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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marigold Commodities Corporation

Serial No. 76/221,729

Lawrence E. Abelman of Abelman, Frayne & Schwab for
Marigold Communications Corporation.

Susan Leslie DuBois, Trademark Examining Attorney, Law
Office 111.

Before Cissel, Hanak and Holtzman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 8, 2001, applicant, a corporation organized
and existing under the laws of the Philippines, filed the
above-referenced application to register the mark shown
below on the Principal Register for "spices and sauces," in
Class 30.



Teresita's

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The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these products.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark so resembles the mark shown below,



which is registered¹ for "condiments, namely, seasonings for foods," in Class 30, that if applicant were to use the mark it seeks to register in connection with spices and sauces, confusion would be likely. She reasoned that the two marks are similar and that the goods with which applicant intends to use its mark are identical to the goods set forth in the cited registration. In addition to refusing registration based on likelihood confusion, she required applicant to

¹ Reg. No. 2,304,361, issued to Colina and Son, Inc., a Florida Corp., on December 28, 1999. The registration provides a translation of the "ESPIGA DE TERESITA" as "the twig of little Teresa," and a disclaimer of "condiment" and "Excellent for rice, soups, stews, chicken, meat & fish" apart from the mark as shown.

amend the application to state that the stippling shown on the drawing is a feature of the mark and is not intended to indicate color, if that were the case.

Applicant responded to the first Office Action by amending the application to identify the goods with which it intends to use the mark it seeks to register as "spices, namely, garlic powder, pepper corns, ground pepper; soy sauce, hot sauce, gravy, salsa."

Applicant also argued against the refusal to register based on likelihood of confusion. Applicant took the position that the overall commercial impressions of the marks are different; that because "Teresita" is a personal name which translates as "little Teresa," it is not a strong mark; that the goods specified in the registration differ from the goods listed in the application, as amended; and that the cited registration was issued notwithstanding the existence of a registration for "LA TERESITA RESTAURANT"² for restaurant services, further evidencing the limited scope of protection conferred by the Office on "Teresita" marks.

In addition to arguing against the refusal to

² Reg. No. 1,915,694, issued on the Principal Register to La Teresita, Inc. on August 29, 1995. A copy of this registration was attached to applicant's response.

register, applicant amended the application to state that the stippling shown in the drawing is a feature of the mark and is not intended to indicate color. Applicant also stated that the name and picture in the mark identify Teresita R. Reyes, and submitted a written consent from her for the use of her name and likeness.

The Examining Attorney accepted the amendments, but was not persuaded by applicant's arguments on the issue of likelihood of confusion. The refusal to register under Section 2(d) of the Act was made final in the second Office Action.

Applicant timely filed a Notice of Appeal, followed by a request to suspend Action on the appeal and remand the application to the Examining Attorney for consideration of additional evidence, namely three third-party registrations and three third-party applications to register, all for marks consisting of or including the name "Teresa" or "Theresa's."

An erroneous dismissal for failure to file a brief timely was vacated. Then the Board granted applicant's request for suspension and remanded the application for reconsideration by the Examining Attorney. Holding that the third-party registrations and applications were entitled to little weight and noting that none of the marks

in the registrations or applications submitted by applicant to consists of or includes "TERESITA," she maintained the final refusal to register and returned the application to the Board for resumption of action on the appeal.

Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based on the written record and arguments of applicant and the Examining Attorney.

The sole issue before us on appeal is whether confusion would be likely if applicant were to use its "Teresita's" and design mark in connection with "spices, namely, garlic powder, pepper corns, ground pepper; soy sauce, hot sauce, gravy, salsa," in view of the registered mark, which also includes the name "Teresita," and which is registered for "condiments, namely food seasonings." We hold that these two marks, when considered in their entirety, create similar overall commercial impressions, that the goods set forth in the application are encompassed within the identification-of-goods clause in the registration, and therefore, that if applicant were to use its mark in connection with the goods listed in the application, confusion within the meaning of Section 2(d) of the Lanham Act would be likely.

In the case of E.I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods as set forth in the application and the cited registration, respectively.

It is well settled that although the marks must be considered in their entirety, under appropriate circumstances, one element or feature of the mark may have more significance in determining the overall commercial impression of the mark, and may accordingly be given more weight in determining whether confusion is likely. Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976). In the instant case, each mark is dominated by the name "Teresita."

