

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

Mailed: November 19, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Augustiner-Brau Wagner KG

Serial No. 79045906

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for Augustiner-Brau Wagner KG.

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Before Bucher, Kuhlke and Wellington, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On January 26, 2007, Augustiner-Brau Wagner KG applied
to register the mark **AUGUSTINER** on the Principal Register
based on a request for extension of protection under
Section 66(a) of the Trademark Act, 15 U.S.C. §1141(f), for
goods identified as "beer, namely, strong beer, low-alcohol
beer, beer wort and colorant beer, non-alcoholic beers,
non-alcoholic beverages, namely, non-alcoholic beers, malt
wort" in International Class 32. The application includes
the statement that the "foreign wording in the mark

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translates into English as Augustinian" and a claim of ownership of Registration No. 3492930.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified goods, so resembles the registered mark AUGUSTINER in typed form for "beer" in International Class 32, as to be likely to cause confusion, mistake or deception.¹

Applicant has appealed the final refusal and the appeal is fully briefed. We affirm the refusal to register.

When there is a question of likelihood of confusion, 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., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

¹ Registration No. 2478537, issued August 14, 2001, Section 8 and 15 affidavits accepted and acknowledged. The registration includes the statement that "the English translation of Augustiner is Augustinian."

In this case, applicant's goods include goods that are encompassed by or closely related to registrant's beer.

Furthermore, at least as to the legally identical goods, we must presume that the purchasers and channels of trade for such goods would overlap. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' foods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"). Finally, applicant has not presented evidence

to support any argument that the goods, as identified, are not related.

In view of the above, the du Pont factors of the relatedness of the goods, the channels of trade, and class of customers weigh in favor of a likelihood of confusion.

In determining the similarity between the marks we analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) quoting *du Pont*, 177 USPQ at 567. In addition, where as in the present case, applicant's identification includes goods legally identical to registrant's beer, the degree of similarity between the marks which is necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant asserts that the mark in the application AUGUSTINER "does not resemble the mark" AUGUSTINER in the cited registration. Reply Br. p. 3. Not surprisingly, applicant offers no explanation as to the points of dissimilarity. Indeed this would be a difficult task as the marks are essentially identical other than the almost indistinguishable block style font in applicant's mark.

Moreover, because registrant's mark is in typed form we must consider all reasonable displays for purposes of comparison, including applicant's block style lettering. In re RSI Systems, LLC, 88 USPQ2d 1445 (TTAB 2008). We find the marks essentially identical in appearance and identical in sound, connotation and commercial impression. This factor also weighs in favor of a likelihood of confusion.

Applicant's argument on the factor of the strength of the marks is not persuasive. First, the reference in applicant's reply brief to a "search of the USPTO database" does not make such search of record and in any event the record is closed and the attempt to include and rely on new evidence is untimely. Trademark Rule 2.142(d); see also TBMP §1207 (2d ed. rev. 2004) and authorities cited therein. Second, registrations are not evidence of use in the marketplace and are not useful for purposes of analyzing this factor. Third, applicant searched the word AUGUST which has a very different connotation from the word AUGUSTINER, thus, the search would have no probative value.

In addition, applicant's arguments regarding its prior registration do not persuade us of a different result. The mark in applicant's prior registration is shown below.



The wording in the mark is J. W. AUGUSTINERBRÄU MÜNCHEN.

The registration includes the translation statement that "the foreign wording in the mark translates into English as Augustiner Brewery Munich."

As noted by the examining attorney, the Board is not bound by decisions made in other applications. See *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). See also *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Each case must be decided on its own facts. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). This is simply a recognition that the Board is not privy to information resulting in allowance of prior registrations and/or that possible prior mistakes by the Office are not a proper basis upon which to register a confusingly similar mark. Moreover, the mark in the registration contains several other elements distinct from the marks in the application and the cited registration.

Applicant relies heavily on its argument that the applicant and registrant's goods have coexisted for ten years without any known actual confusion.

We first note that the inquiry here is likelihood of confusion, not actual confusion. *HRL Associates Inc. v. Weiss Associates Inc.*, 12 USPQ2d 1819, 1824 (TTAB 1989) *aff'd*, 14 USPQ2d 1840 (Fed. Cir. 1990). Also, the Court of Appeals for the Federal Circuit has observed, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context." *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Thus, regardless of the evidence, an *ex parte* proceeding is ill equipped for a fair determination inasmuch as the registrant does not have an opportunity to defend its registration. Moreover, while applicant points to the statement in its responses that its mark has been used in the United States since the 1930s, and to the first use statements in the cited registration, this is not sufficient evidence upon which we could determine whether or not the products actually overlapped

in the marketplace such that there have been meaningful opportunities for confusion to occur.

In its reply brief, applicant requests in the alternative that "[i]f the Board disagrees that the above statements by ABW during prosecution and appeal are not sufficient as evidence, then ABW respectfully request that the Board remand the application back to the Examining Attorney and that ABW be given sufficient opportunity to submit such evidence. Given the opportunity, ABW would easily be able to evidence through various documents its longstanding use of the AUGUSTNER mark on beer abroad and, particularly in the U.S." Reply Br. p.5.

The Board does not consider such alternative requests for remand. The proper procedure is to file a separately captioned request for remand and suspension of the appeal, not to bury an alternative request in the reply brief. Moreover, a request must include a showing of good cause. "Generally, the later in the appeal proceeding that the request for remand is filed, the stronger the reason that must be given for good cause to be found." TBMP §1207.02. Here, where applicant did not request remand until the filing of the reply brief, virtually the last stage of the appeal process, the reason for remand would have had to be strong indeed. However, applicant has not provided any

reason whatsoever to explain its delay in attempting to submit such evidence. In addition, even if granted, the record still would not reflect the extent of registrant's use in the marketplace and, thus, the question of actual overlap would remain. As such, the request is futile. In view thereof, the request for remand is denied.

Finally, applicant argues that its "goods are from the oldest and arguably the most prestigious brewery in Munich, Germany [and applicant] has marketed these goods in the U.S. since the 1930s...Purchasers of specialty German beer are likely very knowledgeable about this niche area of beer tasting, and will be able to distinguish one brand from another."² Reply Br. p. 6.

While some purchasers of specialty beers may be more discriminating, we must consider all potential purchasers which would include general consumers not well-versed in beer varieties. Moreover, even the more discriminating purchasers may be confused. As stated by our primary reviewing court, "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks

² Applicant's relentless reference to and reliance on prior and longstanding use in the United States is misplaced. Such evidence is only relevant in the context of an inter partes case.

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for similar goods. 'Human memories even of discriminating purchasers ... are not infallible.'" In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) quoting Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Further, there is no evidence to support the proposition that all purchasers of applicant's beer would be "looking for a prestigious beer." We must make our determination based on the least sophisticated potential consumer. Finally, applicant's identification of goods is not limited to premium beer. Therefore, this factor weighs in favor of a likelihood of confusion.

Applicant's reliance on G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635 (Fed. Cir. 1990) and Harry Fischer Corp. v. Keneth Knits, Inc., 207 USPQ 1019 (TTAB 1980) is misplaced. Notably, these were inter partes cases where both parties could develop the record on the nature and extent of their respective uses and the existence or nonexistence of opportunities for confusion to occur.

In conclusion, we find that because the marks are nearly identical, the goods are legally identical, the channels of trade and purchasers overlap, and the goods, as identified, are subject to impulse purchase by some

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potential purchasers, confusion is likely between applicant's mark and the mark in the cited registration.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.