

This Opinion is Not a
Precedent of the TTAB

Mailed: July 17, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Elite Gold Ltd.

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Serial Nos. 97160619 and 97213291 (consolidated)

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Adam J. Bruno of Bay State IP, LLC, for Elite Gold Ltd.

Betty Chang, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Larkin, Dunn and Thurmon, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Elite Gold Ltd. (“Applicant”) seeks registration on the Principal Register of the mark ROMA, in standard characters for “cookies and biscuits; all of the foregoing not for sale at wholesale or for foodservice use,” in International Class 30.¹ Applicant also


¹ Application Serial No. 97213291 was filed on January 11, 2022, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Citations in this opinion to the briefs refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 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. Applicant’s appeal brief appears at 6 TTABVUE and the Examining Attorney’s brief appears at 8 TTABVUE. Citations to the application record are to the downloadable .pdf version of the United States Patent and Trademark Office’s Trademark Status & Document Retrieval (“TSDR”) system.



seeks registration of the mark for “biscuits, crackers, cheese-flavored biscuits; cheese biscuits; baked cheese-flavored crackers; all of the foregoing not for sale at wholesale or for foodservice use,” also in International Class 30.²

The Examining Attorney finally refused registration of both Applications under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), finding a likelihood of confusion, based on two registrations owned by a single entity, for the marks and goods shown below.

Mark	Goods
	“food products; namely, flour, pasta, bread, biscuits, yeast, salt, mustard, vinegar, spices, tomato sauce, sauces excluding apple and cranberry, pizza, spaghetti, coffee, tea, and sugar, for sale at wholesale to pizza parlors, restaurants and delicatessens for their in-house preparation of meals,” in International Class 30 ³

² Application Serial No. 97160619 was filed on December 7, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The words “GRILLED CHEESE CRACKERS” are disclaimed. The mark is described as follows: “The mark consists of the white wording “ROMA” below a yellow crown design, both enclosed in a red oval at the bottom of which is a yellow wheat-stalk design; all of the foregoing above the white wording “GRILLED CHEESE” outlined in red; all of the foregoing above the white wording “CRACKERS”; all of the foregoing above the design of two crackers and a wedge of cheese in shades of yellow; all on a background in gradations of yellow; black in the mark represents shading and is not part of the mark.” The colors yellow, red and white are claimed as a feature of the mark.

³ Registration No. 1725523 issued on October 20, 1992, and has been renewed, most recently on September 6, 2022. No description of the mark was provided by the applicant.

ROMA	“pies namely key lime; cookies; cakes; pizza crust; and desserts namely tiramisu all for foodservice use,” in International Class 30 ⁴
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Because the two appeals share common facts—namely, Applicant’s marks share the same literal term ROMA and the same registrations are cited in both Section 2(d) refusals—we consolidate the appeals for purposes of final decision. *See In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board sua sponte consolidated two appeals). All record references are to Serial No. 79160619, unless otherwise noted.

Applicant and the Examining Attorney have filed briefs and these appeals are ready for final decision. We affirm the refusals to register.

I. Applicable Law

Our determination under Section 2(d) is based on 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, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), *cited in B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case

⁴ Registration No. 3486352 issued on August 12, 2008, and has been renewed. The mark was registered based on a claim of acquired distinctiveness. The foreign wording in the mark translates into English as “Rome”.


basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods or services, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shell Oil*, 26 USPQ2d at 1688 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (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.”).

II. Likelihood of Confusion – Analysis

The disputes between Applicant and the Examining Attorney in these appeals primarily involve a single *DuPont* factor. The marks are highly similar and the goods are identical in part or related, as we will explain below. But we begin our analysis with the trade channels factor, because that is where the real dispute lies. There are limitations in the identifications of goods in both appealed Applications and in both cited registrations. Applicant argues these limitations have the effect of eliminating any overlap in trade channels, meaning the goods of Applicant would never reach the same consumers as those who buy and use the Registrant’s goods. 6 TTABVUE 14-15. We turn to that analysis now.


