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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wellshire Farms, Inc.

Serial No. 78157145

Frank A. Mazzeo for Willshire Farms, Inc.

Elissa Garber Kon, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Willshire Farms, Inc. filed an application to register
the mark PRIMO NATURALE for "meats."¹

The trademark examining attorney refused registration
under Section 2(d) of the Trademark Act, 15 U.S.C.

§1052(d), on the ground that applicant's mark, if applied
to applicant's goods, would so resemble the previously

¹ Application Serial No. 78157145, filed August 23, 2002, based
on a bona fide intention to use the mark in commerce.

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registered mark PRIMO for "sausages"² as to be likely to cause confusion. The examining attorney also refused registration due to applicant's failure to comply with a requirement to disclaim the term "NATURALE" apart from the mark.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs.

Given the somewhat unusual prosecution history of this application, a brief review of the pertinent history is in order. In response to the final refusal grounded on likelihood of confusion and failure to comply with the disclaimer requirement, applicant filed a notice of appeal. Within an extended period of time to file its appeal brief, applicant filed, on December 28, 2005, a request for reconsideration that included a proposed amendment to the identification of goods, and a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). The Board suspended the appeal and remanded the application to the examining attorney. The examining attorney, in a non-final Office action dated January 24, 2006, continued the refusals, and also noted

² Registration No. 2156791, issued May 12, 1998; renewed. The registration issued pursuant to a claim of acquired distinctiveness under Section 2(f). The registration includes the following statement: "The English translation of the word 'PRIMO' is 'first.'"

that applicant's proposed amendment to the identification of goods and claim of acquired distinctiveness raised new issues. Applicant sought to amend the identification from "meats" to "all natural meat products," but the examining attorney found the terminology "meat products" to be indefinite. The examining attorney gave guidance to applicant regarding acceptable terminology. As to the Section 2(f) claim, the examining attorney indicated "[a]pplicant must either delete the statement of acquired distinctiveness from the application or explain why it believes that a claim of distinctiveness is necessary, because the mark appears to be inherently distinctive." The examining attorney concluded, "[a] claim of distinctiveness is not needed in this case." The examining attorney went on to address the sufficiency of applicant's claim, indicating that the record did not support acquired distinctiveness, and also pointing out the options regarding the proof required to establish acquired distinctiveness in an intent-to-use application. Applicant filed, on July 21, 2006, a communication that was essentially non-responsive, and the examining attorney, on September 13, 2006, issued a final refusal pertaining not only to the likelihood of confusion ground and the disclaimer requirement, but to the indefinite

identification of goods and the insufficiency of the Section 2(f) claim as well. The examining attorney continued to maintain that a claim of acquired distinctiveness was unnecessary, and that even if the evidence in support of the claim was found to be sufficient, acquired distinctiveness did not contravene a refusal based on Section 2(d). The examining attorney added that in the event that applicant was claiming acquired distinctiveness as to only part of the mark, in this case, "NATURALE," the evidence in support of the claim fell short of proving same given the genericness of the term. The Board, in an order dated October 12, 2006, resumed the appeal and allowed applicant time to submit a brief. The Board also indicated that the six-month response clause in the examining attorney's September 13, 2006 Office action "is not applicable under the circumstances of this case." After receiving several extensions of time, applicant and the examining attorney filed briefs. Applicant, in its appeal brief, addressed only the refusals pertaining to the disclaimer requirement and likelihood of confusion. The examining attorney noted this, and likewise addressed only these two refusals.

Although the examining attorney technically found that applicant's Section 2(f) claim was insufficient, more

significantly the examining attorney maintained in his final refusal that resort to Section 2(f) was not necessary. Throughout the prosecution applicant made attempts to put its application in condition for publication. The examining attorney rejected the proposed amendment to claim the benefits of Section 2(f), and subsequently applicant essentially elected to no longer pursue a Section 2(f) claim. Inasmuch as applicant did not address acquired distinctiveness in its brief, we presume that applicant no longer wished to rely on Section 2(f). Nor did applicant ever state that it was seeking to claim acquired distinctiveness as to only part of the mark. See TMEP §1212.02(d) (5th ed. 2007). Accordingly, we see no reason to further consider the claim of acquired distinctiveness that we now view as effectively withdrawn by applicant.

