

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT  
OF THE TTAB

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Hearing:  
February 5, 1997

Paper No.  
CEW

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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V. La Rosa & Sons, Inc.  
v.  
John Zidian Company, Inc.

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Consolidated  
Opposition No. 87,389 and  
Cancellation Nos. 20,853, 20,854 & 21,092

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Demetra J. Mills of Lowe, Price, LeBlanc & Becker for  
opposer/respondent

Robert Herberger of McLaughlin, McNally & Carlin for  
applicant/petitioner

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Before Simms, Hanak and Walters, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

V. La Rosa & Sons, Inc. filed its opposition to the  
application of John Zidian Company, Inc. to register the

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mark LA RUSSA and design, shown below, for food produce,  
namely, processed tomatoes and tomato based sauces.<sup>1</sup>



As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered marks LA ROSA for "alimentary pastes and bread crumbs"<sup>2</sup>; LA ROSA and design, as shown below, for "spaghetti, lasagna, macaroni, noodles and bread crumbs,"<sup>3</sup>

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<sup>1</sup> Application Serial No. 74/109,377, filed October 26, 1990, in International Classes 29 ("food produce, namely, processed tomatoes") and 30 ("food produce, namely, tomato based sauces"), based upon use of the mark in commerce in connection with the identified goods in both classes alleging first use and first use in commerce as of November 1, 1989.

<sup>2</sup> Registration No. 1,396,003, issued June 3, 1986, to opposer for a term of twenty years; Sections 8 and 15 affidavits accepted and acknowledged, respectively. The registration certificate includes a statement that "LA ROSA translated into English means 'the rose'."

<sup>3</sup> Registration No. 1,390,117, issued April 15, 1986, to opposer for a term of twenty years; Sections 8 and 15 affidavits accepted and acknowledged, respectively. The registration certificate includes a statement that "LA ROSA translates into English as 'the rose'."



and RUSSO's and design, as shown below, for "alimentary pastes,"<sup>4</sup>

**RUSSO'S**

as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Applicant, in its answer, denied the salient allegations of the likelihood of confusion claim. Applicant asserted as affirmative defenses that opposer has failed to

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<sup>4</sup> Registration No. 382,621, issued November 5, 1940, to A. Russo & Co., Inc.; renewed for a second time for twenty years from November 5, 1980. The records of the PTO show title to this registration in opposer. We take notice of the definition of "alimentary pastes" as "a shaped and dried dough (as macaroni, spaghetti and vermicelli) prepared from semolina, farina, or wheat flour or a mixture of these with water or milk and with or without egg or egg yolk," *Webster's Third International Dictionary*, 1976.

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allege grounds sufficient to establish its standing herein; that there is no likelihood of confusion because the parties' marks are not confusingly similar; and that opposer has sold and promoted its goods under the pleaded marks "in limited geographical areas other than applicant's area of use." However, none of applicant's assertions is an affirmative defense.<sup>5</sup>

*Counterclaims to Cancel Opposer's Registrations*

Additionally, by way of counterclaim, applicant petitioned to cancel opposer's three pleaded registrations on the grounds that such registrations were fraudulently obtained and that the marks therein were abandoned prior to the alleged assignment of the registrations to opposer.<sup>6</sup>

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<sup>5</sup> Regarding applicant's "affirmative defense" that opposer has not alleged standing, we note that standing is an initial and basic inquiry made by the Board in every inter partes case; that is to say, standing is a threshold inquiry directed solely to establishing the personal interest of the plaintiff. As such, it is not an affirmative defense. Further, as applicant did not pursue its assertions regarding opposer's allegation of standing either in an appropriate motion or in its trial brief, we do not consider applicant's challenge to opposer's allegations of standing to be before us and give it no further consideration. Applicant's second "affirmative defense," that the marks are not confusingly similar, is merely an amplification of its denial of opposer's claim of likelihood of confusion and will be treated as such. Regarding applicant's third "affirmative defense," in the absence of a concurrent use registration proceeding, applicant's assertions regarding opposer's limited geographic area of use of its mark are not relevant and have not been considered further herein. See, *Trademark Trial and Appeal Board Manual of Procedure*, Section 318.02(b) and cases cited therein.

