

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
July 29, 2014

Mailed:  
August 22, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Real Sitio de Ventosilla, S.A.*

*v.*

*Pagos del Rey, S.L.*

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Opposition No. 91201741  
—

Christopher Kelly and Jennifer L. Elgin of Wiley Rein LLP and Christopher S. Adkins of Wenderoth, Lind & Ponack, L.L.P. for Real Sitio de Ventosilla, S.A.

Lawrence E. Abelman, Julianne Abelman, and Erica R. Halstead of Abelman Frayne & Schwab<sup>1</sup> for Pagos del Rey, S.L.

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Before Mermelstein, Kuczma and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Pagos del Rey, S.L. (“Applicant”) filed an application to register the mark PAGOS DEL REY in standard characters for “wine,” in International Class 33.<sup>2</sup>

Real Sitio de Ventosilla, S.A. (“Opposer”) opposed registration of the mark on the ground that the mark, as used in connection with the identified goods, so

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<sup>1</sup> Julie B. Seyler of Abelman Frayne & Schwab appeared for Pagos del Rey, S.L. at oral hearing.

<sup>2</sup> Application Serial No. 85233020, filed on February 3, 2011 under Trademark Act § 1(a), 15 U.S.C. § 1051(a), stating February 2003 as the date of first use and January 2006 as the date of first use in commerce.

resembles Opposer's earlier used and registered mark PradoRey as to be likely to cause confusion, mistake or deception, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer pleaded ownership of Registration No. 2294782 for the mark PradoRey in the stylized form shown below for "wine," in International Class 33.<sup>3</sup>

## PradoRey

Applicant, in its answer, admitted that Opposer owns Reg. No. 2294782<sup>4</sup> but otherwise denied the salient allegations of the notice of opposition. Applicant stated "affirmative defenses," but they are mere amplifications of its denial that there is a likelihood of confusion. The case has been fully briefed. A hearing was held on July 29, 2014.

### **I. The record.**

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application file for the opposed mark. The parties agreed to allow testimony to be submitted by declaration or affidavit.<sup>5</sup> Opposer's pleaded registration was made of record by means of the testimonial declaration of

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<sup>3</sup> Reg. No. 2294782 issued November 23, 1999; Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

<sup>4</sup> Answer ¶ 4.

<sup>5</sup> Joint Stipulation filed February 19, 2013, TTABVue # 15.

one of Opposer's witnesses, who confirmed its status and Opposer's ownership thereof.<sup>6</sup> The record also includes the following testimony and evidence:

**A. Opposer's evidence.**

1. Declaration of Fernando Rodriguez de Rivera Cremades, Opposer's Managing Director. TTABvue # 20 (redacted) and # 21 (unredacted, confidential).
2. Declaration of Iker Fernandez, President of 3 Castillos, Inc., Opposer's exclusive marketing agent in the United States. TTABvue # 18.
3. Rebuttal declaration of Iker Fernandez. TTABvue # 31.
4. Notice of reliance on the following evidence:
  - Applicant's amended responses to certain interrogatories of Opposer. TTABvue # 17.
  - Excerpts of publications of general circulation. TTABvue # 19.

**B. Applicant's evidence.**

1. Declaration of Felix Solis Ramos, Export and Marketing Manager of Felix Solis Avantis, Applicant's parent organization. TTABvue # 23.
2. Declaration of Gene J. Schaeffer, Vice President of Luneau USA Inc., d/b/a Nicolas Wines, Applicant's U.S. importer. TTABvue # 24.
3. Declaration of Felix Solis Yañez, President and CEO of Felix Solis Avantis. TTABvue ## 30 and 22.
4. Notices of reliance on the following evidence:
  - Third-party trademark registrations. TTABvue # 25.