As to the proposed amendment to the identification of goods, applicant sought to amend it from "meats" to "all natural meat products." The examining attorney refused to enter the amendment, contending that "products" is indefinite. This is not a case where the amendment was offered to counter a finding that the terminology is indefinite. The original identification "meats" was found to be acceptable, but applicant nevertheless proposed an

amendment. When the examining attorney denied the proposed amendment to the identification, applicant did not further pursue the amendment. Accordingly, we presume that applicant was satisfied with its acceptable original identification "meats," and we see no reason to consider the acceptability of the identification of goods. See TMEP §1402.07(d) (5th ed. 2007). It is this identification of goods that we will use in determining the issues on appeal.

There also is an evidentiary point to address before we turn to consider the substantive refusals. In its brief, applicant requests the Board, in two instances, to take judicial notice of third-party registrations; the first group of registrations pertains to its likelihood of confusion argument, and the second group bears on the disclaimer issue. Applicant alternatively requests that, in the event the Board declines to take judicial notice of the new evidence, the appeal be suspended and the application be remanded to the examining attorney for consideration of this evidence. The examining attorney, in her brief, objected to applicant's request.

The request to take judicial notice is denied. The Board does not take judicial notice of official records. *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986).

Further, a remand is not justified at this late juncture of the appeal. Trademark Rule 2.142(b) provides that the evidentiary record in an application should be complete prior to the filing of the appeal, and additional evidence filed after appeal generally will not be considered. Thus, applicant's alternative request for a remand is denied.³ See TBMP §1207 (2d ed. rev. 2004).

Disclaimer

The examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 6 of the Trademark Act, 15 U.S.C. §1056. Merely descriptive or generic terms are unregistrable under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e), and therefore are subject to disclaimer

³ The additional evidence, even if considered, would not change the result herein. The six additional third-party registrations of PRIMO marks are merely cumulative of the other registrations earlier made of record. Likewise, the list of third-party applications and registrations of marks comprising, in part, NATURALE with no disclaimer of this term is not probative. Applicant merely submitted a list, and not copies of the registrations or applications. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) [mere listings of registrations are not sufficient to make them of record]; and TBMP §1208.02 (2d ed. rev. 2004). Moreover, the existence of third-party registrations showing no disclaimer of "NATURALE" is not dispositive. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court."]. Finally, the applications, even if copies were submitted, are probative of nothing more than that the applications were filed.

if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

In the present case, the examining attorney maintains that because the term "naturale" translates as "natural," and this term is generic for a genus of goods known as "natural" meats, a disclaimer is required. In support of the disclaimer requirement, the examining attorney submitted excerpts of applicant's website, as well as of the websites of third parties.

Applicant argues against the disclaimer requirement, contending that the term "naturale" "does not immediately tell an average prospective purchaser what the goods are or something about the goods." Applicant goes on to specifically argue as follows:

Since all meats are natural products in the sense that they are from livestock, it is unclear what the term NATURALE implies. For example, are the meats somehow "more" natural than other "regular" meats, and if so, in what way? NATURALE does not indicate a specific manner or process by which Applicant's meat goods are more natural than other meat goods. It cannot be a descriptive term if its meaning is unclear.

(Brief, p. 11).

In considering the propriety of the disclaimer requirement in the present case, we see no reason to engage in a genericness analysis of the term "naturale." To warrant a disclaimer, it is enough that the term is merely descriptive when applied to the goods.

A term is merely descriptive if it immediately describes the ingredients, qualities or characteristics of the goods or if it conveys information regarding a function, purpose, or use of the goods. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). We look at the mark in relation to the goods, and not in the abstract, when we consider whether the mark is descriptive. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1783 (Fed. Cir. 2003). It is well settled that to be "merely descriptive" a term need only describe a single significant quality or property of the goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

It is undisputed, as evidenced by applicant's statement in the application, that the Italian term "naturale" translates to "natural" in English. See Cassell's Italian Dictionary (1967) (of which we take judicial notice). The term "natural" means "not produced or changed artificially; not altered, treated or disguised;

faithfully representing nature or life." The American Heritage Dictionary of the English Language (4th ed. 2000) (of which we take judicial notice). The examining attorney introduced several excerpts of websites showing that applicant and others in the meat industry use the term "natural" to describe their products:

