

**THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

Mailed:  
February 15, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

V & V Supremo Foods, Inc.  
v.  
Wisconsin Cheese Group, Inc.

---

Cancellation No. 92044301

---

Jeffrey A. Handelman of Brinks Hofer Gilson & Lione for V & V Supremo Foods, Inc.

Matthew P. Lewis of Maslon Edelman Borman & Brand, LLP for Wisconsin Cheese Group, Inc.

---

Before Seeherman, Hairston, and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

V & V Supremo Foods, Inc. has petitioned to cancel U.S. Trademark Registration No. 2,876,481, owned by Wisconsin Cheese Group, Inc., for the mark QUESERIA CARIBE, in standard character form, for "cheese". The application for the registration was filed on April 15, 2003. Respondent claimed May 1, 1992 as the date of first use anywhere and first use in commerce. The registration issued on August 24, 2004. Respondent disclaimed the exclusive right to use

**Cancellation No. 92044301**

"Caribe" and included the following translation: "The English translation of 'QUESERIA' is 'CHEESE SHOP' and the English translation of 'CARIBE' is 'CARIBBEAN'."

Petitioner brought this cancellation on the ground of priority of use and likelihood of confusion, alleging that it is in the business of selling cheese and other dairy products in interstate commerce; that petitioner has extensively and continuously used the mark DEL CARIBE for cheese prior to respondent's use of QUESERIA CARIBE; that petitioner is the owner of U.S. Trademark Registration No. 2,020,442 for the mark DEL CARIBE, in standard character format, for "cheese";<sup>1</sup> and that QUESERIA CARIBE, when used in connection with cheese, so closely resembles DEL CARIBE for cheese as to be likely to cause confusion, to cause mistake, and to deceive.

Respondent denied the pertinent allegations of the petition for cancellation. As an affirmative defense, respondent asserted that the word "Caribe" is Spanish for "Caribbean" which is merely descriptive or geographically descriptive when used in connection with cheese.

Both parties filed briefs.

---

<sup>1</sup> Registration No. 2,020,442, issued December 3, 1996: Sections 8 & 15 affidavit accepted and acknowledged. Petitioner included the following translation: "The English translation of 'DEL CARIBE' is 'from the Caribbean' or 'of the Caribbean'." The registration contains no disclaimer.

The Record

By operation of the rules, the record includes the pleadings and the QUESERIA CARIBE registration file. The record also includes testimony and evidence introduced by the parties.

A. Petitioner's evidence.

Petitioner introduced the following testimony and evidence in support of its case:

1. The testimony deposition of Gilberto Villasenor, II, petitioner's General Manager, with attached exhibits; and,

2. Petitioner's notice of reliance consisting of the following documents:

- a. Excerpts from the discovery deposition of Michael Sigel, respondent's Marketing Director, with attached exhibits;
- b. Status and title copy of Registration No. 2,020,442 for the mark DEL CARIBE;
- c. Respondent's interrogatory answers; and,
- d. Respondent's responses to certain requests for admission.

B. Respondent's evidence.

Respondent introduced the following testimony and evidence in support of its case:

1. Testimony deposition of Michael Sigel with attached exhibits; and,

2. Respondent's notice of reliance consisting of the following documents:

- a. Petitioner's interrogatory answers;
- b. Petitioner's responses to requests for admission;
- c. Status and title copy of Registration No. 2,876,481 for the mark QUESERIA CARIBE;<sup>2</sup> and,
- d. A copy of Registration No. 2,189,794 for the mark DEL CARIBE and Design for fresh fruits and vegetables registered in the name of Caribe Food Corp., a Florida corporation.

Findings of Fact

Petitioner is an Illinois corporation that began doing business in 1964.<sup>3</sup> It manufactures and sells Hispanic lines of food products, including cheeses, sour cream, and sausage.<sup>4</sup> Petitioner has been continuously using the mark DEL CARIBE for queso blanco, a type of white cheese, since 1976.<sup>5</sup> The English translation of "Del Caribe" is "from the Caribbean" or "of the Caribbean."<sup>6</sup> DEL CARIBE cheese is sold at deli counters and on an off-the-shelf basis in chain

---

<sup>2</sup> It was unnecessary for respondent to submit a copy of its registration. As noted previously, the registration file, including the registration, is of record by operation of Trademark Rule 2.122(b).

