



TTAB

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD



12-16-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #:

GOOCH FOODS, INC.,)
)
 Petitioner,)
)
 v.)
)
 HOMESTEAD, INC.)
)
 and)
)
 NEW WORLD PASTA COMPANY,)
)
 Respondents.)

Cancellation No. 26,165
Opposition No. 107,599
Opposition No. 110,644

DEC 16 2002 9:30 AM
U.S. PATENT & TRADEMARK OFFICE

BRIEF OF RESPONDENTS
AND COUNTERCLAIMANTS
HOMESTEAD, INC. AND
NEW WORLD PASTA COMPANY

Cory M. Amron
William H. Oldach III
Vorys, Sater, Seymour and Pease LLP
1828 L Street, N.W.
Eleventh Floor
Washington, DC 20036
(202) 467-8800

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I. INTRODUCTION

In this consolidated proceeding, the current, new owner of the LA ROSA federal trademark registrations¹ is seeking to have the Trademark Trial and Appeal Board (the “Board”) sustain a cancellation and two oppositions filed by the current owner’s predecessor-in-interest against Respondents’ registration and applications for the mark LA BELLA ROSA² based on an asserted likelihood of confusion. The predecessor-in-interest, however, Gooch Foods, Inc., had failed to enter any evidence into the record or to take any trial testimony in support of its assertions against the registration and applications of Respondents, Homestead, Inc. and New World Pasta Company. Without any such evidence, the new owner, Petitioner and Opposer American Italian Pasta Company³ (“Petitioner” or “AIPC”), which bears the burden of proof in this proceeding, is relegated to making its arguments based essentially only on its own registrations and Respondents’ marks.

These arguments comprise little more than a selective reading of several *DuPont* factors, omitting, not surprisingly, factors that weigh in Respondents’ favor. Moreover, the arguments directed to those selected *DuPont* factors are in several critical respects self-contradictory and unsupported. Petitioner has attempted to bolster its argument to allude, without citation, to evidence that is decidedly not of record. Despite its best efforts, however, Petitioner has failed to

¹ As summarized in Petitioner’s Brief, the LA ROSA marks are Registration Nos. 313,418; 389,868; 623,197; 651,541; 1,390,117; and 1,396,003.

² Reg. No. 1,818,079 and Application Serial Nos. 75/194,595 and 75/368,367.

³ In addition, Respondents make note of AIPC’s concurrent motion to substitute itself as Petitioner in place of the former owner of the LA ROSA marks, Gooch Foods, Inc. Respondents have not separately opposed that motion because it appears from the supporting documentation filed with the motion that Gooch in fact no longer holds any interest in the pleaded registrations (as well as other registrations and an application not at issue herein), and that AIPC now owns all interest therein. However, the purchase agreement filed in support of the motion identifies Archer-Daniels-Midland Company (“ADM”) as an assignor, as well as Gooch. Respondents believe that this is because ADM had an interest in one of the marks conveyed in the agreement that is not at issue in this proceeding. Respondents invite AIPC to confirm or clarify this situation in its Reply Brief. Should Respondents learn that ADM

carry its burden of proof on the issue of likelihood of confusion, and for good reason. The Board should order the cancellation and the oppositions dismissed with prejudice.

II. ARGUMENT

A. Petitioner Bears The Burden Of Proof In This Proceeding

Throughout its argument, Petitioner has failed to acknowledge one paramount fact: the burden of proof falls upon *Petitioner* to show by a preponderance of the evidence that Respondents are not entitled to their registrations. *See, e.g., Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1848 (Fed. Cir. 2000). Instead, Petitioner has relied on inapposite cases to imply that any doubt in this *inter partes* proceeding must be construed against Respondents.

For example, Petitioner cites to *In re Hyper Shoppes (Ohio), Inc.*, 6 U.S.P.Q.2d 1025 (Fed. Cir. 1998), but as the caption implies, that case was an appeal of an *ex parte* application rejection under section 2(d), and not an *inter partes* proceeding. Petitioner also cites to *Kimberly-Clark Corp. v. H. Douglass Enterprises, Ltd.*, 227 U.S.P.Q. 541 (Fed. Cir. 1985), but in that case, evidence was of record that the opposer's mark was famous, and that the respondent was aware of the opposer's mark when it chose its own mark, thus giving rise to the Court's comment concerning the duty of the respondent to avoid the opposer's mark. *Id.* at 543. No such evidence is of record in this case.

In an *inter partes* proceeding such as this, it is Petitioner that bears the burden of proof on the issue of likelihood of confusion. Any doubts, therefore, as to whether or not Petitioner has met that burden must be resolved in *Respondents'* favor. Any statement or implication to the contrary is incorrect as a matter of law.

had some interest in the pleaded registrations that was not heretofore known, Respondents reserve the right to seek to reopen the record in this proceeding to take discovery from ADM.

