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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77858375

MARK: MY BIG FAT GREEK WINE



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<http://www.uspto.gov/main/trademarks.htm>

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the mark MY BIG FAT GREEK WINE in standard character for "wine" on the grounds of a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

FACTS

Applicant has applied for registration on the Principal Register for the mark "MY BIG FAT GREEK WINE" for "wine." On February 1, 2011, registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on a likelihood of confusion as to U.S. Registration No. 3202521 for the mark "MY BIG FAT GREEK RESTAURANT" for "restaurant services" and a disclaimer requirement for "GREEK WINE." On November 10, 2010, applicant responded by stating that the marks are different in sound, appearance, meaning and connotation, and the channels of trade differ.

Applicant did not address the disclaimer requirement. The examining attorney was not persuaded by applicant's arguments and issued a final refusal with respect to the Section 2(d) refusal and the disclaimer requirement on November 23, 2010. Applicant did not request reconsideration. This appeal follows the examining attorney's final refusal under Trademark Act Section 2(d) and the requirement for a disclaimer statement.

APPEAL ISSUES

- I. Whether the registration of applicant's mark, MY BIG FAT GREEK WINE for "wine," is likely to cause confusion with the mark, MY BIG FAT GREEK RESTAURANT for "restaurant services," in Registration No. 3202521 under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).
- II. Whether the wording "GREEK WINE" in applicant's mark is descriptive of its goods and should be disclaimed.

ARGUMENTS

I. Applicant's Mark is Likely to Cause Confusion With the Cited Registration

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, ___ F.3d ___, 98

USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. The Marks Are So Similar in Sound, Appearance and Meaning There is a Likelihood of Confusion

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. *See* TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression; greater weight is given to that dominant feature in determining whether the marks are confusingly similar. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); TMEP §1207.01(b)(viii), (c)(ii).

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services; therefore, the word portion is normally accorded greater weight in determining whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011).

Applicant's mark is MY BIG FAT GREEK WINE in standard character. When comparing the marks, each mark must be considered in its entirety; the descriptive portion of a mark cannot be ignored. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). However, one feature of a mark may be more significant in creating a commercial impression. *See In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751; TMEP §1207.01(b), (b)(iii), (b)(viii). Descriptive or generic matter is typically less significant or less dominant in relation to other wording in a mark. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009).

In the present case, as shown by applicant's identification of goods, the wording WINE in the applied-for mark is generic as applied to the relevant goods. Thus, this wording is less significant in terms of creating the mark's commercial impression, rendering the wording MY BIG FAT GREEK the dominant, source-indicating element of the mark.

Registrant's mark is MY BIG FAT GREEK RESTAURANT in stylized wording. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must

be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). In this case, registrant disclaimed the wording GREEK RESTAURANT.

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

Further, consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897

(TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Both marks begin with the wording, MY BIG FAT GREEK. Applicant’s mark ends with the wording WINE, which is generic for applicant’s goods and registrant’s mark ends with the wording RESTAURANT, which is disclaimed and is generic for registrant’s services.

In its brief, applicant argues that WINE and RESTAURANT are the dominant portions of applicant’s mark and registrant’s mark, respectively, because they define applicant’s goods and registrant’s services, thus distinguishing the two marks. *See* Applicant’s Brief, pg. 6. The examining attorney does not argue that the words WINE and RESTAURANT distinguish the two marks. However, the examining attorney respectfully disagrees that those words are the focal points of the respective marks.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling &*

Clamp Co., 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Therefore, the two marks are confusingly similar.

B. The Pertinent Goods and Services are Closely Related

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

The fact that the goods and/or services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods and/or services, but likelihood of confusion as to the source of those goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); TMEP §1207.01; *see Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975).

For purposes of a likelihood of confusion determination, food-related services such as restaurant and catering services, may be found related to beverage products where

the evidence shows something more than just that such goods and services may be provided under the same or similar marks. *See, e.g., In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001) (holding use of OPUS ONE for both wine and restaurant services likely to cause confusion, where the evidence of record indicated that OPUS ONE is a strong and arbitrary mark, that it is common in the industry for restaurants to offer and sell private label wines named after the restaurant, and that registrant's wines were served at applicant's restaurant); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999) (holding use of AZTECA MEXICAN RESTAURANT for restaurant services and AZTECA (with and without design) for Mexican food items likely to cause confusion, where the AZTECA MEXICAN RESTAURANT mark itself indicated that the relevant restaurant services featured Mexican food and the evidence showed that the goods at issue "are often principal items of entrees served by . . . Mexican restaurants"); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988) (holding use of applied-for mark, MUCKY DUCK and duck design, for mustard, and registered mark, THE MUCKY DUCK and duck design, for restaurant services, likely to cause confusion, given that applicant's mark was highly similar to registrant's "unique and memorable" mark, that "mustard is . . . a condiment which is commonly utilized in restaurants by their patrons," and that "restaurants sometimes market their house specialties, including items such as salad dressings, through retail outlets"); TMEP §1207.01(a)(ii)(A).

In this case, the evidence of record consists of 10 restaurants that use the same mark on their wine labels. This evidence shows that the goods and services at issue are related because they are often provided under the same mark. Please see websites for the following restaurants and wine labels attached to the Office action issued on November

23, 2010:

- The Vineyards
- KNAPP
- Sanders Ridge
- South Coast Winery
- Wente
- Magnanini
- Wilson Creek
- Ponte
- KE Kiepersol Estates
- Bully Hill

Further, the trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of 20 third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely wines and restaurant services, are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Specifically, please see the following registrations attached to the Office action issued on November 23, 2010:

- Registration No. 1998084: The mark PLUMPJACK in typed drawing for “wine and restaurant services”;

- Registration No. 2139342: The mark COVA with design for “wine and restaurant services”;
- Registration No. 3074205: The mark CALISTOGA RANCH in typed drawing for “wine and restaurant services”;
- Registration No. 3474535: The mark A COW JUMPED OVER THE MOON GOURMET CAFÉ & ÉPICERIE with a design for “wine and restaurant services”;
- Registration No. 3643141: The mark CETRELLA in standard character for “wine and restaurant services”;
- Registration No. 3652326: The mark COOPER’S HAWK WINERY & RESTAURANT with design for “wine and restaurant services”;
- Registration No. 3744430: The mark VIA DEL MILLE with a design for “wine and restaurant services”; and
- Registration No. 3769468: The mark CITY WINERY with design for “wine and restaurant services”;
- Registration No. 3828638: The mark HVH in stylized form for “wine and restaurant services”; and
- Registration No. 3868986: A design only mark for “wine and restaurant services”.

Therefore, consumers will be confused as to the source of the goods and services.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204,

1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

II. Disclaimer of the Wording “GREEK WINE”

Applicant must disclaim the descriptive wording “GREEK WINE” apart from the mark as shown because it merely describes a type of applicant’s goods. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); TMEP §§1213, 1213.03(a).

Specifically, the evidence from the Internet attached to the Office action issued on November 23, 2010 shows this wording indicates a type of wine. Please see attached evidence from Wikipedia.org, greekwinemakers.com and businessweek.com that show the wording GREEK WINE to refer to a type of wine.

Applicant may submit the following standardized format for a disclaimer:

No claim is made to the exclusive right to use “GREEK WINE” apart from the mark as shown.

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

CONCLUSION

In conclusion, applicant’s mark and registrant’s marks are very similar in sound, appearance and meaning. Moreover, applicant’s goods and registrant’s services are

closely related. In view of the foregoing, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) should be affirmed.

Additionally, the requirement to disclaim the descriptive wording, GREEK WINE, should be affirmed.

Respectfully submitted,

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