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Paper No.18
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

American Italian Pasta Company, substituted for Gooch Foods, Inc.[1]

v.

Homestead, Inc. and New World Pasta Company

Opposition No. 107,599
to application Serial No. 75/194,595
filed on November 7, 1996

Opposition No. 110,644
to application Serial No. 75/368,367
filed on October 6, 1997

Cancellation No. 26,165
to Registration No. 1,818,079
issued January 25, 1994

[1] On April 23, 2003, the Board granted plaintiff's uncontested motion to substitute. In footnote 3 of their trial brief filed December 16, 2002, defendants specifically state that they did not oppose the motion but noted that the documentation filed by plaintiff in support of its motion made reference to a third party, Archer-Daniels-Midland Company. Defendants invited plaintiff to provide an explanation for this reference as part of its reply brief, and further stated if that defendants "learn that ADM had some interest in the pleaded registrations that was not heretofore known, [defendants] reserve the right to seek to reopen the record in this proceeding to take discovery from ADM." Defendant cannot reserve a right to reopen discovery in this manner, and the Board's April 23, 2003 order stands. In any event, plaintiff has provided an explanation in its reply brief that Gooch Foods, Inc. is a wholly-owned subsidiary of Archer-Daniels-Midland Company.

Thomas H. Van Hoozer of Hovey Williams LLP for American Italian Pasta Company.

Cory M. Amron and William H. Oldach III of Vorys, Sater, Seymour and Pease LLP for Homestead, Inc. and New World Pasta Company.

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Before Simms, Seeherman and Drost, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

This is a consolidated proceeding in which American Italian Pasta Company seeks to prevent the registration of two marks, LA BELLA ROSA depicted in a typed drawing, and LA BELLA ROSA and design, and also seeks to cancel a registration for LA BELLA ROSA BRAND and design. The applications and the registration identify the goods as dry pasta, and each includes the statement that "The English translation of 'LA BELLA ROSA' is 'the beautiful rose'." The registration was originally issued to, and the applications were originally filed by, Homestead Inc., but were subsequently assigned, and Office records now show ownership in New World Pasta Company. Hereafter, these entities will be referred to collectively and/or individually as "New World."

The design marks for application serial no. 75/194,595 and registration no. 1,818,079, respectively, are shown below:

The applications have been opposed, and the registration is sought to be cancelled, on the ground of priority and likelihood of confusion. Specifically, American Italian Pasta Company (hereafter AIPC) has alleged that it is the prior user of various LA ROSA marks for pasta products, bread crumbs and other food products; that it is the owner of the six registrations shown below, certified copies of which were submitted as exhibits; and that New World's marks and goods are so similar to AIPC's marks and goods that confusion is likely.

Reg. No. *for* **Goods**	**Mark**
1,396,003[2] *for* Alimentary pastes and bread crumbs	**LA ROSA**

[2] Issued June 3, 1986; Section 8 affidavit accepted; Section 15 affidavit received.

623,193[3]

for Alimentary pastes, pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meat balls in sauce, and sausage links with sauce

389,868[4]

for Butter, macaroni products, noodles and pastina, a macaroni product cut up in small fanciful shapes

313,418[5]

for Alimentary paste products

651,541[6]

for Alimentary pastes, pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, and cheese ravioli in sauce, meat balls in sauce, sausage links with sauce, and canned soups

[3] Issued March 13, 1956; Section 8 affidavit accepted; Section 15 affidavit received; renewed twice.
[4] Issued August 26, 1941; Section 8 affidavit accepted; Section 15 affidavit received; renewed twice.
[5] Issued May 29, 1934; Section 8 affidavit accepted; Section 15 affidavit received; renewed three times.
[6] Issued September 10, 1957; Section 8 affidavit accepted; Section 15 affidavit received; renewed twice.

1,390,117[7]

for Spaghetti, lasagna, macaroni, noodles and bread crumbs.

Each of the registrations states that "LA ROSA" translates into English as "The Rose."

New World denied the salient allegations of the notices of opposition and petition for cancellation, and asserted certain affirmative defenses. New World did not submit any evidence in support of these defenses, and acknowledged, at footnote 10 of its reply brief, that it does "not rely on any affirmative defenses." Therefore, we will not list these affirmative claims, nor have we given them any further consideration.

New World also counterclaimed to cancel AIPC's pleaded registrations Nos. 313,418 and 651,541 in their entirety; to partially cancel Registration No. 389,868 with respect to "butter"; and to partially cancel Registration No. 623,193 with respect to "pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meatballs in sauce, and sausage links with sauce." It

[7] Issued April 15, 1986; Section 8 affidavit accepted; Section 15 affidavit received.

should be noted that New World has not attempted to cancel AIPC's pleaded registrations Nos. 1,390,117 and 1,396,003.