A. Similarity of the Trade Channels and Purchaser Care

We begin our analysis of the trade channels by looking at the identifications in the Applications and cited registrations. Applicant’s goods, in both Applications, include the following limitation: “all of the foregoing not for sale at wholesale or for foodservice use.”⁵ The two cited registrations also contain trade channel limitations, but each registration has a different limitation. The older cited registration of the composite word-and-design mark  has the following limitation: “for

⁵ This amendment was proposed by Applicant in a Request for Reconsideration and was entered by the Examining Attorney after all prosecution closed. We find the amendment was important, and because of the timing of its entry, most of the prosecution of the Applications was conducted with a different identification. As we note below, the Examining Attorney failed to submit certain evidence that might have better supported the refusal. It is probably a better practice to allow for continued prosecution after an important limiting amendment to an application is entered.

sale at wholesale to pizza parlors, restaurants and delicatessens for their in-house preparation of meals.” The second cited registration, for the ROMA word mark, has this limitation: “all for foodservice use.” As we noted above, Applicant argues that the limitations in the Applications and cited registration are mutually exclusive and dispositive of the issue of the likelihood of confusion.

We begin our analysis with a focus on the newer cited registration. This registration is for the standard character mark ROMA, which is more similar to the two applied-for marks, as we will explain below when evaluating the first *DuPont* factor. More importantly for our trade channel analysis, the newer registration has a less restrictive trade channel limitation in the identification of goods. The key portions of the identifications for the two cited marks follow:

- ROMA – “cookies” and other foods “all for foodservice use;”
-  - a variety of “food products ... for sale at wholesale to pizza parlors, restaurants and delicatessens for their in-house preparation of meals.”

The registration of the ROMA word mark (i.e., the newer of the two cited registrations) limits the goods to “foodservice use,” while the older registration of the ROMA + design mark has a more limiting restriction.⁶ The older registration limits the goods in two important ways. First, the goods are “for sale at wholesale to pizza

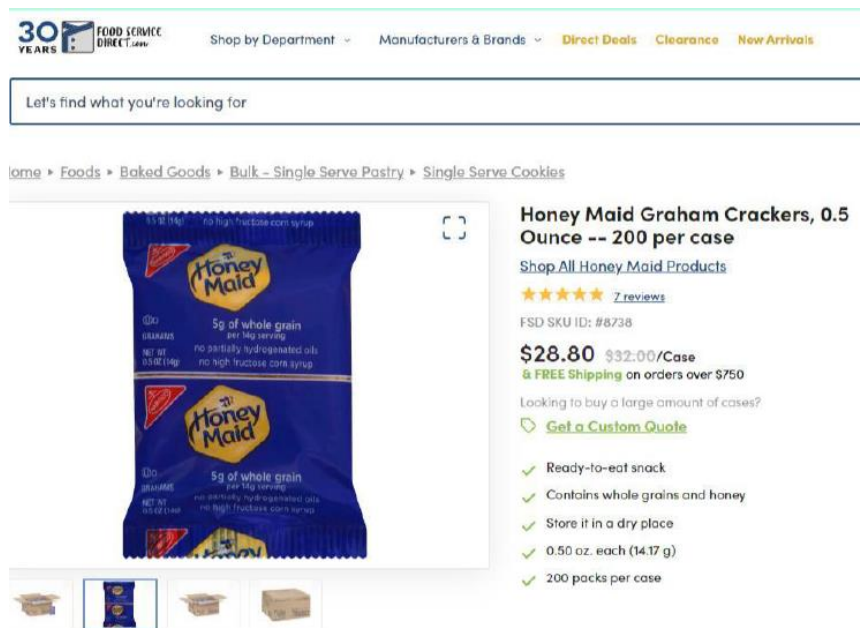
⁶ Applicant and the Examining Attorney do not dispute the meaning of the term foodservice, as evidenced by their obvious understanding of the other’s use of the term. There is evidence, submitted by Applicant, explaining that Food Service refers to food products “served at an establishment that isn’t in the home.” Response to Office Action dated March 15, 2023 at 50. We accept this general definition for purposes of this appeal.

parlors, restaurants and delicatessens” The registration then limits these goods to use in the “in-house preparation of meals.” These two limitations mean that ordinary consumers who buy or eat at “pizza parlors, restaurants and delicatessens” will not be exposed to the marks of the ingredient suppliers unless these businesses take some action to communicate that information to the consumers. The record contains no evidence of such practices, and for that reason, we find the only trade channel overlap between the two applied-for marks and the older cited registered mark is for foodservice buyers, at least some of whom are also buyers of foods in retail groceries and other retail stores. We will return to this limited trade channel overlap below, but first, we turn to the overlap between the cited registration of the ROMA word mark and the two Applications.