<sup>3</sup> Villasenor Dep., p. 6.

<sup>4</sup> Villasenor Dep., p. 9; Petitioner's response to Interrogatory No. 2.

<sup>5</sup> Villasenor Dep., pp. 10 and 12; Petitioner's response to Interrogatory No. 5.

<sup>6</sup> Villasenor Dep., p. 36 and Ex. 18; Petitioner's response to request for admission No. 4.

and independent grocery stores in numerous states.<sup>7</sup> It is also sold to restaurants.<sup>8</sup> On August 18, 1995, petitioner filed a trademark application to register DEL CARIBE for cheese. The mark was registered on December 3, 1996. The DEL CARIBE registration was over five years old when petitioner filed the petition for cancellation against the QUESERIA CARIBE registration.<sup>9</sup>

Respondent is a Wisconsin corporation that began doing business in 1985.<sup>10</sup> It primarily manufactures and sells cheeses.<sup>11</sup> Respondent began selling cheese under the mark QUESERIA CARIBE on May 1, 1992.<sup>12</sup> QUESERIA CARIBE cheese is part of respondent's Hispanic line of products.<sup>13</sup> There are two types of QUESERIA CARIBE cheese: queso blanco and queso fresco.<sup>14</sup> QUESERIA CARIBE queso blanco is a semi-soft white cheese that fries well.<sup>15</sup> QUESERIA CARIBE queso fresco is a semi-soft white cheese that crumbles well.<sup>16</sup> QUESERIA CARIBE is a "control brand" that is only sold to Costco

---

<sup>7</sup> Villasenor Dep., pp. 12-14; Petitioner's response to Interrogatory No. 5.

<sup>8</sup> Villasenor Dep. p. 14.

<sup>9</sup> Villasenor Dep., Ex. 18; petitioner's notice of reliance.

<sup>10</sup> Sigel Testimony Dep., p. 6.

<sup>11</sup> Sigel Testimony Dep., p. 8; Sigel Discovery Dep., pp. 20-21.

<sup>12</sup> Sigel Testimony Dep., p. 10.

<sup>13</sup> Sigel Discovery Dep., pp. 42 and 55.

<sup>14</sup> Sigel Discovery Dep. pp. 21-22.

<sup>15</sup> Sigel Discovery Dep. p. 23.

<sup>16</sup> Sigel Discovery Dep. p. 23.

stores.<sup>17</sup> The English translation of "Queseria Caribe" is "Caribbean cheese shop."<sup>18</sup>

Petitioner's Standing and Priority

Because petitioner has properly made its pleaded registration of record, petitioner has established its standing to cancel the respondent's registration.

*Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Petitioner has established priority by proving continuous use of its DEL CARIBE mark since 1976, well prior to respondent's first use in 1992 and the filing date of its application in 2003.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed.

---

<sup>17</sup> Sigel Testimony Dep. pp. 11-12; Sigel Discovery Dep., p. 23; Respondent's response to Interrogatory Nos. 1 and 3. A "control brand" is a product that is sold to only one customer. Sigel Testimony Dep., p. 11. In other words, it is an exclusive private label brand.

<sup>18</sup> Sigel Testimony Dep. p. 27; Sigel Discovery Dep., p. 26.

Cir. 2003); *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. *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 differences in the marks").

A. The goods of the parties are identical.

The issue of likelihood of confusion must be determined based on an analysis of the marks as applied to the goods recited in the respondent's registration and the petitioner's registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Proceedings before the Board are concerned with registrability and not use of a mark. Accordingly, the identification of goods/services statement in the registrations, not the goods/services actually used by the parties, frames the issue. *Cunningham v. Laser Golf Corp.*, *supra* 55 USPQ2d at 1846. In this case, both petitioner's DEL CARIBE registration and respondent's QUESERIA CARIBE

registration are for cheese. Moreover, the evidence adduced at trial indicates the marks are, in fact, used on the same type of cheese (*i.e.*, queso blanco or white cheese). The identity of the goods is a factor that favors petitioner.