AIPC has filed its brief as plaintiff in the oppositions and cancellations; New World has filed its brief as defendant in the oppositions and cancellation and as plaintiff in the counterclaims; and AIPC has filed a combined brief as defendant in the counterclaims and reply brief as plaintiff in the oppositions/cancellation. An oral hearing was not requested.

The record includes the pleadings; the files of the applications opposed and the registration sought to be cancelled by AIPC; and the files of the four registrations owned by AIPC which New World has counterclaimed to cancel. Because AIPC submitted, with its pleadings, certified copies of its pleaded registrations, these registrations are of record. See Trademark Rule 2.122(d)(1).[8] AIPC did not make any additional evidence of record, and New World did not submit any evidence whatsoever.

Turning first to New World's counterclaims to cancel AIPC's registrations, as noted, New World has not submitted any evidence in support of its counterclaims. However, in its answer to the counterclaims for partial cancellation,

[8] The registrations which are the subject of the counterclaims are also of record because the registration files are of record as a result of the counterclaims. See Trademark Rule 2.122(b)(1).

AIPC has admitted that, with respect to Registration No. 389,868, it has abandoned its rights with respect to butter for failure to use the mark for these goods for a period in excess of three years, and that the registration should be partially cancelled. Similarly, AIPC has admitted that it has abandoned its rights in Registration No. 623,193 with respect to "pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meatballs in sauce, and sausage links with sauce," and that the registration should be partially cancelled. AIPC in its brief filed January 21, 2003, "concedes to the partial cancellation of Registration No. 623,193 on the basis of the non-use of [these goods]" and "concedes to the partial cancellation of" Registration No. 389,868 with respect to butter on the ground of non-use. Accordingly, the counterclaims to partially cancel these registrations are granted.

With respect to the counterclaims to cancel Registration Nos. 313,418 and 651,541 in their entireties, New World has not submitted any evidence in support of these counterclaims, and has acknowledged, at footnote 8 of its brief, that it does not rely on such counterclaims. Therefore, the counterclaims with respect to these registrations are dismissed.

Thus, in determining the oppositions and petition to cancel brought by AIPC, AIPC may rely on its registrations for LA ROSA for alimentary pastes and bread crumbs; LA ROSA in script form (Registration No. 623,193) for alimentary pastes; LA ROSA and "left rose" design for "macaroni products, noodles and pastina, a macaroni product cut up in small fanciful shapes" (Registration No. 389,868) and for alimentary paste products (Registration No. 313,418); LA ROSA and "right rose" design for, inter alia, alimentary pastes, canned spaghetti sauces, and ravioli with meat in sauce and cheese ravioli in sauce; and LA ROSA with "upper rose" design for spaghetti, lasagna, macaroni, noodles and bread crumbs.

First, with respect to the oppositions, priority is not in issue in view of AIPC's registrations. King Candy Company v. Eunice King’s Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). With respect to the cancellation proceeding, the earliest date on which New World can rely is the October 28, 1992 filing date of the application which eventually issued into its registration. See, e.g., Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1428-29 (TTAB 1993) at n. 13. However, the application filing dates of all of AIPC's pleaded registrations all precede this date, most having issued decades earlier.

In determining the issue of likelihood of confusion, we must analyze 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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the goods, they are, in part, identical. New World's goods are identified as "dry pasta." "Pasta," of course, is "paste or dough made of flour and water, used dried, as in macaroni, or fresh, as in ravioli."[9] These goods are, thus, legally identical to the alimentary pastes, spaghetti, lasagna, macaroni, noodles, and pastina identified in AIPC's various registrations. As such, they must be deemed to be sold through the same channels of trade to the same classes of consumers.

We turn next to a consideration of the marks, keeping in mind that "when marks would appear on virtually identical goods or services, 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

[9] The American Heritage Dictionary of the English Language, ©1970. The Board may take judicial notice of dictionary definitions. 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).

874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). New World's marks all consist of the words LA BELLA ROSA; in one application, there is also a rose design which reinforces the meaning of the word ROSA, which means "rose" in Italian. The registered mark also includes the word BRAND, but this word, the equivalent of "trademark", has no source-identifying significance. Neither does the rather ordinary script or type style in which the stylized marks are depicted. Thus, the dominant portion of New World's marks is the phrase LA BELLA ROSA. LA ROSA is also the dominant portion of AIPC's marks. As with New World's mark, the design of the rose merely reinforces the meaning of LA ROSA. Although marks must be compared in their entireties, it is well established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Although New World's marks contain the word BELLA, and AIPC's do not, we do not find this difference sufficient to distinguish the marks. The words LA ROSA in both marks still have the same appearance and pronunciation, and New World's design mark has a rose design, as do four of AIPC's marks. The marks are also virtually identical in meaning, with AIPC's mark meaning THE ROSE, and New World's mark meaning THE BEAUTIFUL ROSE. For those people who are

