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Paper No. 19
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pacific Pinnacle Investments Ltd., dba Pacific
Western Brewing Co.

Serial No. 75/040,585

Mark B. Harrison of Venable for Pacific Pinnacle
Investments Ltd., dba Pacific Western Brewing Co.

Paula M. Mahoney, Trademark Examining Attorney, Law Office
101 (**Jerry Price**, Managing Attorney).

Before Hairston, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On January 5, 1996, Pacific Pinnacle Investments Ltd.,
dba Pacific Western Brewing Co. (a Canadian corporation)
filed an application to register on the Principal Register
the mark PACIFIC for "beer." Applicant claimed dates of
first use and first use in commerce between Canada and the
United States of July 1993.

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of

two previously registered marks, PACIFICO¹ and the mark shown below²

both for "beer," and both owned by Cerveceria del Pacifico, S.A. de C.V. (a Mexican corporation).

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont³ factors.

¹ Registration No. 1,726,063, issued on the Principal Register on October 20, 1992, Section 8 accepted, Section 15 acknowledged. The claimed date of first use is 1900, and the claimed date of first use in commerce is April 1985. The registration includes a statement that "The English translation of the word 'PACIFICO' in the mark is 'peace.'"

² Registration No. 1,336,171, issued on the Supplemental Register on May 14, 1985, Section 8 accepted. The registration includes a statement that "The mark is lined for the colors, red, gold, blue, green and yellow." The registration is based on applicant's claim of priority under Section 44(d) and (e) based on Mexican Registration No. 46237.

³ In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The parties' goods ("beer") are identical, and applicant acknowledges same. "When 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). Obviously identical goods would travel through all the same channels of trade to all the usual purchasers.

Moreover, beer is a relatively inexpensive, common consumer item, available through a wide variety of outlets. Applicant's argument that beer consumers are more discerning today and they exercise a degree of care in purchasing beer is unsupported by evidence and is simply unpersuasive.

Turning next to a consideration of the involved marks, applicant contends that the word PACIFICO in both cited marks translates as "peace" not as "pacific"; that the primary connotation of applicant's mark (PACIFIC) is "the spirit of the Pacific Ocean region" (brief, p. 3), not 'peace'; that the marks do not sound alike; that although the word marks PACIFIC and PACIFICO are somewhat similar in appearance, they are distinguishable in the number of letters and syllables; and that the commercial impressions

are different because in the context of applicant's English sound and a Canadian owner, PACIFIC evokes the spirit of the Pacific Ocean region, whereas, in the context of registrant's Spanish rhythm and a Mexican owner, PACIFICO evokes an idea that registrant's goods pacify the spirit.

Applicant also argues the existence of numerous third-party registrations at the USPTO; and that consumers can distinguish between PACIFIC and PACIFICO for beer.

Applicant did not submit copies of any third-party registrations, but rather, applicant listed several in its appeal brief (pp. 3-5 and 6-7). This evidence cannot be considered by the Board. First, it was untimely filed, and the Examining Attorney properly objected thereto. See Trademark Rule 2.142(d). Second, mere typed listings of third-party registrations are not an appropriate way to enter such material into the record, and the Board does not take judicial notice of registrations in the USPTO. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974); *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); and *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). Third, even if applicant had properly made these registrations of record (which it did not), third-party registrations are of little weight in our determination of likelihood of confusion as they are not evidence of use of

the marks shown therein and they are not proof that consumers are familiar with them so as to be accustomed to the existence of similar marks in the marketplace. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Examining Attorney contends that the marks are similar in meaning and connotation. In support thereof the Examining Attorney submitted The Concise American Heritage Larousse Spanish Dictionary definition of the word PACIFICO as "peaceful, pacific"; Webster's II New College Dictionary definition of PACIFIC as "1. Tending to diminish or end conflict. 2. Peaceful, serene"; Cassell's Spanish-English, English-Spanish Dictionary translation of PACIFICO as "pacific, peaceful, peaceable, peace-loving; el Pacifico, the Pacific Ocean," and PACIFIC as "pacifico"⁴; and Merriam-Webster's Geographical Dictionary (Third Edition) definition of Mazatlan (the words "Mazatlan" and "Mexico" appear in Registration No. 1,336,171) as "...largest Mexican seaport on the Pacific coast...."⁵ Thus, the Examining Attorney finds the words PACIFIC and PACIFICO to

⁴ The Examining Attorney's request (brief, footnote 9) that we take judicial notice of this dictionary definition is granted. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

⁵ The Board also hereby takes judicial notice of this dictionary definition.

be foreign equivalents of one another, with similar meaning and connotation.

Further, she contends that the involved word marks, PACIFIC and PACIFICO, are similar in sound and appearance, as well as overall commercial impression, because the words PACIFIC and PACIFICO differ by only one letter; carry the same or similar meaning which would be understood by the relevant consumers; and in fact, the design shown in one of registrant's marks clearly connotes maritime and the ocean, as it includes a buoy, an anchor and water with a protruding rock formation.

In this case, we agree with the Examining Attorney that the record establishes that applicant's mark, PACIFIC, is similar in sound, appearance, meaning, connotation and commercial impression as to both registrant's word mark, PACIFICO, and registrant's mark which includes additional words and a design. See *In re Perez*, 21 USPQ2d 1075 (TTAB 1991) (wherein EL GALLO, in stylized lettering, for fresh vegetables, namely, tomatoes and peppers, held likely to cause confusion with ROOSTER, in stylized lettering, for fresh citrus fruit); and *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987) (wherein BUENOS DIAS, for bar soap, held likely to cause confusion with GOOD MORNING!, in

stylized lettering, and including a design, for latherless shaving cream).

The fact that the parties' respective word marks differ by one letter does not serve to distinguish the marks which are otherwise particularly similar in sound, appearance, meaning, connotation, and overall commercial impression. Purchasers are unlikely to remember the specific difference between the word marks due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

According to applicant, there have been no instances of actual confusion. However, there is no information of record regarding the respective sales, nor is there any information from the registrant. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

None of applicant's other arguments (for example, the differing trade dress used on the parties' respective bottle labels and cans; applicant's ownership of applications and registrations for marks which each consist of many words, including PACIFIC, and a design, each for, inter alia, beer;⁶ and applicant's asserted policing efforts) are persuasive of a different result in this case.

Decision: The refusal under Section 2(d) is affirmed.

⁶ Applicant did not submit, at any time during the prosecution of this application, a copy of any registration assertedly owned by applicant. In any event, applicant's assertion that it owns registrations which include the word PACIFIC is not relevant to the issue of likelihood of confusion between applicant's applied-for mark and the cited registered marks because applicant cannot rely upon a family of marks in seeking registration of this particular mark. See *In re U.S. Plywood-Champion Papers, Inc.*, 175 USPQ 445 (TTAB 1972). See also, *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992).