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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sanchez Cano, S.A.

Serial No. 78817865

G. Franklin Rothwell and Anne M. Sterba of Rothwell, Figg,
Ernst & Manbeck P.C. for Sanchez Cano, S.A.

Monique C. Miller, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Hohein, Hairston and Taylor, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Sanchez Cano, S.A. has filed an application to
register the mark shown below,



for goods ultimately identified as "sugar confectionery, chewing gum, caramels" in International Class 30.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of Registration No. 2284357 for the mark shown below,



for "pastry and confectionery, namely, bread, bread-sticks" in International Class 30.²

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

¹ Serial No. 78817865, filed February 17, 2006, based on a bona fide intention to use the mark in commerce, pursuant to Section 1(b) of the Trademark Act, and asserting a claim of priority pursuant to Section 44(d) of the Trademark Act, based on the filing of an application in Spain on August 17, 2005. Applicant claims the colors pink, green, yellow, orange, red, and blue as features of the mark.

² Registration No. 2284357, issued October 12, 1999; Section 8 affidavit accepted; Section 15 affidavit filed. The registration contains a statement that "[t]he English translation of 'FINI' is 'finished' in French and 'fine, thin, sharp, pure, keen or accurate' in Italian." The registration also covers goods in Class 29, but the examining attorney has made it clear that the refusal to register is based solely on the Class 30 goods. At the time of issuance of the registration, the identification of the goods in Class 30 covered "pasta, tortellini, ravioli, gnocchi, rice, coffee, tea, sugar, pastry and confectionary, namely, candy, toffee, caramels, chocolates and chocolate truffles; bread, bread-sticks, crackers, chocolate, honey, mustard, vinegar, sauces." When registrant filed its Section 8 and Section 15 affidavits, it deleted a number of the goods in Class 30 such that the identification of goods reads as indicated above.

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 and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Considering first the marks, the examining attorney argues that when the respective marks are considered in their entireties, they are confusingly similar because the term FINI is common to both marks. It is the examining attorney's position that the design elements of the respective marks do not obviate the similarity in the marks.

Applicant, on the other hand, argues that not only are the design elements sufficient to distinguish the respective marks, but that marks containing the term FINI are weak marks which are therefore entitled to only a limited scope of protection. Applicant relies on seven

third-party registrations of marks containing the term FINI for a variety of goods and services.

With respect to the marks, we must determine whether applicant's mark and registrant's mark, 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 and/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).

In this case, the term FINI is the dominant portion of each of the respective marks. Although the design elements

are noticeable parts of the marks, they do not serve to distinguish the marks. It is the term FINI that is the dominant portion of each of the marks because FINI would be used by purchasers to call for both applicant's and registrant's goods. Thus, it is the term FINI that would make a greater impression on purchasers, and it is this portion of the marks that is more likely to be remembered. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

Further, the dominant portion of each of the respective marks, FINI, is identical in sound, appearance and connotation. While we have focused on the dominant portion of each of the marks, we have considered the marks in their entireties. And, in doing so, we find that the marks engender similar commercial impressions.

In attempting to distinguish the marks, applicant relies on seven third-party registrations of marks containing the term FINI for a variety of goods and services. According to applicant, "[b]ecause FINI is a weak designation of source, the conclusion that customers will look to other elements or components of the marks in order to distinguish them is inescapable." (February 8, 2007 Response at page 5)

It is well settled that third-party registrations are entitled to little weight on the issue of likelihood of confusion inasmuch as such registrations are not evidence of use of the marks shown therein. Thus, these registrations are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). In addition, these registrations are of little probative value because only one of the registrations covers goods (pasta) which are even arguably related to the goods involved herein. The goods and services in the other registrations are far removed from the goods involved herein and include, for example, nail conditioners, wines, compressors and machine parts, and financial and educational services.

In sum, we find that applicant's FINI and design mark and registrant's FINI and design mark are similar in sound, appearance, connotation and commercial impression.