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<sup>6</sup> Declaration of Fernando Rodriguez de Rivera Cremades ¶ 8 and Exhibit C. TTABvue # 20. Applicant's objection to the admission of Opposer's pleaded registration, on the ground that it was not properly made of record by submission of a status and title copy of the registration prepared by the U.S. Patent and Trademark Office (Applicant's brief at 10) was discussed at oral hearing and withdrawn by Applicant. In any event, we find that the registration was properly introduced. 37 C.F.R. 2.122(d)(2) ("A registration owned by a party... may be made of record ... by that party by appropriate identification and introduction during the taking of testimony....").

- Opposer's responses to certain interrogatories and one request for admission. TTABvue # 26.
- Excerpts of publications of general circulation. TTABvue # 27.
- Entries from a Spanish/English dictionary. TTABvue # 28.
- Information from the USPTO's TSDR database relating to the subject application.<sup>7</sup> TTABvue # 28.
- Internet web pages containing census information. TTABvue # 29.

## **II. Standing.**

Opposer has properly made of record its pleaded registration and has presented testimony regarding its use of the trademark PradoRey in connection with wine.<sup>8</sup> Opposer has thus shown that it is not a mere intermeddler and has established its standing to oppose registration of Applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

## **III. Opposer's claim under Section 2(d).**

Opposer brings its opposition under Trademark Act § 2(d) on the ground of priority and likelihood of confusion. In view of Opposer's ownership of a valid and subsisting registration of its pleaded mark, priority is not in issue with respect to

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<sup>7</sup> It was unnecessary to submit such information, as the record of the opposed application is automatically of record. Trademark Rule 2.122, 37 C.F.R. § 2.122.

<sup>8</sup> Cremades dec. ¶ 5; Fernandez dec. ¶ 5. Opposer's testimony refers consistently to the mark in the two-word form PRADO REY. However, the record contains no depiction of Opposer's mark on the goods, and the only depiction of the mark, as actually used, is on a printed marketing piece which displays the mark in the stylized one-word form in which the mark is registered. (*See* Fernandez dec., Exhibit A ("Fine Wines from Spain.")) For this reason, we have depicted the mark as PradoRey in this opinion.

the mark and the goods identified in the registration. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion is based on an analysis of all probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

**A. The parties' goods.**

Turning first to the similarity or dissimilarity of the goods at issue, we find that the parties' goods are identical, as the application and registration are both for "wine." This *du Pont* factor favors a finding of likelihood of confusion.

**B. Channels of trade.**

We next consider the channels of trade. Because the parties' goods are identical, we must presume that the parties' goods move through the same channels of trade. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). As there are no limitations as to channels of trade in the identifications of goods in the registration and application, we presume that the parties' goods move in all channels of trade that are normal for such goods. *See Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *In re Linkvest S.A.*, 24 USPQ2d 1716,

1716 (TTAB 1992). The parties' testimony shows that such channels include local and regional importers and distributors; wholesalers; retailers such as liquor stores, specialty wine stores, and those grocery stores and general retail stores that sell wines; and restaurants.<sup>9</sup> As the parties actually share, or are presumed to share, these channels, the *du Pont* factor of trade channels weighs in favor of a finding of likelihood of confusion.

**C. Conditions of sale; Customers.**

We next consider "the conditions under which and the buyers to whom sales are made." *du Pont* at 567. Because the parties' goods are identical, we must presume that the classes of customers at issue are the same. *See In re Viterro Inc.*, 101 USPQ2d at 1908. Moreover, because wine is a consumer item, the customers would include any adult member of the general public who drinks wine or purchases it for others. As to the conditions under which such customers encounter the goods, Applicant argues as follows:

Consumers looking to purchase wine are, more often than not, presented with walls and/or rows of wines when entering a retail establishment. Because of this, purchasers are forced to choose a wine off the shelf in order to read the label to find out exactly what they have the option of purchasing. Wine labels generally contain identifying information such as where the wine is made, by whom the wine is made, and the type of wine. Thus, sales conditions of wines actually enable consumers to differentiate between the many varieties, thus lessening the chances for confusion to occur.<sup>10</sup>

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<sup>9</sup> Fernandez dec. ¶¶ 6, 7; Schaeffer dec. ¶ 6.

<sup>10</sup> Applicant's brief at 23-24.

