

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
18 September 2008  
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

Sonafi, S.A.  
v.  
Randy Judd

---

Opposition No. 91159665  
to application Serial No. 78164521

---

Anita B. Polott of Morgan, Lewis & Bockius LLP for Sonafi,  
S.A.

Peter M. de Jonge of Thorpe North & Western, LLP for Randy  
Judd.<sup>1</sup>

---

Before Grendel, Drost, and Cataldo, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 23, 2003, applicant Randy Judd applied  
under the intent-to-use provision of the Trademark Act to  
register the mark XOCOLATE in typed or standard character  
form on the Principal Register for "confections, namely;  
candies, chocolate and chocolate truffles" in Class 30.  
Serial No. 78164521.

---

<sup>1</sup> Applicant has not submitted a brief.

After the mark was published for opposition, on February 19, 2004, opposer Sonafi, S.A. filed an opposition to the registration of applicant's mark. In its notice of opposition at 1-2 (bold omitted), opposer alleges that:

Opposer filed an application to register XOCO, Application S.N. 76/414,192 for Cocoa, pastry and candy, chocolate, chocolate food beverages not being dairy based or vegetable based, chocolate based fillings for pies and cakes, and chocolate based ready to eat food bars, in International Class 30 on June 5, 2002...

Applicant seeks registration of XOCOLATE on goods to be sold in direct competition with goods sold by Opposer. Such sale of goods by Applicant is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer or as to the origin, sponsorship or approval of Applicant's goods by Opposer.

Applicant denied the salient allegations of the notice of opposition.

#### The Record

The record includes the file of the involved application and opposer's two notices of reliance on a certified copy of its trademark application (No. 76414192), documents from the '192 application file, and applicant's answers and responses to opposer's interrogatories and requests for admission. In its brief, opposer maintains that:

On July 24, 2007, subsequent to the close of Sonafi's Trial Testimony period in this proceeding, the registration for the XOCO mark issued under Registration No. 3,268,682 on the Principal Register. Sonafi respectfully requests that the Board take judicial notice of this Registration and afford XOCO

the rights and privileges reserved to marks registered on the Principal Register. A certified copy of the registration is attached as Exhibit A.

Brief at 1 n.1.

Applicant did not submit any evidence.

Standing

Opposer has alleged that it is the owner of a pending intent-to-use application for a mark that it believes is confusingly similar to the opposed application. Inasmuch as opposer's belief is not without merit, it has demonstrated its standing to oppose. *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990):

Petitioner herein has set forth allegations not only of its bona fide intent to use the mark FADED GLORY for pants but also of its submission to the Office of an intent-to-use application. In view of the recent amendments to the Trademark Act providing for the acceptance and examination of applications based solely on a bona fide intent to use, we believe that an allegation of a petitioner's ownership of an application based solely on a bona fide intent to use, when coupled with an allegation of a reasonable basis (such as a belief of likelihood of confusion that is not wholly without merit) for petitioner's belief that it would be damaged by the continued existence of the registration(s) sought to be cancelled, is a legally sufficient pleading of standing, that is, of petitioner's real interest in the proceeding beyond that of the general public.

Opposer's Registration

As we indicated earlier, opposer has asked that we take judicial notice of its recently issued registration. We normally do not take judicial notice of USPTO records. *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998)

**Opposition No. 91159665**

("The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record"). However, we note that *applicant* specifically filed a "Motion to Suspend until Opposer Submits Acceptable Specimen for U.S. Serial No. 76/414,192." Opposer consented to the suspension and the board granted the suspension in its order dated April 10, 2007 at 3. In effect, applicant has sought suspension of this proceeding to await a determination of whether opposer's application would meet the requirements for registration. Inasmuch as applicant has treated the registration to be of record, we will deem Registration No. 3268682 to be part of the record. See TBMP § 704.03(b)(1)(A) (2d ed. rev. 2004). See also *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.4 (TTAB 1984), *aff'd unpub.*, No. 852594 (Fed. Cir. March 4, 1986) (Applicant "has not contested opposer's ownership of the relied upon registrations, nor questioned that they are still in force. In fact, applicant's counsel assumes that they are properly of record as part of opposer's case in his recitation of the record. Accordingly, we treat the registrations' currency and their ownership by opposer as having been stipulated") (citation to record omitted) and *Jockey International, Inc. v. Frantti*, 196 USPQ 705, 706 n.5 (TTAB 1977) ("Although status copies showing title in opposer were never filed by opposer,

applicant's brief treats the registrations as being in the record and so shall we") (parenthetical omitted).

Priority

In view of our determination that opposer's registration is of record, priority is not be an issue in the opposition. See *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

However, we add briefly that even if the registration is not properly of record, opposer would still have priority. Applicant filed his application on September 16, 2002. Inasmuch as applicant did not submit any evidence<sup>2</sup> of an earlier date of use, the filing date of this application is applicant's constructive use date. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights").

Even if opposer's registration is not record, we note that an opposer with an intent-to-use application may rely

---

<sup>2</sup> In its response to Interrogatory 19, applicant indicated that it would rely on May 2002 as its date of first use. However, it did not submit any evidence of this date.

