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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Crème Glacee Ital Gelati Inc.

v.

Italgel Incorporated

Opposition No. 91151290

James R. Hastings of Collen IP for Crème Glacee Ital Gelati Inc.

Robert Harrison of Harrison & Harrison for Italgel Incorporated.

Before Hairston, Holtzman and Drost, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Italgel Incorporated (applicant) to register the mark shown below on the Principal Register for the following goods (as amended):¹

"Electric ice cream makers for restaurant use and refrigerated display cases for ice cream and pastries" in Class 11

¹ Application Serial No. 75776886 filed on August 16, 1999, based on an assertion of a bona fide intent to use the mark in commerce. Applicant has disclaimed "INCORPORATED" and "GELATO SYSTEMS" apart from the mark as shown. Applicant has translated the Italian word "gelato" as "frozen" and also as "the common name for Italian ices and ice creams."

"Ice cream" in Class 30.

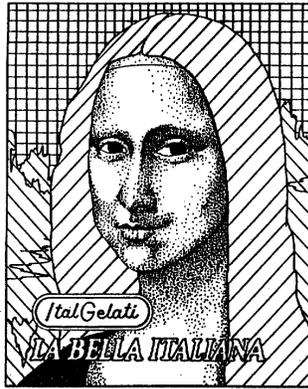


Registration has been opposed by Crème Glacee Ital Gelati Inc. (opposer). As grounds for opposition, opposer asserts that it "has been engaged in the sale and marketing of goods under its trademarks" since at least as early as 1996; that applicant "intends to apply its confusingly similar mark to goods, including electric ice cream makers for restaurant use"; that "the intended use by the Applicant for goods in International Class 11 will cause confusion, mistake and deception with respect to those goods, by virtue of the Opposer's prior use of its marks and by virtue of the Opposer's renown as a purveyor of frozen culinary confections"; and that applicant's mark "when used in conjunction with the goods offered by the applicant" so resembles opposer's previously used and registered marks as to be likely to cause confusion mistake or deception under Section 2(d) of the Trademark Act. Opposer requests that "this application...be refused, [and] that no registration be issued" to applicant.²

² Applicant has not only applied for registration in Class 11 for ice cream makers and refrigerated display cases, but also in Class 30 for ice cream. However, at no time during the course of this proceeding has opposer acknowledged that the application is also for ice cream. Opposer only paid a fee for opposing a single class of goods.

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Opposer alleges that it is the owner of the following two registrations: Registration No. 2024902 for the typed mark ITAL GELATI for "ice cream, flavored ices, frozen yogurt, sherbet, tofu based ice cream substitutes and soy based ice cream substitutes" in Class 30;³ and Registration No. 2336383 for the mark shown below for "ice cream, ice milk, frozen yogurt, ices, sherbet, soy based ice cream substitute and frozen tofu" in Class 30.⁴



Moreover, opposer did not specifically plead likelihood of confusion with respect to ice cream; did not raise the issue at trial; and did not argue the issue, or even mention it, in its trial brief. Nor did applicant make any attempt to defend its right to registration for ice cream. Under the circumstances, we construe the notice of opposition as having been filed solely against the Class 11 goods. We also note that applicant's president, Augusto Bisani, when asked during his testimony deposition, "Do you have any intentions to sell other products under the Italgel mark other than the ones you have testified to [i.e., ice cream making machines and refrigerated display cases]?" Mr. Bisani replied "At this time I don't see any reason for. [sic] I'm an equipment company. I'm not a product company." Dep. p. 30.

³ Issued December 24, 1996. The word "gelati" is disclaimed. The registration contains a translation of "GELATI" as "Italian ice cream."

⁴ Issued March 28, 2000. The word "gelati" is disclaimed. The registration contains a translation of "LA BELLA ITALIANA" as "the beautiful Italian" and a translation of "GELATI" as "ice cream."

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Applicant, in its answer, has denied the allegations in the opposition.