Applicant's importer testified that "I do not believe that wine is an impulse purchase."<sup>11</sup>

In its reply brief, Opposer responds that "consumers are unlikely to rely on descriptive or informational matter on product labels in an effort to distinguish the source of the products,"<sup>12</sup> citing *Somerset Distilling Inc. v. Speymalt Whiskey Distribs. Ltd.*, 14 USPQ2d 1539 (TTAB 1989) and *Monarch Wine Co., Inc. v. Hood River Distillers, Inc.*, 196 USPQ 855 (TTAB 1977). Opposer argues that wines are sold not only in retail stores, but also in restaurants and bars where conditions may be "chaotic," and where customers may not be able to inspect the bottle at the time of selection,<sup>13</sup> citing *Guinness United Distillers & Vintners B.V. v. Anheuser-Busch, Inc.*, 64 USPQ2d 1039, 1044 (S.D.N.Y. 2002). Opposer's U.S. marketing agent testified, "In my experience, wine, particularly wine sold at a lower price point, frequently is purchased at retail either on impulse or at least without a great level of care;"<sup>14</sup> and "a reasonable number of PRADO REY and PAGOS DEL REY wines are purchased by consumers on impulse or without a great deal of care."<sup>15</sup> Inasmuch as the application and the pleaded registration identify the goods as "wine," without reference to price range, we must consider the goods to include wines of all prices within a normal range of prices for wine. That range includes

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<sup>11</sup> Schaeffer dec. ¶ 15.

<sup>12</sup> Opposer's reply brief at 8.

<sup>13</sup> *Id.*

<sup>14</sup> Fernandez rebuttal dec. ¶ 7.

<sup>15</sup> *Id.* ¶ 9.

quite inexpensive wines. The record confirms that some wines sell for as little as \$10 per bottle.<sup>16</sup>

Overall, we find Opposer's characterization of the conditions of sale to be more persuasive than that of Applicant. There is nothing particularly unusual about the shelf presentation of wines in a retail store that would "force" customers to give particularly close inspection to a wine label. We think it is highly likely that inexpensive wines would be selected without an elevated degree of care, and perhaps on impulse. We are also not persuaded by the argument that "identifying information" (other than the trademarks) on the parties' wine labels would render confusion unlikely. There is no evidence of record as to the nature of such information. In any event, we must determine the likelihood of confusion on the basis of the marks, not on the basis of additional matter on the label that might provide other information as to the source of the goods. Opposer's point regarding the conditions of sale in bars and restaurants, where a bottle might not be available for inspection, is a relevant one for purposes of our analysis. Under those circumstances, purchasers who are unable to visually examine the marks will not notice any differences in their appearance. In sum, we find that the *du Pont* factor of the conditions of sale and the buyers to whom sales are made favors a finding of likelihood of confusion.

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<sup>16</sup> See Fernandez dec. ¶ 15; and Applicant's amended response to Interrogatory # 17. The parties submitted evidence showing that they both sell relatively inexpensive wines. To be clear, we are concerned with the conditions of sale attendant to wines in general, and not just the specific wines the parties actually sell. Nonetheless, information about the parties' actual goods is relevant to the extent that it provides information regarding possible price ranges.

**D. The marks at issue.**

We next consider the similarity or dissimilarity of the marks at issue in terms of appearance, sound, meaning, and overall commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). We base our determination on a consideration of the marks in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In comparing the marks, we are mindful that “[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Opposer emphasizes the visual similarities between the marks PradoRey and PAGOS DEL REY. It is apparent that both marks begin with the letter P and end with the syllable –REY, and that both include the letters P-A-O-D-R-E-Y in that order. Opposer also argues that PA and PRA are similar in pronunciation and that DEL REY and –DOREY are also similar in pronunciation.<sup>17</sup>

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<sup>17</sup> Opposer’s brief at 5.

