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Mailed: September 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fabrica de Jabon La Corona, S.A. de C.V.

Serial No. 76330764

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Before Seeherman, Walters and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Fabrica de Jabon La Corona, S.A. de C.V. has filed an application to register the mark shown below on the Principal Register for "vegetable oils, namely corn oil."[1] The application includes a disclaimer of PURE CORN OIL and a statement that the stippling shown in the drawing on the ears of corn is for shading purposes only

[1] Serial No. 76330763, filed October 29, 2001, based on use of the mark in commerce, alleging first use and use in commerce as of June 11, 2001.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the standard character mark MONARCH and the design mark MONARCH, as shown below, both previously registered by the same entity for butter,[2] that, when used on or in connection with applicant's goods, it is likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The examining attorney contends that confusion is likely because MONARCA is the Spanish word for "monarch,"

[2] Registration Nos. 0652490 and 0652493, respectively, both issued October 1, 1957, to Saramar Corporation, in International Class 29. "Ice cream" has been deleted from the identifications of goods in both registrations. [Both registrations have been renewed; Section 15 affidavits for both registrations have been acknowledged.]

making the marks identical in meaning, as well as being quite similar in sound and appearance. She asserts that the CORN OIL portion of applicant's mark is generic and the word PURE and the corn design portion of the mark are highly descriptive; that the rectangular design in applicant's mark is merely a border and of little consequence in the mark; and, thus, that MONARCA is the dominant portion of applicant's mark; that the design portion of the mark in the stylized cited registration is small and below the wording and, thus, MONARCH is the dominant portion of that mark; and that there is no indication in the record that MONARCH is a weak term in connection with the identified goods.

Regarding the respective goods, the examining attorney contends that corn oil and butter "are very closely related 'edible fats' that are used for the same overall purpose in cooking and baking, and are essentially substitutes for each other in this context." (Brief, unnumbered p. 9.) In support of her position, the examining attorney submitted excerpts from numerous websites with recipes wherein the list of ingredients specifies "butter or vegetable oil"; copies of three registrations also owned by the cited registrant for a wide variety of food items, including both "butter" and "edible oils"; three third-party registrations for a wide variety of food items, including both "butter" and "edible oils"; nine third-party registrations for a more

limited list of food items including both "butter" and "edible oils"[3]; and excerpted articles from various websites about butter and light butter and comparing butter and margarine.

Applicant "acknowledges that MONARCA is translated from Spanish [as] MONARCH" but contends that "while the names MONARCH and PURE MONARCA CORN OIL may bear a passing resemblance, the commercial impressions generated by MONARCH and PURE MONARCA CORN OIL differ greatly" (brief, p. 4). Applicant contends the respective goods are different, which should prevent confusion among relevant consumers, asserting that they are found in different areas within a supermarket, butter being found in the refrigerated section, and corn oil being found in the baking dry goods aisle; that the products are physically different, noting that butter is a solid made from milk fats whereas corn oil is a liquid made from corn; that butter is the preferred edible fat and substituting corn oil for butter in baking results in "undesirable taste and texture" (brief, p. 6). In support of its position, applicant submitted excerpts from several websites about butter, from other websites about cooking oils, and one

[3] The examining attorney also submitted evidence of third-party registrations including butter and other solid edible fats in the list of goods. We do not consider these registrations to be relevant to this case involving corn oil and have not considered them in reaching our decision.

website excerpt about new formulations for replacing butter and saturated oils with unsaturated oils.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registered marks, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression.

Applicant's mark consists in part of the word "monarca," which both applicant and the examining attorney agree translates from Spanish to English as "monarch." This Spanish meaning of the word is reinforced by the crown design appearing above the "O" in "MONARCA." Thus, we find this an appropriate situation for applying the doctrine of foreign equivalents and concluding that the MONARCA portion of applicant's mark is identical to registrant's word mark and to the MONARCH portion of registrant's design mark. The Federal Circuit recently stated that "[u]nder the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine ... similarity of connotation in order to ascertain confusing similarity with English word marks." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d *supra at* 1377, 73 USPQ2d *supra at* 1696 (2005). The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Palm Bay,* 396 F.3d *supra at 1377*, 73 USPQ2d *supra at* 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). The "ordinary American purchaser" in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language. *See Trademarks and Unfair Competition,* at 23:26 (McCarthy, 4th ed.) ("The test is whether, to those American buyers

familiar with the foreign language, the word would denote its English equivalent."). There is no question that Spanish is a common foreign language spoken by an appreciable segment of the population.

