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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re COPAN ITALIA S.P.A.

Serial No. 79182453

John P. Murtaugh of Pearne & Gordon LLP,
for COPAN ITALIA S.P.A.

April Roach, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

Before Zervas, Gorowitz and Heasley,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Pursuant to Section 66(a) of the Act, 15 U.S.C. § 1141f(a) (the “Madrid Protocol”),
COPAN ITALIA S.P.A. (“Applicant”) has filed a request for extension of protection of

an international registration on the Principal Register for the mark



(COLIBRÍ and design) for the following goods:

Laboratory equipment for the treatment of biological, microbiological and chemical samples, namely, machines for automatically picking microbiological samples and for automatically seeding microbiological samples in test tubes or on test target plates, for scientific purposes and for environmental analysis; laboratory equipment for processing, visualizing and/or storing images and data relating to biological, microbiological and chemical samples, for scientific purposes and for environmental analysis, namely, cameras, touch screens, blank flash drives, thermal imagers for laboratory use; laboratory equipment for assisting in the identification, manipulation and treatment of biological, microbiological and chemical samples, for scientific purposes and for environmental analysis, namely, centrifuges, columns for chemical synthesis; hardware components for all of the aforesaid laboratory equipment, namely, data processors for analyzing and recording biological, microbiological and chemical sample composition; all the foregoing excluding microscopes and components for microscopes; all the foregoing goods traveling in channels of trade and being directed to specialized professionals in scientific research microbiology laboratories (International Class 9); and

Medical devices, namely, machines for automatically picking microbiological samples and for automatically seeding microbiological samples in test tubes or on test target plates, for medical and veterinary purposes; medical devices for processing, visualizing and/or storing images and data relating to biological, microbiological and chemical samples, for medical and veterinary purposes, namely, medical devices for measuring and displaying blood composition data for medical diagnosis and treatment; medical devices for assisting in the identification, manipulation and treatment of biological, microbiological and chemical samples, for medical and veterinary purposes, namely, blood sampling tubes for medical diagnosis, biopsy instruments; diagnostic and medical equipment and instruments for the treatment of biological, microbiological and chemical samples, for medical and veterinary purposes, namely, sample preparation devices for medical diagnostic use, cell culture chambers for medical diagnostic use; all the foregoing excluding image presentation apparatus for displaying medical images for medical purposes, and excluding

tomographs; all the foregoing goods traveling in channels of trade and being directed to specialized professionals in diagnostic and medical microbiology laboratories (International Class 10).¹

Applicant describes the mark as consisting of “a honeycomb design of seven connected polygons with the top, top right, and center polygons being solid, and the bottom right, bottom, bottom left, left, and top left polygons with a border, and the wording ‘COLIBRÍ’ under the design.” Color is not claimed as a feature of the mark, and the English translation of “COLIBRÍ” is “hummingbird”.²

The Trademark Examining Attorney finally refused registration on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d),³ based on the registered standard character mark KOLIBRI (Registration No. 4561722 – hereinafter the “722 registration”)⁴ for the following International Class 9 goods:

scientific apparatus and instruments, namely, microscopes, in particular scanning probe microscopes; measuring apparatus and instruments, namely, microscopes, in particular scanning probe microscopes, accessory parts for scientific apparatus and instruments and for measuring apparatus and instruments, namely, microscopes, in particular scanning probe microscopes;

¹ Applicant requests that the Board direct Office personnel to update the Office’s records to reflect an amendment submitted on April 12, 2017 to the identifications of goods, which was accepted by the assigned Examining Attorney on April 18, 2017. 7 TTABVue 2. The electronic records of the Office reflect the goods as amended by Applicant.

² Application Serial No. 79182453, based on International Reg. No. 1287489, which issued on June 30, 2015. The USPTO was notified of the request for extension on February 11, 2016.

³ The Final Office Action includes a refusal based on a second registration. The Office cancelled the second registration on September 15, 2017. The Section 2(d) refusal is limited to the ‘722 registration.

⁴ The ‘722 registration (registered July 8, 2014) includes services; the services are not the basis for the refusal to register.

probes and sensors, namely, for scientific purposes, in particular probes and sensors for scanning probe microscopes and for measuring apparatus and instruments; computer hardware and software, for use in transmitting, processing, editing, and analy[z]ing of data in the field of scientific apparatus and instruments, namely, microscopes, in particular scanning probe microscopes; computer programs, namely, computer programs for transmitting, processing, editing, and analy[z]ing of data, and computer programs for controlling scientific apparatus and instruments; electric and electronic control devices and instruments, in particular for controlling scientific apparatus and instruments, namely, microscopes, in particular scanning probe microscopes.

The English translation of “KOLIBRI” is “hummingbird.”

