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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wente Bros.

Serial No. 75/493,919

Edward S. Wright of Dorsey & Whitney LLP for Wente Bros.

Darlene D. Johnson, Trademark Examining Attorney, Law
Office 111 (Craig Taylor, Managing Attorney).

Before Simms, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Wente Bros. ("applicant"), a California corporation,
has appealed from the final refusal of the Trademark
Examining Attorney to register the mark VALLE DE ORO for
wine.¹ The Examining Attorney has refused registration
under Section 2(d) of the Act, 15 USC §1052(d), on the
basis of Registration No. 1,266,555, issued February 7,

¹ Application Serial No. 75/493,919, filed June 1, 1998, based upon
applicant's allegations of use and use in commerce since December 31,
1934. Applicant states in its application that the mark is translated
into English as "Valley of Gold."

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1984 (Sections 8 and 15 accepted and acknowledged, respectively) for the mark GOLD VALLEY for wines. Applicant and the Examining Attorney have submitted briefs but applicant has not requested an oral hearing.

The Examining Attorney contends that, because applicant's mark is a foreign phrase, it is appropriate to translate the mark under the doctrine of foreign equivalents in order to determine if there is a likelihood of confusion. The Examining Attorney argues that the respective marks are similar in sound and appearance and that the marks may have the same meaning. In this regard, the Examining Attorney contends that "Valley of Gold" or "Gold Valley," the translation of applicant's mark, has the same meaning as the registered mark--GOLD VALLEY. The Examining Attorney asks us to take judicial notice of a dictionary definition of the word "gold," which may mean not only the metal but also a color. Therefore, both marks may mean a valley rich in gold or where gold is located, or a valley which is the color of gold, according to the Examining Attorney.

The Examining Attorney notes that the goods here are identical and that where this is the case, the degree of similarity between the marks required to support a finding

of likelihood of confusion is not as great as where the goods are more diverse.

Applicant's attorneys have made several different arguments during the course of this proceeding. Initially, applicant argued that there was little similarity in the respective marks.² Applicant argued that it had not filed a foreign application so that the translation "will not become an issue in countries where Spanish is a common use [sic] language."

In applicant's second response, applicant argued that the registered mark had become abandoned, and submitted copies of two letters from the Franchise Tax Board of the state of California showing that the original registrant (Barcamerica Corporation) as well as a subsequent owner of the registration (Barcamerica International Corporation U.S.A.) had been suspended effective February 1984 and November 1992, respectively.³

In its initial appeal brief, applicant's attorney argued that the respective marks are dissimilar in sound,

² In the first response to the refusal of the Examining Attorney, applicant's attorney incorrectly stated that the registered mark was VALLEY GOLD rather than GOLD VALLEY.

³ According to the letters applicant has submitted, there is an "X" next to both "The above named corporation is in good standing with this agency" and "The above corporation was SUSPENDED effective ..." It appears, therefore, that while registrant and its successor had been suspended at one time, those entities were in good standing at the time of issuance of those letters in March 1999.

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appearance and meaning.⁴ Applicant also argued that the majority of wine consumers would not translate applicant's mark into "Valley of Gold."

After applicant's brief was filed, the Board suspended this appeal in September 1999 because applicant had filed a petition to cancel the cited registration. After that proceeding was dismissed, proceedings were resumed on October 4, 2002, and applicant was allowed time in which to file an additional brief. In that second appeal brief, in addition to arguing that the marks are so different that there is no likelihood of confusion, applicant's new counsel contended that the owner of the cited registration has acknowledged that there is no likelihood of confusion between the marks. In this regard, applicant has quoted from a brief, submitted with its appeal brief, filed in the cancellation proceeding and captioned "Opposition to Petitioner's Response to Order to Show Cause." That brief was filed by Barcamerica International U.S.A. Trust.

It appears from this brief that the Board had issued an order to show cause why the petition (filed by applicant) should not be dismissed for failure to take testimony. Petitioner (applicant herein) filed a response

⁴In this brief applicant again misstated registrant's mark to be VALLEY GOLD.

to the order to show cause and registrant filed this brief in opposition. In this brief, filed on September 18, 2001, registrant argued that its mark had not been abandoned and that petitioner in the cancellation proceeding had failed to prove its case during its testimony period. In a section of registrant's brief entitled "Petitioner Seeks to Misappropriate a Competitor's Trademark," a portion of which applicant has quoted but which is set forth in its entirety below, registrant states:

On page 3 of the Response, Petitioner alleges that it "had no choice but to file the present cancellation" petition. That is simply not true. If a refusal to register is not proper, the appropriate remedy is to appeal. If the Board affirms, the applicant for "Valle de Oro" had a right to appeal either to a district court or to the Federal Circuit. There are good grounds for appeal, because "Valle de Oro" and "Gold Valley" are entirely different in sound and appearance. Even the meaning is slightly different. "Gold Valley" suggests a color of a valley, as in Autumn. The translation of the Spanish words for "Valley of Gold" suggests a valley where the metal gold might be found. It is a stretch to argue that the Spanish term is likely to be confused with the English term in the ordinary course of business. Any alphabetical listing of the two wines would be under "G", in the one use, and under "V" in the other. Because each mark is subsidiary to the primary mark of the party, "Wente Bros." And "Barca", the parties could avoid confusion if they wanted to. There is no evidence of confusion in the concurrent use period of more than twenty years.

