

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mille Miglia Caffee, L.L.C.

Serial No. 78732701
Serial No. 78732725

G. Brian Pingel of the Brown Winick Law Firm for Mille Miglia Caffee, L.L.C.

Woodrow N. Hartzog, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Drost, Zervas and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Mille Miglia Cafee, L.L.C. filed intent to use applications for the marks AMICI ESPRESSO¹ and AMICI COFFEE,² both in standard character form, for the following description of services, as amended:³

Food kiosk services, in Class 35; and,

¹ Serial No. 78732701, filed October 13, 2005. Applicant disclaimed the exclusive right to use the word "espresso," and translated the word "amici" as "friends."

² Serial No. 78732725, filed October 13, 2005. Applicant disclaimed the exclusive right to use the word "coffee," and translated the word "amici" as "friends."

³ Because the applications were filed by the same applicant, reviewed by the same examining attorney, and involve common issues of fact and law, we have consolidated the appeals.

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Snack-bar services; office snack bar supply services;
and salad bars, in Class 43.

Registration has been refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's marks, when used in connection with its services, so resembles the mark AMICI, shown below, for "restaurant, bar and catering services" as to be likely to cause confusion.⁴



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. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between

⁴ Registration No. 2365864, issued July 11, 2000, Sections 8 and 15 affidavits, respectively, accepted and acknowledged. Registrant translated "amici" as "friends."

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the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 UPSQ 24 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co., supra.* In analyzing the similarity or dissimilarity of the marks, 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 overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1835, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). In making this determination, we must consider the recollection of the average purchaser who normally retains only a general, rather than a specific, impression of the marks. *Sealed*

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Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

While marks must be compared in their entireties, it is not improper to accord more or less weight to a particular feature of a mark. *In re National Data Corp.*, 753 F.2d 1056, 24 USPQ2d 749, 751 (Fed. Cir. 1983). In the applications, the word "amici" is the dominant portion of the marks because the words "espresso" and "coffee" are descriptive for beverages served in food kiosks and snack bars. Applicant acknowledged the descriptive nature of the words "espresso" and "coffee" by disclaiming the exclusive right to use those words. Case law recognizes that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting*, *In re National Data Corp.*, 24 USPQ2d at 752 ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion"). *See also In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). In this case, the descriptive words

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"espresso" and "coffee" are unlikely to be used to distinguish the marks.

The significance of the word "amici" is further reinforced by its location as the first word in applicant's mark. As such it is the first word consumers will see when encountering applicant's services (and marks) and it is more likely to have a greater impact on purchasers and be remembered by them. *Presto Products Inc. v. Nice-Pak Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed on the mind of a purchaser and remembered). See also *Palm Bay Imports Inc. v. Vieve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Vieve" is the most prominent part of the mark VUEVE CLICQUOT because "vieve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

In comparing the registered mark and applicant's marks, we note that applicant's marks contain the entire literal portion of the registered mark, omitting only the stylized display. Likelihood of confusion is often found where the entirety of one mark is incorporated within

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another. *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing). In these applications, applicant's addition of the descriptive words "espresso" and "coffee" to the arbitrary word "amici" does not distinguish applicant's marks from the registered mark. *In re Xerox Corp.*, 194 449 (TTAB 1977) ("6500" and "6500 LINE" are basically the same because the addition of the descriptive word "line" does not distinguish the marks). *See also, The Wella Corp, v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (the inclusion of a suggestive or descriptive word to an otherwise arbitrary term will not preclude a finding of likelihood of confusion).

Contrary to applicant's argument, the stylized display of the registered mark is not so distinctive as to render the marks visually dissimilar. Moreover, since applicant has filed its applications in standard character form, the

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rights associated with the marks reside in the wording itself, and applicant is free to adopt any style of lettering, including lettering identical or similar to that used by registrant. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). Accordingly, we find that the marks are similar in appearance.

We also find that the marks are aurally similar because applicant's marks are dominated by the word "amici" which is the first word in the marks.