The record includes the pleadings; the file of the involved application; opposer's notice of reliance on materials including plain copies of its pleaded registrations and applicant's responses to certain discovery requests;⁵ opposer's testimony, with exhibits, of Dominic Acuri, opposer's "representative"; and applicant's testimony, with exhibits, of Augusto Bisani, applicant's president.⁶

Both parties have filed briefs. An oral hearing was not requested.

Opposer, a corporation of Canada, has been in the business of producing frozen and nonfrozen dairy desserts since 1983. These products include ice cream and gelati (the plural of "gelato") which is described by Mr. Acuri as a "specified category of ice cream." Dep., p. 8. Opposer manufactures the ice cream itself or sells the dry product to "co-packers" that mix it for opposer on machines approved by opposer. Opposer then sells the "finished" ice cream under the ITAL GELATI mark in bulk either directly or through distributors to establishments such as restaurants, hotels and ice cream parlors, which in turn sell the

⁵ However, opposer did not make copies of the questions of record as required by Trademark Rule 2.120(j)(3)(i).

⁶ The parties stipulated to the taking of Mr. Acuri's deposition in Montreal, Canada. By agreement of the parties, each party appeared at the other's deposition by telephone.

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products to the public. The record shows that opposer has been selling ice cream products under the ITAL GELATI mark in the U.S. since at least as early as 1996. As shown by one of opposer's recent price lists, a single three-gallon container of ice cream may cost \$40.00. Dep. exh. 6.

Mr. Acuri testified that he has been "approached" by "clients that have chains, franchises" (Dep., p. 43) to offer ice cream makers where opposer's dry product could be mixed and made fresh on the premises, and that opposer has been "asked to supply" ice cream freezer display cases. Dep., p. 28. However, opposer does not manufacture or distribute ice cream makers, display cases, or any other restaurant equipment at this time.

Opposer advertises and markets its products under the ITAL GELATI mark in the U.S. over the Internet, at trade shows and through brochures distributed to its actual and potential customers. Opposer also advertises its products under the ITAL GELATI mark in trade publications directed to restaurants, hotels and other food service establishments as well as on table tents and on posters displayed in the windows of the establishments where its products are served.

Applicant, Italgel Inc., is a subsidiary of Bravo Systems International ("Bravo"), a manufacturer of specialty restaurant equipment such as pasta machines, rotisseries and wood burning pizza ovens. Italgel Inc. was created to sell refrigerated

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display cases and certain models of ice cream or gelato making machines for commercial use. As described by Mr. Bisani, gelato is "an Italian version of an ice cream product" (Dep., p. 20) that contains less butter fat than ice cream and less air. Mr. Bisani states that the same machine could be used to produce either product by changing the pump and the speed of the machine.

Applicant's commercial grade machines are not intended for home use. Depending on the size and grade, a machine could range in price from \$7,500 for a small "table top" model to \$35,000 for the large commercial model. Mr. Bisani explains that the smaller capacity models might be used by a restaurant and a larger one might be used by an ice cream store. The entire sale process may take several months from the initial contact with a customer. The process may include a customer's request for inspection or demonstration of the equipment or an on-site consultation at the customer's facility.

According to applicant's invoices, the cost of a display case holding 24 flavors of ice cream is \$16,000. Mr. Bisani describes the use and placement of these display cases in ice cream shops as follows:

[The product] goes into a stainless steel five liter container, and it gets displayed on a gelato show case which can go from four flavors to 24 flavors.

...

As you enter the shop you would have such a display. The customer comes up and he sees whatever the shop has manufactured.

Dep., p. 24.

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Applicant's parent company, Bravo, has been selling ice cream makers under the name Bravo International to hotels, restaurants and supermarkets. These are the intended customers for applicant's equipment as well. Bravo advertises and markets its ice cream makers through brochures and trade publications targeted to the restaurant and hotel industry, including ice cream and gelato shops. In addition, Bravo promotes and markets these machines at regional and national trade shows for restaurant equipment. Mr. Bisani explains that companies in the equipment trade attend these shows on the first day, and that normally the direct customers such restaurants, hotels or ice cream stores attend the shows on the second day. According to Mr. Bisani, food products are not exhibited at these equipment shows.

