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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wentz Bros. dba Tamas Estates

Serial No. 77314718

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James T. Griffin, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Grendel, Drost, and Zervas, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 26, 2007, Wentz Bros. (applicant) applied
to register the mark ANDIAMO in standard character form on
the Principal Register for "wine" in Class 33. Serial No.
77314718. The application contains an allegation of a date
of first use anywhere and in commerce of September 1, 2007,
and a translation of the mark as "Let's Go."

The examining attorney refused to register the mark
under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d), because of a registration for the mark ANDIAMO,

Ser No. 77314718

in typed or standard character form, for "restaurant services." Registration No. 1803492 issued November 9, 1993, renewed. The registration also translates the mark as "Let's Go."

After the examining attorney made the refusal final, this appeal followed.¹

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

The first factor that we consider concerns the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). In this case, the marks are identical in every aspect. Indeed, both marks

¹ With its Reply Brief, applicant submitted fifty pages of exhibits that were not previously made of record. On June 15, 2009, the board denied the request that the board consider the evidence attached to the request or remand the application to the examining attorney. The board adhered to the decision on reconsideration (Order dated June 19, 2009), and, therefore, we will not consider this untimely evidence.

are displayed in typed or standard character form so we must assume that both marks can be displayed in the same stylization. *In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1044 (TTAB 2007) ("We must also consider that applicant's mark, presented in typed or standard character form, is not limited to any special form or style as displayed on its goods"). Inasmuch as applicant's and registrant's marks are identical, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). See also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Next, we must consider whether registrant's restaurant services are related to applicant's wine. Of course, we must view the goods and services as they are identified in the application and registration. *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

The Federal Circuit's precedent has set out how we must analyze the relatedness of restaurant services and food items.

Appellant's argument with respect to the relationship between foods and food services parallels that made by the opposer/appellant in *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978), seeking to bar registration of ZINGERS for cakes based on prior use and registration of RED ZINGER for herb tea. This court stated:

Interstate's major substantive contention is that case law has established a rule whereby confusion is to be found likely whenever food items are sold under the same or similar marks. There is no such "rule." On the contrary, "[e]ach case must be decided on its own facts and the differences are often subtle ones." *Industrial Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 1199, 177 USPQ 386, 387 (CCPA 1973). [576 F.2d at 927, 198 USPQ at 152].

To establish likelihood of confusion a party must show *something more* than that similar or even identical marks are used for food products and for restaurant services.

Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) (emphasis added).

More recently, the Federal Circuit held that the following evidence did not meet the "something more" requirement.

The Board therefore properly looked to other evidence to determine whether beer and restaurant services are related for purposes of assessing the likelihood of confusion. First, the Board relied on evidence from several references discussing the practice of some restaurants to offer private label or house brands of beer. Second, the Board cited articles showing that

brewpubs, which brew their own beer, often feature restaurant services as well. Finally, the Board reviewed evidence of several third-party registrations showing that a single mark has been registered for beer and restaurant services. Based on that evidence, the Board concluded that beer and restaurant services are related and that consumers encountering a beer displaying a substantially similar mark as that used for a restaurant would be likely to conclude that the beer and the restaurant services came from the same source.

In light of the requirement that "something more" be shown to establish the relatedness of food and restaurant products for purposes of demonstrating a likelihood of confusion, the Board's finding that beer and restaurant services are related is not supported by substantial evidence.

In re Coors Brewing Co., 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003).

In view of the "something more" requirement of *Jacobs*, we now look to see whether the examining attorney's evidence shows that wine and restaurant services are related.

The examining attorney argues that the "goods and services of the parties in this case are very closely related, since restaurants commonly serve wine, and wineries commonly feature restaurants. Food products and food-related services have been considered related goods and services." Brief at unnumbered p.3. The examining attorney argues that "the restaurant in the cited

registration features wine." *Id.* at 4. The relevant advertisement from registrant is set out below:



The ad reads:

Hilton
Take off with takeout
No need to wonder whether you will be served a bistro meal on your next flight. Order Food on the Fly and carry-out/carry-on to your next destination. Choose from such items as exotic salads, delicious pastas, fabulous and mouth-watering desserts. Located on the lobby level in Andiamo restaurant, you meal will be packed and ready when you are. Call ext. 1733, 30-minutes before your hotel departure [to] place an order for a gourmet meal on the fly.
© 1999.

The examining attorney also points to the fact that applicant, in its May 15, 2008, response, has admitted that it has a restaurant at its winery ("The Restaurant at Wente Vineyards").

In response, applicant argues:

[T]here is no evidence showing either that it is common in the industry for restaurants to offer and sell private label wines named after the restaurant or that either party's wines are served in the other's restaurant. More importantly, there is no evidence that the owner of the registration (Hilton Hotels) either sells or is likely to sell private label wines named after its restaurants. In an effort to show that Hilton Hotels does serve wine at its restaurants, the Examining Attorney has provided a room card depicting a bottle of wine on a table along with some food items. However, the trademark on the bottle is Brolio, not Andiamo. Moreover, the card invites the guest to "Take off with takeout" and to "Order Food on the Fly and carry-out/carry-on to your next destination." With take-out food, it is not likely that Hilton will sell wines named after its restaurant.

Brief at 1-2.

The examining attorney concludes by arguing that in "*Opus One*, the Board found that 'the requisite 'something more' exists, both in the strong and arbitrary character of registrant's OPUS ONE mark and the resulting broad scope of protection to which the mark is entitled ... and in the specific commercial relationship between wine and restaurant services.' *In re Opus One Inc.*, 60 USPQ2d 1812, 1813-14 (TTAB 2001). The mark at issue in this case is ANDIAMO, meaning 'let's go,' a similarly strong, arbitrary mark. The goods at issue are wine and restaurant services, the same as in *Opus One*. As such, in this case, the 'something more' required by *Jacobs* is similarly satisfied." Brief at 5.

