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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Casa Larga Vineyards, Inc.

Serial No. 78732951

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Casa Larga Vineyards, Inc.

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(Tomas V. Vlcek, Managing Attorney).

Before Hairston, Walters and Walsh, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Casa Larga Vineyards, Inc. seeks to register on the
Supplemental Register the mark DOLCE BIANCO (in standard
character form) ("BIANCO" is disclaimed) for "wine."¹

¹ Serial No. 78732951, filed on October 13, 2005 and alleging first use anywhere and first use in commerce in 2004. Applicant originally sought registration on the Principal Register. However, during prosecution of the application, and in response to the trademark examining attorney's refusal to register under Section 2(e)(1) of the Trademark Act, applicant amended the application to seek registration on the Supplemental Register. In addition, at the request of the examining attorney, applicant submitted the following translation statement: "The foreign wording in the mark translates into English as sweet white."

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Registration has been 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 applicant's goods, so resembles the marks shown below, all registered by the same entity, as to be likely to cause confusion, to cause mistake, or to deceive.

DOLCE

Registration No. 1958230 issued February 27, 1996 under the provisions of Section 2(f) of the Trademark Act for "wine;" renewed.



Registration No. 1955543 issued February 13, 1996 under the provisions of Section 2(f) of the Trademark Act for "wine;" renewed.

DOLCE

Registration No. 1958231 issued February 27, 1996 under the provisions of Section 2(f) of the Trademark Act for "wine;" renewed.

When the refusal was made final, applicant filed this appeal. Briefs have been filed.

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, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 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 a consideration of the respective goods. Applicant's identified "wine" is legally identical to the "wine" identified in the cited registrations. Moreover, because the goods are legally identical, the channels of trade and classes of purchasers for applicant's wine and registrant's wine are also legally identical. Thus, if applicant's and registrant's goods are marketed under the same or similar marks, confusion as to their source or sponsorship is likely to occur.

Turning next to a consideration of the respective marks, the examining attorney argues that applicant has simply added the descriptive term BIANCO to the word DOLCE in each of the registrant's marks, and that this is not sufficient to obviate the similarity between the marks. In support of the refusal, the examining attorney submitted an entry from the Italian A-Z Wine Dictionary/Glossary (on-line version) showing the English translation of the word "dolce" as "*sweet*;" an entry from the Italian Wine Dictionary Glossary (on-line version) showing the English translation of the word "bianco" as "*white*;" and an entry from The American Heritage Dictionary of the English Language (Fourth Edition 2000, on-line version) showing the word "white" defined as, inter alia, "3. "[o]ne that is *white or nearly white, as c. A white wine.*"

Applicant, on the other hand, contends that by failing to give appropriate consideration to the term BIANCO in its mark and the stylization and design elements in the registrant's marks, the examining attorney has failed to analyze the marks in their entirety. Specifically, applicant argues that:

Applicant's mark consists of the two words DOLCE and BIANCO, while the registered mark consists of the single word DOLCE either in stylized form or with a design. Except for the presence of the common word DOLCE, the marks neither look nor sound alike. The

meaning of the two marks is also different. The registered marks mean simply, sweet, and are clearly descriptive in connection with wine, while applicant's mark means sweet white. Further, the marks create different commercial impressions. DOLCE BIANCO imparts a sophisticated Italian impression. DOLCE BIANCO brings to mind drinking wine on a carefree Italian vacation while one is relaxing in a piazza or on the balcony of a palazzo. DOLCE with design simply imparts an impression of sweetness. DOLCE BIANCO and DOLCE with design create distinctly different commercial impressions. Such differences preclude the possibility of a likelihood of confusion. (Brief at 4).

Applicant also contends that the examining attorney has failed to take into account the evidence it presented to show that registrant's marks are weak and, as such, are entitled to only a narrow scope of protection. In particular, applicant claims that the term DOLCE is so frequently used in connection with wine and wine-related products that no one party can claim exclusive rights to the term as used in connection with such goods. As support for its contention in this regard, applicant relies upon excerpts from third-party Internet web sites which offer wines for sales named "ANNO 1898-MODICA DOLCE;" "DELAWARE DOLCE;" "FAR NIENTE DOLCE;" and "2002 DOLCE LATE HARVEST." Also, applicant submitted an excerpt from a third-party web site which features a review of a wine named "SCHUBERT DOLCE 2000;" and excerpts from the Internet "home pages" of "La Dolce Vita" winery and the "Dolce Restaurant." In

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addition, applicant submitted a third-party application and three third-party registrations, namely, Serial No. 76636325 for the mark POGGIO DOLCE RED WINE and design for wines; Registration No. 2644882 for the mark DOLCE BY S. PELEGRINO and design for a variety of alcoholic beverages, excluding wine; Registration No. 1524758 for the mark FARNIENTE DOLCE and design for wine; and Registration No. 1059712 for the mark AMARETTO E DOLCE and design for liqueur.