B. The goods of the parties move in the same channels of trade and are sold to same classes of consumers.

It is well-settled that the issue of likelihood of confusion between the registered marks of the petitioner and the respondent must be determined on the basis of the goods or services as they are identified in the involved registrations, rather than on what any evidence may show as to the actual nature of the products, their channels of trade and/or classes of purchasers. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Because there are no restrictions as to channels of trade in the description of goods in the parties' registrations, we must consider the respondent's cheese and the petitioner's cheese to be sold in all of the normal channels of trade and to all of the normal purchasers for such goods. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, supra*; *Toys R Us v. Lamps R Us*, 219 USPQ 340, 343 (TTAB 1983). In other words, we consider respondent's cheese as being sold in chain and independent grocery stores and petitioner's cheese as being sold at warehouse stores

such as Costco. In addition, we consider the cheese to be sold to the same classes of consumers, including ordinary consumers. Accordingly, this is a factor that favors petitioner.

C. The degree of consumer care.

Petitioner argues that because "both parties sell relatively inexpensive cheese products to ordinary consumers with no special training or expertise," the likelihood of confusion is increased because purchasers exercise less care purchasing inexpensive cheese than for more costly products. (Petitioner's Brief, pp. 11-12). On the other hand, respondent argues that petitioner has presented no evidence regarding the degree of care used by consumers purchasing cheese and that the evidence actually shows that the consumers are not unsophisticated. For example, respondent asserts that because consumers ask for petitioner's cheese by name,<sup>19</sup> then such customers cannot be as unsophisticated as petitioner suggests. In any event, respondent maintains that because the marks are so different, even consumers who do not exercise a high degree of care will not be confused by the marks. (Respondent's Brief, pp. 21-22).

---

<sup>19</sup> Villasenor Dep., p. 29.

Petitioner's cheese is sold in chain and local grocery stores and respondent's cheese is sold in Costco stores.<sup>20</sup> These are mass-market type stores, rather than specialized gourmet stores or cheese boutiques, and their cheese products are sold off-the-shelf. The price for petitioner's cheese is \$2.99 - \$3.69 per pound.<sup>21</sup> Because the parties use their marks on the identical kind of cheese (*i.e.*, queso blanco), we must assume that respondent's cheese can be sold for similar prices.<sup>22</sup> The cheese products are standard grocery store products. The relative low cost of the cheese and the fact that the cheese may be purchased on impulse are factors that increase the likelihood of confusion. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ 1894, 1899 (Fed. Cir. 2000) ("When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care") (citations omitted). Therefore, the degree of consumer care is a factor that favors petitioner.

---

<sup>20</sup> Costco is a warehouse club store. Sigel Discovery Dep., p. 27. In order to shop at Costco, one must purchase a membership. Sigel Testimony Dep., p. 34; Sigel Discovery Dep., p. 27. Costco features bigger packaging configurations than at standard grocery stores. Sigel Testimony Dep., p. 33.

<sup>21</sup> Villasenor Dep., Exhibits 27-28.

<sup>22</sup> Mr. Sigel did not know the price at which consumers could purchase respondent's cheese. Sigel Discovery Dep., pp. 27-28.

D. The strength of petitioner's mark and the number and nature of similar marks in use on similar goods.

Petitioner argues that DEL CARIBE is a strong mark as evidenced by petitioner's extensive sales and promotional efforts and, therefore, it is entitled to a broad scope of protection. (Petitioner's Brief, pp. 8-9). In support of its argument, petitioner contends that it has been continuously using the mark DEL CARIBE for cheese since 1976; and that since 1996, its sales have been extensive.<sup>23</sup> However, petitioner has not provided any context in which to place these raw sales figures (e.g., the percentage of the market share). See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002). For example, in response to Interrogatory No. 5, petitioner stated that it has sold its cheese in numerous states, but we do not know how many states. Sales of X pounds of cheese in Chicago are more significant than sales of X pounds throughout the Midwest or throughout the entire nation. The only conclusion that we can draw from the sales figures is that petitioner has sold enough DEL CARIBE cheese to make it an important product for petitioner.<sup>24</sup>

---

<sup>23</sup> Villasenor Dep., Exhibit 19 (Confidential). Because petitioner has designated its sales figures in terms of dollars and pounds as confidential, we will refer to them only in the general terms petitioner has used in its brief.