Applicant and registrant have translated the word "amici" as "friends." Applicant's marks are, in essence, "Espresso Friends" (or "Friends Espresso") and "Coffee Friends" (or "Friends Coffee"). We find that the marks have similar meanings derived from the translation of the word "amici" as "friends."

Finally, we find that the marks engender the same commercial impression because they share the word "amici," or "friend," that implies that applicant's and registrant's businesses are places to meet friends. Applicant concedes this point in its brief when it states that "the term 'Amici' is a natural term for use in connection with food

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services" because "it carries with it a positive connotation that emphasizes socializing with friends."⁵

Applicant's argument that the use of the candle designs in the registered mark conveys the connotation of fine dining does not persuade us that the marks convey different commercial impressions. First, as indicated *supra*, the candle designs in registrant's mark are not so distinctive as to form a viable basis for distinguishing the marks. Because the candle designs are not so distinctive, we find that the dominant portion of registrant's mark is the literal portion of the mark. It is the word "amici," not the candle designs, which consumers will recognize and use to refer to registrant's services. See *In re Appetito Provisions Co.*, 3 UPSQ2d 1553, 1554 (TTAB 1987). Because the word "amici" is the dominant feature of registrant's mark, it is accorded more weight in our comparison of the marks. Second, even assuming applicant is correct in asserting that registrant's mark connotes "fine dining candle light dinner," it also connotes friendly dining by virtue of the word "amici." Finally, because of the similarity in appearance, sound and meaning of the marks, customers

⁵ Applicant's Brief, p. 10.

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familiar with the registered mark may believe that the registrant has expanded its services.

In view of the foregoing, we find that the similarity of the marks is a *du Pont* factor that weighs in favor of a finding of likelihood of confusion.

B. The similarity or dissimilarity and nature of the services.

Applicant is seeking to register its marks for food kiosk services, snack bar services, office snack bar supply services, and salad bars. The registered mark is for restaurant, bar and catering services. While applicant "acknowledges that its services have somewhat of a relationship to certain of the services of the cited registrations (sic),"⁶ it contends that the services "are sufficiently dissimilar so as to serve as a basis for a determination that there is no likelihood of confusion."⁷ On the other hand, the examining attorney submitted copies of numerous third-party registrations based on use in commerce for marks registered for the services rendered by both parties. These registrations have probative value to the extent that they serve to suggest that the services may

⁶ Applicant's Brief, p. 8.

⁷ Applicant's Brief, p. 9.

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emanate from a single source. *In re Infinity Broadcasting Corporation*, 60 USPQ2d 1214, 1217–1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1267, 1470 n.6 (TTAB 1988).

The following representative third-party registrations purport to show a relationship between applicant's services and registrant's services:⁸

Mark	Reg. No.	Services
RITAZZA	2961914	Restaurant, catering, snack bar, coffee shop services, and providing food and beverages via food carts
NOREENA	2788721	Food kiosk services, restaurant services
LEGOLAND	2334535	Restaurant services, food kiosk services, snack bar services
EASY LIFE	2560070	Restaurant services, snack bar services, salad bars
SAWEIMA	2798511	Restaurant services, snack bars, office coffee supply services, salad bars
E LEISURE STATION	2748247	Snack bars, restaurant services, office coffee supply services, salad bars

⁸ In the following table, we have not included the entire description of services for each of the subject registrations. Only the services set forth in applicant's applications and the cited registration are included in the table.

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Mark	Reg. No.	Services
ISLA	2785883	Restaurant services, catering services, salad bars, snack bars
THE BUONA COMPANIES	2960222	Restaurant and catering services, food kiosk services at sporting events
LEO'S LATTICINI	2724108	Restaurant services, snack bars, salad bars, catering services
CREPEMAKER	2863876	Food kiosk services, café services

In addition, the Examining Attorney submitted a web page from the CANTEEN website, a food service supplier, promoting the fact that it supplies menu items from well known restaurants in Canteen's food kiosks. For example, Canteen food kiosks feature menu items from, *inter alia*, Blimpie, Tony Roma's, and Au Bon Pain. Specifically, Canteen is advertising that it sells restaurant branded foods at its food kiosks.

