

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 5/30/00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WMGA, Inc.

Serial No. 75/306,785

Leslye S. Fenton of Odin, Feldman & Pittleman, P.C.
for WMGA, Inc.

Susan Leslie DuBois, Trademark Examining Attorney, Law
Office 111 (Craig Taylor, Managing Attorney).

Before Hanak, Wendel and Rogers, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

WMGA, Inc. has filed an application to register the
mark SANTA LUCIA for "coffee beans, whole and ground."¹

Registration has been finally refused under Section
2(d) of the Trademark Act on the ground of likelihood of

¹ Serial No. 75/306,785, filed June 11, 1997, based on an
allegation of a bona fide intent to use the mark in commerce.
The application as filed recited a number of coffee and tea
products, but the identification of goods was ultimately limited
to the above.

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confusion with the marks SANTA LUCIA² and SANTA LUCIA and design,³ as shown below, both of which have been registered by the same entity for "mineral waters."

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

We make our determination of likelihood of confusion on the basis of those of the du Pont factors⁴ which are relevant under the present circumstances. Two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used or are intended to be used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Applicant's mark SANTA LUCIA and registrant's mark SANTA LUCIA (Registration No. 1,888,761) are obviously

² Registration No. 1,888,761, issued April 11, 1995.

³ Registration No. 1,894,254, issued May 16, 1995. The statement is made that the lining in the mark is a feature of the mark and is not intended to indicate color.

identical. Moreover, we agree with the Examining Attorney that even in registrant's second mark, SANTA LUCIA and design, SANTA LUCIA is the dominant portion of the mark and the portion which will be relied upon by consumers in calling for the goods in the marketplace. As a general rule, design elements of a mark are of lesser import, because it is the word portion of a mark, rather than any design feature, unless highly distinctive, which is more likely to be remembered and relied upon by customers in calling for the goods. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Fugli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

Applicant has acknowledged that the respective marks are similar in sight and sound, but argues that a new meaning has been attributed to its mark in the marketplace by the association of the mark with applicant's particular product. Applicant claims that the meaning of quality which its product has brought to the mark SANTA LUCIA is sufficient to avoid confusion. Applicant states that its coffee beans come from a single plantation in Nicaragua and are sold to the finest restaurants, hotels, gourmet

⁴ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

supermarkets and coffee shops. Applicant relies heavily upon the rulings made by the District Court in *Southern Foods Group L.P. v. Ben & Jerry's Homemade Inc.*, 48 USPQ2d 1220 (D. Utah 1998) as support for its contention that identical marks can be used on the same product, much less the different products involved here, without the likelihood of confusion.

The *Southern Foods* case was an infringement and unfair competition action in which an injunction was sought barring the defendants' further use of the mark TOTALLY NUTS for ice cream. The District Court considered not only the marks and the goods of the parties, which were the same, but other factors involved in the actual marketing of the goods, particularly the trade dress, noting the distinct visual differences in the packaging used by the two parties.

By contrast, the present appeal involves the right of applicant to register its mark, in view of the statutory bar under Section 2(d) when there is the likelihood of confusion with a previously registered mark. The registration sought is for the word mark SANTA LUCIA in a typed drawing, which leaves applicant free to use the mark in any format. Since the trade dress used in conjunction with the mark may be changed at whim, the trade dress at

any given time is normally not considered in determining likelihood of confusion. An exception may be made if the trade dress provides evidence that there is a likelihood of confusion, i.e., that the commercial impression created by the mark as it is being used is confusingly similar to the other mark. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984). The alternative, however, is not true. The absence of a likelihood of confusion cannot be established on the basis of the present trade dress of the respective products, in view of its transitory nature.

In any event, applicant is arguing that confusion is avoided here by the mere fact that the products involved are different products which must be packaged differently, not by any distinctive style of trade dress. The similarity or dissimilarity of the goods and their packages, however, are factors separate from the similarity of the marks per se. Applicant's mark and registrant's mark SANTA LUCIA are identical and thus necessarily create the identical commercial impression. Even though registrant's second mark has an additional design feature, we find the overall commercial impression of this mark highly similar to applicant's mark. The fact that applicant's coffee beans bearing the mark SANTA LUCIA have

achieved a high degree of recognition in the marketplace as a quality product is immaterial, if the previously registered marks are confusingly similar to applicant's mark.

