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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Maestro Tequilero, S.A. de C.V.

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Serial No. 77904774

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Lawrence E. Abelman and Erica R. Halstead for Maestro Tequilero, S.A. de C.V.

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Before Mermelstein, Ritchie, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On January 4, 2010, Maestro Tequilero, S.A. de C.V., a Mexican corporation, applied to register the mark ATELIER (in standard character form) on the Principal Register for “alcoholic beverages” in Class 33 pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). After the examining attorney found the identification of goods to be indefinite, the applicant amended the goods to “tequila.”

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the mark in Registration No. 3020017. That mark is ATELIER WINERY (in

standard character form), with WINERY disclaimed, for “wine” in Class 33. Applicant timely appealed after the refusal was made final, and its request for reconsideration was denied.

Analysis

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“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.”). We discuss each of the *du Pont* factors as to which applicant or the examining attorney submitted argument or evidence. To the extent that any other *du Pont* factors for which no evidence or argument was presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Marks

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression. *Du Pont*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988);

In re Lamson Oil Co., 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that 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 so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd*, No. 92-1086 (Fed. Cir. June 5, 1992).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, our 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. *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 entirety. *In re Nat'l Data Corp.*, 224 USPQ at 751.

Applicant's mark is the single word ATELIER, which is also the first word in the applied-for mark. Although neither the application nor the cited registration includes a translation, other registrations and applications of record specify that the English translation of the French word "atelier" is "workshop." We view ATELIER as arbitrary in association with either wine or tequila, heightening the similarity in commercial impression made by the marks ATELIER and ATELIER WINERY and therefore increasing the likelihood of confusion. For those consumers who know the meaning of the French word "Atelier," applicant's and registrant's marks will have the same connotation, i.e., that both applicant's and the registrant's goods are hand-crafted in an "atelier" or workshop. For consumers who do not know the meaning of the word, they are likely to perceive the two marks as presenting the same overall commercial impression, albeit without knowledge of the meaning of the distinctive term shared by both applicant's and the registrant's mark. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

We also find that the word ATELIER is the dominant portion of the registered mark ATELIER WINERY, for the following reasons.

First, ATELIER is the initial word in the registered mark. *See Palm Bay Imports, Inc.*, 73 USPQ2d at 1692 (finding "veuve" the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (noting that upon

encountering the marks, consumers will first notice the identical lead word); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (stating that “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

Second, the term WINERY is disclaimed from the prior registered mark and is at least descriptive of the identified goods, while, as noted, the term ATELIER is arbitrary for tequila and wine. It is well-settled that disclaimed, descriptive or generic matter may have little or no significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Applicant has submitted print-outs from the websites of several wine-producing companies that contain “Wines” or “Winery” in their corporate names and apparently make and sell wine only. Applicant argues that the term “winery” in the registered mark ATELIER WINERY will alert consumers that the registrant’s goods are wines, thereby in fact reducing a likelihood of confusion. “Consumers are

not likely to believe that ‘tequila’ comes from the same source, namely, a winery.” Applicant’s Brief, at 2.

This argument, however, improperly focuses on a side-by-side comparison of the marks, rather than on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). The word WINERY in the registered mark is at least highly descriptive of the registrant’s wine and therefore is unlikely to be used by purchasers as a basis for distinguishing the **source** of the respective goods. This difference is outweighed by the overall similarity which results from the dominant presence in both marks of the identical, distinctive word ATELIER. Thus, we find that applicant’s mark ATELIER is the dominant portion of the registered mark. We also find that the two marks make similar commercial impressions. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women’s dresses is likely to be confused with LILLI ANN for women’s apparel including dresses).

Applicant has argued that the term ATELIER is relatively weak and entitled to only a narrow scope of protection because it is commonly used in connection with alcoholic beverages, submitting as evidence two registrations and one abandoned application. The two registrations are for ATELIER DE MAÎTRE ALBERT

(Registration No. 3892808), translated as “Workshop of Master Albert,” for (among other goods and services) “alcoholic beverages, except for beers, namely, whiskey, distilled spirits, liqueurs, beverages, containing fruit, brandy; wines” in Class 33; and L’ATELIER DE JOËL ROBUCHON (Registration No. 3409256) in design form:



for “alcoholic beverages other than beers, namely, alcoholic essences, alcoholic extracts of spirituous liquors; wine; beverages containing alcohol, namely, alcoholic coffee-based beverages, alcoholic punch” in Class 33, among other goods and services.¹