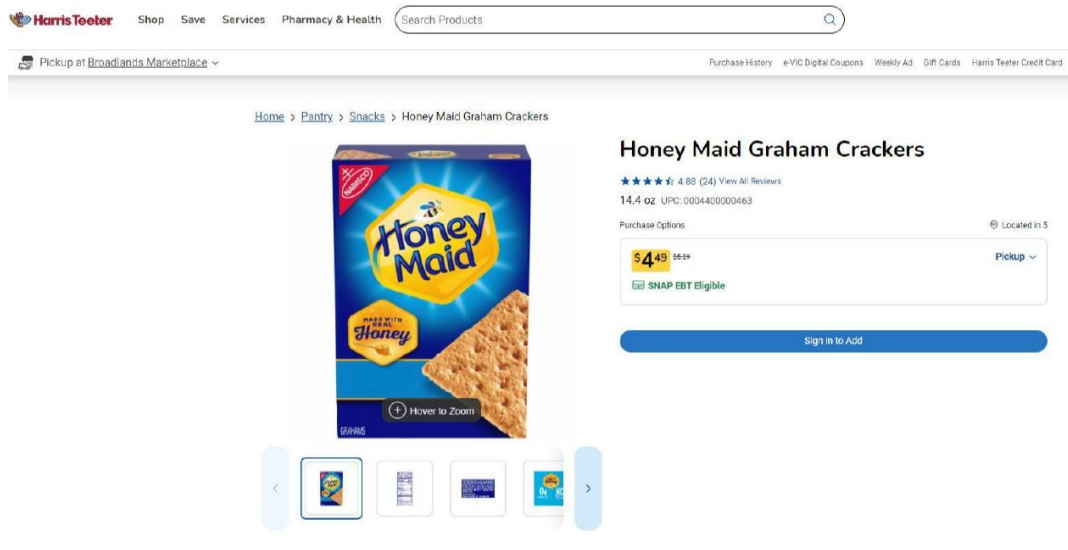
The cited registration for the word mark ROMA, includes a limitation that the goods are “all for foodservice use.” This limitation is different than the one in the older registration, as it does not limit the goods to use as ingredients in other food products. It is possible, therefore, that within the scope of this limitation, ROMA goods sold for foodservice use might be offered to retail consumers under the ROMA mark, rather than being incorporated into some other food product that might be offered under a different mark.

The Examining Attorney submitted evidence showing that foodservice users effectively offer some of the same branded goods to end consumers as retail grocers (though perhaps packaged differently than retail versions). In this sense, the branded goods pass through the foodservice user to the end consumers. When this happens,

end consumers are exposed, in a foodservice setting, to exactly the same brands they see in retail grocery stores, as the following images illustrate.



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⁷ Denial of Request for Reconsideration dated October 23, 2023 at 21.

⁸ *Id.* at 25.

These images show a foodservice and retail grocery version of Honey Made graham crackers. When the foodservice pack of these crackers is provided to an end consumer (e.g., at a cafeteria), the consumer will see the same HONEY MAID mark that is present on the retail version of this product. We cannot determine exactly how often the foodservice version reaches an end consumer still bearing the branded packaging, but given the evidence of record, but we find that such pass through branding is at least somewhat common. Many of the foodservice products in evidence show single-serving packaging, suggesting the goods pass through to the end consumer in that same packaging. *See, e.g., Id.* at 29 (Pepperidge Farm Milano cookie foodservice product), 38 (Otis Spunkmeyer cookie in foodservice packaging), 50 (Oreo cookies in foodservice packaging). Much of the evidence involves cookies, which as we note below, are the most similar of the goods at issue in this appeal.