Applicant then filed a notice of appeal and a request for reconsideration with a proposed amendment to the identification of goods. The proposed amendment to the identification of goods was accepted, but the request was otherwise denied. Applicant then filed a request for remand to the Examining Attorney with another amendment to the identification of goods. The Examining Attorney accepted the amendment to the identification of goods but maintained the Section 2(d) refusal. The appeal was resumed and Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin*

Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *quoted in In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

A. The Marks

We compare the marks in their entireties for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the United States Army*, 85 USPQ2d 1264 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, different features may be analyzed to determine whether the marks are similar. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (citing *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955)). In fact, 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 the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat'l Data Corp.*, 224 USPQ at 751.

Here, we accord the wording in Applicant’s mark more weight than the design, because it is the wording and not the design element that will be recognized and used by purchasers as the primary means of source identification. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (finding GIANT to be the dominant portion of a mark consisting of the words GIANT HAMBURGERS with a large background design); *see also In re Appetito Provisions Co. Inc.*, 3 USPQ2d

1553, 1554 (TTAB 1987) (wording often dominates over design). The word COLIBRÍ, the dominant portion of Applicant's mark, is identical in sound to registrant's mark. To those English speakers who do not know Spanish, Italian or German, the terms are arbitrary terms having no meaning.⁵ The marks are similar in appearance, because COLIBRÍ and KOLIBRI share all but one of the same letters, and the accent on the final letter "I" in COLIBRÍ is an insignificant addition. Further, registrant's mark is a standard character mark, and marks appearing in standard character form may be displayed in any stylization, font, color and size, including the style identical to COLIBRÍ in Applicant's mark, because the rights reside in the wording and not in any particular display or rendition. *See Squirtdo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (a mark in standard character form is not limited to the depiction thereof in any special form). Because of the similarities in sound and appearance of the marks, we also find the commercial impression of the marks to be similar.

The *du Pont* factor regarding the similarity of the marks therefore favors a finding of likelihood of confusion.

⁵ "Kolibri" evidently is a German word for "hummingbird" and "Colibri" has the same meaning in both Spanish and Italian. March 21, 2016 Office Action, TSDR 2-6. We need only consider English speakers; in general, the Board does not apply the doctrine of foreign equivalents in cases where both marks are non-English words from two different languages. *See Safeway Stores Inc. v. Bel Canto Fancy Foods Ltd.*, 5 USPQ2d 1980, 1982 (TTAB 1987) (French expression "bel air" v. Italian expression "bel aria").

B. The Goods, Trade Channels and Purchasers

We now turn to the relationship between the respective goods, trade channels and purchasers. With regard to the relationship between the goods, we consider the goods as they are identified in the application and the ‘722 registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (goods as identified in involved application and cited registration compared); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The goods of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”). The goods need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

We consider first Applicant’s International Class 9 goods, which include “laboratory equipment for processing, visualizing and/or storing images and data relating to biological, microbiological and chemical samples, for scientific purposes and for environmental analysis, namely, cameras.” The cited registration includes

“scanning probe microscopes”⁶ within its identification of goods, and the Examining Attorney submitted the following webpages demonstrating such goods offered by the same entities under the same mark:

1. <https://www.micro-shop.zeiss.com>
microscopes and cameras for attachment to microscopes.⁷
2. <http://www.leica-microsystems.com>
a broad range of microscopes and cameras for microscopes for imaging, measuring, and documentation.⁸
3. <http://www.olympus-lifescience.com>
scanning microscopes for medicine and science and cameras.⁹
4. <https://www.nikoninstruments.com>
microscopes, including scanning microscopes, and cameras for microscope imaging.¹⁰

The International Class 10 goods identified in the application include

medical devices for assisting in the identification, manipulation and treatment of biological, microbiological and chemical samples, for medical and veterinary purposes, namely, blood sampling tubes for medical diagnosis ... diagnostic and medical equipment and instruments for the treatment of biological, microbiological and chemical samples, for medical and veterinary purposes, namely, sample preparation devices for medical

⁶ We take judicial notice of the definition of “scanning probe microscope” as “[a]ny of a number of devices capable of producing images of individual atoms and molecules on surfaces of materials” from *The New Dictionary of Cultural Literacy*, (3d ed. 2005). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁷ October 21, 2016 Final Action, TSDR p. 3-5.

⁸ October 21, 2016 Final Action, TSDR p. 15-18, 23-26.

⁹ October 21, 2016 Final Action, TSDR p. 31-40.

¹⁰ March 20, 2017 Office Action, TSDR p. 2, 7.

diagnostic use, cell culture chambers for medical diagnostic use.

The Examining Attorney submitted the following webpages demonstrating that a single source offers “scanning probe microscopes” and Applicant’s International Class 10 goods listed above:

1. <https://www.micro-shop.zeiss.com>
microscopes and sample capture caps, slides, tubes, dishes.¹¹

2. <http://www.leica-microsystems.com>
microscopes and sample preparation instruments.¹²

3. <https://www.nikoninstruments.com>
microscopes, including scanning microscopes, and (i) cell culture device for incubation and imaging, and recording and (ii) a cell screening device with microscope, incubator and camera.¹³

4. <http://www.jeolusa.com>
scanning microscopes and sample preparation instruments, including polishers and coating instruments.¹⁴

In addition, at least one device incorporates both a microscope and a camera. *See* Nikon BioStation IM-Q (“A compact cell incubation and monitoring device that incorporates a microscope, an incubator and a high-sensitivity cooled quantitative CCD camera into one self-contained system.”).¹⁵

¹¹ October 21, 2016 Office Action, TSDR p. 3-4, 6-10.

