

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

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Opposition No. 104,589

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE
TTAB 3/31/00

Bari Foods, Inc.

v.

Bari Importing
Corporation

Before Hohein, Hairston and McLeod, Administrative Trademark
Judges.

By the Board:

Bari Foods, Inc. has filed an opposition against Bari
Importing Corporation's application Serial No. 74/462,220
for the mark BARI and design, as shown below, for the
following goods:

canned tomatoes; meat; cheese, namely,
mozzarella, provolone, romano, parmesan and
ricotta; edible oils, namely, blended pomace,
pure Italian, X-virgin, vegetable, peanut,
frying; canned fish items, namely, processed
anchovies; canned and jarred vegetables,
namely, processed mushrooms, artichokes and
onions; frozen poultry products, namely,
chicken breast, turkey roll, turkey breast,
chicken patties, chicken fillets; processed
olives, namely, black sliced, whole, wedges,
green whole, green stuffed, green pitted,
Greek black, camata, and cocktail olives" in

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Class 29 and "vinegar and spices" in Class 30.¹

Applicant has disclaimed the geographic representation of the country of Italy and seeks registration under Section 2(f), in part, as to the term BARI.

As grounds for opposition, opposer asserts priority of use and alleges that applicant's mark, as used in connection with the identified goods, so resembles opposer's mark as to be likely to cause consumer confusion, to cause mistake, or to deceive. Specifically, opposer alleges that (1) it is the owner of U.S. Registration No. 1,718,409² for the mark BARI for goods identified as "canned vegetable products, namely, tomatoes, tomato paste, tomato puree, peeled tomatoes, and hot vegetable condiments; and grated cheese, capers, wine vinegar and oregano," (2) it has been engaged in the business of advertising, offering for sale and selling the goods identified in its registration prior to any use of the BARI and design mark by applicant, and (3)

¹ Application Serial No. 74/462,220, filed November 23, 1993, alleging date of first use on July 15, 1973 and date of first use in commerce on April 1, 1982.

² U.S. Registration No. 1,718,409, registered September 22, 1992.

confusion would be likely to result from applicant's use of BARI and design on the goods identified in its application.

Applicant has filed an answer denying the salient allegations of opposer's notice of opposition.

This case now comes up for consideration of opposer's motion for summary judgment on its likelihood of confusion claim under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), and applicant's motion to strike the affidavit of Donald Ursini which was submitted in support of opposer's motion for summary judgment. The motions have been fully briefed.³

We first turn to applicant's motion to strike the affidavit of Donald Ursini. In support of its motion, applicant contends that since Mr. Ursini died some time between the date the affidavit was executed and the date opposer's motion for summary judgment was filed, Mr. Ursini's affidavit is inadmissible hearsay and should be stricken. In his affidavit, Mr. Ursini attests to, among

³ The Board has considered applicant's reply brief on the motion for summary judgment. See Trademark Rule 2.127(e)(1), as amended, Notice of Final Rulemaking, published in the *Federal Register* on September 9, 1998 at 63 FR 48081; see also *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991); *Avon Products, Inc. v. MarCon, Ltd.*, 225 USPQ 977 (TTAB 1985).

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other things, the continuous use of opposer's predecessor-in-interest's use of the mark BARI. Applicant argues that since opposer has offered no evidence whatsoever, except the affidavit of Mr. Ursini, that demonstrates that opposer's mark was used continuously by the previous owner until the registration was assigned to opposer and since applicant is not able to cross-examine Mr. Ursini in light of his death, Mr. Ursini's affidavit should be stricken.

In opposition to applicant's motion, opposer argues that Mr. Ursini's affidavit is not hearsay since affidavits in support of motions for summary judgment are governed by Rule 56(e) of the Federal Rules of Civil Procedure and not by the Federal Rules of Evidence. Furthermore, opposer maintains that although it identified Mr. Ursini during the discovery period as an individual who possessed personal knowledge of the extent of the use of the term BARI by opposer and/or opposer's predecessor-in-interest, applicant nonetheless elected not to seek discovery from Mr. Ursini. Accordingly, opposer argues that applicant cannot now attempt to strike the affidavit of Mr. Ursini when applicant had ample opportunity to seek discovery concerning Mr. Ursini's personal knowledge of opposer's and/or opposer's predecessor-in-interest's use of the BARI mark during the discovery period.