<sup>6</sup> Cancellation No. 20,853 pertains to Registration No. 1,390,117 for the mark LA ROSA and design. Cancellation No. 20,854 pertains to Registration No. 1,396,003 for the mark LA ROSA. Cancellation No. 21,092 pertains to Registration No. 382,621 for the mark RUSSO'S.

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Following the hearing on this case, applicant filed its motion to withdraw its petitions to cancel opposer's three pleaded registrations. Consistent with the Board's order of April 7, 1997, Cancellation Nos. 20,853, 20,854 and 21,092 are dismissed with prejudice, as applicant's requests for withdrawal were filed without consent after the answers were filed in those cases. Thus, all further discussion herein pertains only to the opposition in this consolidated proceeding.

*The Record in the Opposition*

The record consists of the pleadings; the file of the involved application; title and status copies of opposer's pleaded Registrations Nos. 382,621, 1,390,117 and 1,396,003; certain specified responses of applicant to opposer's first set of interrogatories, with exhibits annexed thereto, made of record by opposer's notice of reliance; copies of third-party registrations and several excerpts from printed publications and official records, all made of record by applicant's notice of reliance;<sup>7</sup> and the testimony depositions of James C. Dobos, applicant's controller and

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<sup>7</sup> Several of applicant's submissions by its notice of reliance are not properly made of record by a notice of reliance. In particular, applicant has submitted a Sea World of Ohio promotional brochure, a product list and several food labels. However, the same food product list and several of the same food labels are made of record properly as exhibits to the testimony deposition of applicant's controller and personnel director, James C. Dobos. Further, opposer has treated this evidence as being of record by identifying the record to include the evidence submitted by applicant's notice of reliance and not objecting thereto. Thus, we have considered this evidence herein.

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personnel director, Thomas E. DeMarco, applicant's assistant sales manager, and Robert G. Schmohr, opposer's president, all with accompanying exhibits. Both parties filed briefs on the case and were represented by counsel at a hearing before the Board.

*The Parties*

Opposer, since 1983 a wholly owned subsidiary of Gooch Foods, manufactures and distributes pasta products, particularly, macaroni, spaghetti and noodles, as well as bread crumbs and macaroni and cheese dinners.<sup>8</sup> Opposer uses its pleaded LA ROSA trademarks in connection with all of these products and its pleaded RUSSO'S trademark in connection with pasta products. Opposer's pleaded marks are not used in connection with tomato sauces. The bulk of opposer's sales is under its LA ROSA trademarks.<sup>9</sup> It is in connection with this mark that opposer has done most of its advertising,<sup>10</sup> including television advertising, cooperative advertising with retailers, promotionals and "off invoice" offers, which are discount offers to the distributor.

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<sup>8</sup> Robert Schmohr, opposer's past president, testified that opposer's predecessor used the LA ROSA mark in connection with its products since "the late 1800's."

<sup>9</sup> Opposer reports sales of LA ROSA products over the last 20 years totaling \$200 million wholesale, or \$400 million retail. Opposer reports sales of RUSSO'S products over the last 20 years totaling \$10 million wholesale, or \$20 million retail.

<sup>10</sup> Opposer states that it has spent in excess of \$25 million on the advertising and promotion of its LA ROSA products during the last 20 years. The record includes evidence of television and print advertising from "the 1960's," and through the 1980's to the time of trial herein.

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Opposer uses its RUSSO'S mark on lower priced goods and any advertising is done only by the retailer.

Opposer has manufacturing facilities in Illinois and Nebraska and its products are sold "in the states between the Rockies and the east coast."<sup>11</sup> The ultimate purchaser of opposer's products includes retail consumers and buyers for hospitals, restaurants and military food service establishments. Through its own sales force and independent brokers, opposer sells and ships its products to about 150 wholesalers, including wholesalers serving retail stores and supermarkets and wholesalers serving institutional buyers, such as hospitals and restaurants. Opposer sells to at least one retail distributor, Murray Steaks, which sells to consumers along the east coast.

In 1950, applicant began its business of producing and distributing Italian food products, including pasta, cheeses and sauces. Through the years, applicant has carried various lines of such products owned by third parties, including Vimco and Prince. On November 1, 1989, applicant introduced its own LA RUSSA brand of processed tomatoes and tomato sauces, the subject of this application. Applicant has expanded its use of this mark to include use on other

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<sup>11</sup> Opposer identifies these states as Illinois, Indiana, Iowa, Wisconsin, Nebraska, Oklahoma, Kansas, Utah and Pennsylvania. Opposer also notes that those of its products sold by Walmart or Walgreen are sold throughout the United States.