<sup>24</sup> Villasenor Dep., p. 10.

Petitioner also contends that its promotional efforts demonstrate that DEL CARIBE is a strong mark. Petitioner promotes its DEL CARIBE cheese primarily by supplying retailers with point-of-purchase marketing materials that are prominently displayed in store windows, on walls, and on shelves.<sup>25</sup> In addition, Mr. Villasenor testified that petitioner provides retailers with support for promoting DEL CARIBE cheese in their advertising.<sup>26</sup> The specifics of that support were not discussed, but based on the context of the testimony, we assume that it is some type of financial support. Petitioner also conducts in-store demonstrations.<sup>27</sup>

In arguing against petitioner's position that DEL CARIB is strong, respondent maintains that petitioner is actually attempting to exclusively appropriate the use of the word "Caribe"; that respondent has been using the word "Caribe" as part of its mark for many years; and that the only issue is whether QUESERIA CARIBE is likely to cause confusion with DEL CARIBE. (Respondent's Brief, pp. 18-19).

In addition, respondent contends that the word "Caribe," the common element of the two marks, is highly suggestive, if not descriptive, of cheese, and that, therefore, DEL CARIBE is actually a weak mark.

---

<sup>25</sup> Villasenor Dep., p. 14.

<sup>26</sup> Villasenor Dep., pp. 15-16.

<sup>27</sup> Villasenor Dep., p. 15.

(Respondent's Brief, pp. 13-15). In support of this argument, respondent has introduced one third-party registration (Registration No. 2,189,794 for the mark DEL CARIBE and Design for "fresh fruit and vegetables")<sup>28</sup> and evidence of third-party use of "Caribe." The third-party use includes the following web pages and photographs:

1. Caribe Food Corp. ([www.caribefood.com](http://www.caribefood.com)) displaying the DEL CARIBE and Design trademark referenced above.<sup>29</sup> The webpage states that "Caribe Food Corp has been importing and distributing fruits and vegetables for over 30 years in South Florida";
2. Caribe Food Development Inc. in Charlotte, North Carolina ([www.ncagr.com/ncproducts/showsite.asp?ID=2131](http://www.ncagr.com/ncproducts/showsite.asp?ID=2131)).<sup>30</sup> According to the webpage, Caribe Food Development, Inc. sells condiments, marinade, barbecue sauce, and tropical tea. The products purportedly can be found in various chain grocery stores. However, there is no evidence that the word "Caribe" is used as a part of a mark;
3. A photograph taken by Mr. Sigel of a product called MALTA CARIBE;<sup>31</sup>
4. El Caribe Restaurant in Lenexa, Kansas ([www.kcrestaurantguide.com/El\\_caribe.htm](http://www.kcrestaurantguide.com/El_caribe.htm)).<sup>32</sup> The restaurant advertises "Coastal Seafood Cuisine From Mexico and Cuban Cuisine.";
5. A photograph taken by Mr. Sigel of the sign for the Caribe Cafeteria located in Miami;<sup>33</sup> and,

---

<sup>28</sup> The registrant disclaimed the exclusive right to use "Del Caribe" and included the following translation: "The English translation of 'Del Caribe' is 'From the Caribbean'."

<sup>29</sup> Sigel Testimony Dep., Exhibit 5.

<sup>30</sup> Sigel Testimony Dep., Exhibit 6.

<sup>31</sup> Sigel Testimony Dep., p. 18; Exhibit 7. The product is not identified in Mr. Sigel's testimony. MALTA CARIBE appears to be a malt beverage.

<sup>32</sup> Sigel Testimony Dep., Exhibit 8.

