

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

Hearing: November 19, 2015

February 16, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
Luigi Lavazza S.p.A.

v.

Favazza's, Inc.
—

Opposition No. 91210050
to Application Serial No. 85666504
—

Leo M. Loughlin of Rothwell Figg Ernst & Manbeck PC,
for Luigi Lavazza S.p.A.

Morris E. Turek of Yourtrademarkattorney.com,
for Favazza's, Inc.

Before Quinn, Goodman and Heasley,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Favazza's, Inc. ("Applicant") seeks registration on the Principal Register of the mark FAVAZZA'S (in standard characters) for "bar services; catering services; restaurant services" in International Class 43.¹

¹ Application Serial No. 85666504, filed July 2, 2012, based upon Applicant's allegation of first use and first use in commerce of December 1977 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

Luigi Lavazza S.p.A. (“Opposer”) has opposed registration of Applicant’s mark on the ground that Applicant’s mark, when used in connection with Applicant’s services, so resembles Opposer’s previously-used and registered mark LAVAZZA (typed drawing) for “a wide variety of goods and services including restaurant services, bars and catering services” as to be likely to cause confusion.² Opposer specifically claimed ownership of the registration LAVAZZA for “coffee shops, bars, restaurants, cafeterias, self-service restaurants, pubs, catering services” in International Class 42.³ By its answer, Applicant denied the salient allegations in the notice of opposition.

I. The Parties

A. Opposer

Opposer is an Italian coffee company that established its wholly-owned U.S. subsidiary in 1989.⁴ It sells traditional roasted whole bean coffee, ground coffee and single-serve capsule coffee to the “home market” consumer, single-serve all-capsule coffee to the “office coffee market,” and whole bean coffee, ground coffee, single serve coffee, and single serve coffee equipment to the “out of home” hospitality market which includes restaurants, cafés, cruise ships, casinos, and hotels.⁵ Opposer operates a limited franchise of Lavazza Expression cafés in Austin Texas, Chicago

² 1 TTABVUE 3.

³ Registration No. 2236996, in typed drawing form, Section 2(f); issued April 6, 1999; renewed. Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing.

Opposer submitted as an exhibit to the notice of opposition a copy of its pleaded registration from the USPTO TSDR database showing current status of and title.

⁴ 15 TTABVUE 6-7, 13.

⁵ *Id.* at 10-12, 16, 42.

and California, but for the most part, Opposer is not in the business of operating cafés.⁶

B. Applicant

Applicant owns a single location Italian restaurant in St. Louis, Missouri that has been in continuous operation since 1978.⁷ In addition to its restaurant services, Applicant provides catering, banquet and bar services.⁸ On average, Applicant serves 150,000 customers a year, including individuals who reside outside of the St. Louis metropolitan area.⁹

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application. In addition, Opposer introduced the trial testimony of Ennio Ranaboldo, CEO and Executive Vice President of Lavazza Premium Coffee Corp., the U.S. subsidiary of Opposer, and a notice of reliance on USPTO TSDR printouts of fifteen additional LAVAZZA and LAVAZZA-formative registrations owned by Opposer that were not pleaded in the notice of opposition.¹⁰ Applicant introduced the trial testimony of Vito A. Favazza, Jr., President and managing officer of Applicant.

⁶ *Id.* at 67, 87.

⁷ 17 TTABVUE 7-9.

⁸ *Id.* at 7.

⁹ *Id.* at 12-13.

¹⁰ 14 TTABVUE. Applicant did not object to the introduction of these registrations, and considers them part of the record. 22 TTABVUE 6 n.1. We consider the unpleaded registrations to have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b) and deem the notice of opposition amended to assert the registrations. As indicated *infra*, our focus will be on Registration No. 2236996; therefore, we need not provide the details of these other registrations. We do note that with the exception of one LAVAZZA-formative

The parties filed briefs, and each party was represented by counsel at an oral hearing held before this panel.