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Italian food products.<sup>12</sup> Through its own sales force applicant sells its products both to retail grocery stores and to distributors and food brokers for sale, ultimately, to the retail consumer.<sup>13</sup> Applicant's sales representatives sell applicant's products in, at least, a five-state area,<sup>14</sup> and applicant distributes its products throughout the rest of the United States by mail order. Applicant advertises its LA RUSSA products by radio, through cooperative advertising in newspapers, coupons, shelf talkers, and through a number of charity spaghetti dinners.<sup>15</sup>

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<sup>12</sup> These include barbecue and other sauces, artichoke hearts, cheeses, pasta, vegetable and olive oils, olives, vinegar, beans, peppers, chicken broth and bread crumbs. Applicant indicates its dates of first use of LA RUSSA in connection with these products in both its answers to opposer's first set of interrogatories (No. 4) and in Exhibit 2 to the testimony of James C. Dobos, applicant's controller and personnel director. While the only dates of concern to us are those pertaining to the goods identified in this application, we note that in several instances there are discrepancies between the two documents regarding the stated dates of first use of LA RUSSA in connection with these other products.

<sup>13</sup> Applicant's evidence pertains primarily to sales of all of its products under the LA RUSSA mark. Applicant reports that sales of its LA RUSSA products comprised 30% of its total sales in 1990 (\$1,808,047) and increased to 80% of its total sales for the first six months of 1994 (\$2,874,272), with sales of LA RUSSA products for the five year period prior to trial totaling \$15,996,325. (James C. Dobos deposition, Exhibit 3.) For 1993, applicant reports \$953,211.62 in sales of its LA RUSSA tomato products (Dobos deposition, Exhibit 153, p. 9). While the overall sales figures reported in Dobos Exhibit 3 differ substantially from the figures indicated in applicant's answer to opposer's first set of interrogatories, no. 20, we find greater credibility in the specificity of the figures indicated in Dobos Exhibit 3. Further, these figures are consistent with those reported for 1993 in Dobos Exhibit 153.

<sup>14</sup> Applicant identifies these states as New York, West Virginia, Maryland, Ohio and Pennsylvania. Applicant indicates that it also distributes its products in Kentucky, Michigan and Tennessee.

<sup>15</sup> Applicant indicates that it has spent a total of \$576,505 on advertising its LA RUSSA products from November, 1989, to the date of trial. (Dobos deposition, p. 30, and Dobos Exhibit 144.)



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*Analysis*

Inasmuch as certified copies of opposer's registrations are of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Further, the evidence of use supports opposer's claim of priority and applicant does not contest or otherwise address opposer's priority herein.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). We begin our analysis by considering the similarities between the parties' goods and conclude that the goods are related. Pasta products and tomato products are sold in the same sections of retail stores (e.g., Dobos deposition, pp. 51-52) and are often served together by the ultimate consumer. Applicant, which produces and distributes both pasta and tomato products under its LA RUSSA mark, admits that pastas and tomato sauces are often sold side-by-side (Dobos deposition, p. 61).

Further, the evidence clearly indicates that opposer's pasta products and applicant's tomato products are sold

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through the same channels of trade to the same retail consumers.

Turning to the marks, opposer contends, essentially, that applicant's mark is a composite of opposer's two marks and is not sufficiently different from either mark to avoid confusion<sup>16</sup>; that the design element in applicant's mark is minimal and does not distinguish the parties' marks; that the parties' marks are similar in sound, with the only difference being a single vowel sound in each case; and that the Board should consider the similarity in sound of these foreign words rather than the differences in their connotation when opposer's LA ROSA mark is translated into English as "the rose."

Additionally, opposer contends that both parties' goods involve impulse purchases not requiring any degree of sophistication; that applicant adopted the mark herein with the intent to trade on opposer's good will; and that evidence of third-party registrations, telephone directory listings and a trademark search report is of little persuasive value as this evidence does not establish use of the respective marks or any relative weakness of opposer's marks; and that the evidence of third-party uses pertains to

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<sup>16</sup> In this regard, opposer states, "[applicant] may not avoid confusion with [opposer's] marks by changing the 'O' in LA ROSA to a 'U' as in LA RUSSA, and the 'O' is RUSSO's to an 'A' in LA RUSSA." (Opposer's brief, p. 13.)

