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OF THE TTAB

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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 Robert V. Marcon

Application No. 78288366

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Robert V. Marcon, *Pro Se*.

D. Beryl Gardner, Examining Attorney, Law Office 112  
(Angela Wilson, Managing Attorney).

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**Before Quinn, Mermelstein, and Wellington, Administrative  
Trademark Judges.**

**Opinion by Wellington, Administrative Trademark Judge:**

On October 29, 2003, Robert V. Marcon filed an application to register the mark HEINEKEN (in standard character format) on the Principal Register for goods ultimately identified as "meat juices" in International Class 29.<sup>1</sup>

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<sup>1</sup> Application serial no. 78288366 was filed August 17, 2003, based on applicant's statement of a *bona fide* intent to use the mark in commerce and ownership of a foreign application. Trademark Act §§ 1(b) and 44(d). The original identification of goods read: "water, still water, mineral water spring water, aerated water carbonated water sparkling water, ice water, iceberg water, ice, crushed ice, juices, flavored drinks (except beverages based on coffee, tea, or cocoa and milk beverages), nutrient drinks, non-alcoholic beverages, preparations for making beverages, syrups."

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The trademark examining attorney refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that applicant's mark falsely suggests a connection with Heineken Brouwerijen B.V. ("Heineken brewery"), a Dutch beer brewing company. The examining attorney also refused registration under Section 2(d), 15 U.S.C. §1052(d), on the ground of likelihood of confusion with ten previously registered marks, all issued to the Heineken brewery.

Applicant appealed. Both applicant and the examining attorney have filed briefs. In view of the meager record, we are constrained to reverse the refusal on both grounds.

We turn first to the refusal to register under Section 2(a).

In *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that to succeed on a Section 2(a) false suggestion of a connection ground for refusal, the plaintiff or the examining attorney must demonstrate that the name or equivalent thereof claimed to be appropriated by another is unmistakably associated with a particular personality or "persona" and must point uniquely to the plaintiff. Following that decision and in accordance with the principles set forth therein, the Board, in *Buffett v. Chi-*

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*Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), required that a plaintiff asserting a claim of a false suggestion of a connection demonstrate the following: 1) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; 2) that the mark would be recognized as such; 3) that the plaintiff is not connected with the activities performed by the defendant under the mark; and 4) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed. See also, *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997); and *In re Kayser-Roth Corp.*, 29 USPQ2d 1379 (TTAB 1993).

In this *ex parte* proceeding, the trademark examining attorney must establish the elements relating to the name or identity with which the examining attorney asserts the applicant's mark falsely suggests a connection. Specifically, the examining attorney must establish that applicant's mark falsely suggests a connection with the Heineken brewery persona. See *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003), and cases cited therein.

Based on the scant record before us, we can not make a finding in the Office's favor as to the fourth *Buffett*

element, namely, that the HEINEKEN name is of sufficient fame that a connection with Heineken brewery will be presumed. Indeed, the only evidence submitted by the examining attorney in support of the false suggestion of a connection ground consists of: (1) two sets of Google search engine "hit list" result pages; and (2) printouts from a Heineken brewery website [www.heineken.com/usa/](http://www.heineken.com/usa/).<sup>2</sup>

The two sets of Google search "hit list" evidence each consist of two pages which merely demonstrate that the examining attorney conducted searches (via the Google search engine) for websites containing the term "Heineken." Although one search results in 1,170,000 "hits" and the other results in 11,800,000 "hits", the printouts only show excerpts for the first ten (or fewer) results of each search and these excerpts are extremely truncated, containing very little text. It has long been held that such evidence, i.e., an electronic search hit list that does not show results in context, has very limited probative value. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); *In Remacle*, 66 UPSQ2d 1222, 1223 (TTAB 2002) ("Examining Attorney's print-out of the results of an Internet search by the Yahoo search engine are of little probative value, largely because insufficient text is

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<sup>2</sup> Attached to Office action issued on August 30, 2005. Results pages from a second Google search engine hit list were attached to the Office action issued on April 18, 2006.

available to determine the nature of the information and, thus, its relevance"); *In re Fitch IBCA Inc.*, 64 UPSQ2d 1058, 1060 (TTAB 2002). See also TBMP § 1208.03 (2d ed. rev. 2004). We are unable to accord any fame to the Heineken name based on this evidence because we have not been provided with copies from any of the web pages identified by Google so that we can examine the content and context within which the term "Heineken" is being used.

Regarding the Heineken.com website printouts, they appear to have been retrieved under the website's "Heineken's History in the USA" section. The following are the only relevant excerpts from these pages:

Second page:

"1880's - The first barrels of Heineken reach the USA."