When we evaluate the similarities between an English word mark and a mark containing a foreign word, we must, as in the comparison of two marks containing all English words, consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We agree with the examining attorney that MONARCA is the dominant portion of applicant's mark. Of the literal portion of the mark, it appears in the largest letters and, in relation to corn oil, it is arbitrary, whereas the phrase PURE CORN OIL in the mark is highly descriptive, if not generic in its entirety. Similarly, the cornhusk design is merely descriptive of the type of oil. A "'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting, In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). The design elements, i.e., the font, the corn husk design and the border, have less significance in the overall commercial impression of applicant's mark than the word portions of the mark, particularly when the mark is spoken. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) "([M]inor design features do not necessarily obviate likelihood of confusion arising from consideration of the marks in their entireties. Moreover, in a composite mark comprising a design and words, the verbal position of the mark is the one most likely to indicate the origin of the goods to which it is affixed").

Therefore, we find that applicant's mark is substantially similar to the word mark MONARCH in cited

registration no. 0652490. With respect to the design mark in cited registration no. 0652493, there is no question in our minds that the word MONARCH is the dominant portion of that mark. The font used is common and unlikely to stand out on its own and the circle design is much smaller than and below the wording, and the actual design within the circle is impossible to discern. We find that applicant's mark is also sufficiently similar to registrant's design mark that, if used in connection with similar or related goods, confusion as to source is likely.

We note that, for the first time in its brief, applicant argues that the term MONARCH in the registered marks is likely to connote, in connection with butter, a monarch butterfly rather than a ruler. Applicant has provided no evidence or justification for this argument and we find it unpersuasive.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See also, Octocom Systems, Inc. v. Houston Computer Services, Inc.,* 918 F.2d 937, 16

USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

In the case before us, applicant and the examining attorney spend a great deal of their time and evidence distinguishing butter from vegetable oil, which includes corn oil; distinguishing both products from margarine; and discussing the relative merits of each for health, cooking and baking. However, this is relevant only to the extent that discussions of the relative merits of butter versus vegetable oil would appear to indicate that they are generally accepted as interchangeable ingredients. We note, particularly, applicant's contention that purchasers will not confuse the respective products and remind applicant

that the issue is not whether purchasers will confuse the goods themselves, but rather whether purchasers are likely to be confused as to the source of the goods. The facts before us establish that both butter and corn oil are edible fats; that corn oil is a vegetable oil; that both butter and vegetable oil are used in cooking and baking; and that, in the vast majority of the many recipes submitted by the examining attorney, butter and vegetable oil are interchangeable. The manner in which the two products are stored is not significant; and, although they may be found in different areas within a store, both are likely to be found in the same stores and sold to the same consumers, often for the same, related or complementary end use.

The examining attorney also submitted a significant number of third-party registrations, all based on use in commerce, that include both butter and vegetable or corn oil among the goods listed. Although third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and

In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988). While the few registrations that cover a wide range of food products are not probative, there were a significant number of registrations that had limited lists of goods, with butter and vegetable oil listed with mostly dairy products in these registrations. We also note the registrations owned by the registrant, not cited by the examining attorney but of record, that include among the listed goods both butter and vegetable oil. Therefore, viewing the evidence together, we find strong support for finding butter and corn oil to be closely related products.

With regard to applicant's assertion that it is aware of no instances of actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant, we note that, while a factor to be considered, the absence or presence of actual confusion is of little probative value where we have little evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. *See, In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, and registrant's two marks, their contemporaneous use

on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

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