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Paper No. 17

GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Café Rico, Inc.*

Serial No. 75/213,493

*Janet G. Ricciuti*, Esq. for *Café Rico, Inc.*

*Zachary R. Bello*, Trademark Examining Attorney, Law Office 111  
(*Craig Taylor*, Managing Attorney).

Before *Cissel, Hohein and Walters*, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

*Café Rico, Inc.* has filed an application to register



the mark "CAFÉ RICO," in the stylized manner shown below,

for "coffee, decaffeinated coffee, espresso, and a blend of regular and decaffeinated coffee."<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "RICO," which is registered for "coffee,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

The determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of

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<sup>1</sup> Ser. No. 75/213,493, filed on December 16, 1996, which alleges dates of first use anywhere and in commerce of 1938 and claims, pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), that the mark has become distinctive of applicant's goods. A translation of the mark is "RICH COFFEE" and the term "CAFÉ" is disclaimed.

<sup>2</sup> Reg. No. 1,707,612, issued on the Supplemental Register on August 11, 1992, which sets forth dates of first use of 1950; affidavit §8 accepted. The English translation of the word "RICO" is "RICH."

the goods and the similarity of the marks.<sup>3</sup> Here, inasmuch as applicant's goods are identical in part (coffee) and are otherwise closely related to registrant's goods,<sup>4</sup> the focus of our inquiry is on the similarities and dissimilarities in the respective marks when considered in their entirety. Moreover, as pointed out in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), "[w]hen marks would appear on virtually identical goods ... , the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

Turning, therefore, to consideration of the respective marks, applicant argues that, when considered in their entirety, its mark "is unique in appearance[,] resulting in a visually, phonetically, and conceptually distinguishable mark from the registered mark." The latter, applicant asserts, is "a normally understood and well recognized descriptive term, is relatively weak," and is thus entitled, in keeping with its registration on the Supplemental Register, to only a narrow

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<sup>3</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

<sup>4</sup> Applicant, in fact, concedes in its brief that "[i]n this instance, there is little room in which to debate the similarity or lack of similarity between the goods of the parties as both have specified 'coffee' in their recitations [of goods] and neither party has entered any limitations."

scope of protection. In view thereof, and in light of "the well known idiosyncrasy of coffee drinkers," who are assertedly "loyal to and notoriously choosey [sic] in their brands of coffee," applicant maintains that there is no likelihood of confusion.

Citing, in particular, *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992), applicant insists that the Examining Attorney impermissibly "has taken the position that NEITHER the term CAFÉ nor the stylization used by Applicant in its mark need be given any weight in the determination of confusion" and that it is the term "RICO" which constitutes the dominant portion of applicant's mark. While acknowledging that such portion is identical to registrant's mark "RICO" and that the term "CAFÉ" is generic, applicant "submits that if fair weight is given to the term CAFÉ and the unique stylization used by Applicant [in its mark], then the sound, sight and commercial impression rendered by the marks are different and confusion is not likely."

In addition, applicant argues that the sole element common to the respective marks, namely, the Spanish term "RICO," means "rich" in English and thus is descriptive of both its goods and those of registrant. Applicant consequently urges, although without any evidentiary support, that:

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[T]he registered mark RICO is on the Supplemental Register due to its descriptive nature. Many in the coffee industry describe their coffee as "rich" and in view of the fact that most of the coffee consumed in the United States originates in Spanish speaking countries, many in the coffee industry tend to describe their coffee as "rico" or "rich". Due to its highly descriptive nature and the natural employment of the term by all in the industry, the Board must recognize that the registered mark has limited source identifying qualities and is thus entitled to a circumscribed scope of protection.

Comparing the mark at issue with these factors in mind, it becomes apparent that no consumer is likely to confuse Applicant's mark with its highly distinctive design and stylization with the simple term RICO.

Finally, and again notably without any evidentiary support, applicant "submits that coffee purchasers exercise more care and deliberation in their purchase of coffee than a consumer seeking to purchase other groceries such as bread, milk, or eggs." Although contending that it "does not believe that coffee is expensive or that the purchase of coffee can be elevated to a 'discriminating level'," applicant maintains that "coffee is nonetheless a 'relatively' expensive item and [that] coffee purchasers tend to be excessively attached to their brand of choice." Applicant insists, therefore, that "in the marketplace the likelihood of there being confusion between Applicant's product and that of Registrant is unfounded."

We concur, however, with the Examining Attorney that confusion is likely from the contemporaneous use of the respective marks in connection with coffee products. Although we do not fully agree with the Examining Attorney's analysis that, because of the presence therein of the generic word "CAFÉ," applicant's mark is necessarily dominated by the descriptive term "RICO,"<sup>5</sup> we nevertheless find that, when the respective marks are considered in their entireties, they are substantially similar in sound, appearance and connotation and are substantially identical in commercial impression due to the shared term "RICO." Clearly, when used in connection with its

