

Mailed:

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

May 30, 2003
Paper No.14
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Calzificio FAP S.p.A.**

Serial No. 75/866,321

James V. Costigan and Kathleen A. Costigan of Hedman & Costigan,
P.C. for **Calzificio FAP S.p.A.**

Michael L. Engel, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before **Simms, Hohein and Hairston**, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Calzificio FAP S.p.A. has filed an application to
register the mark "BELLISSIMA BY CALZIFICIO FAP" and design, as
shown below,

BELLISSIMA
BY CALZIFICIO FAP

for "stockings."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "BELLISSIMO" and design, which is registered, as reproduced below,



for "children's dresses,"² as to be likely to cause confusion, or mistake or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098,

¹ Ser. No. 75/866,321, filed on December 7, 1999, which is based on Italian Reg. No. 760,688, dated September 22, 1998. While the term "FAP" is fanciful and has no translation, the English translation of the word "BELLISSIMA" is "very fine" and that of the word "CALZIFICIO" is "hosiery factory."

² Reg. No. 1,334,447, issued on May 7, 1985, which sets forth 1980 as the date of first use of the mark anywhere and in commerce; combined affidavit §§8 and 15. The English translation of the word "BELLISSIMO" is "very beautiful."

192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.³

Turning first to consideration of the respective goods, applicant asserts that its mark "will be applied to women's stockings" while registrant's mark "will be applied to children's dresses." According to applicant, "[t]he differences in the actual goods, without any other factor, is enough to ... obviate any possible confusion," given that "children's dresses are not sold in the same venue as women's stockings."

It is well settled, however, that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration, and not in light of what such goods are asserted to actually be. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where an applicant's and a registrant's goods are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration

³ The court, in particular, pointed out that: "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."

encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

The Examining Attorney, accurately observing that applicant's goods are in fact broadly identified in its application as "stockings," properly points out that, in view of the above, applicant's and registrant's goods are indeed closely related items of apparel for children. In particular, he correctly notes that (underlining in original):

Like registrant's goods, the stockings marketed by applicant would be worn by children. Although applicant refers to its goods as "women's stockings," it did not limit the identification of goods to stockings for women, so the identification of goods must be construed to include stockings for girls. The intended customers for applicant's goods are the same as for registrant's [goods], since adult women, a substantial portion of which are mothers, are the primary purchasers of both dresses for children and stockings.

Accordingly, and inasmuch as applicant's stockings and registrant's children's dresses additionally are products which would be sold through the same channels of trade, such as the girls' clothing or children's apparel sections of clothing stores, department stores and mass merchandisers, it is plain that confusion as to the source or sponsorship of the goods would be likely if they are marketed under the same or substantially similar marks.

Turning, therefore, to consideration of the respective marks, applicant argues among other things that "the distinctive visual appearance" of its mark "will clearly distinguish it" from registrant's mark.⁴ Specifically, applicant maintains that visually, as well as aurally, "the terms BELLISSIMA BY CALZIFICIO

⁴ Applicant asserts, for the first time in its brief, that because "[t]here is no evidence of wide spread use" of registrant's mark, such mark cannot be considered famous and therefore entitled to a broad scope of protection. However, the absence of evidence of use of registrant's mark is not evidence of the absence of such use nor does it show that registrant's mark is not famous. Instead, whether such mark is famous is simply not a relevant *du Pont* factor in this appeal.

Applicant also contends, likewise for the first time in its brief, that registrant's mark is weak, and therefore entitled only to a narrow scope of protection, because "the words 'Bellissimo' and/or 'Bellissima' ... are used in [marks which are the subjects of] a number of [third-party] registrations on a variety of goods." Aside from the fact that any information pertaining to such registrations is untimely at this juncture under Trademark Rule 2.142(d), the Board does not take judicial notice of third-party registrations. See, e.g., *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Moreover, even if applicant had timely supported its contention with copies of the various third-party registrations upon which it purports to rely, such would not in any event constitute proof of actual use of the registered marks and that the purchasing public, having become conditioned to encountering certain products under marks which consist of or include the terms "BELLISSIMA" or "BELLISSIMO," is therefore able to distinguish the source thereof based upon differences in such marks. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). Nevertheless, inasmuch as applicant has specifically mentioned in its brief that a third-party registration for the mark "'DOMINIC BELLISSIMO DB' was **allowed over** the ... [cited] registration for 'BELLISSIMO' despite the fact that both marks were applied to women's apparel and were independently owned" (emphasis by applicant), and the Examining Attorney in his brief has responded to applicant's argument that, because "the differences between the marks was found to be sufficient to distinguish between the two marks," the same result should occur in this case, we have considered such. However, as the Examining Attorney persuasively points out with respect to the mark in the third-party registration, "the connotation of BELLISSIMO is quite different in that mark because DOMINIC BELLISSIMO is the name of an individual." Accordingly, we agree with the Examining Attorney that: "The use of the term BELLISSIMO as a surname by one other party for clothing goods hardly allows one to draw the conclusion that the term is weak and deserving of [but] a limited scope of protection." Given, however, the lack of proof with respect to any of the other marks which are assertedly the subjects of third-party registrations, the