Applicant, in response, argues that the dissimilarities between the marks are such as to be dispositive of this case;<sup>18</sup> and that it would be improper dissection of the marks to ignore those letters that the marks do *not* have in common, resulting in a failure to consider the marks in their entirety.<sup>19</sup> While we must consider the marks in their entirety, it is appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, “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. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 224 USPQ at 751.

Both parties address in detail the meanings or connotations of the two marks. The evidence shows that Opposer’s mark is a composite of the two Spanish words “prado” and “rey,” which mean “meadow” and “king,” respectively. The three Spanish words that compose Applicant’s mark are best translated, in the context of Applicant’s goods, to mean “the king’s estates” or “the king’s vineyards.”<sup>20</sup> Applicant’s president testified:

PAGOS can be translated as “Estate” that can be either a Estate of Vineyards or Olive trees. REY is translated as “King.” When taken as a whole, the mark PAGOS DEL REY means “King’s Wine Estates”....<sup>21</sup>

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<sup>18</sup> Applicant’s brief at 13.

<sup>19</sup> *Id.* at 14.

<sup>20</sup> See definition of “pago” from <spanishdict.com>, Applicant’s notice of reliance, TTABVue # 28: “Lot of land; especially of vineyards.” See also Applicant’s brief at 16.

<sup>21</sup> Yañez dec. ¶ 32.

Although Applicant indicated in its application that the mark means “the king’s payments,” we find the testimony of Applicant’s president more persuasive.

Applicant argues, on the basis of census data found online, that in 2011 there were 52 million people of Hispanic descent in the United States plus 3.7 million residents of Puerto Rico, who would recognize the different meanings of the two marks.<sup>22</sup> We accept, for purposes of our analysis, that many millions of persons in the U.S. marketplace understand the Spanish language and would be capable of interpreting the marks in light of that understanding. Opposer argues that, in Spanish, the two marks have similar meanings, as “king’s meadow” and “king’s lands” both describe “property owned by a king.”<sup>23</sup>

Even if we accept Applicant’s contention that those who speak or understand Spanish would derive distinctly different meanings from the two marks, that is not the correct focus of our analysis. A consideration of the English translation of foreign wording can effectively reveal that some customers – those who understand the foreign language – would likely experience confusion, if the translated meanings are similar. The same consideration can dispel concerns about confusion with respect to such knowledgeable customers, if the translated meanings are clearly different. However, such an analysis cannot effectively dispel concerns about confusion with respect to those customers who are unfamiliar with the foreign language at issue. The fact that some persons in the market *would not* be confused by the marks is not dispositive if another substantial number of relevant customers

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<sup>22</sup> Applicant’s brief at 16.

<sup>23</sup> Opposer’s brief at 7.

would be confused. *See Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009).

In *Brown Shoe*, the Board compared the marks PALOMA and PALOMITA, stating:

Here, where both marks are Spanish words we must consider the connotation of the marks to both non-Spanish-speaking consumers and to Spanish-speaking consumers.

In English the words have no meaning ... Thus, a substantial portion of the purchasing public would not understand the possible differences in meaning asserted by applicant. Therefore, even if we were to accept the translation applicant proposes, this is not sufficient to distinguish the marks with respect to non-Spanish speakers.

90 USPQ2d at 1756.

In the case before us, we take into consideration, as we must, the meaning and commercial impression of each mark. Although to customers who understand Spanish, the literal or suggestive meaning of the marks would be intelligible, many – and likely, most – relevant customers do not understand Spanish and will not understand the Spanish significance of the marks. For them, the marks may have no meaning and the visual and phonetic aspects of the marks, as well as the overall commercial impression created by the marks, will be the critical elements in forming their impression of the marks. Thus even assuming that Spanish-speaking consumers will distinguish the marks on the basis of their meanings, that distinction cannot be made by the substantial number of customers who do not understand Spanish.

In our assessment of the marks, we bear in mind that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but

rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Both marks are of sufficient complexity that customers who do not understand Spanish are very likely to retain an imperfect recollection of them.