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<sup>5</sup> While, of course, marks must be compared in their entireties, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ...." 224 USPQ at 751. However, in the present case, applicant's mark consists of the generic word "CAFÉ" and the descriptive term "RICO," and it is only the combination thereof which has acquired distinctiveness. Therefore, we tend to disagree with the Examining Attorney that it is the descriptive term "RICO" which is the dominant element of applicant's stylized "CAFÉ RICO" mark and is "the registrable portion" thereof, to the exclusion of the generic word "CAFÉ" and the stylized manner of presentation of the entire mark. The fact, however, that applicant's mark includes a generic term does serve to distinguish this case from In re Hearst Corp., supra, upon which applicant principally relies, in that the latter, in finding no likelihood of confusion between the marks "VARGA GIRL" (with "GIRL" disclaimed) and "VARGAS" for calendars, emphasized the contribution of the descriptive, rather than generic, term "GIRL" in distinguishing the such marks.

coffee products, applicant's stylized "CAFÉ RICO" mark, which translates as "RICH COFFEE," engenders substantially the same overall commercial impression as registrant's "RICO" mark for coffee, which means "RICH" in English and hence likewise denotes rich coffee. Confusion as to the source or sponsorship of such goods, when marketed under the respective marks, is therefore likely to occur.

Moreover, we concur with the Examining Attorney that the stylization of applicant's mark is insufficient to avoid a likelihood of confusion. Although applicant stresses the "specialized design, unique to Applicant," of its mark, the Examining Attorney is correct in noting that because registrant's mark is registered in a typed format consisting of all capital letters, its rights therein encompass the word "RICO" and are not limited to the depiction thereof in any special form. See *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Instead, "[a]s the *Phillips Petroleum* case makes clear," when a registration for a word mark is in typed form, "then the Board must consider all reasonable manners in which ... [the word] could be depicted". *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992). Registrant's "RICO" mark must accordingly be regarded as including the display thereof in the same stylized lettering as

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that in which applicant's "CAFÉ RICO" mark appears, since such would appear to be a reasonable manner of display and there is no showing by applicant that the lettering format is unusual for coffee products or otherwise "unique" as claimed by applicant. The stylized lettering format of applicant's mark consequently does not serve to distinguish its mark from registrant's mark.

Furthermore, as the Examining Attorney also properly observes, it has been consistently held that when a mark consists of a word portion and a design portion, it is the word portion which is more likely to be impressed upon a purchaser's memory and to be used in calling for or asking about the goods or services. See. e.g., In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). We agree with the Examining Attorney that, when considered in their entirety, it is the literal element of applicant's stylized "CAFÉ RICO" mark which is the principal source-distinguishing portion thereof and, hence, is entitled to greater weight in determining whether there is a likelihood of confusion. Such portion, as previously indicated, plainly is substantially similar to registrant's "RICO" mark in all significant respects.

As to applicant's contention that because registrant's mark, as evidenced by its registration on the Supplemental Register, is weak in that it is descriptive of coffee and thus is entitled to only a limited scope of protection, the Examining

Attorney correctly notes that, as held in *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340-41 (CCPA 1978), not only is it the case that "a mark registered on the Supplemental Register can be used as a basis for refusing registration to another mark under §2(d) of the Act," but there is no "requirement that citation of marks on the Supplemental Register under §2(d) be limited to marks identical to that sought to be registered." Specifically, the court pointed out that:

No reason exists, however, for the application of different standards to registrations cited under §2(d). The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely, ... but that fact does not preclude citation under §2(d) of marks on the Supplemental Register."

Id. at 341. It also can be usefully added that, as stated by the court in *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974):

Confusion is confusion. The likelihood thereof is to be avoided, as much between "weak" marks as between "strong" marks, or as between a "weak" and a "strong" mark.

Consequently, even though registrant's "RICO" mark is merely descriptive and thus is considered to be a weak mark, it is still the case that applicant's contemporaneous use of its stylized "CAFÉ RICO" mark is likely to cause confusion, especially since the respective marks project substantially the same overall commercial impression and are used in connection

with identical and otherwise closely related coffee products. See, e.g., In re Hub Distributing, Inc., 218 USPQ 284, 286 (TTAB 1983) [likelihood of confusion found, even though marks at issue were weak, inasmuch as such marks "evoke identical commercial impressions and are used on identical and closely related goods"].

Lastly, as to applicant's unsupported assertion that coffee purchasers exercise greater care and deliberation in their selection of brands of coffee than, for example, other staple items like bread, milk or eggs, suffice it to say that not only is such contention speculative, but even if true, it is still the case that the fact that consumers may exercise a degree of discrimination in choosing among various coffee brands "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. Wincharger Corp. v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also In re Decombe, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983).

We accordingly conclude that purchasers and potential customers, who are familiar or acquainted with registrant's "RICO" mark for its coffee, would be likely to believe, upon encountering applicant's substantially similar stylized "CAFÉ RICO" mark for its coffee, decaffeinated coffee, espresso, and

blend of regular and decaffeinated coffee, that such identical and otherwise closely related coffee products emanate from, or are sponsored by or associated with, the same source. In particular, even among consumers who would notice the relatively minor differences overall in the respective marks, it would still be reasonable for them to believe, for example, that applicant's stylized "CAFÉ RICO" mark for its goods designates a new or additional line of coffee products emanating from, or sponsored by, the same source as the coffee offered by registrant under its "RICO" mark.

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