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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re S.A. Establecimientos Vitivinicolas Escorihuela

Serial No. 78967315

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Michael Litzau, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Rogers, Zervas and Ritchie de Larena, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On September 5, 2006, S.A. Establecimientos Vitivinicolas Escorihuela ("applicant") filed an application under Trademark Act §§ 1(a) and 44(e), 15 U.S.C. §§ 1051(a) and 1126(e), to register the mark

on the Principal Register for "wine" in International Class 33. Applicant has claimed first use anywhere and first use in commerce on July 1, 2007 and has entered the following description of the mark: "The mark consists of the stylized words 'Don Miguel Gascon' with an accent mark above the 'O' in GASCON, and below GASCON the design elements of circles and slashes in four horizontal rows."

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark HACIENDA DE DON MIGUEL (in standard character form) for "wines" in International Class 33.[1] The registration includes the following statement: "HACIENDA can be translated as 'estate.' Thus a translation of the mark is 'Don Miguel Estate.'" Registrant has entered a disclaimer of the term HACIENDA.

Additionally, the examining attorney has required (i) that a true copy, photocopy, certification or certified copy of the foreign registration on which applicant relies under Section 44(e) of the Trademark Act be submitted in order to satisfy the requirements of Section 44(e); and (ii) that applicant submit a specimen of use supported by a statement, verified with an affidavit or signed declaration

[1] Registration No. 3098323, issued May 3, 2006.

under Trademark Rule 2.20, 37 C.F.R. § 2.20, supporting the specimen. The application does not now contain either a specimen of use or copy of the foreign registration on which applicant relies.

Applicant has appealed the final refusal and the requirements of the examining attorney. Both applicant and the examining attorney have filed briefs.[2] As discussed below, the refusal to register is affirmed.

We first address one preliminary matter. Applicant sought to introduce into the record evidence with its attorney's brief, to which the examining attorney has objected. The examining attorney's objection is sustained. As stated in Trademark Rule 2.142(d), 37 C.F.R. 2.142(d), in countless Board decisions, in TMEP § 710.01(c) and in TBMP § 1207.01 (2d. ed. rev. 2004), the record should be complete prior to the filing of an appeal. Applicant could have easily entered the evidence it seeks to enter through its brief earlier in this proceeding; the issues which are discussed in applicant's brief are the same as those discussed in applicant's responses to the examining attorney's Office actions.[3] We therefore do not further

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[2] Applicant's reply filed late because applicant did not receive the examining attorney's brief, is accepted.

[3] At fn. 5 of its brief, applicant has offered another argument in support of allowing its late-filed evidence into the record. It maintains that "the third party registrations constitute

consider any of applicant's evidence submitted with its brief, which is the only evidence submitted in connection with its application.

Turning next to the merits of the Section 2(d) refusal, our determination under Section 2(d) 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 (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Because applicant and the examining attorney have focused their arguments on the similarity and dissimilarity of the goods and marks, we also focus on these two *du Pont* factors.

Applicant's and registrant’s goods are identical. The *du Pont* factor regarding the similarity of the goods

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official records and therefore should be admitted as evidence.” Applicant provides no support for its argument, but ostensibly is relying on Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), which concerns the admission of official records at trial during an inter partes proceeding pursuant to the notice of reliance procedure. That rule has no applicability in this ex parte proceeding.

therefore weighs heavily in favor of finding a likelihood of confusion.

We next consider the *du Pont* factor regarding the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under this *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 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, in cases such as this, where the goods are identical, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant, who points out that "the marks are to be compared in their entireties and not dissected in to [sic]

their individual components," and who accuses the examining attorney of "ignoring the basic precept that marks are to be compared in their entireties," nonetheless contends that that "a consumer is much more likely to remember the GASCON element rather than the [D]on [M]iguel element when recalling the goods," and that "the primary source-identifier of Applicant's mark is GASCON." Brief at p. 7. Applicant also relies on *Giant Food, Inc. v. Nation's Foodservice, Inc*. 218 USPQ 390 (CAFC 1983) for the proposition that "one feature of a mark may be more significant than other features" and "it is proper to give greater force and effect to that dominant feature," i.e., GASCON.