III. Evidentiary Matters

A. Motion to Strike

Opposer has raised objections to the testimony of Applicant's witness, Mr. Favazza, and seeks to strike the testimony on the basis of relevance.

The Board is "capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations," precluding the need to strike the testimony. *Inter Ikea Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1737 (TTAB 2014). Accordingly, we decline to strike Applicant's testimony on this basis; rather, we will consider it and give it whatever probative value it merits.

IV. Standing

Opposer has properly made its pleaded registration of record by attaching a copy of it obtained from the USPTO TSDR database to the notice of opposition, and by making the fifteen other registrations of record by way of notice of reliance and by testimony. Trademark Rule 2.122(d)(1)-(2), 37 C.F.R. §§ 2.122(d)(1)-(2). In view thereof, we find Opposer has established its personal interest in this proceeding and proven its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lincoln Nat'l Corp. v. Anderson*, 110 USPQ2d 1271, 1274 (TTAB 2014). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d

mark for restaurant services, the majority of these registrations are for coffee, and/or coffee blends and coffee extracts, and related equipment such as percolators.

1024, 213 USPQ 185, 189 (CCPA 1982). Applicant has not contested Opposer's standing.

V. Priority

Because Opposer has made its sixteen registrations of record and shown they are valid and subsisting, priority is not an issue in this case as to the LAVAZZA and LAVAZZA-formative marks for the goods and services recited in those registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, in its brief on the case, Applicant concedes "as a matter of law" Opposer's priority based on those registrations.¹¹

VI. Likelihood of Confusion

We now turn to the merits of the notice of opposition. Our determination under Trademark Act Section 2(d), 15 U.S.C. § 1052, is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. We focus on Opposer's Registration No. 2236996 for the typed mark LAVAZZA for "coffee shops, bars, restaurants, cafeterias, self-service restaurants, pubs, catering services" because if we do not find a likelihood of confusion with that mark and the associated services, then there would be no likelihood of confusion with the marks in the other pleaded registrations. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

¹¹ 22 TTABVUE 7.

We note Applicant's argument in its brief that because LAVAZZA is a “family name,” and registered under Section 2(f), it is “not entitled to the broad scope of protection reserved for arbitrary and fanciful marks.”¹² However, the fact that LAVAZZA may be a surname does not mean that Opposer’s LAVAZZA mark is automatically weak or otherwise entitled to a narrower scope of protection. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1639 n.20 (TTAB 2007). It is well settled that “Section 2(d) ... does not set forth special rules regarding the registration of marks involving surnames in determining the issue of likelihood of confusion.” *Hunt Foods & Indus., Inc. v. Gerson Stewart Corp.*, 367 F.2d 431, 151 USPQ 350, 352 (CCPA 1966). While surnames *per se*, because of their proliferation of use, are generally considered to fall within the designation of “weak” marks, nevertheless, it is recognized that such names can, through extensive use and exposure over a period of years, acquire distinctiveness and serve as a strong indication of origin for the goods or services of a particular producer. *G. H. Tennant Company v. Wyandotte Chemicals Corporation*, 154 USPQ 453, 455 (TTAB 1967).

As noted by Applicant, Registration No. 2236996 for the mark LAVAZZA is registered on the Principal Register under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). Having acquired distinctiveness, the mark LAVAZZA is entitled to the same trademark protection as any other validly registered trademark under Trademark Act Section 7(b), 15 U.S.C. § 1057(b), including the right to preclude the registration by others of marks comprising not only the identical designation but any similar designation that may be used on

¹² 22 TTABVUE 9.

identical or related goods or services if confusion is likely to occur. *See E. I. du Pont de Nemours & Co. v. Societe S.T. Dupont*, 161 USPQ 489, 491 (TTAB 1969) (surname that has acquired distinctiveness afforded same protection as if it were arbitrary, technical mark).

We now turn to consideration of the relevant *du Pont* factors in the proceeding now before us.