familiar with Italian, the similarity in meaning will be clear. Those who are not familiar with Italian may still, because BELLA is a simple Italian word, and because ROSA sounds like "rose" and the meaning is emphasized by the design element, understand that the marks are similar in connotation. As for those who will not recognize the meaning at all, the additional term BELLA, placed between the identical elements LA and ROSA, will not distinguish the marks. The marks still appear to be in the same foreign language, even if the consumer cannot identify that language as Italian, and have the same beginning and ending words.

Accordingly, we find that the commercial impression of AIPC's and New World's marks are the same.

It must be remembered that pasta is an inexpensive food item, bought by the general public. Its purchase is not likely to be the subject of great deliberation, and consumers will not spend much time examining trademarks for subtle differences. Under actual marketing conditions consumers do not generally have the opportunity to make side-by-side comparisons of marks, so they must rely upon hazy past recollections. Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). Given the fallibility of memory, consumers are not likely to remember the differences between the parties' marks. Thus, a consumer who is familiar with AIPC's LA ROSA trademarks for

pasta products, seeing New World's LA BELLA ROSA products for the identical goods, is likely to not even notice the differences between the marks or, if he or she does notice, is likely to assume that the marks are variants of each other.

New World has argued that AIPC's marks are weak, and entitled to a limited scope of protection, because LA ROSA is both a surname and because ROSA is descriptive of pasta sauce. There are many problems with this position. With respect to the surname claim, New World has presented no evidence that "La Rosa" is a surname. To remedy this oversight, it asks the Board to take judicial notice that La Rosa is a surname. However, this is not the type of fact that is not subject to reasonable dispute. See FRE 201. New World has not pointed to any authority to support our taking judicial notice of this adjudicative "fact." This is not the type of fact that is set forth in TBMP § 712.01, or the cases discussed in that section.

As for the so-called descriptiveness of "Rosa" for pasta sauce, we note preliminarily that the goods at issue are, in general, pasta rather than pasta sauce, and therefore "rosa" would not be descriptive and entitled to a limited scope of protection for such goods. More importantly, New World has submitted no evidence to show that "rosa" is descriptive of pasta sauce. Again, New World

seeks to remedy this failure by asking us to take judicial notice of its statement that "a simple internet search for the term 'rosa sauce' produces hundreds of recipes and menus featuring a rosa sauce (comprising cream with tomatoes or tomato sauce) to be served with pasta." Brief, footnote 6. An internet search would not normally be an appropriate subject for judicial notice; certainly we could not take judicial statement of New World's one sentence general comment about what its search revealed.

In any event, even if there were evidence to support a finding that AIPC's registrations were entitled to a limited scope of protection, that protection would still extend to the use of a very similar mark (similar even to the extent of being in the same foreign language) on identical goods.

In reaching our conclusion that confusion is likely, we have not given any weight to the factor of fame. As previously discussed, AIPC has not submitted any evidence except for its registrations. Thus, we have no information about the amount of its sales and promotion of its goods from which to find that its marks are famous.

The fact that AIPC has not submitted any evidence of actual confusion, however, does not require us to find that confusion is not likely. Evidence of actual confusion is notoriously difficult to obtain. Further, because there is no evidence in this record as to either AIPC's or New

World's areas of geographic distribution, we cannot determine whether there has been an opportunity for confusion to occur, such that a lack of actual confusion would indicate no likelihood of confusion.

The parties have argued about the effect to be given New World's intent in adopting its marks. However, because there is no evidence whatsoever on this factor, we must regard it as neutral.

In conclusion, we find that the duPont factors either favor AIPC (e.g., similarity of the marks, similarity of the goods, similarity in channels in trade and customers, lack of care in purchasing) or are neutral (e.g., lack of actual confusion, intent of New World). We further find that New World's applied-for LA BELLA ROSA marks and its registered LA BELLA ROSA BRAND mark, all for dry pasta, are likely to cause confusion with AIPC's six registered marks.

Decision: AIPC's oppositions to Serial Nos. 75/194,595 and 75/368,367 are sustained, and its petition to cancel Registration No. 1,818,079 is granted. New World's counterclaims to partially cancel Registration No. 389,868 with respect to "butter" and to partially cancel Registration No. 623,193 with respect to "pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meatballs in sauce, and sausage links with sauce"

are granted, and these items will be cancelled from the respective registrations in due course. New World's counterclaims to cancel Registration Nos. 313,418 and 651,541 are denied.