In the cited registered mark, the descriptive word "condiment" has been disclaimed, along with the descriptive phrase "Excellent for rice, soups, stews, chicken, meat & fish." When the minor design features and these non-source-identifying terms have been appropriately discounted, the term "ESPIGA DE Teresita" remains, but the name "Teresita" is displayed in letters twice as large as

the term "ESPIGA DE." "Teresita" plainly plays the dominant role in creating the commercial impression engendered by this mark.

In a similar sense, the cited registered mark is dominated by the same name. This mark utilizes the possessive form of the name "Teresita" and includes a drawing of a lady with the name "Teresita" displayed in print directly beneath it. It is the name "Teresita" which plays the dominant role in creating the commercial impression this mark engenders. The picture of her only amplifies and reiterates her name, which is what would be used to order the products bearing this mark. This name is what would be recalled and used to reorder or recommend the goods to others.

As the Examining Attorney points out, the issue is not whether the marks could be distinguished from one another if they were evaluated on a side-by-side basis, but rather whether they create the same overall commercial impression in view of the fact that ordinary consumers normally retain general, rather than specific, impressions of trademarks. Visual Information Institute, Inc. v. Vicon Industries Inc., 209 USPQ 179 (TTAB 1980); Chemtron Corp. v. Morris Coupling & Clamp Co., 203 USPQ 537 (TTAB 1979).

Because when they are considered in their entirety, these marks create similar commercial impressions, our analysis must turn to the relationship between the goods set forth in the cited registration and those listed in the application. We agree with the Examining Attorney that applicant's "spices, namely garlic powder, pepper corns, ground pepper; soy sauce, hot sauce, gravy and salsa" are closely related to the "condiments, namely seasonings for foods" specified in the cited registration. The Examining Attorney notes that the dictionary definitions submitted with her brief (and of which the Board may take judicial notice) define the words "pepper" as "any of various condiments made from the more pungent varieties of *Capsicum frutescens*..."; "soy sauce" as "a salty brown liquid condiment..."; "gravy" as "a sauce made by thickening and seasoning ... juices"; "salsa" as "a spicy sauce"; "condiment" as "a sauce, relish, or spice used to season food"; and "seasoning" as "something, such as a spice or herb, used to flavor food."³ With the possible exceptions of gravy and salsa, all of applicant's goods are seasonings for foods, so the goods specified in the application are

³ The American Heritage Dictionary of the English Language, Third Edition, Houghton Mifflin Company, 1992.

encompassed within the identification-of-goods clause in the cited registration.

It is well settled that when the marks in question are used on virtually identical goods, the degree of similarity between the marks which is necessary to support the conclusion that confusion is likely declines. *Century 21 Real Estate Corp. v. Century Life of America*, 0 F.2d 874, 23 USPQ 1698 (Fed. Cir. 1982). In view of the overlap in the goods at issue in this appeal, the overall similarities between the marks in their entirety clearly provide a sufficient basis upon which to conclude that confusion would be likely if applicant were to use the mark it seeks to register.

Applicant's arguments to the contrary not persuasive the different conclusion. Applicant contends that the marks are sufficiently dissimilar to avoid the likelihood of confusion, but although each mark combines the name "Teresita" with other elements which are not present in the other mark, when the source-identifying significances of the various components in each of the marks are considered, overall, these marks are similar.

With regard to the third-party registrations submitted by applicant in support of its contention that "Teresita" is weak in source-identifying significance, as the

Examining Attorney notes, only one of these registrations incorporates the name "Teresita," and that mark is registered for restaurant services, not spices or condiments. The Examining Attorney cites *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ 2d 1467 (TTAB 1988) in support of the proposition that marks with common terms in them which are used to identify both restaurant services and food items are not necessarily determined to be so similar that confusion is likely. She also notes that third-party registrations, by themselves, are not entitled to much weight in determining whether confusion is likely, citing *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983), and argues that such registrations are not evidence of what happens in the marketplace or that the public is so familiar with the use of such marks that the other elements are emphasized in order to allow purchasers to distinguish among such marks. *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975). In any event, marks which consist of or include the name "Teresa" can hardly be the basis for concluding that "Teresita" is a weak trademark.

When the issue before us is whether confusion is likely, we must resolve any doubt in favor of the prior user and registrant, and against applicant, who, as the

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newcomer, has a duty to select a mark which is unlikely to cause confusion with a mark already in use in the same field of commerce. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979). In the case at hand, applicant did not live up to this obligation.

DECISION: The refusal to register under Section 2(d) of the Lanham Act is affirmed.