reflects that vermouth consists primarily of wine, and it contains other ingredients, which often include another type of alcohol. Ultimately, we agree with the Examining Attorney that vermouth is considered a type of wine. Therefore Registrant's goods encompass Applicant's goods, and they are legally identical.

Even if the goods were not legally identical, they certainly are related. To address Applicant's argument that vermouth is a "mixed spirits" product that differs from wine, the Examining Attorney also submitted marketplace evidence showing consumer exposure to non-fortified wine and vermouth offered under the same mark:

- Gallo Family Vineyards uses the GALLO mark on various wines such as Chardonnay, Cabernet, Pinot Grigio, White Zinfandel, Moscato, Sauvignon Blanc, as well as on vermouth;³⁸
- Martini & Rossi offers under the MARTINI mark both sparkling wines and vermouth;³⁹
- Ransom Wine Co & Distillery offers under the RANSOM mark wines such as Pinot Noir, Riesling and Cabernet Franc, along with sweet and dry vermouth;⁴⁰
- Under the COCCHI mark, Giulio Cocchi's website mentions sparkling wines and vermouth;⁴¹
- The Alcohol Professor online article on California vermouths notes that "Under this [MASSICAN] brand," in addition to "Massican white wine," "niche

³⁸ March 1, 2022 Office Action at TSDR 28, 36-41.

³⁹ *Id.* at TSDR 45-57.

⁴⁰ *Id.* at TSDR 58-63.

⁴¹ January 22, 2024 Office Action at TSDR 37.

vermouth” is offered, including MASSICAN 2018 Dry White Vermouth and MASSICAN 2018 Sweet Red Vermouth;⁴²

- The same article points to Rita’s TOULOUSE Vermouth, which is promoted as “Made from Toulouse Estate wine;”⁴³
- The record also contains screenshots from the Toulouse Vineyards & Winery displaying the mark TOULOUSE on wines such as Petite Sirah, Pinot Noir, and also promoting RITA’S TOULOUSE Vermouth;⁴⁴
- The Alcohol Professor article also discusses “Sonoma County label, Scribe [] known for site-specific wines made using very little intervention,” including “two seasonal vermouths;”⁴⁵
- The record shows the Scribe Winery’s website offering its SCRIBE Summer Vermouth as well as SCRIBE Chardonnay, SCRIBE Pinot Noir, and SCRIBE Cabernet Sauvignon, corroborating the Alcohol Professor article’s discussion of SCRIBE;⁴⁶ and
- The MATTHIASSEN mark is used on vermouth and various wines such as Syrah, Cabernet Sauvignon, Chardonnay and Zinfandel.⁴⁷

⁴² January 22, 2024 Office Action at TSDR 42.

⁴³ *Id.*

⁴⁴ January 22, 2024 Office Action at TSDR 47.

⁴⁵ *Id.*

⁴⁶ January 22, 2024 Office Action at TSDR 45-46.

⁴⁷ January 22, 2024 Office Action at TSDR 43-44.

Thus, even if Applicant's assertion that vermouth is not a type of wine were accepted, the record shows that vermouth and wine are related. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (crediting relatedness evidence that third parties use the same mark for the goods at issue, because "[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both"); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (stating that evidence that "a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis"). As to Applicant's argument that its goods are high-end, no such restriction appears in the identification of "vermouth" and the record does not indicate that these goods are inherently high-end. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods").

B. Trade Channels, Classes of Consumers and Degree of Care in Purchasing

Turning to the trade channels for the goods under the third *DuPont* factor, because the goods in the cited registration are legally identical to Applicant's goods, we presume that they travel through all of the same channels of trade to all of the same classes of purchasers. *Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, Opp. No. 91190361, 2011 TTAB LEXIS 260, *14 (TTAB 2011) (where the services were legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same"); *see also In re Viterra, Inc.*, 671 F.3d

1358, 1362 (Fed. Cir. 2012) (where goods were identical, Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 754 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

Even if vermouth and wine were not considered legally identical, the marketplace evidence discussed above shows that non-fortified wine and vermouth are sold together on the same retail websites and from the same wineries and vineyards. This also shows that the goods travel in at least some of the same trade channels, reaching at least some of the same consumers.

As mentioned above, Applicant makes an unsupported argument that the relevant consumers “are generally quite sophisticated.”⁴⁸ *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence.”). Degree of purchaser care may be considered under the fourth *DuPont* factor. The record shows that wine and vermouth appear to be sold to ordinary consumers of legal drinking age through online retailers and at bars and restaurants. The evidence does not suggest any heightened degree of care in purchasing the relevant goods.

C. “Trademark Significance” of the Cited Mark

Before we turn to the comparison of the marks, we briefly address Applicant’s argument that PETRONI “is primarily merely a surname and therefore has little

⁴⁸ 14 TTABVue 18 (Applicant’s Supplemental Brief); May 8, 2023 Response to Office Action at TSDR 16.

trademark significance.”⁴⁹ Despite Applicant’s crafty insistence that it “is not attacking the validity of the Cited Mark,”⁵⁰ Applicant’s argument indeed constitutes an improper collateral attack on the registration. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1408 (Fed. Cir. 1997). As the Examining Attorney correctly points out, the registration on the Principal Register entitles Registrant to the accompanying legal presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), including as to the validity and distinctiveness of the cited mark.

Also, in addition to the improper ex parte forum for a challenge to the cited mark’s distinctiveness, the cited registration issued over five years ago, and the USPTO acknowledged Registrant’s Section 15 affidavit of incontestability. Thus, PETRONI is no longer subject to challenge on the basis that, as Applicant asserts, it is primarily merely a surname. Rather, PETRONI in the cited registration for wine primarily serves as a source-indicator, not a mere surname.