Federal Rule of Civil Procedure 56(e) allows a party to submit an affidavit in support of a motion for summary judgment. See Fed. R. Civ. P. 56(e). There is no provision in Rule 56(e), however, which entitles a party to cross-examine the affiant of an affidavit submitted in support of a motion for summary judgment. Moreover, the information provided in Mr. Ursini's affidavit concerns the same information provided in the affidavit of Mr. Frank Pedota, opposer's president, i.e., the continuous use of opposer's mark. Consequently, Mr. Pedota's affidavit corroborates the information provided in Mr. Ursini's affidavit, yet, interestingly enough, applicant does not seek to strike Mr. Pedota's affidavit. Accordingly, we see no reason to strike Mr. Ursini's affidavit. Furthermore, and more importantly, there is no issue of priority here because opposer has made of record a certified copy of its pleaded registration, which shows that such registration is subsisting and owned by opposer. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In view thereof, applicant's motion to strike the affidavit of Mr. Donald Ursini is denied.⁴

⁴ The Board notes that applicant had ample opportunity during the discovery period to question Mr. Ursini concerning his personal knowledge of opposer's predecessor-in-interest's use of the mark BARI but applicant chose not to seek discovery from Mr. Ursini.

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We next turn to opposer's motion for summary judgment. In support of its motion, opposer argues that there are no genuine issues of material fact with respect to priority and likelihood of confusion. Opposer maintains that, through its predecessor in interest, it has priority by virtue of its use of the BARI mark dating to 1949. Opposer further contends that the involved marks are similar in appearance, sound, and meaning, and that the involved goods are identical and are sold to the same class of purchasers.

As evidence in support of its motion, opposer has submitted (1) a certified copy of its federal registration, showing that such is subsisting and owned by opposer, for the typed mark BARI for "canned vegetable products, namely, tomatoes, tomato paste, tomato puree, peeled tomatoes, and hot vegetable condiments; and grated cheese, capers, wine vinegar and oregano," (2) the affidavits of Frank Pedota, opposer's president, and Donald Ursini, an employee of opposer, both of which attest to, *inter alia*, the continuous use of the mark BARI since December 20, 1949 and (3) portions of applicant's responses to opposer's interrogatories and portions of opposer's responses to applicant's interrogatories which identify the parties' trade channels and class of purchasers.

In opposition to the motion, applicant argues that its mark and opposer's mark are so dissimilar in appearance that

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confusion is not likely. In particular, applicant maintains that, when its mark is considered as a whole, including all of the design elements incorporated therein, the design components clearly dominate the composite mark and, therefore, significantly reduce the impact the word BARI alone may have on a potential consumer.

Furthermore, applicant argues that while both parties offer food products under their respective marks, there is no "per se" rule that all products in the same field are to be deemed related. Moreover, applicant maintains that while there may be one or two areas of overlap between the parties' products, this alone does not mean that all the products are identical commercially or so highly related that they will be presumed to come from a single source.

Applicant also contends that a genuine issue of material fact exists with respect to the similarity of the parties' trade channels. Specifically, applicant states that it markets and sells its products to wholesalers, distributors and retailers, including hotels and restaurants, as well as food stores. In contrast, applicant maintains that opposer has indicated that its products are sold in the normal and ordinary channels of trade for such goods, including on the wholesale and retail level in the United States. As such, applicant contends that a significant issue of fact remains as to precisely what opposer's "ordinary and normal"

channels of trade are or whether they do in fact overlap with applicant's trade channels, and that the ambiguities of opposer's description of its trade channels can only be settled at trial. Finally, applicant maintains that during the twenty-five years the parties appear to have coexisted, there have been no instances of actual confusion and, therefore, confusion as to source is not likely.

In support of its arguments, applicant has submitted the affidavit of its president, Enzo Paparella. Mr. Paparella, through his affidavit, states, *inter alia*, that (1) applicant is a leading distributor of food products and that applicant has been using the BARI name and design since 1973 to promote its goods, (2) applicant markets and sells its food items to wholesalers, distributors and retailers, including hotels and restaurants, as well as food stores, (3) applicant's sales are approximately \$20 million or more, and (4) he has not encountered any confusion by consumers and competitors between applicant or applicant's products and those of opposer or its predecessor.

Summary judgment is appropriate when the record shows that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A dispute as to a material fact issue is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the

nonmoving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id.*

The party seeking summary judgment bears the initial burden of informing the Board of the basis for its motion and identifying those portions of the record which it believes demonstrate the absence of a genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts which must be resolved at trial. The nonmoving party may not rest on mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record, or produce additional affidavit evidence, showing the existence of a genuine issue of material fact for trial. If the nonmoving party does not so respond, summary judgment, if appropriate, shall be entered in the moving party's favor. See Fed. R. Civ. P. 56(e).