**Opposition No. 91159665**

on the filing date of its application to establish priority. See *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1845 n. 7 (TTAB 1995) ("An opposer may rely on Section 7(c) to establish priority if it owns a registration for the mark it is asserting under Section 2(d) or if it has filed an application for registration of that mark. We might put the matter more simply by saying that in proceedings before the Board the constructive use provisions of Section 7(c) may be used both defensively and offensively"). See also 3 *McCarthy on Trademarks and Unfair Competition* § 19.31.10 (4<sup>th</sup> ed. 2008). Opposer's '192 application was filed on June 5, 2002, which is prior to applicant's September 16, 2002 filing date. Therefore, regardless of whether its registration is of record, opposer has established its priority.

Likelihood of Confusion

The ultimate question in this case is whether there is a likelihood of confusion. In likelihood of confusion cases, we look to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

**Opposition No. 91159665**

The Court of Customs and Patent Appeals has noted that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by comparing the goods of the parties. Opposer's goods are "chocolate" and applicant's goods are "candies, chocolate and chocolate truffles." Because both parties' identifications of goods include "chocolate," they are at least in part identical. Furthermore, applicant's truffles are "chocolate" truffles and its candies would include chocolate candies. These goods would be very closely related to opposer's chocolate. Furthermore, 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 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Regarding the purchasers and channels of trade, because the goods are in part identical, we must assume that there are no differences regarding these factors. *Hewlett-Packard Co. v. Packard Press, Inc.* 281 F.2d 1261, 62 USPQ2d 1001 1005 (Fed. Cir. 2002) ("[A]bsent restrictions in the application and registration, goods and services are

**Opposition No. 91159665**

presumed to travel in the same channels of trade to the same class of purchasers") and *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade").

The next "DuPont factor requires examination of 'the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567. In this case, applicant's mark is for the term XOCOLATE and opposer's mark is for the term XOCO. Both marks are in typed or standard character form so there is no legal difference in the stylization of the marks. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"). Therefore, applicant's and opposer's marks are similar to the extent

**Opposition No. 91159665**

that applicant's mark includes opposer's entire mark XOCO. They are different because applicant adds the suffix "-LATE" to opposer's mark. The appearance of both marks is similar because the term XOCO is the only term in opposer's mark and it is the first term in applicant's mark. The first term in a mark is often the most significant one. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a 'prominent feature' as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by VCP's marks, it also constitutes 'the dominant feature' in the commercial impression created by Palm Bay's mark"). The term XOCO appears to be an arbitrary or fanciful term because it is not a term with a recognized meaning. The added term in applicant's mark, "-LATE," would not be as significant here because it, along with the other letters, suggests a connection with the goods, "chocolate." *In re L.C. Licensing Inc.*, 49 USPQ2d 1379, 1382 (TTAB 1998) ("[U]pon considering the marks LIZ (stylized) and LIZSPORT, when used upon the closely related and identical goods listed in the application and the cited registration, we find there is a likelihood of confusion on the part of the purchasing public as to the source of applicant's fragrances

**Opposition No. 91159665**

and body care products"). Thus, the arbitrary term XOCO would be the dominant part of both marks. *Faberge, Incorporated v. Madison Shirt Corp.*, 192 USPQ 223, 227 (TTAB 1976) ("Both 'BRUTUS' and 'BRUT' will project the same general impression of masculinity or 'brute' strength. They are also substantially similar in sound and appearance"). Therefore, the marks' appearances are similar.

Next, we look at the pronunciation, and here we note that there "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Applicant's and opposer's marks would have some similarities in pronunciation. Inasmuch as these marks begin with the same term and the marks themselves are not recognized words, many purchasers may pronounce these marks similarly in view of the identical, common element, XOCO.

When we look at the meanings of the marks, it is clear that these marks are not recognizable terms. While applicant's mark may suggest a misspelling of the word chocolate, it is not clear that this would be the only meaning of the term. Even if it were, prospective purchasers encountering both marks on chocolate, are likely to attribute a similar chocolate-related meaning to the

**Opposition No. 91159665**

marks XOCOLATE and XOCO on chocolate. Therefore, we cannot find that the differences in the meanings of the marks would be enough to avoid confusion.

Regarding their commercial impressions, we find that the unusual XOCO- beginning of both marks, and the entirety of opposer's mark, would dominate these marks. Seeing this unusual letter combination in both marks creates similar commercial impressions, and these marks would likely cause purchasers to assume that the identified products were associated with a common source.

When we compare the marks in their entirety, the identical nature of the common XOCO element would result in marks that are similar. *See In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILTRONICS confusingly similar) and *In re BASF AG*, 189 USPQ 424 (TTAB 1975) (LUTEX and LUTEXAL confusingly similar).

When we view the record in light of the *du Pont* factors, we conclude that there is a likelihood of confusion. The marks XOCO and XOCOLATE are similar, at least, in appearance, pronunciation, and commercial impression. The goods are identical or closely related. The purchasers and channels of trade would be at least overlapping. When these purchasers encounter the marks XOCO and XOCOLATE on chocolate and chocolate truffles and candy,

**Opposition No. 91159665**

they are likely to assume that the source of these goods are related or associated.

Decision: The opposition is sustained.