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different marks and different goods than are involved herein.

On the other hand, applicant contends that the marks involved herein are different in sound, appearance and connotation; that the design elements of the parties' marks further distinguish the marks; that both parties' marks are surnames, and that there is extensive evidence of third-party use and registration of surnames as marks in the Italian food industry so that the public is accustomed to recognizing slight differences among these surname marks; that, in view of the extensive use and registration of third-party marks containing the roots ROSA and RUSSO, opposer's marks are relatively weak; and that, in addition to being a common surname, opposer's mark LA ROSA translates into English as "the rose" and applicant's mark is only a surname with no English translation. Applicant contends further that opposer's marks are not famous and that, in fact, opposer does not advertise its products sold under its mark RUSSO; that there is no evidence that there has been any actual confusion between the parties' marks; and that applicant adopted and is using its mark LA RUSSA in good faith.

We begin our consideration of the marks by noting that opposer has not pleaded or established a family of LA ROSA and RUSSO'S marks and, therefore, we shall compare

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applicant's mark, first, to opposer's LA ROSA marks and, second and separately, to opposer's RUSSO'S mark.

We find the design elements of both applicant's LA RUSSA and design mark and opposer's LA ROSA and design mark to be minimal. The design element of applicant's mark serves primarily as a border outline emphasizing LA RUSSA as the central and dominant feature of applicant's mark. Similarly, the term LA ROSA is clearly dominant in opposer's design mark, as the oval serves merely to outline the words and the single rose design merely reinforces the English translation of LA ROSA. Further, opposer has pleaded and established its registration of LA ROSA without a design element. Comparing LA RUSSA to LA ROSA, we find both marks to consist of two terms with the identical first terms, LA, followed by two-syllable words that are very similar and differ, essentially, only in the vowels "U" or "O" following the "R" in each mark. Despite the fact that ROSA is a foreign term that means "rose" in English, applicant's evidence has established that LA RUSSA and LA ROSA are likely to be perceived by the purchasing public primarily as surnames. We conclude that these marks are so similar in appearance, sound and connotation as to create substantially similar overall commercial impressions. Further, both parties' goods sold under their respective marks are relatively low cost, impulse purchases so that little care

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is likely to be exercised by retail consumers purchasing these goods.

We believe that applicant has established that ROSA and LA ROSA are relatively common surnames in the United States; that surname marks are relatively common in the Italian food industry; and that there are at least several third-party uses of ROSA and LA ROSA in connection with similar or related goods and services. However, we cannot conclude that applicant has established that surnames are so common in the Italian food industry that the minor differences between LA RUSSA and LA ROSA and the marks' respective design elements are sufficient to distinguish the parties' marks in connection with these related goods. Further, applicant has not established that LA ROSA is a weak mark simply because it is a surname and there is some evidence of third party use in the industry. Opposer has established, through evidence of long use and substantial advertising expenditures and sales over many years, that any weakness the LA ROSA marks may have had initially has long since been overcome and these marks are clearly distinctive in connection with the identified products.

Additionally, applicant's lack of evidence of actual confusion is of little significance in this case which includes little evidence of the nature and extent of overlap of the parties' areas of use. Thus, we cannot determine

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whether there has been any real opportunity for confusion to arise. In any event, the standard under Section 2(d) is likelihood of confusion, not actual confusion.

In this case, in view of the strong similarities between the parties' marks as used on related products, we find that we must resolve what doubt we may have in favor of the prior user and registrant. See, *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988). Therefore, we conclude that in view of the substantial similarity in the commercial impressions of opposer's LA ROSA marks and applicant's LA RUSSA mark, their contemporaneous use on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.<sup>17</sup>

While we have sustained the opposition on the basis of opposer's LA ROSA marks, to render a complete decision, we now consider the similarity of opposer's mark, RUSSO'S and design, to applicant's mark, LA RUSSA and design, to

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<sup>17</sup> Applicant has shown that the trade dress for its LA RUSSA products is quite different from opposer's trade dress for its LA ROSA products and that, in this product area, trade dress is a significant factor distinguishing different parties' entire lines of products. While this effectively counters opposer's allegations that applicant intended to trade on opposer's good will, it does not persuade us that there is no likelihood of confusion with respect to opposer's LA ROSA marks and applicant's mark. We note that we are considering the registrability of applicant's mark as applied for and the mark in the application herein does not include applicant's trade dress. See, for example, *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985); *Miles Laboratories Inc. v. Naturally Vitamin*

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determine the issue of likelihood of confusion in connection therewith.