The registrations applicant has submitted are distinguishable in that, unlike applicant’s mark ATELIER and the prior registration for ATELIER WINERY, they combine other distinctive wording with ATELIER and formatives. Applicant’s mark is much closer to the mark in the cited registration than the cited mark is to the marks in these additional registrations. Moreover, “[t]he existence of [third-party] registrations is not evidence of what happens in the market place or that consumers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.” *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403,

¹ We need not discuss the proffered abandoned application. An abandoned *registration* is evidence of nothing more than that it was once filed, and an abandoned application is surely no more probative. See *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973); *Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987).

177 USPQ 268, 269 (CCPA 1973); *see also In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

The third-party registrations introduced by applicant are not evidence that those marks have been used at all, let alone used so extensively that consumers have become sufficiently conditioned by their usage that they can distinguish between such marks on the basis of minor differences. The probative value of third-party trademarks depends entirely on their usage. *Palm Bay Imports, Inc.*, 73 USPQ2d at 1693. Where, as here, the record includes no evidence about the extent of third-party uses, the probative value of this evidence is minimal. *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001); *see also Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (“As to strength of a mark, however, registration evidence may not be given *any* weight.”).²

For all of the reasons discussed above, we find the marks to be quite similar in commercial impression, and the similarities in sight, sound and connotation to outweigh the differences. In our likelihood of confusion analysis, this finding (under the first *du Pont* factor) supports a conclusion that confusion is likely.

² We have given no consideration to the third-party registrations attached to applicant’s brief, which address marks and goods not at issue here. As the examining attorney correctly pointed out, this evidence was not timely submitted. 37 C.F.R. § 2.142(d); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Trans Cont’l Records, Inc.*, 62 USPQ2d 1541, 1541 n.2 (TTAB 2002); TBMP §§ 1203.02(e), 1207.01. We hasten to add that the evidence would not change our decision herein.

B. Similarity of the Goods and Channels of Trade

We turn next to the similarity of the goods and their channels of trade, the second and third *du Pont* factors, respectively. In determining the similarity or dissimilarity of the goods, we note that the more similar the marks at issue, the less similar the goods need to be for the Board to find a likelihood of confusion. *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). The goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each of the parties' goods. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978).

Because the application is unrestricted, we must presume that applicant's tequila will travel through all normal channels of trade and reach all classes of purchasers which are usual for such goods. *See Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990); *Nike, Inc. v. WNBA Enters., LLC*, 85 USPQ2d 1187, 1195 (TTAB 2007).

Applicant argues that, although wine and tequila may be sold in the same retail outlets, they are not competing products and that rather there are

appreciable differences between the goods. Applicant submits: “They are produced differently, one being a distilled beverage and one being fermented, they look, taste and smell different, and they are generally contained in bottles of differing aesthetics.” Applicant’s Brief, at 3. Applicant further argues that it “is simply not within reason to believe that ATELIER tequila is manufactured by the same source as ATELIER WINERY wines. As said before, wineries are not known for their tequilas.” *Id.*

Based on the evidence regarding the similarity of the marks and the related nature of the goods, we find that alcoholic beverage consumers who are familiar with ATELIER WINERY wine, upon encountering ATELIER tequila, are likely to assume that the winemaker also is marketing tequila, or that there is some sponsorship relationship or affiliation between the producers of the respective goods.

Although there is no per se rule that all alcoholic beverages are related, *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009), the Federal Circuit Court of Appeals and the Board repeatedly have found that different types of alcoholic beverages are related goods for purposes of a Trademark Act Section 2(d) analysis. *See, e.g., In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1947-48 (Fed. Cir. 2004) (holding JOSE GASPAR GOLD for tequila likely to be confused with GASPAR’S ALE for beer and ale); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1265 (TTAB 2011) (finding beer related to wine); *In re Majestic Distilling Co.*, 65 USPQ2d at 1207 (holding RED BULL for tequila likely to be