We turn first to the question of priority. A plaintiff may make a pleaded registration of the record in the proceeding by filing, either with the complaint or by a notice of reliance during its testimony period, a copy of the registration prepared and issued by the USPTO showing both the current status of and current title to the registration. Alternatively, a registration may be made of record by introducing a copy of the registration as an exhibit to testimony establishing that the registration is still subsisting and is owned by the offering party. See Trademark Rule 2.122(d).

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Opposer did not submit status and title copies of the registrations either with the complaint or by a notice of reliance. Moreover, although Mr. Acuri has testified that opposer is the owner of its pleaded registrations for the ITAL GELATI marks, there was no testimony that the registrations are still valid. Thus, the pleaded registrations are not properly of record and are not considered evidence of opposer's priority. See *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.2 (TTAB 1985) (no probative value where testimony established opposer's ownership of registration, but not current status).

Nevertheless, opposer has clearly established use of the word mark ITAL GELATI⁷ in connection with its frozen confectionary products, including ice cream, which predates the August 16, 1999 filing date of the opposed intent-to-use application.⁸

Accordingly, we turn to the question of likelihood of confusion as between opposer's word mark ITAL GELATI and applicant's mark ITALGEL and design as used in connection with the parties' respective products.

Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E. I. du Pont de Nemours & Co.*,

⁷ We find that ITAL GELATI is used in a manner that is essentially the equivalent, in its commercial impression, of a typed version of the mark.

⁸ There is no claim by applicant, and insufficient evidence to show, that ITAL GELATI is either merely descriptive or misdescriptive, or geographically descriptive or deceptively misdescriptive, of ice cream.

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476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ["The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and the differences in the marks."].

Opposer argues that the marks create highly similar commercial impressions in light of the dominant portions of the respective marks. Opposer contends that the term ITALGEL and the depiction of the ice cream cone are the dominant portions of applicant's mark.

We agree with opposer to the extent that we find that the dominant part of applicant's mark is ITALGEL. While this term and ITAL GELATI have a similar meaning, both suggestive to some degree of Italian style ice cream, it is clearly not the same meaning. We take judicial notice that "Ital" is a recognized abbreviation for "Italian,"⁹ and opposer has explained that "gelati" is the plural form of "gelato." Moreover, Mr. Bisani has testified that gelati is "an Italian version of an ice cream

⁹ *The American Heritage Dictionary of the English Language* (4th ed., 2000). The Board may take judicial notice of dictionary definitions. See, e.g., *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).

product."¹⁰ Dep., p. 20. On the other hand, we have no evidence that "gel" would immediately be recognized as an abbreviated form of "gelato." Thus, where ITALGEL is only mildly suggestive of an ice cream maker that produces an Italian style ice cream, the meaning of ITAL GELATI for an Italian style ice cream is close to obvious.

It is settled that highly suggestive marks are weak and are generally accorded a more limited scope of protection than an arbitrary mark. See *The Drackett Company v. H. Kohnstamm & Co., Inc.*, 404 F.2d 1399, 160 USPQ 407, 408 (CCPA 1969) ["The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods."]; and *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295 (CCPA 1958).

Thus, while ITALGEL and ITAL GELATI share some similarities in terms of sound and appearance, in view of the weak and highly suggestive nature of ITAL GELATI, we find that the differences in sound and the differences in the overall visual impressions of the two marks are sufficient to distinguish the marks as a whole.

¹⁰ We also note that in response to the question on cross-examination, "Now, would they be carrying your product along with other Italian foods or Italian desserts, or is it a mix,...?" Mr. Acuri stated, "Mainly they won't have two (2) Italian ice cream[s], they probably have an American ice cream like Ben & Jerry's and then carry Ital Gelati like a, you know, to show the distinction, but they wouldn't carry two (2) Italian ice creams, it doesn't make sense." Dep., p. 66 (emphasis added.)