The marks have substantial similarities in sound, resulting from the initial letter P of each mark, the assonance between the vowels of PRADO- and PAGOS, and the shared final syllable REY. Although the pronunciation of the marks, if viewed as combinations of Spanish words, is quite definite, we do not assume that the marks would have one correct pronunciation for customers that do not understand Spanish. Such customers would likely have difficulty determining how to pronounce both marks, thereby increasing the likelihood that they would be confused by the similarities between the marks. Although Opposer's mark is rendered as a single word, albeit with capitalization of the letters P and R which suggests two words, and Applicant's mark consists of three words, when the goods are called for orally this distinction disappears (although we acknowledge that

Applicant's mark would most likely be pronounced with four syllables as opposed to the three syllables of Opposer's mark). Visually, we find that the sharing of seven letters, in similar order, in marks that both begin with "P" and end with "REY" and would be perceived by many as having no meaning, would likely lead to inaccurate recollection. Overall, we find that the similarities between the marks in appearance and sound render confusion likely when the marks are used on identical goods. Accordingly, we find that the factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

**E. Similar marks of third parties.**

In accordance with *du Pont*, we consider any evidence of record regarding "the number and nature of similar marks in use on similar goods [and services]."

*Du Pont* at 567. Applicant's witness has testified as follows:

Throughout my professional years in the wine industry, I have come across a number of wines in the U.S. market that contain the term REY which translates into English as "KING." In my professional opinion, many parties use the term REY (King) because it signals to consumers that its wine is superior. Due to the common use of this term, prospective buyers are conditioned to distinguish between the different brands.<sup>24</sup>

This testimony is, because of its lack of specificity, of limited probative value. It does not mention any particular "REY" trademarks in actual use, or the volume and scope of use of such marks, and therefore we cannot compare them to Opposer's mark to determine whether they would have a diluting effect on its source-indicating strength. The conclusory statement that "buyers are conditioned" does

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<sup>24</sup> Schaeffer dec. ¶ 13.

not provide us with the evidence that would be necessary to draw this conclusion for ourselves.

Applicant has also submitted evidence of eight third-party registrations (and one pending application) for wine trademarks that include the element REY.<sup>25</sup> The marks are POSADA DEL REY, GRAN VEGA DEL REY, GAIA & REY, COPA DEL REY, PRIVILEGIO DEL REY SANCHO, VINA DEL REY, WESTREY, GOUNDREY, and SENDAS DEL REY. Applicant argues that “These marks currently co-exist on the Register for identical goods and evidence the weak nature of the term ‘REY.’ ... Due to the common use of the term REY for wines, consumers are conditioned to distinguish between these marks ‘on the basis of minute distinctions.’”<sup>26</sup> For purposes of demonstrating the weakness of a mark, third-party registrations are entitled to no weight, because they are not evidence that the marks are *in use*, and thus “provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion.” *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). Accordingly, this evidence does not demonstrate that the distinctiveness of the term REY has been weakened by widespread third-party use. For the same reason, Applicant’s argument that the fact that many wine sellers have sought and obtained registration of REY trademarks “is significant to show that ‘REY’ is a diluted term

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<sup>25</sup> Applicant’s notice of reliance, TTABvue # 25.

<sup>26</sup> Applicant’s brief at 18.

when used on wines, and cannot be considered a source-identifier”<sup>27</sup> is not well taken. The third-party registrations do not show that the term is “diluted” or incapable of being “a source-identifier.” We find the factor of similar marks in use on similar goods to be neutral.

**F. Absence of actual confusion.**

In response to interrogatories, Opposer admitted that it had no information relating to any instance of actual confusion between the parties’ marks, or relating to any perception of a connection between the parties’ goods or between Applicant’s goods and Opposer.<sup>28</sup> Applicant points out that it has been importing goods under its mark into the United States since 2003 without interruption;<sup>29</sup> and that its goods under the mark have been distributed throughout the entire United States.<sup>30</sup> A representative of Applicant’s importer stated that it imports 90,000 bottles of the goods into the United States annually (constituting 80% of the total imports of the brand into the United States).<sup>31</sup> Applicant points out that Opposer claims to have been present in the U.S. market during that entire period, and argues that “the absence of confusion is strong evidence that confusion is highly unlikely.”<sup>32</sup>

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<sup>27</sup> *Id.*

<sup>28</sup> Opposer’s responses to Interrogatories Nos. 17-19 and 27.