¹² October 21, 2016 Office Action, TSDR p. 11-18.

¹³ March 20, 2017 Office Action, TSDR p. 2, 4-6.

¹⁴ March 20, 2017 Office Action, TSDR p. 9, 11-13.

¹⁵ March 20, 2017 Office Action, TSDR 5.

The foregoing persuades us that scanning probe microscopes and (i) cameras as laboratory equipment for processing, visualizing and/or storing images and data relating to biological, microbiological and chemical samples, for scientific purposes and for environmental analysis, (ii) blood sampling tubes for medical diagnosis, and (iii) sample preparation devices for medical diagnostic use, and (iv) cell culture chambers for medical diagnostic use are commercially related goods and that consumers would expect that one entity is the source of such goods when offered under similar marks. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

As for the remaining goods in Applicant's identification of goods, we need not find relatedness as to every good listed in the identification. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for a good in each class. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion may be found with respect to a class of goods in an application if there is likely to be confusion with respect to any item that comes within the identification of the goods in that class); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015) ("Likelihood of confusion must be found if there is likely to be confusion with respect to any item in a class that comes within the identification of goods in the application and cited registration.") *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).¹⁶

¹⁶ Applicant expresses its "belief" in its reply brief that the remaining goods in the application may be registered even if the Board affirms the refusal. 13 TTABVUE 2. Inasmuch as the

Applicant argues:

To make sure that there is no overlap or relatedness between the '722 goods and applicant's goods, applicant has amended its Class 9 ID to specifically exclude all software and to specifically exclude all microscopes and components for microscopes. Since applicant has specifically removed all the complained-about overlap with the '722 goods, there is clearly no longer any overlap or relatedness between applicant's goods and the '722 goods. If you carefully analyze the '722 goods, all the goods in Class 9 are related to software (which applicant has now expressly cancelled) or to microscopes and components for microscopes (which applicant has now expressly excluded). With these limitations, it is evident that there is now no overlap between applicant's goods and the '722 goods.

The problem with this argument is that there need not be an overlap in goods in order for confusion to be likely. As noted earlier in this decision, goods need only be related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that the goods emanate from the same source. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722. Further, with regard to the limitation in registrant's identification that the recited goods are directed to "specialized professionals in scientific research microbiology laboratories," there is no limitation in the registration precluding sales of registrant's goods to "specialized professionals in scientific research microbiology laboratories," and we do not read limitations into identifications of goods. *Squirtco v. Tomy Corp.*, 216 USPQ at 940 ("There is no specific limitation and nothing in the inherent nature

Examining Attorney has not stated that the Section 2(d) refusal is limited to specific goods, the remaining goods may not be registered if likelihood of confusion is found as to one of the goods in an International Class.

of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Registrant's identification allows that its goods may also be offered to "specialized professionals in scientific research microbiology laboratories."

We therefore find the goods to be related, and the purchasers and trade channels, which at least include the Internet, to be the same.

C. Conditions of Purchase

Applicant points out that the specialized professionals who purchase Applicant's goods "pay close attention to details in expensive purchasing decisions [and] [i]n this situation, in which the highest level of expertise and attention is involved by the consumers concerned, it is beyond any doubt that such experts would never confuse or associate goods sold under applicant's COLIBRI and Design mark with the mark KOLIBRI" Applicant has not submitted any evidence to support its argument. Moreover, even assuming purchasers of Applicant's goods are sophisticated, this does not necessarily mean that they are immune to source confusion. It is well-settled that even careful or sophisticated purchasers who are knowledgeable as to the goods are not necessarily knowledgeable in the field of trademarks or immune to source confusion arising from the use of confusingly similar marks on or in connection with goods. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d at 1204. Here, the respective goods are highly similar, and sold under such similar marks that even sophisticated purchasers could be led to the mistaken belief that they originate from the same source. Further, that

“the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. Human memories even of discriminating purchasers . . . are not infallible.” *In re Research and Trading Corp.*, 793 F2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986). Therefore, the *du Pont* factor relating to the purchasers to whom sales are made, i.e., “impulse” versus careful, sophisticated purchasing, is neutral.

D. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Applicant’s and registrant’s marks are similar and Applicant has not established any weakness in registrant’s mark. The goods at issue are commercially related, and would travel through overlapping channels of trade to the same classes of purchasers, whose sophistication would not prevent a likelihood of confusion, given the similarity of the marks. We therefore find that Applicant’s COLIBRÍ and design mark for both its International Class 9 and 10 goods is likely to cause confusion with the registrant’s standard character mark KOLIBRI for its International Class 9 goods.

Decision: The refusal to register under Section 2(d) is affirmed with regard to the goods in both International Classes 9 and 10.