<sup>33</sup> Sigel Testimony Dep., Exhibit 9.

6. Caribe Café located in the Mirage hotel in Las Vegas ([www.mirage.com/dining/causal\\_dining\\_caribe-cafe.aspx](http://www.mirage.com/dining/causal_dining_caribe-cafe.aspx)).<sup>34</sup>

At the outset, it is clear that respondent is not attempting to attack petitioner's registration of the mark DEL CARIBE. Petitioner's registration is more than five years old and respondent has not filed a counterclaim to cancel the registration. Thus, we regard respondent's arguments as going only to the scope of protection to be accorded the mark DEL CARIBE, and specifically the amount of protection to be accorded the element "Caribe" in terms of a finding of likelihood of confusion when this is the only element common to both marks.

In that regard, there is no question that DEL CARIBE means "from the Caribbean" and that it suggests that the cheese may come from the Caribbean. However, the term "Caribbean" references a broad geographic region and when applied to cheese, suggests a feeling of the tropics, rather than describing a geographic origin of the goods.

Restatement (Third) of Unfair Competition §14, comment d (1995) (if a locale is not known for a commercial activity or the designation is so all-inclusive that it does not indicate a specific location, the use may be understood as arbitrary or suggestive); 2 McCarthy On Trademarks And Unfair Competition §14.7 (4<sup>th</sup> ed. 2006) (if buyers do not

---

<sup>34</sup> Sigel Testimony Dep., Exhibit 10.

care that the goods come from the place named - - and they do not come from the place named - - then the mark is being used in an arbitrary sense).

With reference to the evidence of third-party use, where a term is commonly used on numerous types of goods and services by different companies, it may be reasonable to infer that purchasers have become conditioned to expect different sources for related goods and services sold under that common term. *NCTA v. American Cinema Editors*, 937 F2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *Miles Laboratories v. Naturally Vitamin Supplements*, 1 USPQ2d 1445, 1462 (TTAB 1987) (purchasers will not rely on the common element as a means of distinguishing source). However, in this case, the small number of relevant examples of third-party use does not support a finding that the word "Caribe" has been so commonly used that consumers have become conditioned to encountering trademarks comprising, in whole or in part, the word "Caribe" in general, let alone for products similar to those at issue herein. The third-party uses that are of record are not for cheese. *NCTA v. American Cinema Editors*, 937 F.2d 1572, 19 UPSQ2d 1424, 1430 (Fed. Cir. 1991) (the relevant public does not need to be defined any broader than purchasers of the products at issue and the third-party uses other than the products at issue may be irrelevant); *Saab-Scania Aktiebolag v. Sparkomatic*

**Cancellation No. 92044301**

*Corp.*, 26 USPQ2d 1709, 1712-1713 (TTAB 1993); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). El Caribe Restaurant, the Caribe Cafeteria, and the Caribe Café are restaurants. The restaurants appear to be local in nature with local exposure. Therefore, they do not diminish the strength of the DEL CARIBE mark. MALTA CARIBE is for a malt beverage, while Caribe Food Development, Inc. is a trade name for a company that purportedly sells condiments, marinade, barbecue sauce, and tropical tea. It is not clear to what extent the public would be exposed to this trade name use, or whether this name would be familiar only to the retail stores that carry the products this company distributes.

The most pertinent third-party use, although here again the goods are different, is DEL CARIBE and Design for fruits and vegetables. This use, however, is not sufficient for us find that the consuming public is so used to "Caribe" trademarks that they would look to the other elements in petitioner's and respondent's marks when the marks are used on identical goods. Thus, the evidence does not support respondent's argument that DEL CARIBE is a weak mark. *Puma-Sportsschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 064, 1066 (TTAB 1984); *Dubonnet Wine Corp. v. Schneider*, 218 USPQ 331, 335 (TTAB 1983). Accordingly,

respondent's evidence of third-party use, while certainly considered in our analysis, is entitled to limited weight.