B. Petitioner's Analysis Of The *DuPont* Factors Is Flawed
And Does Not Support A Finding Of Likelihood Of Confusion

Given the lack of any evidence of record in this case, other than the subject registration and applications, and the registrations owned and pleaded by Petitioner's predecessor-in-interest, Petitioner is left to rely on a basic comparison between the LA ROSA marks and the LA BELLA ROSA marks in light of the factors discussed by the court in the landmark case *In re E. I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1973). Petitioner's discussion of these factors, however, leaves much to be desired, as Petitioner has ignored factors favoring Respondents and has implied the existence of evidence that is not of record. As discussed herein, when the factors favoring Respondents are considered, and when Petitioner's improper implications are ignored, the Board should conclude that Petitioner has not met its burden of proof.

1. Petitioner's Mark Is Weak and
Entitled Only to Limited Protection

Petitioner argues that Respondents' marks are similar to its marks because they share the same terms, LA ROSA. However, the mere fact that the marks share a term in common is not determinative. *Clairol, Inc. v. Cosmair, Inc.*, 224 U.S.P.Q. 229, 232 (S.D.N.Y. 1984). This is particularly true when the common terms are weak or descriptive. *See The Wooster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316, 318 (TTAB 1986). In this case, Petitioner's mark, LA ROSA, is weak because it is a surname and because it has a descriptive connotation as applied to Petitioner's pasta products.

The Board may take judicial notice that LA ROSA is a surname⁴ and has no other meaning in the English language. Although, as pointed out by Petitioner in its brief, LA ROSA may have other meanings in Italian (i.e., “the rose”), Petitioner also has argued that the consumers who purchase its products are not conversant in foreign languages. As a result, these consumers will be likely to ascribe to Petitioner’s mark the primary meaning of LA ROSA in the United States, that of a surname.⁵ It is well settled that surnames, when used as trademarks, are inherently indistinctive, weak marks. *See, e.g., Scott Paper Company v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1228 (3rd Cir. 1978); 2 J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 13.1 (4th ed. 1998).

Furthermore, in the context of Petitioner’s pasta products, the Board may take judicial notice that the term “rosa” is a descriptive term used to refer to a type of pasta sauce.⁶ As a result, the term that Respondents’ and Petitioner’s respective marks share, ROSA, is a weak and arguably descriptive term as applied to the goods offered under the marks. The Federal Circuit has held that a descriptive component of a mark is to be given little weight in determining that there is a likelihood of confusion between marks. *In re National Data Corp.*, 224 U.S.P.Q. 749, 752 (Fed. Cir. 1985). Such terms are weak source identifiers and accordingly are entitled to a very limited scope of protection. 3 J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:48 (4th ed. 1998). The scope of protection accorded to weak marks has often

⁴ The TTAB may take judicial notice of the facts that are not subject to reasonable dispute and which are capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. Trademark Trial and Appeal Board Manual of Procedure § 712.01 (1st ed. 1995).

⁵ Some of Petitioner’s registrations also show a drawing of a rose. However, a review of each of those registrations shows that the term “LA ROSA” appears as the dominant element of the mark.

⁶ A simple internet search for the term “rosa sauce” produces hundreds of recipes and menus featuring a rosa sauce (comprising cream with tomatoes or tomato sauce) to be served with pasta.

been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods. *Wooster Brush*, 231 U.S.P.Q. at 318.

2. Petitioner's Marks and Respondents' Marks
Do Not Create Similar Commercial Impressions

Once Petitioner's mark is properly understood to have only a limited scope of protection, the question of the similarity of the commercial impression presented by the marks under the *DuPont* test is easily resolved in Respondents' favor. Petitioner's argument on this most central *DuPont* factor suffers throughout from a core inconsistency: Petitioner argues that it is relevant that Respondent's additional term BELLA is a descriptive modifier meaning "beautiful" as applied to ROSA, implying that the added term does not sufficiently distinguish the marks. Petitioner also, however, argues that American consumers in the relevant market would not understand Italian. If so, then the term BELLA would appear to be an arbitrary or fanciful term, and indeed from its central position would appear to be the dominant term in the mark. This inconsistency undermines Petitioner's argument.

The Board and the Federal Circuit have previously held that one *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that factor is the dissimilarity of the marks. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998). Indeed, the Federal Circuit has pointed out that "the more important factor for resolving the issue of likelihood of confusion ... is the dissimilarity in commercial impression between the marks." *Keebler Co. v. Murray Bakery Prods.*, 9 U.S.P.Q.2d 1736, 1739 (Fed. Cir. 1989). This is particularly true where, as here, Petitioner has failed to provide evidence of record with respect to any of the other *DuPont* factors. *See Roederer*, 47 U.S.P.Q.2d at 1462.