The dominant feature of opposer's mark, RUSSO'S and design, is the term RUSSO'S, as the plain block lettering and angle at which the term appears are minor design elements. As opposer admits (Schmohr deposition, p.59) and the evidence supports, RUSSO is a surname with no other meaning in English or Italian. While the only difference between RUSSO and the second term in applicant's mark, RUSSA, is the final vowel, we also look at the marks in their entireties, as we must, and note that opposer's mark is a single word in possessive form, whereas applicant's mark includes a second term, LA, preceding RUSSA. These differences in appearance, sound and connotation engender overall commercial impressions sufficiently different to distinguish these marks in connection with the identified goods. In view of the differences in the commercial impressions of opposer's mark, RUSSO'S, and applicant's mark, LA RUSSA, we find that, despite the relationship between the parties' goods, their contemporaneous use on these goods is not likely to cause confusion as to the source or sponsorship of such goods.

Therefore, the opposition is dismissed as to opposer's claim of likelihood of confusion with its mark RUSSO'S as

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*Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986); *Purex Corp., Ltd. v. Thompson-Hayward Chemical Co.*, 179 USPQ 190 (TTAB 1973).

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used and registered in connection with certain specified  
pasta products.

*Decision:* The opposition is sustained with respect to  
opposer's LA ROSA marks and dismissed with respect to  
opposer's RUSSO'S mark.

E. W. Hanak

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board

Simms, Administrative Trademark Judge,  
concurring in part and dissenting in part:

I agree with the majority opinion that confusion is  
likely with respect to applicant's mark LA RUSSA and design  
and opposer's mark LA ROSA for goods which are sold in the  
same aisles of grocery stores and supermarkets and may be  
used with each other. These marks have obvious similarities  
in sound and appearance. In addition, opposer's mark has  
been in use for nearly a century, with annual retail sales  
in recent years averaging around \$20 million and advertising  
expenses of around \$1 million a year. This decision finding



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likelihood of confusion, of course, precludes applicant from obtaining a federal registration.

Where I disagree with the majority is in their conclusion that confusion is unlikely with respect to applicant's mark LA RUSSA and opposer's mark RUSSO'S for these closely related food products. In this regard, I agree with opposer that applicant's mark is not sufficiently different from opposer's to avoid the likelihood of confusion. LA RUSSA and RUSSO'S have obvious similarities in sound and appearance, and both may be perceived as marks with no connotations other than as surnames. With respect to these marks and goods as well, opposer's pasta products and applicant's tomato sauces are inexpensive food products purchased by ordinary consumers without great care during a shopping trip to the supermarket. To the extent there may be doubt on the question of likelihood of confusion, I would resolve this doubt in favor of the long prior user and registrant.

Concerning the third-party marks, I would give little weight to similar names appearing in directory listings and in search reports because, without evidence of actual use, those listings do not establish that any goods have been sold or that the public is aware of those marks and names. We also do not know in many cases what particular goods, if any, those marks may have been used with. Nor would I find

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no likelihood of confusion simply because of proof of use (by purchase of the products) of such marks as BELLA ROSSA for pizza sauce and MAMA ROSA'S for pizza and MAMMA ROSA'S for pasta sauce.<sup>1</sup> Not only do those marks differ in commercial impression from both opposer's and applicant's marks, but also there is no evidence of the nature and extent of the use of those third-party marks. We simply have an insufficient record from which to conclude that the public has been exposed to all of these marks and has learned to distinguish them and that, in addition, applicant's mark has and will not be likely to cause confusion with opposer's.

Finally the lack of evidence of actual confusion, while a factor, should be largely discounted because there is only one state (with the exception of a few nation-wide chain discount stores)---Pennsylvania---where both parties' goods have been distributed. Even so, however, we have no information that the products have been sold in the same parts of that state. Without that kind of evidence, we should not assume that the use of both parties' marks is not likely to cause confusion because of the lack of evidence of actual confusion.

R. L. Simms  
Administrative

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<sup>1</sup> There is also evidence of use of a third-party mark (LA ROSA'S), for canned tomatoes and spaghetti sauce, almost identical to opposer's mark.

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Trademark Judge