FAP create a multi-word mark [which stands] in stark contrast to the cited BELLISSIMO and design" mark. Applicant emphasizes, in this regard, that its mark "contains a stylized printed BELLISSIMA in a 'bridge' like design over the wording BY CALZIFICIO FAP while the cited mark is the word BELLISSIMO, set on an angle, in script, with a flower design." In view thereof, and inasmuch as applicant's mark "when read or spoken is an eleven syllable phrase" while registrant's mark "is a four syllable word," applicant insists that contemporaneous use of the respective marks is not likely to cause confusion.

Although the various differences noted by applicant are readily apparent on the basis of a side-by-side comparison of the respective marks, such a comparison is not the proper standard for determining whether there is a likelihood of confusion. The correct test, rather, is whether the marks at issue create basically the same overall commercial impression. The reason for utilizing such a test, as opposed to basing a decision on a side-by-side comparison, is that the latter ordinarily is not the way that customers will be exposed to the respective marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks at issue which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains only a general rather than a specific impression of marks. See, e.g., Grandpa Pidgeon's of

number and nature of similar marks in use on similar goods is not a

Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); Envirotech Corp. v. Solaron Corp., 211 USPQ 724, 733 (TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

With the foregoing in mind, we agree with the Examining Attorney that, when considered in their entirety, the marks "BELLISSIMA BY CALZIFICIO FAP" and design and "BELLISSIMO" and design are so substantially similar that, when respectively used in connection with such closely related goods as stockings and children's dresses, confusion as to source or sponsorship would be likely to occur. Applicant's mark, as the Examining Attorney observes in his brief, is dominated by the term "BELLISSIMA" due to the fact that such term appears in significantly larger lettering, and hence is much more prominently displayed, than the disproportionately smaller lettering used for the subordinate terms "BY CALZIFICIO FAP," which while designating the source of the "BELLISSIMA" brand of stockings is not likely to be readily noticed by a hurried shopper. Registrant's mark, as the Examining Attorney further notes in his brief, similarly is dominated by the term "BELLISIMO" since such term is not only more prominently displayed than the accompanying flower design, but it is the only literal element in the mark which serves as a source indicator. As the Examining Attorney properly points out, where, as here, a mark consists of a literal portion and a design portion, it is generally the literal portion which is more likely to be impressed upon a consumer's memory and to be used in

relevant *du Pont* factor in this appeal.

calling for and/or asking about the goods. See In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987).

In view thereof, it is plain that applicant's "BELLISSIMA BY CALZIFICIO FAP" and design mark and registrant's "BELLISSIMO" and design mark are substantially similar in sound and appearance, differing principally only in the vowel which forms the final letter of the dominant terms "BELLISSIMA" and "BELLISSIMO." To those consumers who may also be fluent in or have some knowledge of Italian, the respective marks would also be substantially similar in connotation, given that the dominant term "BELLISSIMA" in applicant's mark means "very fine" while the term "BELLISSIMO," which dominates registrant's mark, connotes "very beautiful."⁵ Overall, in light of such similarities, the marks at issue engender substantially the same commercial impression, especially when allowance is made for the fallibility of a consumer's memory with regard to the minor differences between applicant's mark and registrant's mark.

Accordingly, we conclude that customers who are familiar or acquainted with registrant's mark "BELLISSIMO" and design for its "children's dresses" would be likely to believe, upon encountering applicant's substantially similar mark "BELLISSIMA BY CALZIFICIO FAP" and design for its "stockings," that such closely related goods emanate from, or are sponsored by or associated with, the same source.

⁵ Additionally, to such consumers, the phrase "BY CALZIFICIO FAP" in applicant's mark, which would be regarded as meaning "by FAP hosiery factory," would have even less possible distinguishing significance due to the descriptiveness of the term "CALZIFICIO."

Ser. No. 75/866,321

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