In any event, even if DEL CARIBE is treated as a weak mark, it is still entitled to protection against maintenance of a registration for a confusingly similar mark for identical goods. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 UPSQ 108, 109 (CCPA 1974) ("The likelihood of confusion is to be avoided, as much between 'weak' marks as between 'strong' marks, or as between a 'weak' and a 'strong' mark"). Therefore, we regard this factor as favoring petitioner.

E. Actual confusion.

Respondent argues that QUESERIA CARIBE and DEL CARIBE have coexisted for more than fourteen years without any reported instances of actual confusion; and that the fact that the two marks have existed for such a long time without any instances of actual confusion is highly probative that there is no likelihood of confusion. (Respondent's Brief, pp. 16-17).

The record in this case is too vague to support any conclusions regarding the probative value that should be accorded to the fourteen years of concurrent use without any reported instances of confusion. It is difficult to assess whether a reasonable opportunity for confusion could arise.

Respondent did not provide any evidence as to the sales volume of QUESERIA CARIBE cheese,<sup>35</sup> so we do not know whether the products have coexisted in the marketplace. There is nothing in the record to indicate whether the parties sell their products in the same geographic trading areas. Petitioner sells its cheese in numerous states, but those states are not identified.<sup>36</sup> While respondent sells its products to Costco, respondent does not know where Costco sells the products.<sup>37</sup> Thus, we have no evidence that the parties sell their cheese in the same geographic markets.

Respondent does not advertise its QUESERIA CARIBE cheese<sup>38</sup> and petitioner promotes its DEL CARIBE cheese through in-store promotions and retailer advertising.<sup>39</sup> Thus, we cannot view the QUESERIA CARIBE and DEL CARIBE cheeses as being so extensively promoted that we can assume that consumers have been exposed to both marks.

In the absence of evidence that demonstrates that there has been a reasonable opportunity for confusion to have actually occurred (e.g., the areas of use, the extent of the use of the marks, etc.), this likelihood of confusion factor

---

<sup>35</sup> Respondent's response to Interrogatory No. 7.

<sup>36</sup> Petitioner's response to Interrogatory No. 5.

<sup>37</sup> Sigel Discovery Dep., pp. 26-27 (there are eight Costco regions; QUESERIA CARIBE is sold in some of the regions; but Mr. Sigel does not know how many regions).

<sup>38</sup> Sigel Discovery Dep., pp. 35-36.

<sup>39</sup> Villasenor Dep., pp. 14-16.

does not carry any weight. *Nina Ricci S.A.R.L. V. E.T.F. Enterprises, Inc.*, 12 USPQ2d 1901, 1903 (TTAB 1989); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988).

F. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours and Co.*, *supra*. 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 overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, *supra* at 1741.

Additionally, we are mindful that where, as here, the marks are applied to identical products, the degree of similarity necessary to support a conclusion of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (finding CENTURY LIFE OF AMERICA for insurance underwriting services likely to cause confusion

with CENTURY 21 for insurance brokerage services); *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1700 (TTAB 2006) (finding iSHINE likely to cause confusion with ICE SHINE when both marks are applied to floor-refinishing preparations).

Petitioner argues that the marks are similar because the word "Caribe" is featured as the dominant part of both marks. As shown below on respondent's labels,<sup>40</sup> the word "Queseria" appears in substantially smaller type than the word "Caribe."



Petitioner also contends that both marks have a similar meaning: petitioner's mark means "from the Caribbean" and respondent's mark means "Caribbean cheese shop." Finally, petitioner asserts that the marks are phonetically similar. (Petitioner's Brief, pp. 9-11).

Respondent argues that the "marks do not look alike, sound alike, or create similar impressions in the mind of

---

<sup>40</sup> Sigel Discovery Dep., Exhibits 3 and 4.

the consumer" because when the marks are compared in their entireties, "the marks are entirely different." In particular, respondent asserts that the marks have different meanings (QUESERIA CARIBE means "the Caribbean cheese shop" while DEL CARIBE means "from the Caribbean"); the marks are phonetically distinct; and when viewed in actual use, the marks look different because they have different color schemes, different fonts, and create different impressions. (Respondent's Brief, pp. 10-13).

