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August 7, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bianchi Vending S.p.A.

Serial No. 78218441  
(filed February 24, 2003)

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Before Seeherman, Rogers, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Bianchi Vending S.p.A., an Italian corporation, filed an application to register the following mark:<sup>1</sup>



for "automatic vending machines for dispensing cold beverages, warm beverages, and packaged food items" in

<sup>1</sup> The application contains a statement describing the mark as consisting of "the word BIANCHI in special type lettering appearing between two parallel lines and an arbitrary design."

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International Class 9.<sup>2</sup> The application contains a statement that the English translation of BIANCHI is "white."

The examining attorney has refused to register the mark under Section 2(d) of the Trademark Act because of two registrations for the mark BIANCHI (in typed character format) for "coffee making machines for commercial use" in International Class 11<sup>3</sup>, and "coffee" in International Class 30.<sup>4</sup> The registrations are owned by the same entity.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the 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 & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

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

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<sup>2</sup> Application Serial Number 78218441 is based on a foreign registration and applicant's statement that it has a bona fide intent to use the mark in commerce, under Sections 44(e) and 1(b) of the Trademark Act.

<sup>3</sup> Registration No. 1344186 issued on June 25, 1985; renewed.

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in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Azteca Rest. Enter., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

We turn to the first *du Pont* factor, i.e., whether applicant's mark and registrant's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first *du Pont* factor 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 impression 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). We further note that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their

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<sup>4</sup> Registration No. 2127295 issued on January 6, 1998. Section 8 and 15 affidavits have been accepted and acknowledged. A Section 9 renewal application was received on April 9, 2008.

imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980).

In comparing the marks, we initially note that the dominant element of applicant's mark is the literal portion, i.e., BIANCHI, because it is by this term that consumers will refer to or call for the goods, and will be recognized and used by purchasers as the primary means of source identification. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987) [When a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services.] Moreover, attention is drawn to this term by applicant's use of the two parallel lines in the mark that serve as a border for the term BIANCHI.

The mark in the cited registrations is BIANCHI, presented in typed character format. As such, the dominant element of applicant's mark is phonetically identical to registrant's mark. As to appearance, the ordinary upper and lower case lettering employed by applicant is not distinctive and does not distinguish the marks. Because the registered mark is in typed character format, it could reasonably be displayed in the same stylized lettering form as applicant's, thereby increasing the visual similarity of the two marks. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000)

(typed drawings are not limited to any particular rendition of the mark). See also *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971).

Applicant's primary argument with respect to the marks is that the marks "do not create the same commercial impression" because of "the distinct design element in applicant's mark." Brief, p. 4. Applicant does not elaborate or even describe what is the alleged different commercial impression. Regardless, we note that the design element is described in the application as an "arbitrary design" and find that it does very little, if anything, to help distinguish applicant's mark from the registered mark.<sup>5</sup> Instead, we conclude that applicant has essentially incorporated the registrant's mark, BIANCHI; and applicant's use of stylized lettering, a border surrounding the term and an abstract design do not serve to distinguish the two marks.

Insofar as connotation or commercial impression is concerned, BIANCHI is translated into English as meaning "white" - a translation statement to this effect is contained in the application as well as the two

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<sup>5</sup> Because applicant cannot control how individuals will perceive the design element in its mark, we must also consider the possibility that others may view the design as an abstract representation of a hot beverage, with steam rising therefrom. So perceived, the design may actually reinforce an association with the BIANCHI brand goods of registrant, rather than distinguish the marks.

registrations. Thus, to the extent that persons familiar with this translation may encounter the marks, the marks convey the same connotation and commercial impression. Further, even many unfamiliar with the translation of the term may find the marks to create the same impression, e.g., that BIANCHI is a coined term or an Italian name or word, even if the meaning is unknown.

When we compare these marks in their entireties, with appropriate weight given to the literal term BIANCHI in applicant's mark, which is identical to registrant's mark, we find that the marks are identical phonetically and are highly similar in appearance, connotation and commercial impression. This factor strongly supports a finding of likelihood of confusion.

We now consider whether the goods of applicant and registrant are related. It is well established that the goods of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society*

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*for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Again, applicant's goods are "automatic vending machines for dispensing cold beverages, warm beverages, and packaged food items." The cited registrations cover "coffee making machines for commercial use" and "coffee." Clearly, the goods are not the same; however, based on the evidence, we find the goods to be related.