[Applicant's] brand of Smoked Sausage are made of All Natural pork that is raised free of drugs, chemicals, and growth stimulants. There are no added artificial flavors, colors, food starches or fillers...Tasty varieties to choose from are the All Natural Pork Kielbasa, All Natural Pork Andouille... (www.wellshirefarms.com)

Aloha and welcome to Hawaii natural meats. We are the purveyors of Kamuela pride certified naturally-raised, grass-fed beef and lamb...we have established a company which serves as a link between ranchers of Hawaii and a growing community of health conscious individuals seeking a natural meat product. (www.kamuelapride.com)

We do not buy from other stockers or sale barns; this enables us to guarantee high quality, all natural meats. (www.peacefulpastures.com)

Welcome to Chicago Prime Cuts, the finest purveyor of superior quality, humanely raised, all natural meats. (www.chicagoprimecuts.com)

The Whole Foods Market standards for natural meat and poultry go far beyond what the US Department of Agriculture

requires for labeling meat or poultry as "natural." All of our meat and poultry offerings are minimally processed with no artificial additives or preservatives (as required by the USDA for "natural" labeling)...Whole Foods Market is proud of our role as a leader in the natural meat industry...We offer a wide variety of meats, including game, duck, sausages, low fat cuts, range-grown turkey and natural chicken.
(www.wholefoodsmarket.com)

The record establishes that the term "natural" is used in connection with a specific type of meat product, that is, one free of anything artificial. Thus, the term NATURALE in applicant's marks describes a laudatory feature or characteristic of applicant's meats, namely that the products are free of artificial additives. This fact is confirmed by applicant on its website. Thus, at the very least, the term is highly descriptive of applicant's goods.

In view thereof, the requirement of a disclaimer of the term NATURALE is affirmed.

Likelihood of Confusion

The examining attorney maintains that the marks are similar; more specifically, that applicant has adopted the entirety of registrant's mark and merely added a highly descriptive/generic term that fails to distinguish the marks. The examining attorney also asserts that the goods

are legally identical. In support of this refusal, the examining attorney introduced copies of third-party registrations and excerpts of third-party websites to show that "meats" and "sausages" are closely related products. Pursuant to the examining attorney's request, we take judicial notice of the dictionary definition of the term "sausage" (see infra).

Applicant contends that PRIMO is a laudatory term, and that the coexistence of several third-party PRIMO marks for food products warrants a finding of no likelihood of confusion. In support of its position, applicant submitted third-party registrations comprising, in part, PRIMO for food products. Applicant also states that the marks and the goods sold thereunder are different.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544

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F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to compare applicant's "meats" with registrant's "sausages." In determining the issue of likelihood of confusion in ex parte cases, the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Where the goods in the cited registration and/or application are broadly identified as to their nature and type (as is the case herein with applicant's identification), such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *Id.*

The term "meats" in applicant's identification is broadly worded and is presumed to encompass all types of meats, including sausages. Lest there be any doubt about this *du Pont* factor, the record includes a dictionary

definition of "sausage": "finely chopped and seasoned meat, especially pork, usually stuffed into a prepared animal intestine or other casing and cooked or cured." The American Heritage Dictionary of the English Language (3rd ed. 1992). Thus, to state the obvious, sausage is a particular type of meat. For purposes of our likelihood of confusion analysis, the goods are considered to be legally identical. Various types of meats, including sausages, move through the same trade channels (e.g., grocery stores, supermarkets and, as shown by the examining attorney's evidence, on-line retailers) to the same classes of purchasers, namely, ordinary consumers. Further, these individuals would be expected to exercise nothing more than ordinary care in their purchasing decisions. The goods are presumed to include relatively inexpensive meats and sausages, and thus are capable of being purchased on impulse.

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). 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 their entireties that confusion as to the source of the goods 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. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In considering the marks, we also note that when marks are used in connection with legally identical goods, as is the case herein, "the degree of similarity [between the marks] 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).

Registrant's mark PRIMO and applicant's mark PRIMO NATURALE are similar in sound, appearance, meaning and overall commercial impression. Both begin with the identical term, and applicant has merely added a highly descriptive (if not generic) term to its mark.