Turning to the goods, we note that the Examining Attorney has made of record copies of several third-party registrations showing the adoption by the same entity of the same mark for both mineral waters and coffee. She relies upon this evidence to support her argument that the goods are related products which may be found in the same commercial setting and, if being marketed under the same mark, may well be assumed by purchasers to originate from the same source. She also points out that coffee beans are used to make coffee; that both coffee and mineral waters are beverages and may be used interchangeably; and that these are common items which are purchased without any particular expertise.

Applicant argues that there is an obvious difference in the goods, namely, applicant's coffee beans are staples and registrant's mineral waters a "light fluid," and that as such, the products would be not normally be sold in the same areas in food stores. Applicant contends that the goods are not only marketed in visually distinct packaging, but there is also a price differential, registrant's

mineral waters being significantly less expensive.

Applicant also points to the affidavit of its president William Gutierrez as support for its arguments that its coffee beans travel in different channels of trade and are sold to a different class of purchasers. In this affidavit Mr. Gutierrez states that applicant sells its "premium" coffee beans, which come from one specific plantation in Nicaragua, to a specialized market, the food and hospitality industry, and that the purchasers of this coffee are extremely discriminating.

AS a general principle, the issue of likelihood of confusion must be determined on the basis of the goods as identified in the application and in the cited registration(s). *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, despite applicant's arguments as to the quality or price of its coffee beans, the goods as identified in the application cover all grades of coffee beans, regardless of origin or cost. Furthermore, if there are no restrictions in the application or registration(s) as to channels of trade, the parties' goods must be assumed to travel in all the normal channels of trade for goods of this nature. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). There being no

restrictions in applicant's application as to the particular market in which applicant claims to sell its coffee beans, we must assume that the goods travel in all the normal channels for coffee beans, which includes general retail outlets.

Accordingly, we make our determination of the similarity or dissimilarity of the goods by a comparison simply of coffee beans, whole and ground, and mineral waters. As a general principle, it is not necessary that the goods be similar or even competitive to support a holding of likelihood of confusion, it is sufficient if 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, because of the similarity of the marks used thereon, give raise to the mistaken belief that they emanate, or are associated with, the same source. See *In re Albert Trostel & Sons*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein. When the goods are food products, the use of identical marks which are not descriptive or highly suggestive in itself weighs heavily on the side of likelihood of confusion. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir.

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1984); In re Vroman Foods, Inc., 224 USPQ 242 (TTAB 1984) and the cases cited therein.

Here, besides bearing identical (or nearly identical) non-suggestive marks, the goods are closely related beverage products. While applicant's coffee beans may be the raw ingredient for a coffee drink, both products would be purchased for consumption as beverages. See In re Pan-O-Gold Baking Co., 20 USPQ2d 1761 (TTAB 1991)[muffin mix and baked bread and rolls closely related bread products]. The two products might very well be encountered by the same purchasers in the same retail outlets, regardless of the specific location of each product in a particular store, and be purchased at the same time for use either together, at a party or family gathering, or for use singularly, depending upon the beverage desired at a particular time. Although the third-party registrations made of record by the Examining Attorney are not evidence that the marks shown therein are actually in use, they are adequate to suggest that both coffee products and mineral waters may reasonably be expected to emanate from a single source, along with other beverage products. See In re Albert Trostel & Sons Co., *supra*. This being the case, we find confusion highly likely if the identical marks SANTA LUCIA, or the highly similar marks SANTA LUCIA and SANTA LUCIA and

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design, are used on applicant's coffee beans and registrant's mineral waters.

Decision: The refusal under Section 2(d) is affirmed.

E. W. Hanak

H. R. Wendel

G. F. Rogers
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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