Considering next the goods, applicant's goods are identified as "sugar confectionery, chewing gum, caramels." We note that the examining attorney's refusal to register is based solely on the remaining Class 30 goods in the

cited registration which are identified as "pastry and confectionery, namely, bread, bread-sticks." The examining attorney maintains that "[p]astry stands by itself as a separate product in the registrant's identification and has not been deleted. The word 'namely' in the identification applies solely to the indefinite wording 'confectionery.'"

(Brief at unnumbered page 8) The examining attorney goes on to argue that applicant's "caramels" and registrant's "pastry" are related goods. In support of her position, the examining attorney submitted copies of five use-based third-party registrations of marks which she maintains show that companies have registered their marks for both caramels and pastry. In addition, the examining attorney maintains that applicant's "caramels" and registrant's "bread" are related goods. In support of her position in this regard, the examining attorney submitted copies of three use-based third-party registrations of marks which she maintains show that companies have registered their marks for both hot caramel and bread.

Applicant, in urging reversal of the refusal to register, contends that the examining attorney has improperly construed the identification of the remaining Class 30 goods in the cited registration. In particular, applicant maintains that "pastry" is not a separate product

in the identification of goods, and should not be considered in determining whether applicant's goods and the goods in the cited registration are related. Rather, applicant maintains that the goods in the cited registration are simply bread and breadsticks, and such goods are not related to applicant's goods. Thus, applicant argues that the five third-party registrations of marks that cover caramels and pastry are not relevant to the likelihood of confusion determination herein. With respect to the three third-party registrations of marks that cover hot caramel and bread, applicant argues that these registrations are not relevant to our likelihood of confusion determination because applicant's goods are caramels, not hot caramel.

It is not necessary that goods or services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. See *In re Melville*

Corp., 18 USPQ2d 1386 (TTAB 1991); and In re International Telephone & Telegraph Corp., 197 USPQ2d 910 (TTAB 1978).

In this case, we acknowledge that the remaining Class 30 identification of goods in the cited registration is not a model of clarity. Nonetheless, we agree with the examining attorney that it is reasonable to read "pastry" as a separate item in the identification of goods.³ We find that applicant's "caramels" and registrant's "pastry" are sufficiently related that confusion is likely to result if the goods are marketed under the similar marks involved herein. Caramels and pastry are both in the nature of snack and dessert items. Also, as noted, the examining attorney has made of record the following five use-based third-party registrations which show that entities have adopted a single mark for caramels, on the one hand, and pastry, on the other hand: Registration Nos. 3319372, 3319373, and 3319374, all for, inter alia, caramels and pastries⁴; Registration No. 3246556 for, inter alia, pastry and caramel; and Registration No. 3329399 for, inter alia,

³ However, we disagree with the examining attorney that "bread, bread-sticks" should be read as types of "confectionery" products, notwithstanding the prefatory word "namely." In this regard, we judicially notice that the word "confectionery" is defined as: "1. Candies and other confections considered as a group." The American Heritage Dictionary of the English Language (4th ed. 2000).

⁴ We note that these three registrations are owned by the same entity.

Danish pastries and candy with caramel. Although these third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that caramels and pastry are the kinds of goods which may emanate from a single source under a single mark. 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).

Moreover, there can be no doubt that caramels and pastry are marketed in some of the same channels of trade, for example, grocery stores and gourmet food shops, to the same class of purchasers, namely, ordinary consumers. Further, caramels and pastry are inexpensive products and may be purchased on impulse and without care.

In view of the foregoing, we conclude that consumers familiar with registrant's pastry offered under the mark FINI and design would be likely to believe, upon encountering applicant's substantially similar mark FINI and design for caramels, that the goods originated with or

are somehow associated with or sponsored by the same entity.⁵

Lastly, to the extent that any doubt might exist, we resolve it against applicant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register under Section 2(d) is affirmed.

⁵ Inasmuch as it is well established that a refusal under Section 2(d) is proper if there is a likelihood of confusion involving any of the goods listed in an application and any of those set forth in the cited registration, it is unnecessary to rule with respect to applicant's sugar confectionery, chewing gum and/or caramels and registrant's bread and/or bread-sticks. See, e.g., *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).