Finally, the Examining Attorney submitted web pages from online newspapers discussing salad bars offered by Ruby Tuesday restaurants and Brick Oven restaurants.

While it is true that the services at issue are different, the question is not whether purchasers would confuse them (food kiosk services, snack bar services,

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office snack bar supply services, and salad bars versus restaurant, bar and catering services), but rather whether purchasers are likely to confuse the source of the services. *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 UPSQ2d 1618, 1624 (TTAB 1989); *In re Permagrain Products, Inc.*, 223 USPQ 147, 148 (TTAB 1984). See also *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975) ("In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties"). Thus, it is sufficient if the respective services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, *supra* at 1785; *In re International Telephone & Telegraph Corp.*, 197 UPSQ 910, 911 (TTAB 1978).

As noted above, the Examining Attorney has made of record third-party registrations and web pages that show various entities have adopted a single mark for services

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that are identified in both the applications and the cited registration suggesting that such services may emanate from the same source. The Canteen web page demonstrates that at least some restaurants may sell their menu items through food kiosks thereby evidencing a relationship between restaurant services and food kiosk services.

In view of the foregoing, we find that this *du Pont* factor favors a finding of likelihood of confusion.

C. The similarity or dissimilarity of likely-to-continue trade channels and the buyers to whom sales are made.

There are no restrictions or limitations in the description of services for the applications or cited registration. Absent such restrictions or limitations, we must assume that the services travel in "the normal and usual channels of trade and methods of distribution." *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis for the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the

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particular channels of trade or the class of purchasers to which the sales of goods are directed"). Accordingly, the services of both applicant and registrant are presumed to move in all normal channels of trade and be available to all classes of potential consumers, including the general public. *Venture Out Properties LLC v. Wynn Resorts holding LLC*, 81 USPQ2d 1887, 1894 (TTAB 2007); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In fact, the Canteen web page demonstrates that restaurants will sell their menu items through food kiosks.

In view of the foregoing, we find that the same consumers would patronize both applicant's food kiosk services, snack bar services, office snack bar supply services, and salad bars and registrant's restaurant, bar and catering services.

D. The number of similar marks that are used with similar services.

Applicant contends that "the use of the term [AMICI] in the food industry is widespread" as evidenced by counsel's GOOGLE search using the search terms "amici" and "restaurant" resulting in 838,000 occurrences. Thus, applicant concludes that "[b]ased upon such a high level of occurrences, it is strongly urged that this factor further

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supports Applicant's position that confusion based upon the shared element 'Amici' is, therefore, unlikely."⁹ The problem with applicant's argument is that it is not supported with any evidence. Applicant did not introduce into the record any of the purported documents showing the use of "Amici" as a trademark or trade name in the food industry. As indicated *supra*, the likelihood of confusion determination is based on an analysis of all of the probative facts in evidence. *In re E. I. du Pont de Nemours & Co., supra; In re Majestic Distilling Company, Inc., supra*. Accordingly, because there is no third-party use in evidence, we have not given this *du Pont* factor any consideration.

E. Balancing the factors.

The *du Pont* factors require to us to consider the thirteen factors made of record in likelihood of confusion cases. The CCPA has also observed that "[t]he 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." *Federated Foods, Inc. v.*

⁹ Applicant's Brief, p. 10. The Examining Attorney objected to this "fact" as being raised for the first time in Applicant's Briefs. However, applicant raised this argument, without any

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Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). When we compare applicant's marks AMICI ESPRESSO and AMICI COFFEE and registrant's mark



the similarity of the marks, the services identified by each mark, and the identity of consumers, we conclude that there is a likelihood of confusion.

Decision: The refusals to register applicant's marks under Section 2(d) are affirmed.

factual support, in its August 11, 2006 and August 18, 2006 Responses filed in each application.