<sup>29</sup> Schaeffer dec. ¶ 5.

<sup>30</sup> *Id.* at 9.

<sup>31</sup> *Id.* at 7.

<sup>32</sup> Applicant’s brief at 21.

The evidence indicates that Opposer's goods have been present in the U.S. market since 1997.<sup>33</sup> However, at the time of trial Opposer's goods had been introduced into only 19 states.<sup>34</sup> Annual sales in the United States for the five years prior to trial were approximately \$200,000; and sales figures for 2003-2012 indicate that annual sales were often substantially less.<sup>35</sup> Notably, Applicant's importer stated, "I am not familiar with the PRADOREY brand of wine. I haven't seen this brand before; and I haven't found this brand as a regular listing in any of the national chains."<sup>36</sup>

In view of the relatively low volume of Opposer's sales and the limited geographic range of distribution of its goods, it is not clear that there has been a meaningful opportunity for confusion to occur. Under the circumstances, we find the lack of evidence of actual confusion to be a neutral factor in our analysis of likelihood of confusion. *Cf. Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

**G. Foreign co-existence.**

Applicant argues that the parties' marks have "peacefully co-existed" in Spain, Mexico, Japan, China, "and possibly the Russian Federation"; that

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<sup>33</sup> Cremades dec. ¶ 5.

<sup>34</sup> Fernandez dec. ¶ 13.

<sup>35</sup> Cremades dec. ¶ 6 and Exhibit B.

<sup>36</sup> Schaeffer dec. ¶ 14.

Applicant's mark is registered in those countries; and that Applicant successfully withstood an opposition proceeding brought against it by Opposer in Spain.<sup>37</sup>

The issue now before the Board depends upon perceptions of U.S. customers under market conditions prevailing in the United States. Accordingly, peaceful co-existence of the marks in foreign markets has no relevance to our inquiry. Similarly, nothing in the record demonstrates that standards for registration of marks in foreign countries are the same as those that we must apply under U.S. law.

We note also Applicant's president's testimony that in 2012, both parties' products were represented, "without incident or confusion," at the PROWEIN trade show in Germany, which "[is] directed towards the U.S. market."<sup>38</sup> We do not treat the experience of this one trade show as indicating that confusion is unlikely; we cannot conclude from this single event that there has been any meaningful length of time during which there has been concurrent use without evidence of actual confusion. Further, attendees of foreign trade shows would be knowledgeable commercial professionals. Such customers do not represent the much broader range of U.S. customers, including ordinary consumers, that we must consider in our analysis.

**H. Applicant's good faith adoption of its mark.**

Applicant argues that it "adopted its mark in good faith, and with no intent to trade on any alleged goodwill associated with Opposer, Opposer's Mark, and/or

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<sup>37</sup> *Yañez* dec. ¶¶ 18-19, 24.

<sup>38</sup> *Id.* ¶ 14.

Opposer's goods."<sup>39</sup> The record presents us with no reason to doubt this assertion. However, Applicant's good faith "does very little to obviate a finding of likelihood of confusion because it is expected that applicants are acting in good faith." *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1713 (TTAB 2010). *See also J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) ("Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion.") Accordingly, Applicant's good faith is a neutral factor in our analysis.

#### **IV. Conclusion.**

We have considered all of the evidence of record relevant to the *du Pont* factors and all arguments of the parties, including those not specifically discussed herein. In view of the similarities between the marks, and considering that the parties' goods are identical and would travel through the same channels to the same classes of customers, we find that Applicant's mark so resembles Opposer's mark as to be likely to give rise to confusion, mistake or deception as to the source of Applicant's goods.

**Decision:** The opposition is sustained.

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<sup>39</sup> Applicant's brief at 24.