Registrant agreed to cooperate to registration of Petitioner's mark. Petitioner refused an agreement and instead set about taking Registrant's mark for itself on the ground it is the prior user. Prior use is of no help where the registration is incontestable. So, Petitioner took the first step of claiming abandonment, without any evidence whatsoever except that a former owner of the Registrant's mark ceased doing business after the mark had been assigned to the present owner.

If Wente Brothers is capable of destroying the registration, it will simply appropriate the mark it knows is owned by another. This Board has no jurisdiction over such an act of unfair competition, but it should not set the stage for such misappropriation by canceling the registration.

Petitioner chose not to appeal the refusal to register and instead chose inter partes litigation. Having failed to put on a case in its testimony period, Petitioner should be denied relief.

Finally, in a reply brief, applicant's counsel again argues that the respective marks are different in sound and appearance and that a purchaser of applicant's wine is likely to view applicant's mark as a "romantic Spanish term" and not translate it. Applicant's attorney also contends that the respective marks have co-existed in the same market without confusion for more than twenty years, despite the fact that both applicant and registrant are located within about 50 miles of each other in Northern California.

We turn then to the issue of likelihood of confusion. Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering first the goods, both applicant's application and registrant's registration cover wine, a product sold to the general public in liquor stores, grocery stores (in some states), as well as in other retail stores, and in bars and restaurants. Wine purchased in retail stores, while varying in price, may be obtained relatively inexpensively, and may be bought without a great deal of purchasing care or deliberation.

We observe that when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion

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declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

We turn then to a comparison of the respective marks. Under the doctrine of foreign equivalents, a foreign word (from a language familiar to an appreciable segment of American consumers) and the English equivalent may be found to be confusingly similar. See, e.g., *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987)(BUENOS DIAS for soap held likely to be confused with GOOD MORNING and design for latherless shaving cream); *In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986)(LUPO for men's and boys' underwear held likely to be confused with WOLF and design for various items of clothing); and *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983)(EL SOL for clothing and footwear held likely to be confused with SUN and design for footwear). Compare *In re Sarkli Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983)(REPECHAGE for various skin care products held not likely to be confused with SECOND CHANCE for face creams and other toiletries); *In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987)(DOVE and design for solid fuel burning stoves and furnaces held not likely to be confused with PALOMA for various forms of gas heating apparatus); *In re L'Oreal*

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S.A., 222 USPQ 925 (TTAB 1984)(HAUTE MODE for hair coloring cream shampoo held not likely to be confused with HI-FASHION SAMPLER (with "SAMPLER" disclaimed) for finger nail enamel); and *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975)(TIA MARIA for restaurant services held not likely to be confused with AUNT MARY'S for canned fruits and vegetables). Under the doctrine of foreign equivalents, foreign words are translated into English for comparison. The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent. See TMEP §1207.01(b)(vi).

Here the registered mark is GOLD VALLEY and applicant's mark is VALLE DE ORO, translated into English as VALLEY OF GOLD or, perhaps, GOLD (or GOLDEN) VALLEY. While the marks are, of course, somewhat different in pronunciation and appearance, the marks do have some similarities. The Spanish word "valle" is similar in sound and appearance to the English word "valley." Of course, the meaning of the two marks is closely similar if not identical.⁵ As the Examining Attorney has pointed out, both the registered mark and applicant's mark may have reference to a valley where gold is found or to a valley which may be

⁵ We grant the Examining Attorney's request to take judicial notice of the dictionary definition of "gold." *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

gold in color, as the result of the color of leaves or, perhaps, in the context of the goods, the color of the grapes. These marks are essentially identical in meaning and otherwise somewhat similar that, when used for identical goods--wine--we believe that confusion is likely.

With respect to the marks, we also observe that there is no evidence that there are similar marks in the marketplace, the existence of which may render the registered mark somewhat "weak" or lacking in distinctiveness with respect to wine.

Applicant argues, however, that we should allow registration here because registrant has "acknowledged" that confusion is unlikely when these marks are both used on wine.⁶ We have carefully considered this argument but find it unpersuasive.

First, registrant's counsel's statements about the differences in the marks were made in an opposing brief in the cancellation proceeding, filed in an attempt to persuade the Board that judgment should be entered against petitioner (applicant). They were made in the context of

⁶ We note that the Examining Attorney did not address this issue in her brief. Because "the market interface between applicant and the owner of a prior mark" as well as any "consent" are factors to be considered in the likelihood-of-confusion analysis (*In re du Pont de Nemours, supra*), the Examining Attorney should have set forth her view of applicant's contention with respect to statements made by registrant in the earlier cancellation proceeding, which were submitted with applicant's instant appeal brief.

suggesting possible arguments that applicant may have in any appeal from a refusal to register the mark here sought to be registered. Registrant further indicated that applicant and registrant have been unable to reach a settlement of this trademark dispute. Further, registrant indicated that applicant was trying to "misappropriate" applicant's registered mark. Suffice it to say that, if registrant had indeed consented to the use and registration of applicant's mark, applicant could have submitted such a consent. We do not believe that the introduction of statements made in a brief submitted in connection with a different proceeding in a completely different context is the appropriate method of making of record the "consent" of the registrant. See, for example, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("As the Board and the examining attorney have pointed out, however, there has been no consent agreement executed between Majestic and Stroh... The record appears to be silent as to whether Majestic ever attempted to negotiate an agreement with Stroh, but, in any event, we agree that no presumption can be made that Stroh consents to Majestic's use of the mark or that Stroh has determined or admits that confusion of the public by Majestic's concurrent use of the mark is unlikely.")

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Finally, if there were any doubt about likelihood of confusion in this case, we would, in accordance with precedent, resolve such doubt in favor of registrant and against applicant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.