The basic principle in determining whether a likelihood of confusion exists between marks is that the marks must be compared in their entireties. *National Data Corp.*, 224 U.S.P.Q.

at 752. “It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” *Id.* at 751.

Here, even assuming the similarity of the goods on which the marks are used and the trade channels in which they travel, Respondent’s mark, LA BELLA ROSA, when viewed in its entirety, is distinctly different from Petitioner’s mark, LA ROSA, in sound, appearance and commercial impression. The differences in the overall visual appearance and pronunciation of the respective marks caused by the addition of the word BELLA in Respondents’ mark are clear. *See, e.g., Colgate-Palmolive Company v. Carter Wallace, Inc.*, 167 U.S.P.Q. 529, 530 (CCPA 1970) (“PEAK” and “PEAK PERIOD” found to be different in both sound and appearance). Moreover, the presence of the word BELLA in Respondent’s mark causes it to have different connotative properties than Petitioner’s mark, LA ROSA. As discussed above, a primary impression that would be conveyed to American consumers by Petitioner’s mark, LA ROSA, is that of a surname. In contrast, because of the addition of the term BELLA, Respondents’ mark, LA BELLA ROSA, would not be viewed as a surname. This causes Petitioner’s and Respondents’ respective marks to differ significantly in overall commercial impression.

The Federal Circuit’s decision in *In re Hearst*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992), is highly instructive in establishing the proper guidelines in determining whether marks are confusingly similar simply because they may share a term in common. In *Hearst*, the Federal Circuit reviewed the Board’s determination that the marks VARGA GIRL and VARGAS for identical goods, calendars, were confusingly similar. In reversing the Board’s determination, the Federal Circuit pointed out that diminishing the weight of the term “GIRL” in VARGA GIRL when comparing the marks was in error since doing so inappropriately changed the mark. *Id.*

Similarly, when the term BELLA in Respondents' mark is given fair weight when compared to the Petitioner's mark, LA ROSA, it is evident that the marks create overall different commercial impressions. In this case, assuming Petitioner is correct in noting that American consumers would be unaware of the meaning of foreign words, BELLA would be considered to be a distinctive coined or fanciful mark since it does not exist in the English language. The combination of the distinctive term, BELLA, with ROSA therefore creates an overall commercial impression that is different from that conveyed by the word portion of Petitioner's mark, which is simply LA ROSA. Even in cases where the only term that is different between two marks is descriptive, as was the term "GIRL" in *Hearst*, that term should not be improperly diminished in significance when the two marks are compared. This is particularly true in cases where the term, such as BELLA, is a distinctive term that has not been disclaimed.

This proceeding therefore differs from those cases cited by Petitioner at pages 8-9 of its brief. In those cases, the fact that the marks in question comprised foreign terms was held to make it more difficult for consumers to distinguish between marks having a like number of phonetically similar elements (i.e., "BOTTEGA VENETA" vs. "BORSA VENETO"; "KAHLUA" vs. "CHULA"; "DUCA D'AREZZO" vs. "DUCA D'AOATA"; "DUE TORRI" vs. "TRES TORRES"). That is not the case here, where Respondents' mark comprises a distinctive and additional term placed between two elements that, in the form of Petitioner's mark as a whole, form a weak mark.

In comparing Respondents' mark, LA BELLA ROSA, with Petitioner's mark LA ROSA, the diminution of the term BELLA would be inappropriate, and the respective marks should be considered in their entireties. When BELLA in Respondent's mark is given fair weight together with the remaining terms in the mark, it is evident that it is unlikely that there would be any

confusion between the Petitioner's mark, LA ROSA and Respondent's mark, LA BELLA ROSA.

3. Petitioner's Mark Is Not Famous

Petitioner has tried to argue as a separate *DuPont* factor that its mark, LA ROSA, is presumed to be famous by virtue of its seventy years of use in the market. (Petitioner's Brief at 11.) Petitioner provides no support for this assertion, and it is indeed incorrect.

Assuming that the earliest filing date of any of Petitioner's registrations establishes continuous use in interstate commerce since that date, it nevertheless does not follow that Petitioner's mark is famous. As the Federal Circuit has commented, the evidence that usually is supplied in the record to support a claim of fame under the *DuPont* factor are sales records, evidence of advertising expenditures, and, in some cases, direct evidence of consumer recognition. *See Bose Corp. v. QSC Audio Products, Inc.*, 63 U.S.P.Q.2d 1303, 1305-06 (Fed. Cir. 2002). Since Petitioner has failed to provide here any such evidence to support its claim that its mark is famous, it is not entitled to the broader scope of protection that may be accorded to marks that have been proven to be famous or strong. *See Roederer*, 47 U.S.P.Q.2d at 1464.