The cited registration includes a claim of acquired distinctiveness, which equates to a concession that PETRONI was not inherently distinctive at the time of registration, presumably because of the surname significance of PETRONI.⁵¹ We accord the cited mark the conceptual strength associated with its acquired distinctiveness, rather than at the level of an inherently distinctive mark. Applicant

⁴⁹ 14 TTABVUE 12 (Applicant’s Supplemental Brief).

⁵⁰ 14 TTABVUE 17 (Applicant’s Supplemental Brief); 17 TTABVUE 3 (Applicant’s Reply Brief).


⁵¹ Applicant submitted evidence that PETRONI has surname significance in the U.S., such as Census data, and Internet evidence from Ancestry.com, Namespedia, and Whitepages.com. 14 TTABVUE 13-14; June 21, 2022 Request for Reconsideration at TSDR 18-44.

points to no third-party uses or registrations in the relevant field (or otherwise) that include PETRONI. Thus, there is nothing in that regard to narrow the cited marks' scope of protection. On this record, Applicant's argument that the cited mark should receive "the narrowest possible scope of trademark protection" is a substantial overstatement. We reject the argument. Instead, the proper scope of protection is that of a registered mark that has acquired distinctiveness.

D. Similarity of the Marks

Turning to the first *DuPont* factor regarding similarity of the marks, we next



compare Applicant's mark, , to the cited mark, PETRONI, "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005) (quoting *DuPont*, 476 F.2d at 1361). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, Serial No. 87075988, 2018 TTAB LEXIS 170, *13 (TTAB 2018), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012). When the goods are legally

identical, as they are here, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Est. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir.1992).

We remain mindful that Registrant may display its PETRONI standard-character mark in any lettering style, including that in which Applicant displays the term PETRONI encompassed in its mark. *See Viterra*, 671 F.3d at 1363-64. Both the mark in the Application and the cited mark contain the identical term PETRONI. Applicant’s mark includes the additional wording ST and VERMUTERÍA DE GALICIA, as well as a design element.

The shared element PETRONI dominates Applicant’s mark and forms the entirety of the cited mark. Applicant’s mark as a whole looks and sounds similar to the cited mark, and gives a similar commercial impression. A consumer likely would view Applicant’s mark as a related variation of the mark in the cited registration. While Applicant’s mark comprises both words and a design, “the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371 (Fed. Cir. 2015), *citing CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983). If a mark comprises both wording and a design, greater weight is often given to the wording, because it is the wording that purchasers would use to refer to or request the goods or services. *See, e.g., Viterra*, 671 F.3d at 1366.

The design in Applicant's mark serves as background for the more prominent element PETRONI, which appears superimposed over the design in very large bold font in the center of the mark. *See Aquitaine Wine USA, LLC*, 2018 TTAB LEXIS 108, at *7 (in assessing a composite mark with a large design element, Board found that "because of the position, size and bolding of the term LAROQUE," it dominates the mark). The design includes a hand that appears to be finishing writing ST above PETRONI, giving the impression that ST is an element being written last, and perhaps added later. Applicant argues that ST, in this context, would be understood as "the shortened form of the term 'Saint,'" and therefore makes clear that "PETRONI' is meant to be the name of a saint – not just an ordinary word to be focused on by itself."⁵² Even accepting this view of ST, without the usual period to abbreviate "saint," ST PETRONI is not significantly different from PETRONI alone. As Applicant acknowledges, "St." precedes a name, and as noted above, in Applicant's mark, a hand appears to be in the process of writing ST, adding this title to the name PETRONI that already appears below. Consumers familiar with Registrant's PETRONI mark likely would view this as a variation creating the impression that the PETRONI named in Registrant's mark has been literally or figuratively canonized.

Furthermore, the Spanish words VERMUTERÍA DE GALICIA appear at the bottom of Applicant's mark in a font so small as to minimize their visual impact on the mark as a whole. The translation evidence discussed above convinces us that this

⁵² 14 TTABVUE 8 (Applicant's Supplemental Brief).

wording means “vermouth maker from Galicia.” We find that consumers, therefore, would not focus on this wording in the mark for source-indication. *See Aquitaine Wine USA, LLC*, 2018 TTAB LEXIS 108, at *7-8 (finding that “a geographically descriptive term ... in significantly smaller lettering” within the composite mark “is entitled to less weight in the likelihood of confusion determination”); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (“Geographically descriptive terms are generally regarded as inherently weak and entitled to less protection than arbitrary or suggestive marks.”); *see also In re Chatam Int’l Inc.*, 380 F.3d 1340, 1343 (Fed. Cir. 2004) (“Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under *DuPont*.”). We remain mindful that “[a]lthough the [Board] may place more weight on a dominant portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, the ultimate conclusion nonetheless must rest on consideration of the marks in total.” *Viterra*, 671 F.3d at 1362 (citations omitted).

Overall, the marks are similar, particularly as “marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014) (cleaned up).

E. Conclusion

Where the goods are legally identical, as they are here, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *Bridgestone Ams. Tire Ops., LLC v. Fed. Corp.*, 673 F.3d 1330, 1337 (Fed. Cir. 2012). In this case, even accounting for some degree of conceptual weakness

of the cited mark PETRONI as a surname, the similarity of the marks for legally identical and otherwise overlapping goods that move in at least some of the same channels of trade to at least some of the same classes of customers renders confusion likely. 15 U.S.C. § 1052(d). We affirm the refusal to register Applicant's mark under Section 2(d).

Decision: We affirm the refusal to register Applicant's mark, both for failing to submit the required translation, and for likelihood of confusion with the cited mark. We therefore need not reach the disclaimer requirement.