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In this case, we believe that opposer has carried its burden of showing *prima facie* the absence of any genuine issue of material fact, and its entitlement to judgment as a matter of law. Applicant has not presented evidence showing the existence of a genuinely disputed fact issue for trial, but rather has argued the merits of the likelihood of confusion issue. We do not find applicant's arguments persuasive.

First, as stated above, there is no genuine issue of material fact as to priority because the certified copy of opposer's pleaded registration for the mark BARI and the goods identified therein establishes that the registration is subsisting and owned by opposer. Priority, therefore, lies with opposer and is not in issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We find that opposer also has carried its burden of establishing that no genuine issues of material fact remain and that it is entitled to judgment as a matter of law on the issue of likelihood of confusion. In reaching our decision, we have carefully considered the relevant likelihood of confusion factors enumerated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

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First, there is no genuine issue of material fact as to the relatedness of the parties' goods. We are not persuaded by applicant's arguments that its goods are distinguishable from opposer's goods. As noted above, applicant's application identifies goods which include "canned tomatoes, cheese, vinegar, and spices." Opposer's registration identifies goods which include "canned vegetable products, namely, tomatoes, tomato paste, tomato puree, peeled tomatoes, grated cheese, wine vinegar and oregano." The parties' respective goods thus include identical items, namely, canned tomatoes, vinegar, and cheese.

With respect to the other goods identified by both opposer and applicant, it is not necessary that these goods be identical in order to find a likelihood of confusion. Rather, it is sufficient that the goods are related in some manner such that consumers encountering them under their respective marks are likely to assume that the goods originate from the same source or that there is some association between the sources. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The Board finds that there is no genuine issue that the parties' non-identical food items are commercially similar and that consumers will presume that they emanate from a single

source, especially since the goods are relatively inexpensive consumer food items not likely to be purchased with any great degree of care.

Moreover, the nature and scope of an applicant's goods must be determined on the basis of the goods as identified in the application. *See, e.g., Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Applicant's identification of goods contains no limitations as to the trade channels through which and the classes of purchasers to whom applicant's goods are offered. Therefore, it must be presumed that applicant's goods are offered in all normal trade channels and to all customary classes of purchasers, including those to whom opposer's goods are offered. *See Canadian Imperial Bank of Commerce, supra.*

Second, applicant has failed to identify any genuine dispute as to the similarity of the parties' marks which would require resolution at trial. In this vein, although we recognize that the marks are to be viewed in their entirety, one portion of a mark may be considered more prominent in determining similarity. *See Giant Food, Inc. v. National Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Here, opposer's mark is solely the word

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BARI, while the same term, BARI, is the most significant element of, and thus the dominant portion in, applicant's mark. While applicant's mark employs other features such as the design of a basilica and the geographic representation of the country of Italy, it has often been held that as between the design and word portions of a trademark, the word portion generally dominates inasmuch as it is the portion by which the goods and/or services would be called for. See *Burger Cher Systems, Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875, 203 USPQ 733 (CCPA 1976). It is our opinion that the identity between opposer's mark and the word portion of applicant's mark outweighs the differences added to applicant's mark by the design elements. Thus, viewing the marks in their entireties, as we must, we find that the marks BARI and BARI and design are very similar in sound and appearance and create highly similar commercial impressions. Accordingly, we find that there is no genuine issue of material fact with respect to the similarity or dissimilarity of the parties' marks in their entireties in terms of appearance, sound, connotation and commercial impression.

Finally, although applicant points to the lack of any evidence of actual confusion, we note that the absence of actual confusion is not sufficient to raise a genuine issue. Indeed, opposer is not required to prove actual confusion in

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order to make a prima facie showing of likelihood of confusion. See *Block Drug. Co. v. Den-Mat, Inc.*, 17 USPQ2d 1315 (TTAB 1989); *Airco, Inc. v. Air Equipment Rental Co., Inc.*, 210 USPQ 492 (TTAB 1980).

Because there are no genuinely disputed factual issues which require trial for their resolution, and because the undisputed facts of record establish, as a matter of law, that opposer is entitled to judgment on its Section 2(d) claim, opposer's motion for summary judgment is granted. See Fed. R. Civ. P. 56(c).

Judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.

G. D. Hohein

P. T. Hairston

L. K. McLeod
Administrative Trademark Judges
Trademark Trial and Appeal Board