Third page:

"1950's...[d]uring the 1950's, sales of Heineken in the US really took off...sales were growing by 20 to 30 percent per year, focusing predominantly in better class hotels, restaurants and cafes. Although it costs 20 cents more than the average domestic beer, Heineken launches its advertising campaign under the motto 'Heineken tastes tremendous' and sales continue to climb."

Fourth page:

"Now & future...As the Millennium passed, Heineken USA continued to be a leader in the imported beer segment. The company garnered awards for advertising, as well as for its community involvement activities in its corporate home of Westchester County and around the nation..."

Fifth page

"The corporate office is located in White Plains, New York...We also have regional offices in Atlanta, GA; Oakbrook, IL and El Segundo, CA."

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The information that may be gleaned from this Heineken website is clearly of little consequence to the specific issue in this appeal, and does not demonstrate any real level of fame of the Heineken name for its brewery. There are no hard facts as to the amount of beer being imported into the U.S., Heineken brewery's actual market share in the U.S., advertising figures, etc. We also need to take into consideration the source of the information contained on this website. Inasmuch as the website is obviously a Heineken corporate website, there is a strong likelihood that some of information being provided may be more in the form of advertising or puffery rather than stating objectively the Heineken brewery's importance or its fame in the beer industry. Without discounting the website material, we view it as less probative or objective than had it come from an unrelated source. Accordingly, in addition to there being very little substance to show any fame of the Heineken name for its brewery, we give this evidence limited weight in view of the source of the information.

The Board can not and does not take judicial notice of fame of an entity's mark or, more specifically, that the Heineken name for its brewery is of sufficient fame or reputation to consumers in the United States as contemplated in a Section 2(a) ground for refusal. Instead, these are matters which must be borne out by the evidence of record.

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See, e.g., *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998) ("[W]e will not take judicial notice of fame."); and *Bristol-Myers Company v. Texize Chemicals, Inc.*, 168 USPQ 670, 671 (TTAB 1971) (Board refused to take judicial notice that parties were large, diversified corporations and of various other facts relative to their respective operations). Rule 201(b) of the Federal Rules of Evidence provides that "a judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned."

Because certain authoritative reference materials may demonstrate a generally known fact within the territorial jurisdiction of the Board, the Board has taken judicial notice of the information or facts contained therein. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (Board may take judicial notice of dictionary definitions); see also TBMP §704.12(a) (2d ed. rev. 2004). However, this case is distinguishable from *Notre Dame* because we have no such dictionary definitions. Fed. R. Evid. 201(d) ("A court shall take judicial notice if requested by a party *and supplied with*

*the necessary information.*"). Thus, even if this were a situation where we were willing to take judicial notice, we have not been presented with the "necessary information."

Without any resources of which to take judicial notice, and upon consideration of what little evidence is of record, we are simply unable to make a finding based on this record that the Heineken brewery persona is of sufficient fame or reputation to consumers in the United States that, when applicant's mark is used on its goods, a connection between the mark and the Heineken brewery would be presumed. Because we find that the Office has not established the fourth factor set forth in *Buffett*, we reverse the refusal of registration on the false suggestion of connection ground.

At the risk of stating the obvious, certainly a different result might have been possible on this Section 2(a) ground, had we been privy to a fuller record. We acknowledge that an *ex parte* appeal will generally be decided on a smaller record than an *inter partes* proceeding.<sup>3</sup> And, both the Federal Circuit, our primary reviewing court, and the Board have recognized the "limited facilities for acquiring evidence" faced by the Office in

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<sup>3</sup> In addition, certain grounds for refusing registration of a mark, e.g., dilution under Sections 13(a) and 14 of the Trademark Act, are not contemplated in an *ex parte* setting, but may be asserted by a plaintiff in an *inter partes* proceeding.



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obtaining evidence supporting a prima facie case. See *In re Budge Mfg., Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260-61 (Fed. Cir. 1988); *In re Squaw Development Co.*, 80 USPQ2d 1264, 1271 - 1272 (TTAB 2006). Nonetheless, the limited record in this proceeding was not the result of "limited facilities." Rather, the examining attorney in this case was presented with Google search engine "hit lists" indicating 1 to 12 million results for the term "Heineken," but surprisingly did not attach any of the web pages themselves or any other information probative of how "Heineken" is used on those websites and whether it has attained sufficient fame to justify the refusal to register. We can not assume that all of the results refer to the Heineken brewery or that such a high number of results, by itself, is indicative of a high level of fame or reputation.

