

**This Opinion is Not a
Precedent of the TTAB**

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United States Patent and Trademark Office
Trademark Trial and Appeal Board

In re Whatley

Serial No. 85299521

Mona J. Geidl of Minnick-Hayner, representing Barbara Whatley.

Ingrid C. Eulin, Trademark Examining Attorney, Law Office 111
(Robert L. Lorenzo, Managing Attorney).

Before Bucher, Cataldo and Wolfson, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Barbara Whatley (“applicant”) seeks registration on the Principal Register of
the mark WINERY DOGS (in standard characters) for

Printed material, namely, books, hard bound books, picture books, pamphlets, brochures, newsletters, journals, magazines, and booklets featuring dogs found on wineries; note pads; note books; postcards; stationery; blank cards; posters; portraits; greeting cards; calendars; desk calendars; day planners for a year and multiple years; photograph albums; books for holding photographs in the nature of photo albums; photographs; photographic prints, photographic prints that are reproductions; art prints; mounted photographs; framed photographs; framed art pictures; framed postcards; framed posters; coasters in card form made of paper, coasters of cardboard, coasters of paper, bookends, book markers

in International Class 16.¹

The Trademark Examining Attorney has refused registration of applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), contending that applicant's use of its mark for its identified goods is likely to cause confusion with the mark WINE DOGS (in standard character format) for

Printed material, namely, pamphlets, brochures, newsletters, journals, magazines, booklets, note pads, note books, postcards, stationery, blank cards, posters, portraits, books, photo books, picture books, hard bound books, greeting cards, calendars, desk calendars, year planners, photograph albums, books for holding photographs, address books, photographs, photographic prints, photographic reproductions, art prints, mounted photographs, framed photographs, framed pictures, framed postcards, framed posters, framed prints, diaries, desk diaries, coasters in card form made of paper, coasters of cardboard, coasters of paper, bookends, bookmarkers, all featuring dogs that live on wineries; mounts for pictures that are made from paper; push pins; calendar holders made of paper; calendar pad bases made of paper; materials for book binding made of paper

in International Class 16.²

When the refusal was made final, applicant appealed and filed a request for reconsideration. After the examining attorney denied the request, the appeal was resumed. We affirm the refusal to register.³

¹ Application Serial No. 85299521 was filed on April 20, 2011, based on an allegation of first use and first use in commerce of January 1, 2007. On February 25, 2013, applicant amended the application to seek registration under Section 1(b), intent-to-use.

² Reg. No. 3500870; registered September 16, 2008. The word "DOGS" has been disclaimed.

³ During prosecution, the examining attorney raised additional grounds for refusal, namely, that the mark is a phantom mark, that it is merely descriptive, and that the specimens do not conform to the mark as presented in the drawing. Applicant submitted a declaration that the mark has been in substantially continuous and exclusive use for the five years preceding the declaration; the declaration was accepted and the refusal under Section

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. 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); see also *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Turning first to the goods, among the many goods that are identified with identical wording, are applicant’s “booklets featuring dogs found on wineries” and registrant’s goods include “booklets ... all featuring dogs that live on wineries.” As a result, the goods are, in part, legally identical and otherwise include numerous other closely related printed products. Further, because the goods are in part legally identical, they are presumed to travel in the same channels of trade and be sold to the same classes of consumers. *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Although registrant is an Australian company whose products,

2(e)(1) was withdrawn. As for the refusal that the mark is a phantom mark, and the requirement for a new specimen, these were raised after the initial Office action had issued and were ultimately withdrawn before appeal. Because the refusal and requirement are no longer before us, we will not give an advisory opinion on the merits thereof; suffice it to say, however, that we cannot condone the piecemeal fashion in which they were raised.

applicant argues, “are primarily available online,” *Brief* p. 6, the registration is not restricted to online trade channels and therefore the goods must be presumed to travel through all normal channels of trade for the goods, including “book stores throughout the Pacific Northwest,” which applicant contends are her primary marketing channels. *Id.* These two *du Pont* factors favor a finding of likelihood of confusion.

We next consider the *du Pont* factor of the similarity of the marks, keeping in mind that “[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Here, of course, the goods are legally identical in part. Further, in comparing the marks, we must consider the marks in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *du Pont*); *Palm Bay*, 73 USPQ2d at 1692; and TMEP §1207.01(b)-(b)(v) (April 2013). The test, under the first *du Pont* factor, 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 that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a

specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's mark is WINERY DOGS; the cited mark is WINE DOGS. The marks differ only in that applicant's mark uses the word WINERY to modify the subject DOGS in the mark, while the cited mark uses the word WINE. However, the word "winery" is derived from the word "wine" and their meanings are interrelated. *See* Office action dated August 22, 2012, including a dictionary definition of *winery* as "an establishment at which wine is made."⁴ Applicant argues that the marks are distinguishable because the "word 'winery' brings to mind vineyards, tasting rooms and wine barrels" while "the word 'wine' connotes the alcohol beverage itself." *Brief* p. 4. To the contrary, images of vineyards, tasting rooms and wine barrels, are evocative of images of wine. Moreover, we do not consider the connotations and commercial impressions of the marks in a vacuum but in relation to the goods with which they are associated. Both marks suggest that the subject matter of a WINE(RY) DOGS book involves dogs that are symbolized by their connection to a winery. When consumers familiar with registrant's "WINE DOGS" books encounter applicant's "WINERY DOGS" book, it is likely they will believe that both books emanate from the same entity.

Applicant notes that she began using her mark in 2007 and has not encountered any instance of actual confusion. However, applicant's assertion is of little probative value because we have no evidence pertaining to the nature or extent of any such use either by applicant or by registrant and "thus cannot

⁴ At <http://education.yahoo.com/reference/dictionary/entry/winery>.

ascertain whether there has been ample opportunity for confusion to arise, if it were going to.” *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). *See also*, *In re Majestic Distilling Co.*, 65 USPQ2d at 1205 (“uncorroborated statements of no known instances of actual confusion are of little evidentiary value”). Inasmuch as the test under Trademark Act § 2(d) is whether there is a likelihood of confusion, it is unnecessary for the examining attorney to show actual confusion in establishing likelihood of confusion. Moreover, a registrant has no chance to be heard in an *ex parte* setting. Accordingly, this *du Pont* factor is considered neutral.

Applicant argues that the purchasers are likely to be careful in their selection of applicant’s goods because the cost of applicant’s book is “about \$38 due to the fact that it is a hardcover, coffee table book.” *Brief* at 5. This argument is unavailing for several reasons. First, these goods are legally identical and have not been restricted to relatively expensive items, but may be purchased by less sophisticated purchasers who will exercise only an ordinary degree of care. Secondly, registrant’s books appear to be priced at similar price points; *see* applicant’s Response to Office action dated November 28, 2011 (printout from registrant’s website). There is no evidence to suggest that this is a relatively expensive price for a coffee table book or that purchasers of such books are sophisticated or generally discerning. Moreover, even sophisticated purchasers, when faced with substantially similar marks, may be subject to source confusion. *See In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

In view of the similarity of the marks and the fact that the goods are legally identical in part and would be sold through similar channels of trade to the same purchasers, we find that applicant's registration of the mark WINERY DOGS is likely to cause confusion with registrant's mark WINE DOGS for the printed items listed in the respective identification of goods for each mark.

Decision: The refusal to register applicant's mark WINERY DOGS is affirmed.