A. The Services, Channels of Trade, Purchasers and Conditions of Sale

We begin by considering the second, third, and fourth *du Pont* factors, similarity or dissimilarity of the parties' services, channels of trade, purchasers, and the conditions of sale. *In re E. I. du Pont*, 177 USPQ at 567. Applicant, in its brief on the case, "is willing to concede" the following:¹³

- 1) "[t]he services recited in Opposer's Registration No. 2,236,996 are legally identical to the services recited in Applicant's Application Serial No. 85666504";
- 2) "[t]he restaurant, bar and catering services of Applicant and Opposer could theoretically be rendered in the same channels of trade";
- 3) "[t]he restaurant, bar, and catering services of Applicant and Opposer could theoretically be provided to, and purchased by, the same class of consumers";
- 4) "[t]he restaurant, bar, and catering services of Applicant and Opposer could theoretically be advertised through the same media channels"; and
- 5) "[a]t least some of the purchasers of the restaurant, bar, and catering services offered by Applicant and Opposer are of ordinary sophistication and would exercise ordinary care in selecting and purchasing such services."

Based on these concessions, we find that Applicant's recited services are identical to Opposer's services, rendered in the same channels of trade and provided to the same class of purchasers, and the purchasers of the services are ordinary consumers

¹³ *Id.* at 9.

who would exercise nothing more than ordinary care in their purchasing decision. These factors weigh heavily in favor of a finding of likelihood of confusion.

B. Similarity of the Marks

As to the first *du Pont* factor, “similarity or dissimilarity of the marks,” we analyze “the marks in their entirety as to appearance, sound, connotation and commercial impression.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) quoting *In re E.I. du Pont*, 177 USPQ at 567. See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *In re E.I. du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys.*, 110 USPQ2d at 1740; *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

With regard to the similarities of the marks, Applicant “concedes that the only differences in appearance and sound between the Parties’ marks are (1) they begin with different letters, and (2) Applicant’s mark incorporates an ‘apostrophe S’ at the end.”¹⁴ However, Applicant argues in its brief that

¹⁴ *Id.* at 10.

[B]ased on how individuals generally perceive surnames in our society ... likelihood of consumer confusion between the two marks is remote at best ... it is indisputable that consumers would recognize the parties' marks as Italian surnames and nothing else. ... [I]n light of the differences between the marks and the fact that both are primarily merely Italian surnames which are easily distinguishable from one another [by the minor differences in leading letters] and possess no other readily apparent meaning or connotation, this *du Pont* factor clearly favors Applicant.¹⁵

As Applicant acknowledges, as to appearance and sound, both marks contain the six letters AVAZZA, differing only by the first letter in each mark and by the concluding apostrophe and "S" in Applicant's mark that may be viewed as the possessive form of FAVAZZA.¹⁶ The parties' marks are visually similar because they both contain AVAZZA and there is little, if any, trademark significance in the addition of the apostrophe and letter "S" in Applicant's mark. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) ("The absence of the possessive form in applicant's mark BINION has little, if any, significance for consumers in distinguishing it from the cited mark.") (internal citations omitted). The difference in the leading letters "L" and "F" in each party's mark does little to distinguish the marks, and is outweighed by the shared element AVAZZA. As to similarity of sound, it is reasonable to conclude that the marks may be pronounced similarly because they share a similar structure and could well be accorded a similar sound and cadence. Thus, when the marks are compared in their entireties, they are strikingly similar in appearance and sound, and the differences are not sufficient to distinguish the marks visually or phonetically. *See Krim-Ko Corp. v. Coca-Cola*

¹⁵ *Id* at 11.

¹⁶*Id.*

Bottling Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (BEEP and VEEP phonetically similar and visually similar); *American Cyanamid Co. v. United States Rubber Co.*, 356 F.2d 1008, 148 USPQ 729, 730 (CCPA 1966) (CYGON and PHYGON phonetically similar in sound and similar in spelling); *Apple Computer v. TVnet.net Inc.*, 90 USPQ2d 1393, 1396 (TTAB 2007) (letter “v” is insufficient to distinguish the dominant portions of the parties’ ITUNES and VTUNES marks). Most consumers are not likely to note or long remember any differences between the parties’ marks. *See Interlego AG v. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862, 1863 (TTAB 2002) (many adults and children would not notice the very minor difference between LEGO and MEGO).