confused with RED BULL for malt liquor); *In re Salierbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (holding CHRISTOPHER COLUMBUS for beer likely to be confused with CRISTOBAL COLON & design for sweet wine); *Somerset Distilling Inc. v. Speymalt Whisky Distribs. Ltd.*, 14 USPQ2d 1539, 1542 (TTAB 1989) (holding JAS. GORDON and design for scotch whiskey likely to be confused with GORDON'S for distilled gin and vodka); *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (holding BRADOR for malt liquor, beer and ale likely to be confused with BRAS D'OR for brandy); *Bureau Nat'l Interprofessionel Du Cognac v. Int'l Better Drinks Corp.*, 6 USPQ2d 1610, 1617 (TTAB 1988) (holding COLAGNAC for cola liqueur likely to be confused with certification mark COGNAC for brandy); *Rosenblum v. George Willsher & Co.*, 161 USPQ 492, 492-93 (TTAB 1969) (holding RED BULL for scotch whiskey likely to be confused with TORO ROJO for rum).

The Board has specifically found wine and distilled spirits to be related goods. *Monarch Wine Co. v. Hood River Distillers, Inc.*, 196 USPQ 855, 857 (TTAB 1977) (finding distilled spirits related to wine and champagne); *In re AGE Bodegas Unidas, S.A.*, 192 USPQ 326, 326 (TTAB 1976) (finding wine related to whiskey). *Cf. In re Majestic Distilling Co.*, 65 USPQ2d at 1204 (finding malt liquor and tequila to be related goods).

The Board and the Federal Circuit Court of Appeals also have repeatedly found that different types of alcoholic beverages share identical trade channels and classes of purchasers. *See, e.g., In re Chatam Int'l Inc.*, 71 USPQ2d 1944 at 1948; *In*

re Majestic Distilling Co., 65 USPQ2d at 1204; *Monarch Wine Co.*, 196 USPQ at 857; *In re AGE Bodegas Unidas, S.A.*, 192 USPQ at 326.

In this case, the examining attorney has submitted evidence, consisting of Internet print-outs, that wine and tequila have complementary uses and may be used together or otherwise purchased by the same purchasers in the same places for the same purposes, as summarized below:

- Use of wine and tequila together: approximately ten recipes for cocktails, margaritas, and sangria featuring both tequila and wine or champagne.
- Restaurants and bars offering wine and tequila pairings: references to three restaurants and bars offering both wine and tequila menus or pairings with food, as well as a food and wine festival sponsored by Tequila Herradura.
- Manufacture and distribution of wine and tequila: print-outs from Hoover's Company Records and from the websites of several producers, distributors, and retailers of both wine and tequila.
- Third-party registrations for both tequila and wine, including the following:
Registration Nos. 1803376 (BANDOLERO); 2488097 (COMPADRE); 2791187 (CHARBAY); 3083621 (CAVE ART); 3188831 (QI); 3209611 (MORGENSTER); 3261562 (BROCK SAVAGE); 3326272 (EL AMO); 3428626 (THE PROOF IS IN THE FRUIT); 3624987 (CABRITO & design); 3632066 (FRUITION).³

³ We also note applicant's submission of a third-party registration for a mark including the term ATELIER which is registered for distilled spirits and wine: ATELIER DE MAÎTRE ALBERT (Registration No. 3892808), translated as "Workshop of Master Albert," for (among other goods and services) "alcoholic beverages, except for beers, namely, whiskey, distilled spirits, liqueurs, beverages, containing fruit, brandy; wines" in Class 33.

The first three types of evidence demonstrate on their face that wine and tequila have complementary uses and travel in the same channels of trade. The third-party registrations demonstrate that tequila and wine are goods 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). Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the identified goods are products which are produced and/or marketed by a single source under a single mark. *See Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1893 (TTAB 2007); *see also In re Kysela Pere et Fils Ltd.*, 98 USPQ2d at 1264-65 (third-party registration evidence sufficient to establish relatedness of alcoholic beverages).

In sum, we find the examining attorney has submitted persuasive evidence establishing that wine and tequila move in the same channels of trade and are sufficiently complementary or related that source confusion is likely. In our likelihood of confusion analysis, these findings under the second and third *du Pont* factors support a conclusion that confusion is likely.

Balancing the Factors

We have considered all of the evidence of record as it pertains to the relevant *du Pont* factors. We have carefully considered applicant's arguments and evidence, even if not specifically discussed herein, but have not found them persuasive. In view of our findings that the marks make a similar commercial impression and that the goods are related and move in the same or similar channels of trade, we find

that applicant's mark ATELIER for tequila is likely to cause confusion with the registered mark ATELIER WINERY for wine.

To the extent that any of applicant's points raises a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

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