Respondent asserts that the common portion of the marks, the word "Caribe," is descriptive because it indicates a particular type of food (*i.e.*, Caribbean food). Respondent contends that consumers will give less weight to the descriptive term "Caribe" and will look to the other portions of the marks to identify and distinguish source. (Respondent's Brief, pp. 13-15).

Finally, respondent argues that the word "Queseria" is the dominant portion of QUESERIA CARIBE because it is the first part of the mark and because it is the part of the mark that distinguishes respondent's mark from all other products using the descriptive term "Caribe." (Respondent's Brief, pp. 19-20).

When we compare the two marks in their entireties, giving appropriate weight to all of their features, we find that the marks, while obviously not identical, are similar,

and that the similarities in the marks outweigh their differences.

As for appearance and sound, the marks are similar because they share the word "Caribe" as a common element. Respondent's argument that in actual use the marks look different is unavailing. Since both marks are presented in typed or standard character form, the marks are not limited to any specific display and, in particular, they are not limited to the manner in which the marks are currently being used. The marks may be displayed in the same style, color scheme, font, etc., thereby increasing the visual similarity of the two marks. Therefore, it is irrelevant that the display of the marks in actual use is different. *Cunningham v. Laser Golf Corp.*, *supra* at 55 USPQ2d at 1846.

While in certain circumstances it is permissible to accord greater weight to one element of a mark than another in making a determination of likelihood of confusion, we do not think that the word "Queseria" in respondent's mark should be accorded greater weight than the word "Caribe." First, the display of QUESERIA CARIBE in actual use belies respondent's argument that "Queseria" is the dominant portion of its mark. Based on respondent's use, we think that it is "Caribe" which is more likely to be noted and remembered by consumers.

Second, as indicated above, there is no basis in this record to conclude that the word "Caribe" is descriptive or geographically descriptive when used in connection with cheese.

Finally, the word "Queseria" is suggestive of respondent's cheese in that Spanish-speaking purchasers will view it as a laudatory term indicating that the cheese is worthy of being sold in cheese shops. With respect to non-Spanish speaking purchasers, "Queseria" may call to mind cheese because of the familiarity with quesadillas or queso (cheese). Accordingly, we cannot conclude that "Queseria" is a distinguishing element of respondent's mark.

The connotation and commercial impressions engendered by the marks are similar in that both marks suggest a Caribbean theme. DEL CARIBE means "from the Caribbean" and QUESERIA CARIBE means "Caribbean cheese shop." Although there are differences in the specific translations of the marks, the meanings do not need to be identical to be confusingly similar. Slight differences in meaning are unlikely to be noticed or remembered by consumers. *Mohawk Rubber Co. V. Mobiliner Tire Co., Inc.*, 217 USPQ 929, 932 (TTAB 1981) (MOHAWK and MOHICAN for tires are likely to cause confusion); *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 332 (CCPA 1953) (CYCLONE and TORNADO for fencing are likely to cause confusion).

In considering the commercial impression engendered by the marks, it must be kept in mind that a side-by-side comparison is not the proper test because consumers are not exposed to the marks in that way. The proper emphasis is on the recollection of the average customer, who normally retains a general rather than a specific impression of the marks. *Spoons Restaurants Inc. v. Morrison Inc., supra.* Given the similar meanings of the marks, we find that the commercial impression engendered by both marks also suggest a Caribbean theme.

To be sure there are differences in the marks. However, in considering the marks in their entirety, we conclude that the similarities in appearance, sound, meaning, and commercial impression outweigh the dissimilarities.

After weighing all of the likelihood of confusion factors present in this case, we find that QUESERIA CARIBE for cheese so closely resembles DEL CARIBE for cheese as to be likely to cause confusion, to cause mistake, and to deceive. While this decision is not without doubt, the doubt must be resolved in favor of the prior user. *Koplin v. Golf Players, Inc.*, 179 UPSQ 378, 381 (TTAB 1973); *Servicemaster Industries, Inc. v. Collman Industries*, 173 USPQ 508, 510 (TTAB 1972).

Decision: The petition for cancellation is granted.