The addition of NATURALE in applicant's mark does not serve to sufficiently distinguish it from registrant's mark. The general rule is that a subsequent user may not appropriate the entire mark of another and avoid a likelihood of confusion by adding descriptive or

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subordinate matter thereto. Thus, "if the dominant portion of both marks is the same [as is the case herein], the confusion may be likely notwithstanding peripheral differences." TMEP §1207.01(b)(iii) (5th ed. 2007). See, e.g., *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) [HEWLETT PACKARD and PACKARD TECHNOLOGIES]; *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) [MACHO and MACHO COMBOS]; *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) [RESPONSE and RESPONSE CARD]; and *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) [CONFIRM and CONFIRMCELLS]. The present case is no exception.

The existence of the various third-party registrations of PRIMO marks in the food products field does not persuade us to reach a different result. Applicant submitted copies of thirty-six third-party registrations for goods listed in Class 29. Although not specifically articulated by applicant, it would appear that it is urging that its mark falls into one of the exceptions to the above stated rule regarding additions to marks, namely, when the matter common to the marks (in this case, PRIMO) is not likely to be perceived by purchasers as distinguishing source because it is diluted. See, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004).

These third-party registrations are not evidence of use of the subject marks in the marketplace, nor do they show that the public is familiar with those marks. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ["The existence of [third-party] registrations is not evidence of what happens in the market place or that customers are familiar with them..."]. However, third-party registrations may be used in the manner of dictionary definitions to show that a term has a particular significance or meaning within an industry. See *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 585 (TTAB 1975).

The term "primo" may be found in an English dictionary and is defined as "first" or "first class." Webster's Third New International Dictionary (unabridged ed. 1993) (of which we take judicial notice). The term "primo" is also found in an Italian dictionary, translating to "first, foremost, leading" in English. Cassell's Italian Dictionary (1967) (of which we take judicial notice). This meaning and/or translation and the number of registrations containing the term PRIMO for food products is evidence that PRIMO is at least a highly suggestive term for such

goods. Even assuming *arguendo* that consumers are accustomed to distinguishing the several PRIMO marks for food on the basis of other portions of the marks, we do not view this to be the case by the mere addition of the term NATURALE. As discussed above, the term NATURALE is highly descriptive, if not generic when used in connection with food items. Thus, we simply do not believe that consumers would look to NATURALE in applicant's mark as a distinguishing or source-indicating feature and as a result not be confused between PRIMO and PRIMO NATURALE for meats and sausages. Rather, we find that consumers familiar with registrant's sausages sold under the mark PRIMO, upon encountering applicant's mark PRIMO NATURALE for meats, would be likely to be confused as to the source of applicant's goods, mistakenly believing that applicant's mark identifies a natural line of meats emanating from registrant. Applicant could, based on its identification of "meats," use its mark on sausages similar to registrant's, and both applicant's and registrant's products might be found next to or near each other in the supermarket. The fact that the goods can be purchased on impulse only adds to the likelihood of confusion, since a consumer is not likely to engage in any deliberation about whether the additional term NATURALE identifies a separate

source of the goods; moreover, because, as we have said, NATURALE will be viewed as merely describing that the meat has no additives, even a careful consumer is not likely to regard the differences in the marks as indicating that the goods emanate from separate sources. In short, for the reasons we have discussed--the legal identity of the goods, channels of trade and customer, the similarity of the marks, and the fact that the goods will be purchased by ordinary consumers who may buy the products on impulse--consumers are likely to believe that the products sold under these similar marks come from a common source.

In comparing the marks, we have not ignored the subordinate NATURALE portion of applicant's mark. Indeed, we have considered applicant's mark PRIMO NATURALE in its entirety, and find that this mark is similar to registrant's mark PRIMO in sound, appearance, meaning and commercial impression.

One last point requires comment. During prosecution, applicant claimed that the term "primo" connotes "first" and therefore is laudatory and does not function as a mark. To the extent that applicant's allegations constitute a collateral attack on registrant's registration, they are impermissible. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of

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registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant's nonuse of the mark). *In re Dixie Restaurants*, 41 USPQ2d at 1534; and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP § 1207.01(d)(iv) (5th ed. 2007). Accordingly, no consideration has been given to applicant's arguments in this regard.

In view of the above, the likelihood of confusion refusal is affirmed.

Decision: The refusals to register are affirmed.