We now turn to the likelihood of confusion ground.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants*

*Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

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); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

As already noted, the examining attorney has cited ten different registrations (owned by the same party). They are as follows<sup>4</sup>:

1. HEINEKEN SPECIAL DARK BEER BREWED IN HOLLAND HORS CONCOURS MEMBRE DU JURY PARIS 1900 TRADE MARK GRAND PRIX PARIS 1889 DIPLOME D'HONNEUR AMSTERDAM 1883 MEDAILLE D'OR PARIS 1875 (and design) for "beer" in Registration No. 0823033;
2. HEINEKEN LAGER BEER BREWED IN HOLLAND HORS CONSOURS MEMBRE DU JURY PARIS 1900 TRADE MARK GRAND PRIX PARIS 1889 DIPLOME D'HONNEUR AMSTERDAM 1883 MEDAILLE D'OR PARIS 1875 (and design) for "beer" in Registration No. 0823034;<sup>5</sup>

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<sup>4</sup> Registrations Nos. 1846907 and 1731454 were added to the list of cited marks by the examining attorney in her fourth Office action (issued April 18, 2006), but she did not attach copies of these registrations to the Office action. TMEP Section 705.03 provides that "[w]hen refusing registration under 15 U.S.C. §1052(d) based on a likelihood of confusion with a previously registered mark, the examining attorney must give the registration number(s) and attach to the Office action copies of each cited registration, which will become part of the record." In spite of this omission, we have considered these two registrations in our decision.

<sup>5</sup> This registration was cancelled (for failure to renew) on October 27, 2007, subsequent to the briefing of the appeal. It is therefore not considered a possible bar to registration of applicant's mark.

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3. HEINEKEN HORS CONCOURS MEMBRE DU JURY PARIS 1900 GRAND PRIX 1889 DIPLOME D'HONNEUR AMSTERDAM 1883 MEDAILLE D'OR PARIS 1875 for "beer" in Registration No. 0823035;
4. HEINEKEN for "beer and malt beverages" in Registration No. 0956608;
5. HEINEKEN (and configuration of a bottle) for "beer" in Registration No. 1504209;
6. HEINEKEN (and design) for "beers" in Registration No. 1846907;
7. HEINEKEN HEINEKEN LAGER BEER BREWED IN HOLLAND EST. 1873 THE ORIGINAL QUALITY BREWED WITH NATURAL INGREDIENTS HORS CONCOURS MEMBRE DU JURY PARIS 1900 GRAND PRIX PARIS 1889 TRADEMARK DIPLOME D'HONNEUR AMSTERDAM 1883 MEDAILLE D'OR PARIS 1875 (and design) for "beers" in Registration No. 1731454;
8. HEINEKEN (and design) for "beer" in Registration No. 2019060;
9. HEINEKEN EN VIVO for "beer" in Registration No. 2285509; and
10. HEINEKEN (and design) for "beer" in Registration No. 2781138.

We focus our likelihood of confusion analysis on the fourth-identified registered mark vis-à-vis applicant's mark inasmuch it is the only registered mark that is simply HEINEKEN, i.e., without additional wording or design elements, and is, therefore, the closest mark to applicant's, and it covers the same goods, beer, as the other registrations, in addition to "malt beverages."

We begin with the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra.* We find that

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applicant's HEINEKEN mark is identical in every respect to the cited registered HEINEKEN mark. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Next, we turn to the second *du Pont* factor that requires us to determine the similarity or dissimilarity of the goods as recited in the application and in the cited registrations. It is settled that it is not necessary that the goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). Rather, it is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910

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(TTAB 1978). Moreover, in cases such as this where the applicant's mark is identical to the cited registered mark, there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Before considering the relatedness of the goods, we find our analysis is inhibited by the lack of any clear definition of applicant's goods, i.e., "meat juices." We do take notice that "meat juices" in International Class 29 is listed in the USPTO's "Acceptable Identification of Goods and Services Manual." However, neither applicant nor the examining attorney actually clarifies the exact nature and purpose of these goods.<sup>6</sup> Applicant is presumably in a better position to describe the identified goods and does shed some light by stating that its goods "form a constituent or ingredient typically used in cooking recipes." Brief, p. 10. Nevertheless, it is the examining attorney who ultimately bears the burden of establishing at least a "viable relationship" between applicant's "meat

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<sup>6</sup> Because the Board was not familiar with the term "meat juices," we consulted several dictionaries and internet sources, *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990), but we were unable to find any definition of the term.

juices" and registrant's beer and malt beverages. To this end, it would have behooved her to at least explain what she believes meat juices to be. As a result, it remains unclear to us if "meat juice" is akin to au jus or if it could encompass chicken or beef broth, or something else entirely.

In her brief, the examining attorney dedicated one paragraph of argument as to how applicant's "meat juices" are related to the registrant's "beer." The paragraph also appears to cover why she believes the trade channels for the respective goods are similar. It is as follows:

The evidence of third party registrations in the record, provided by the examining attorney, shows that a single owner provides meats, meat extracts and beer. Additional evidence revealed that restaurants, such as microbreweries of beer and lager also provide meat dishes that may be prepared with beer. For example, the attached third[-]party registration for HOPS GRILL & BAR MICROBREWERY shows that this registrant is a brewery providing restaurant services which likely feature meat dishes. Two other third[-]party registrations for the SEA DOG BREWING CO. and the BLUEGRASS BREWING COMPANY each show that these breweries also provide restaurant services that likely feature meat dishes. Finally, there is internet evidence from a Google search and Lexis-Nexis articles showing that beer is used as a marinade to tenderize and season meats.