The Federal Circuit has stated that there is nothing improper in giving more weight, for rational reasons, to a particular portion or feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056 USPQ 749 (Fed. Cir. 1985). Turning first to registrant's mark, we find that the term DON MIGUEL is the dominant part of that mark. The disclaimed term HACIENDA, translated as "estate," serves little in indicating the source of the goods because it is a descriptive term that identifies a place where the goods are produced. Rather, it is the DON MIGUEL portion of the mark, translated as DON MIGUEL's ESTATE or ESTATE OF DON

MIGUEL, which largely serves as the source indicator of the mark, and is entitled to more weight in our analysis than the remaining terms in registrant's mark.

The wording DON MIGUEL also appears in applicant's mark. Applicant has placed DON MIGUEL in lettering smaller than the term GASCON, but by including DON MIGUEL in the manner it has, applicant's mark still suggests an association with or sponsorship by registrant. Those familiar with registrant's mark would likely believe that a connection exists between applicant's and registrant's identical goods.[4]

Applicant has also included design elements in its mark. These design elements do not distance the mark from registrant's mark. Because of their simple shapes, the design elements would be viewed merely as background for the wording in applicant's mark. Additionally, if a mark comprises both a word and a design, the word portion is normally accorded greater weight because it would be used by prospective consumers to order the services or be spoken through word of mouth. See *In re Appetito Provisions Co.*,

[4] Applicant, referring to the term "don" at p. 9 of its brief, argues that it is a "title of respect [and it] cannot be viewed as particularly strong." Applicant's argument is not persuasive because the common portion of the marks is DON MIGUEL, not DON.

3 USPQ2d 1553 (TTAB 1987); *Ceccato v. Manifattua Lane Gaetano Marzotto & Figli, Spa.*, 32 USPQ2d 1192 (TTAB 1994).

Thus, when we consider the marks as a whole, we find that applicant's mark is similar in sound and appearance to registrant's mark in view of applicant's inclusion of the dominant portion of registrant's mark, DON MIGUEL, in its mark. We also find that the marks are similar in meaning; *Merriam-Webster's Online Dictionary* located at merriam-webster.com defines "don" as "a Spanish nobleman or gentleman — used as a title prefixed to the Christian name," and, of course, "Miguel" is a name. The meaning of DON MIGUEL, i.e., a Spanish nobleman or gentleman named Miguel, is the same in both marks; the addition of GASCON and the design elements in applicant's mark do not change the meaning of DON MIGUEL.[5] As for the commercial impression of the marks, the commercial impression is also similar because DON MIGUEL is in both marks and has the same meaning in both marks. The inclusion of GASCON in applicant's mark would not distinguish the marks because registrant's mark would be viewed as merely omitting the

[5] We take judicial notice of this definition; the Board may take judicial notice of dictionary definitions including online dictionaries which exist in printed format. See In re CyberFinancial.Net Inc., 65 USPQ2d 1789 (TTAB 2002); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

surname of DON MIGUEL, while applicant's mark would be viewed as providing it. The *du Pont* factor regarding the marks is resolved against applicant.

Applicant maintains that there have been no instances of actual confusion between the marks. However, there is nothing in the record to show that there has been a meaningful opportunity for such confusion to have occurred. More importantly, in the context of an ex parte proceeding, "the lack of evidence of actual confusion carries little weight." *Majestic Distilling*, *supra*, 65 USPQ2d at 1205. Applicant's argument regarding actual confusion therefore is unpersuasive, and the seventh *du Pont* factor is neutral.

Another point applicant makes is that applicant has alleged a date of use earlier than registrant's filing date. However, this is not relevant since we do not determine priority in an ex parte proceeding. *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971) ("As the board correctly pointed out, 'the question of priority of use is not germane to applicant's right to register' in this ex parte proceeding"). See also *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001).

In short, we find that the marks are similar, and that the goods are identical. Based on these findings under the relevant *du Pont* factors, we conclude that a likelihood of

confusion exists. Applicant's arguments to the contrary are not persuasive.

As for the examining attorney's requirements regarding applicant's foreign registration and specimen of use, which the examining attorney has not addressed in its briefs, they too are affirmed.

Decision: The refusal to register under Section 2(d) is affirmed. The refusal to register for applicant's failure to comply with requirements to submit a specimen of use and the relevant foreign registration also is affirmed.