Our analysis shows more trade channel overlap between the Applications and the cited ROMA word mark registration. There is evidence in the record showing the sort of brand pass through described above in the foodservice setting. The evidence shows that the limitation in the cited registration of the ROMA mark does not prevent ordinary consumers from being exposed to brands sold into foodservice channels.

This conclusion is further supported by the lack of specific channel limitations in the newer cited registration. There is no limitation to “pizza parlors, restaurants and delicatessens,” nor are the goods limited to use as ingredients in other end products. The absence of these more specific limitations means more ordinary consumers will see the ROMA branded goods in a foodservice setting such as a school cafeteria,

hospital, theater snack bar, or sports venue. In other words, the limitation in the registration of the ROMA word mark does not effectively prevent ordinary consumers from exposure to the registered ROMA mark for the goods identified in the second cited registration.

We further find that some trade channel overlap exists for the foodservice buyers of the goods sold under both the cited marks. Foodservice buyers are likely to also buy foods at retail grocery stores, and when they do, such buyers may be exposed to the applied-for ROMA marks (e.g., when shopping for groceries) and the foodservice ROMA marks (e.g., when buying ingredients for a restaurant). This overlap creates a risk of confusion, but we agree, to an extent, with Applicant that these buyers are likely more sophisticated about such matters than are ordinary grocery shoppers. Given the narrowness of this trade channel overlap and the likely sophistication of the overlapping buyers, we find this overlap does not substantially increase the risk of confusion beyond that created by the general consumer overlap discussed above.

We find there is substantial overlap in the trade channels of the goods identified in the registration of the ROMA word mark and the goods identified in the two appealed Applications. This overlap involves ordinary consumers who, based on the evidence of record, are likely accustomed to seeing some brands for similar goods in both the foodservice setting and the retail grocery setting. That overlap increases the likelihood of confusion.

B. Similarity of the Goods

Our evaluation of the second *DuPont* factor is based on the goods identified in the Applications and the cited Registrations. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A likelihood of confusion may be found if any goods recited in the identification of goods in a particular class in an application are related to any of the goods identified in a cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *see also Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6 (TTAB 2019); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015). In addition, the goods need only be sufficiently related that a consumer would be likely to assume, upon encountering the goods marketed under the marks at issue, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1492 (TTAB 2007).

The Applications do not identify the same goods. The Application for the ROMA word mark includes “cookies.” The cited registration for the ROMA word mark also includes “cookies.” The goods in the ROMA word mark Application, therefore, are identical in part to those in the cited ROMA registration. That fact increases the likelihood of confusion as between the mark in this Application and the cited mark.

The Application for the ROMA GRILLED CHEESE CRACKERS mark does not include cookies or any other specific goods identified in the cited registration for the

ROMA mark. This Application identifies “crackers,” which the evidence of record shows are related to “cookies.” For example, the Examining Attorney submitted evidence showing single-serve foodservice versions of both cookies and crackers bearing the same mark. Indeed, the example provided above shows a graham cracker product in a single portion package. There is similar evidence showing cookies in single portion packaging. These items are likely viewed by consumers as similar, or at least related in the sense that any one of these items might be provided as a snack option by a foodservice provider. We find the “crackers” identified in the Application for ROMA GRILLED CHEESE CRACKERS are related to the “cookies” identified in the cited registration of the ROMA mark in the sense that consumers would likely believe these types of goods are likely to come from a single source. Indeed, the HONEY MAID graham crackers shown above feature a Nabisco mark as do the OREO cookies in the record.⁹ This evidence supports our finding that cookies and crackers are related.

Applicant argues the goods are different because of the trade channel limitations. That argument misses the point of the multi-factor *DuPont* analysis. We considered the trade channels in the preceding part of our analysis. It is possible, as Applicant has noted, that identical goods may travel through wholly distinct trade channels referenced in the identification of goods an application and registration, a result that may eliminate the risk of consumer confusion. But when evaluating the goods here,

⁹ Denial of Request for Reconsideration dated October 23, 2023 at 21 (graham crackers), 50 (cookies).

we compare the goods as they are recited, and without the trade channel limitations.¹⁰ If there were limits on the goods themselves (e.g., peanut butter cookies, rather than simply cookies), we would consider those here. But in this appeal, the limitations in the Applications and cited Registrations limit the trade channels, but not the nature of the “cookies” or other goods. Applicant conflates the trade channels factor and the similarity of goods factor.