Brief, unnumbered pp. 12-13.

As to the examining attorney's contention that the evidence shows that beer and meat or meat extracts may emanate from the same source, this is not supported by the evidence of record. Although the examining attorney submitted eleven third-party registrations for marks

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covering beer and meat products (usually in addition to a long line of other goods), all of these registrations are owned by foreign entities, based on Section 44(e) (ownership of a foreign registration) and do not have use in commerce dates. As we have held many times before, these registrations therefore are not indicative of a common source in the United States of the goods identified therein and have no probative value. See, e.g., *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470, n. 6 (TTAB 1988) (third-party registrations which are based upon foreign registrations "are not even necessarily evidence of a serious intent to use the marks shown therein in the United States on all of the listed goods and services, and they have very little, if any, persuasive value on the point for which they were offered.").

The examining attorney's other arguments that applicant's "meat juices" and registrant's "beer" are otherwise related are not persuasive. That a restaurant (or microbrewery) serves beer and meat dishes (including meat dishes prepared with beer), is wholly irrelevant to establishing that beer is somehow related to "meat juices." There is simply no evidence to suggest that "meat juices" (again, we are uncertain as to what that term encompasses) are also sold to customers at these restaurants. The examining attorney also fails to establish a link between

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"meat juices" and beer based on the scant evidence indicating that beer may be used in marinades or cooking meat dishes. At best, the evidence establishes a connection between beer and meat, albeit a tenuous one. She also attached a Google search engine "hit list" reflecting "10,700" results for a search of the terms "meat sauces" and "beer" combined, of which she only submitted four extended excerpts. One of these suggests "Top 10 household uses for drinks" -- proposing "beer and wine as marinades for meat" in addition to using beer as "an enricher for garden soil." Even if we were to accept that beer has a multitude of uses, other than as a beverage, we can not conclude that beer and "meat juices" are related based on this evidence. Simply put, this evidence falls far short of establishing a connection between the goods.

Accordingly, the second *du Pont* factor weighs against a finding of likelihood of confusion.

Finally, applicant's argument regarding the fifth *du Pont* factor, namely, that the term HEINEKEN should be accorded less protection because it is a surname and "inherently weak", is not well taken. Brief, pp. 5-6. In support of this contention, applicant submitted printouts from two websites, "WhitePages.com" and "411.com", both indicating 70 persons in the United States with the surname



"Heineken."<sup>7</sup> On this record, we conclude that "Heineken" is, at worst, a rare surname.<sup>8</sup> However, the mere fact that the prior registered mark may be a rare surname is not enough reason to accord it any less protection against the identical mark.

To the extent that the examining attorney argues the contrary, i.e., that the registered HEINEKEN trademark is famous, we acknowledge that while it is not usually a factor in *ex parte* proceedings famous marks may enjoy a wide scope of protection. *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). However, for the reasons stated above, we can not conclude on this record that HEINEKEN is famous mark.

Accordingly, we find the fifth *du Pont* factor regarding the fame or strength of the registered marks to be neutral in our likelihood of confusion analysis.

Upon balancing all of the *du Pont* factors for which there is evidence of record, we conclude that the examining attorney has not demonstrated that there is a likelihood of confusion. Despite the marks being identical in one case, we have no evidence on which to base a conclusion that

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<sup>7</sup> Attached, respectively, to applicant's responses filed July 14, 2005 and March 1, 2006.

<sup>8</sup> In reaching this conclusion, we rely on the fact that only 70 examples of the "Heineken" surname were located from a directory purportedly of the entire United States. See *In re Sava Research Corp.*, *supra*; *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987).

purchasers are likely to assume or expect that beer (and malt beverages) and "meat juices" originate from a single source. The examining attorney's suggestion that these same products may be used in cooking or preparing meat dishes is tenuous at best. Without any viable relationship between "beer" and "meat juices" having been established, the dissimilarity of the goods under the second *du Pont* factor is dispositive, outweighing all of the scant evidence of record pertaining to the other *du Pont* factors in our likelihood of confusion analysis. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

So as to be clear here, the examining attorney had the burden of proof in showing that Section 2(a) and/or Section 2(d) barred registration. *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985). The evidentiary record controls the result herein, and the examining attorney's evidence, as indicated above, falls far short in meeting this burden.

**Decision:** The refusals to register under Trademark Act §§ 2(a) and 2(d) are reversed.