In support of his refusal and to show a relationship between the respective goods, trade channels, and purchasers, the examining attorney submitted printouts from various third-party websites.<sup>6</sup> These websites demonstrate that coffee-dispensing vending machines and commercial

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<sup>6</sup> Attached to Office Actions issued July 27, 2006 and March 16, 2007. The examining attorney also submitted twelve third-party registrations indicating registration under the same mark for goods including those of applicant and those of the cited registrants. However, ten of these registrations are owned by foreign entities, based on Section 44(e) (ownership of a foreign registration) and do not reflect use in commerce. These registrations therefore are not indicative of a common source in the United States of the goods identified therein and have no real probative value. As stated in *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6, third-party registrations which are based upon foreign registrations "are not even necessarily evidence of a serious intent to use the marks shown therein in the United States on all of the listed goods and services, and they have very little, if any, persuasive value on the point for which they were offered."

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coffee machines and/or coffee are sold or supplied by the same entities and that these products are aimed at the same consumers. For example, the Cuda Coffee Vending website ([www.cudacoffeevending.com](http://www.cudacoffeevending.com)) touts a "coffee vending business" and offers "coffee vending machines" as well as coffee. This same website describes the benefits of having such a coffee machine in the office by citing to an excerpt from The Washington Post newspaper, that "companies have to make offices seem more like home. The coffee perk could boost productivity, make workers feel more appreciated..."

The American Vending Coffee Service website ([www.americanvendingonline.com](http://www.americanvendingonline.com)) also advertises an "office coffee service" and offers a wide variety of machines that include coffee (and snack) vending machines as well as coffee-dispensing and brewing machines. The machines are also advertised as being capable of dispensing a variety of other hot beverages, including hot chocolate, tea, etc.

The AAA Vending, Coffee & Espresso Systems website ([www.javaespresso4u.com](http://www.javaespresso4u.com)) offers vending machines for sodas and snacks in addition to offering "espresso and cappuccino machines," akin to registrant's, that are available in a "wide range of sizes" and can dispense various hot beverages.

The examining attorney also submitted printouts from applicant's website ([www.bianchivending.com](http://www.bianchivending.com)) which show that

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applicant, itself, manufactures a coffee machine advertised as suitable for "workplace, leisure, hotels & restaurants" and "ideal for small offices and restaurants." Applicant's vending machines that dispense espresso, coffee and other hot beverages are also featured on the website.

Based on the evidence of record, we find the respective goods to be related in that both applicant's vending machines and the registrant's commercial-use coffee making machines have one common purpose, i.e., dispensing hot beverages in a commercial and/or office environment. Also, the same class of purchasers, namely, the vending machine consumer who purchases or leases such machines for use by the public might also purchase the coffee to use in those machines, i.e., the same class of purchasers would be customers for both vending machines and coffee. As a result, there is a likelihood of reverse confusion, i.e., that a purchaser of coffee-dispensing vending machines is likely to believe, upon seeing the virtually identical mark for coffee, that the BIANCHI coffee emanates from the same source and is designed to be used with applicant's coffee-dispensing vending machines.

Moreover, as the evidence bears out, the goods may travel in the same trade channels inasmuch as the coffee-dispensing vending machines, such as applicant's, may be obtained from the same online retailers who sell or provide

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coffee machines for commercial use. Commercial consumers, such as a business office or automobile dealership seeking to install or replenish a coffee-dispensing machine in a lobby or waiting room, are likely to encounter both applicant's and registrant's goods. And consumers already familiar with registrant's goods sold under the mark BIANCHI are likely to conclude that applicant's goods, sold under the very similar mark BIANCHI and design, are associated with the same source.

We add that even if the consumers of these products were careful purchasers, "even careful purchasers are not immune from source confusion." *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999). That is particularly true in this case, where the marks are so very similar. Even sophisticated consumers are not likely to view the design element of applicant's mark as indicating a separate source from BIANCHI coffee makers for commercial use and coffee; rather, if they note the design and upper and lower case stylization of applicant's mark, they are likely to consider applicant's mark merely as a variation of the registered mark BIANCHI.

We therefore find that the *du Pont* factors involving the similarities between the goods, trade channels and purchasers all weigh in favor of a finding of likelihood of confusion.

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Upon balancing the relevant *du Pont* factors, we conclude that consumers familiar with registrant's coffee machines for commercial use and coffee, sold under its mark BIANCHI, would be likely to believe, upon encountering applicant's similar mark BIANCHI (stylized with design) for automatic vending machines for dispensing cold beverages, warm beverages, and packaged food items, that the goods originate with or are associated with or sponsored by the same entity.

**Decision:** The examining attorney's refusal to register applicant's mark BIANCHI (stylized with design) for the identified goods on the ground that it is likely to cause confusion with the cited registrations is affirmed.