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Contrary to opposer's contention, the absence of evidence of third-party use is a factor which is, at best, neutral as it does not offset the highly suggestive nature of opposer's mark or serve to broaden the scope of protection to which the mark is entitled. Nor is the weakness of the mark offset by any evidence of renown of opposer's mark, and opposer has not argued otherwise in its brief.

We turn then to the goods. It is well settled that the goods of the parties need not be similar or even competitive to support a finding of likelihood of confusion. It is sufficient that the respective goods 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, if similar marks are used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

There is no evidence of record that ice cream on the one hand and ice cream makers and refrigeration equipment on the other emanate from the same source or that any third parties provide both types of products such that the relevant purchasers might assume a connection between those goods if they were offered under similar marks. Moreover, we do not find Mr. Acuri's rather vague statements that he has been "approached" to sell ice cream makers and refrigerated display cases to be

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particularly convincing evidence of opposer's intent to expand into that field.

Opposer argues that the parties' respective products are complementary in nature. This may be true with respect to ice cream and cases for displaying ice cream. However, opposer has not explained or shown any such connection between ice cream and machines for making ice cream, nor does there appear to be one. Opposer sells "finished" ice cream products in prepackaged containers to its customers. Prepackaged ice cream would certainly not be dispensed from applicant's type of ice cream making machine. Nor is there any evidence that applicant's type of ice cream maker would, or even could, after manufacturing the ice cream, be used to dispense ice cream into serving containers such as cups or cones, or into anything other than commercial dispensing containers.

In any event, and even assuming that the respective products have complementary uses, there is no evidence that either piece of equipment is sufficiently related to ice cream such that, notwithstanding the differences in the marks used thereon, purchasers would believe that these goods come from the same source.

Moreover, while the channels of trade may to some extent be the same (both are sold directly from the manufacturer through brochures, trade publications and over the Internet), we have no persuasive evidence that the goods would be encountered in those

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trade channels by the same purchasers. To begin with, it is clear from applicant's identification of goods as well as its testimony that its ice cream making machines and refrigerated cases are directed to the restaurant and food service industry, not to the general public. While the general public may encounter applicant's display cases in their purchase of ice cream at, for example, an ice cream parlor, it would not be under circumstances where confusion is likely to result because the general public is neither a purchaser nor an ultimate user of the display cases.

Nor is it clear that the commercial purchasers for the respective products would be the same. The goods of both parties may be purchased by the same food service institutions, such as restaurants or hotels. However, opposer has not shown, and it cannot be presumed from the inherent nature of these products, that the person responsible for the purchase of food for the restaurant would be the same person who would purchase the supplies and equipment for the restaurant, and in particular, a \$32,000 ice cream maker or \$16,000 refrigeration unit. Our primary reviewing Court has stated that the mere purchase of the goods of both parties by the same institution does not, in itself, establish overlap of customers. See *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992). The fact that food products and equipment are

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not even exhibited at the same trade shows further suggests that the purchasers would not be the same.¹¹

Thus, to the extent that the commercial purchasers do overlap, any such overlap would be de minimis. In any event, these commercial purchasers would be sophisticated and knowledgeable about the products they are buying. In addition, the record shows that ice cream making machines in particular are expensive goods that are purchased only after a careful evaluation process. The Court has made it clear that purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales v. Electronic Data Systems*, supra at 1392. Moreover, "there is always less likelihood of confusion where the goods are expensive and purchased after careful consideration." *Electronic Design & Sales v. Electronic Data Systems*, supra at 1392.

In view of the cumulative differences in the marks and the respective goods and the fact that the goods are not marketed under circumstances which would give rise to the mistaken belief that the goods emanate from a single source, we find that there is no likelihood of confusion.

Decision: The opposition is dismissed.

¹¹ Mr. Acuri stated that he has exhibited in combined food and restaurant equipment trade shows. However, those trade shows were held outside of the United States. Dep., p. 54.