In *Opus One* (60 USPQ2d at 1815), the board held that "the record in this case reveals that registrant's OPUS ONE wine is offered and served by applicant at its OPUS ONE restaurant. The fact that applicant's restaurant serves the type of goods (indeed the actual goods) identified in the cited registration is certainly probative evidence which supports a finding under the second du Pont factor that applicant's services and opposer's goods are related."

We begin our analysis by noting that the fact that the board has found goods and services to be related under the facts presented in a previous decision does not mean we can take judicial notice of those facts in this case.

In the instant case, although it may be said that the opinions of the U.S. District Court for the Northern District of California and the U.S. Court of Appeals for the Ninth Circuit may be relevant under the broad definition of "relevant evidence" in Rule 401, the Board remains of the opinion that such "evidence" is not competent evidence in a proceeding before it to prove uniqueness, notoriety or market power of opposer's mark in the marketplace today. For it is well settled that a decision in a prior case is incompetent as proof of any fact recited therein as against one who was not a party thereto. See: *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 USPQ 146 (TT&A Bd., 1970), and cases cited therein.

Chicken Delight, Inc. v. Delight Wholesale Co., 193 USPQ 175, 177 (TTAB 1976).

Therefore, we must look to the evidence in this case to determine if the goods and services are related. The

only facts that support the relatedness of wine and restaurant services are the fact that applicant has a restaurant at its winery ("The Restaurant at the Wente Vineyards") and that registrant apparently had a hotel and that ten years ago it displayed a picture of a bottle of wine in an advertisement for its takeout food (with no mention that wine is one of the items available as a "to go" item). There is no other evidence that wine is actually served in registrant's restaurant. We note that the picture also displays a salt shaker, a pepper mill, and apparently, a can of olive oil and a cruet of vinegar.

At this point, we observe that the board has found the "something more" requirement to be met in various ways. For example, the board found that the "average consumer, therefore, would be likely to view Mexican food items and Mexican restaurants services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks." *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999). In a case involving restaurant services and mustard, the board found that the term MUCKY DUCK was "a very unique, strong mark." *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988). In *Opus One*, registrant's wines were actually sold in applicant's

restaurant. See also *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074, 1074 (TTAB 1990) ("Applicant's mark [GOLDEN GRIDDLE PANCAKE HOUSE (Pancake House disclaimed)] makes it clear that its restaurant serves pancakes and, no doubt, pancake (or table) syrup, as well. There is an undeniable connection between the goods of the registrant [pancake syrup] and the services of applicant"). Also, in a case somewhat similar to this case, the board found that the mark AMAZON and parrot design for chili sauce and pepper sauce was confusingly similar to the mark AMAZON for restaurant services. *In re Comexa Ltda.*, 60 USPQ2d 1118 (TTAB 2001). However, in that case, there were "numerous [50] third-party registrations" and the board was able to conclude that of "all food products[,] sauces and dressings are perhaps the ones most likely to be marketed by the restaurants in which those items are served." *Id.* at 1120.

The facts of this case are much less persuasive. Applicant and registrant are not providing the same type of ethnic food and restaurant services. The only evidence of record to show that the goods are related is the simple picture of a bottle of wine along with other food items in a flyer about registrant's takeout services and the fact that applicant has a restaurant with a different name at its winery. We find that this evidence is not enough to

show the "something more" required by *Jacobs*. We do not find that the mark ANDIAMO is a "very strong, unique" term as the mark MUCKY DUCK was held to be. As a foreign term, it would not be as memorable as an unusual combination of English words.

We also note that Federal Circuit has emphasized that "[t]his case would be different ... if the registrant's mark had been for a brewpub or for restaurant services and beer. In that case, the goods and services associated with the two marks would clearly be related and the case for a likelihood of confusion therefore much stronger." *Coors Brewing*, 68 USPQ2d at 1064. The Court was looking for evidence that the restaurant was also the source of the goods not simply that a picture of the goods appeared in an ad for the restaurant's services. Indeed, the Court described as "a very weak evidentiary basis for a finding of relatedness" that "a tiny percentage of all restaurants also *serve as a source* of beer." *Id.* (emphasis added). There is no evidence that registrant is a source of wine or that anyone other than applicant is such a source. The fact that applicant has a restaurant *at its winery* is not enough to show that the goods are related. It is true that some consumers who have patronized registrant's ANDIAMO restaurant may go to applicant's winery and eat at The

Restaurant at Wente Vineyards. They may then order a bottle of ANDIAMO wine and conclude that the source of these goods and services are related. However, while it is possible that some consumers may believe that there is an association between goods and services, the "statute refers to likelihood, not the mere possibility, of confusion."

Bongrain International (American) Corp. v. Delice de France, Inc., 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987). Indeed, we have no reason to conclude that the level of confusion would be higher in this case than in *Coors Brewing*.

We conclude with the Federal Circuit's observation in *Coors Brewing* (68 USPQ2d 1064), which makes it clear that the relatedness of restaurant services and food items is not to be assumed and that significant evidence of their relatedness is necessary:

It is not unusual for restaurants to be identified with particular food or beverage items that are produced by the same entity that provides the restaurant services or are sold by the same entity under a private label. Thus, for example, some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant. The *Jacobs* case stands for the contrary proposition, and in light of the very large number of restaurants in this country and the great variety in the names associated with

those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.

As a result we determine that under the facts presented in this appeal, there is no likelihood of confusion because there is not enough evidence to meet the "something more" requirement of *Jacobs*.

Decision: The refusal to register applicant's mark under Section 2(d) of the Trademark Act is reversed.