As for connotation, it is not clear whether consumers would ascribe any meaning to the marks, but rather would see both marks either as invented foreign words or as surnames.¹⁷ We find it highly unlikely that consumers would view one mark as a surname and the other as an invented foreign word. Thus, regardless of whether consumers would view the marks as invented foreign words or surnames, the connotation is the same.

As a result of the similarities between the marks, both marks convey similar overall commercial impressions. We therefore find that the marks are highly similar in sound, appearance, connotation, and commercial impression.

¹⁷ Mr. Favazza testified that Favazza is his family name and that he founded the restaurant in 1978 with his parents and named it “Favazza’s” because it is “our family name.” 17 TTABVUE 6-7, 9. Mr. Ranaboldo testified that Opposer was founded by Luigi Lavazza who “started off with a small grocery store in Torino, [Italy].” 15 TTABVUE 11-12. He further testified that “[Lavazza] is a family name. Luigi Lavazza S.P.A., the founder, was named Lavazza. ...” *Id.* at 85.

C. Fame and Scope of Protection

Inasmuch as Opposer has argued in its brief that its LAVAZZA mark is famous,¹⁸ we direct our attention to the fifth *du Pont* factor, “fame of the prior mark.” *In re E. I. du Pont*, 177 USPQ at 567.

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). In the absence of direct evidence of fame, “[t]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). In addition, some context in which to place raw statistics may be necessary. *Id.* at 1309. Further, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, “the party asserting that its mark is famous has the burden to prove it.” *See Coach Servs.*, 101 USPQ2d at 1720 (citing *Leading Jewelers Guild, Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Mr. Ranaboldo testified that ten to fifteen years prior to establishing its U.S. subsidiary in 1989, Opposer sold its coffee sporadically through distributors.¹⁹ With respect to its products and services, in 2014, Opposer spent “[a]nywhere between

¹⁸ 19 TTABVUE 20.

¹⁹ 15 TTABVUE 13, 96.

five and ten million” on advertising in the United States.²⁰ Opposer had net sales in the United States of \$69 million in 2013 and \$75 million in 2014.²¹ However, Mr. Ranaboldo testified that he did not have information as to the percentage of advertising directed to LAVAZZA-branded cafés versus LAVAZZA-branded products nor could he provide a breakdown of sales for LAVAZZA-branded cafés by distribution channels.²² Mr. Ranaboldo testified generally regarding a confidential 2014 United States brand awareness study as to the “coffee category” and “specialty coffee sub segment,” stating that “[w]e are in the same bracket of some famous brands. ...”²³ Notably, this study is limited to coffee, and does not pertain to restaurants.

We find that Opposer’s evidence falls short of clearly proving fame. *Coach Servs.*, 101 USPQ2d at 1720. For example, we have no context for Opposer's advertising and sales figures such as how the figures for Opposer’s goods and services compare with that of other brands of like goods or services, and what portion of these figures are attributed to coffee versus restaurants. *Bose Corp.*, 63 USPQ2d at 1309. We also have relatively little specific evidence about Opposer's use of the various LAVAZZA and LAVAZZA-formative marks in the United States; there is no specific testimony as to how long these particular marks have been used, or the sales made under each of the marks, or advertising expenditures for each of these particular marks. Opposer and its sole witness have in general referred to

²⁰ *Id.* at 73.

²¹ *Id.* at 72, 82.

²² *Id.* at 98-100. Mr. Ranaboldo testified: “We do not break down sales by channel of distribution, meaning we don’t make that information available.”

²³ *Id.* at 71.