With respect to the marks, we must determine whether applicant's mark and registrant's marks, when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Although the marks 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). Furthermore, 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 commercial impression 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. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Finally, we note the well established principle that when marks would appear on virtually identical goods, as they do here, the degree of similarity 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).

When we apply these principles to the marks in this case, we agree with the examining attorney that when considered in their entirety, applicant's mark is similar to each of the registered marks in sound, appearance, connotation and commercial impression.

In this case, a prominent feature of all of the marks is the word DOLCE. Insofar as applicant's mark is concerned, the word DOLCE is the dominant portion thereof because it comes first and "it is often the first part of a mark which is mostly likely to be impressed upon the mind of a purchaser and remembered." *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Moreover, the disclaimed word "BIANCO" in applicant's mark clearly is descriptive and entitled to less weight in our

likelihood of confusion analysis. Because applicant's DOLCE BIANCO mark is shown in standard character form, we must consider that applicant's mark is not limited to any special form or style. *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2 1376, 170 USPQ 35 (CCPA 1971). In other words, we must consider all reasonable manners in which applicant could depict its DOLCE BIANCO mark, including in a stylized font that is similar to DOLCE in the registered marks.

With respect to the registered marks, it is the word DOLCE that is dominant in each of these marks. The stylized font and designs in these marks do not serve to distinguish such marks from applicant's mark. It is the word DOLCE that is mostly likely to be impressed upon a customer's memory as it is used by prospective purchasers when asking for registrant's goods. *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553 (TTAB 1987). [When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services.]

In terms of connotation and commercial impression, we also find that the respective marks are similar. As applied to wine, DOLCE (sweet) and DOLCE BIANCO (sweet

white) have similar meanings. Contrary to applicant's contention, due to the descriptive nature of the word BIANCO, it adds little to the source-indicating commercial impression of applicant's mark.

Considering the marks in their entireties, we find that applicant's mark and registrant's marks are similar in sound, appearance, connotation and commercial impression. Purchasers familiar with one or more of registrant's DOLCE and design marks would be likely to mistakenly assume that the wine sold under applicant's mark DOLCE BIANCO is a new white wine from registrant's line of DOLCE wines.

Applicant's evidence does not compel a different result in determining likelihood of confusion. First, applicant's argument that the registered marks are descriptive constitutes a collateral attack upon the validity of the registered marks and as such can only be entertained in the context of a petition to cancel. Further, the issuance of the cited registrations under the provisions of Section 2(f) of the Act indicates that the marks shown therein had become distinctive of the registrant's goods in commerce prior to the issuance of the registrations. We note that the applications for these registrations were filed in 1993; the registrations issued in 1996; and they were renewed in 2006. Under the

circumstances, and for the reasons discussed below, we cannot agree that registrant's marks today are weak marks entitled to but a limited scope of protection.

It is well settled that third-party registrations are not evidence of use of the marks shown therein, or that consumers have been exposed to them. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Furthermore, we note the third-party registrations submitted by applicant are of limited probative value for the reason that only one of the registrations covers wine. Insofar as the third-party application is concerned, it is not probative of the issue in this appeal. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1947, 1949 n. 4 (TTAB 2002) [Third-party applications have no probative value other than as evidence that the applications were filed.]

Similarly, the excerpts from the third-party web sites are of limited probative value because there is no indication of the extent to which the wines/winery services identified at the web sites have been offered, when the names of the wines/winery were adopted, or customer familiarity with the names.

In short, we are not persuaded by applicant's evidence that the registered marks are weak marks. In any event, even if marks which consist of or contain the word DOLCE

are considered to be weak, even weak marks are entitled to protection where confusion is likely. Here, notwithstanding any alleged weakness in the term DOLCE, each of the registered marks is still substantially similar in sound, appearance, connotation and commercial impression to applicant's mark.

Accordingly, we conclude that purchasers familiar with either of the registered DOLCE and design marks for wine, would be likely to believe, upon encountering the substantially similar mark DOLCE BIANCO for applicant's wine, that such legally identical goods emanate from or are associated with or sponsored by the same source.

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