4. Petitioner Has Produced No Evidence of Actual Confusion or Intent but Instead Has Alluded to Evidence Not of Record

Petitioner, in addressing two affirmative defenses raised by Respondents, has stated that Respondents have submitted no evidence as to the absence of either actual confusion or intent. (Petitioner's Brief at 13-14.) Despite the absence of these factors having been pled, however, they are in fact subfactors used to evaluate likelihood of confusion,⁷ the ultimate issue on which *Petitioner* bears the burden of proof.⁸

⁷ *See, e.g., Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 50 U.S.P.Q. 2d 1545 (9th Cir. 1999) (actual confusion); *Pignons, S.A. v. Polaroid*, 212 U.S.P.Q. 242 (1st Cir. 1981) (actual confusion); *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 192 U.S.P.Q. 797 (TTAB 1976) (intent).

Therefore, in the event that any instances of actual confusion existed, it would be incumbent upon Petitioner, as the party with the ultimate burden, to introduce such evidence into the record. Since Petitioner has not done so, no actual confusion can be said to exist.

Moreover, with respect to intent, Petitioner has alluded to evidence that is not of record in this case. Such unfounded allusions only serve to weaken further Petitioner's argument. Petitioner asserts, without foundation or citation, that Respondents had "long knowledge of Petitioner's famous LA ROSA marks." (Petitioner's Brief at 12.) There simply is no evidence of record in this case to support such an assertion. Similarly, Petitioner complains that Respondents are attempting "to capitalize upon the reputation and good will" of Petitioner (*id.*), but there is no evidence to support any contention with respect to Respondents' intent. The Board should disregard these baseless assertions.

5. Summary of DuPont Factors

When properly evaluated without reference to evidence that does not exist, the *DuPont* factors paint a much different picture of the confusion issue in this case from that presented by Petitioner. Here, Petitioner's mark is weak and therefore not subject to broad protection. Despite the presumed long use of Petitioner's mark, no evidence exists as to its strength as evaluated by any objective factor, such as sales volume, advertising expenditures, or customer recognition. Moreover, Petitioner has introduced no evidence as to any actual confusion between the marks or of Respondents' intent. Most importantly, when the marks as a whole are compared under the proper standard, Respondents' mark creates a commercial impression very distinct from the weak, descriptive impression created by Petitioner's mark.

⁸ In light of the state of the record, Respondents, like Petitioner, rely solely on the pleaded registrations and the subject registration and applications, and do not rely on any pleaded affirmative defenses or counterclaims, with the exception of the counterclaims for partial cancellation discussed at Section C, *infra*.

On the basis of these *DuPont* factors, Petitioner has not met its burden of proof in this proceeding of establishing by a preponderance of the evidence that there exists a likelihood of confusion between its LA ROSA marks and Respondents' LA BELLA ROSA marks.

Petitioner's claims, therefore, should be dismissed.

C. Judgment Should Be Granted In Favor Of
Respondents On Counts III And IV Of Their Counterclaims

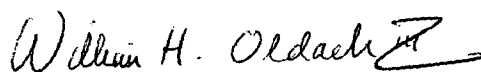
In Counts III and IV of their counterclaims, Respondents seek partial cancellation of Petitioner's Registration Nos. 389,868 and 623,198 as to certain goods listed therein on which Petitioner had no longer been using the mark for at least three years ("butter" for No. 389,868; and "pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meatballs in sauce, and sausage links with sauce" for No. 623,193).

Petitioner admitted in its Answer to the Counterclaims that it has no longer used the marks for such goods as set forth by Respondents and has abandoned those rights. (*See, e.g.*, "Answer and Counterclaim for Opposition" and "Answers to Counterclaims to Cancellation" ¶¶ 27-32.) Accordingly, judgment on Counts III and IV of Respondent's Counterclaim should be entered in Respondents' favor.

III. CONCLUSION

For all the foregoing reasons, Respondents request that the Board enter judgment in their favor dismissing Petitioner's claims with prejudice and sustaining Respondents' Counterclaims Counts III and IV for partial cancellation of Registration Nos. 389,868 and 623,193.

Respectfully Submitted,



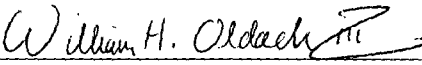
Cory M. Amron
William H. Oldach III
Vorys, Sater, Seymour and Pease LLP
1828 L Street, N.W.
Eleventh Floor
Washington, DC 20036
(202) 467-8800

Attorney for Respondents
HOMESTEAD, INC. and NEW WORLD
PASTA COMPANY

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Brief of Respondents and Counterclaimants Homestead, Inc. and New World Pasta Company was served this 16th day of December, 2002, via first-class mail, postage prepaid, upon:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Boulevard, Suite 400
Kansas City, MO 64108


William H. Oldach III
William H. Oldach III