The evidence shows that the goods are related in a way that would lead consumers to believe some of Applicant’s goods come from the same source as Registrant’s goods. The second *DuPont* factor, therefore, weighs in favor of a finding of likelihood of confusion as to both Applications.

C. Similarity of the Marks

To evaluate the similarity of the marks, we consider the marks in their entireties as to appearance, sound, connotation and commercial impression. *See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019). *Accord, Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA

¹⁰ While some trade channel limitations might effectively limit the nature of the goods, we do not find that here. The limitations in the appealed Applications and in both cited registrations do not appear to limit the nature of the goods.

1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“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). The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018).

Applicant argues the marks are “visually distinct” and therefore the similarity does not increase the likelihood of confusion. 6 TTABVUE 10-11. We disagree. First, Applicant seeks registration of the ROMA mark in standard characters in one of the two appealed Applications. The cited registration for the mark ROMA involves the identical mark. There is no difference, visual or otherwise, between these marks. This fact significantly increases the likelihood of confusion.

The second Application, for the mark ROMA GRILLED CHEESE CRACKERS, involves a different mark, but one that is a variant of the ROMA mark. Applicant disclaimed “GRILLED CHEESE CRACKERS” leaving the ROMA element of the mark as the only nondisclaimed element of the mark. The ROMA GRILLED CHEESE CRACKERS mark, therefore, is similar to the cited ROMA mark. We have frequently found that the first term is dominant in multi-word marks. *See, e.g., Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first

part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). That is true here where ROMA is not only the first word in the mark, it is the only word that was not disclaimed by Applicant. These marks are visually similar.

The ROMA GRILLED CHEESE CRACKERS mark sounds different from the ROMA mark, but only due to the nondistinctive phrase “grilled cheese crackers.” Consumers are likely to remember and use ROMA to identify the goods from this Application, making the sound of the marks effectively similar. Indeed, we have noted that consumers have a propensity to shorten marks, and we expect that will be common with Applicant’s ROMA GRILLED CHEESE CRACKERS, a somewhat long mark. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (“Although the record does not indicate that applicant’s business is commonly referred to as ‘Giant,’ it does indicate that people have called it by that name, omitting the word ‘Hamburgers.’ Thus, in a conversation between two consumers in opposer’s area about a place of business called ‘Giant,’ there likely would be confusion about which ‘Giant’ they were talking about.”); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring) (acknowledging that generally, “users of language have a universal habit of shortening full names from haste or laziness or just economy of words”); *Big M. Inc. v. United States Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks[.]”).

Similar reasoning applies to the meaning and commercial impressions of the marks. Whatever ROMA means to consumers of these goods, it will have the same meaning in the context of Applicant's ROMA GRILLED CHEESE CRACKERS mark and Registrant's ROMA mark. These marks are similar in all respects, and that fact increases the likelihood of confusion.

D. Conclusion: Weighing the Factors

We have compared the marks from both Applications to the cited registration of the ROMA mark. As to the Application for the ROMA mark, the marks are identical and the goods are identical in part. The mark in the Application for the ROMA GRILLED CHEESE CRACKERS is similar to the cited ROMA mark and the goods are related.

Both Applications contain the same trade channel limitation and the cited ROMA mark also includes a trade channel limitation. These limits reduce the overlap between the trade channels, but do not prevent ordinary consumers from seeing foodservice versions of branded cookies and crackers that are also sold in retail channels. The trade channels overlap enough that consumer confusion may occur. When this fact is considered together with the similarity of the marks and the goods, it is clear that confusion is likely.

The only factor that weighs against a likelihood of confusion is the sophistication of the foodservice buyers. But those buyers are not the only consideration here, because the evidence shows that ordinary consumers are accustomed to seeing the same cookie and cracker brands in both foodservice and retail. So, even if the

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foodservice buyers are less likely to be confused, there remains a substantial likelihood of confusion for ordinary consumers.

Decision: The Section 2(d) refusals are **affirmed** as to all goods in both appealed Applications.