“LAVAZZA marks” without specifying any particular LAVAZZA mark, and have focused on use of the marks on coffee and use by third parties in the national chain/hospitality sector who are supplied LAVAZZA coffee products, equipment and point of sale branding materials. Mr. Ranaboldo’s testimony is lacking context, and not specific enough to support a finding of fame for individual products and services or for any particular LAVAZZA or LAVAZZA-formative mark. *See e.g., Inter IKEA Sys.*, 110 USPQ2d at 1740 (testimony not specific enough to support finding of fame of mark for individual products and listed services, other than retail stores); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1506 (TTAB 2007) (“non-specific testimony about sales and advertising might not be sufficient to demonstrate the fame of a mark in the typical case”).

Overall, we find that the record evidence relevant to the strength of Opposer's mark is not sufficient to reach the level where the renown of the mark plays a dominant role in the process of balancing the *du Pont* factors. Moreover, even if we were to find that the mark LAVAZZA is strong for coffee, which on this record we do not, that does not mean that the mark also is strong for restaurants for purposes of a likelihood of confusion analysis.

D. Extent of Concurrent Use and Actual Confusion

The seventh and eighth *du Pont* factors are “the nature and extent of any actual confusion,” and “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *In re E. I. du Pont*, 177 USPQ at 567.

Where the parties have coexisted in the marketplace under circumstances where there has been an opportunity for confusion to have occurred, the lack of any reported instances of confusion is a factor that the Board may consider. *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 USPQ 364, 367 (Fed. Cir. 1986) (while lack of evidence of confusion is not dispositive, the concurrent use of the marks for 19 years without any reported instances of confusion suggests that the marks are not likely to cause confusion); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ at 110 (absence of confusion for over 20 years supports finding that confusion is not likely).

In this case, Applicant points to the testimony of Applicant's witness, Mr. Favazza, and Opposer's witness, Mr. Ranaboldo, both of whom testified that they are personally unaware of instances of actual confusion.²⁴ Applicant argues in its brief that

...Applicant's FAVAZZA's mark and Opposer's LAVAZZA mark have coexisted with each other for between **30 and 35 years**. [*emphasis in original*] ... there has been plenty of opportunity for actual consumer confusion to have arisen ... there are consumers residing in the St. Louis metropolitan area who are familiar with Applicant's FAVAZZA'S restaurant and who have been exposed to Opposer's LAVAZZA-branded products/services and the nationwide advertising of those products/services. Yet there is still no actual confusion anywhere to be found.²⁵

We find on this record that there is no meaningful way to gauge the absence of actual confusion given the fact that we do not know the extent of Opposer's use of LAVAZZA or LAVAZZA-formative marks in connection with cafés. Although Mr.

²⁴ 17 TTABVUE 14-15; 15 TTABVUE 93.

²⁵ 22 TTABVUE 12, 15.

Ranaboldo provided some general testimony related to its LAVAZZA-branded cafés,²⁶ he focused his testimony primarily on Opposer's use of LAVAZZA or LAVAZZA-formative marks in connection with coffee. We are unable to ascertain, therefore, whether there has been a meaningful opportunity for actual confusion to have occurred in the marketplace between Opposer's cafes and Applicant's restaurant. In any event, the applicable test here is likelihood of confusion, not actual confusion, and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion. *Herbko Int'l, Inc. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

VII. Conclusion

We have considered all of the evidence pertaining to the relevant *du Pont* factors, as well as the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion). In balancing the relevant *du Pont* factors, we conclude that the similarity of the marks, the identity of the services, overlapping trade channels and consumers, and conditions of sale favor a likelihood of confusion with the services identified in Registration No. 2236996.²⁷ In view thereof, we need not consider the issue of likelihood of confusion with respect to Opposer's other pleaded registrations. *Max Capital*, 93 USPQ2d at 1248.

Decision: The opposition is sustained on the basis of likelihood of confusion with the mark LAVAZZA in Registration No. 2236996, and registration to Applicant is refused.

²⁶ 15 TTABVUE 57, 67 and 93.

²⁷ We deem the other *du Pont* factors neutral.