

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

Mailed:
November 7, 2014

United States Patent and Trademark Office
Trademark Trial and Appeal Board

In re Barton

Serial No. 85554813

Mark W. Hendricksen of Wells St. John P.S. for Joseph Barton.

James W. Stein, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop,
Managing Attorney).

Before Bergsman, Wolfson and Adlin, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Joseph Barton (“Applicant”) seeks registration on the Principal Register of the mark BARTON FAMILY WINERY (in standard characters) for “wine” in International Class 33.¹

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 THOMAS BARTON (in standard character format) for “alcoholic

¹ Application Serial No. 85554813 was filed on February 28, 2012, on the basis of Applicant’s bona fide intent to use the mark in commerce.

beverages, namely, wines” in International Class 33.² An initial refusal under Section 2(e)(4) that the mark is primarily merely a surname was withdrawn after Applicant claimed the benefit of Section 2(f) with respect to BARTON FAMILY and disclaimed exclusive rights to the term “Winery” in the mark.

When the refusal was made final, Applicant appealed and filed a request for reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

Applicable Law

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. *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); *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).

² Reg. No. 3575334; registered February 17, 2009; Section 8 and 15 combined declaration accepted and acknowledged.

Comparison of the Goods; Trade Channels; Classes of Purchasers

We begin with the *du Pont* factor of the relatedness of the goods. We base our evaluation on the goods as they are identified in the registration and application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

There is no dispute that the identified goods in both Applicant's application and the cited registration are identical: "wine(s)." The second *du Pont* factor thus heavily favors a finding of likelihood of confusion.

There are also no limitations in the identifications of goods with respect to channels of trade or classes of customers. Accordingly, we must presume that both Applicant and Registrant offer wine for consumption to the same classes of consumers through identical distribution channels. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, 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"). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). Since the services are broadly offered to the general public, potential customers include ordinary purchasers. Moreover, Applicant admits that

the trade channels are the same: “It should be noted that alcoholic beverages (beer, wine, whiskey, rum) of all kinds are sold through the same market channels such as grocery stores and specialty shops such as Total Wines.”³ The third *du Pont* factor also favors a finding of likelihood of confusion.

Comparison of the Marks

In comparing the marks, we must consider the marks in their entireties as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *In re Viterra*, 101 USPQ2d at 1908 (quoting *du Pont*); *Palm Bay*, 73 USPQ2d at 1692. Similarity in any one of these elements may be sufficient to find the marks confusingly similar. See *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (“Similarity in sound alone may be sufficient for a finding of likelihood of confusion.”). Moreover, because the goods at issue are identical, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *In re Viterra*, 101 USPQ2d at 1908 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)). See also *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

Because both Applicant’s mark and the cited mark share the designation BARTON, the marks are similar in appearance and pronunciation. When Applicant’s mark BARTON FAMILY WINERY is compared with the cited mark, THOMAS BARTON, it is readily apparent that in both marks, the term BARTON

³ Request for reconsideration, 4 TTABVUE 1.

will be perceived as a surname, perhaps identifying the same wine-producing family. With respect to the cited mark, “Thomas” is a common first name, and together with BARTON forms the usual convention in the United States for a combined given and family name. In Applicant’s mark, BARTON FAMILY will be seen as a reference to a family group whose common surname is BARTON. Therefore, consumers familiar with Registrant’s wines are likely to believe that Registrant is now producing a line of wines bearing only its surname, and that Registrant is designating its own “Barton family” as the maker of the wines produced under the mark BARTON FAMILY WINERY. The fact that the cited mark also includes the name THOMAS does not sufficiently distinguish it from Applicant’s mark. As stated in *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1446-7 (TTAB 2014):

Applicant has added the given name BRUCE, but the addition of a given name to a recognizable surname has limited distinctive capability. A surname preceded by a given name is a common, highly conventional combination of word elements, and the mark BRUCE WINSTON could well be interpreted as a more specific reference to a person or company that is otherwise identified by the designation WINSTON. (internal citations omitted).

Of further note is the fact that Applicant’s mark is dominated by the term BARTON, as it is the first word of the mark. *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”). See also *Palm Bay*, 73 USPQ2d at 1692; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Moreover, even

though Applicant has shown acquired distinctiveness in the phrase BARTON FAMILY, it does not stand apart from the word “winery” in the mark. Prospective purchasers will perceive Applicant’s mark as identifying wine that has been distilled in a family winery. The Examining Attorney’s evidence shows that it is not uncommon for wineries to be run as a family businesses, and that they use the term “family winery” to describe their operations.⁴ Prospective purchasers of Applicant’s wine will understand the mark BARTON FAMILY WINERY as identifying wines distilled by the Barton family in a family winery. Accordingly, as the first and most distinctive term, it is not improper to give more weight to the name BARTON in Applicant’s mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature when evaluating the similarities of the marks.)

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 commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Here, the mark BARTON FAMILY WINERY could well be interpreted as a broad reference to wines

⁴ See, e.g., website advertisements for family businesses running a winery under the names Frank Family Vineyards, Hope Family Wines, Hartford Family Winery, and Mayo Family Winery, attached to the denial of Applicant’s request for reconsideration.

emanating from THOMAS BARTON as part of the Registrant's Barton family wine business.

Although Applicant has submitted copies of six third-party registrations for marks containing the surname BARTON, they do not persuade us of a different result. In general, absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). In this regard, only two marks submitted by Applicant have been registered under Section 1(a) with a claim of use, namely, Reg. No. 0683398 (BARTON for whiskey) and Reg. No. 2,895,058 (BARTON'S QT for "whisky and distilled spirits, excluding wines and wine-based beverages"). These two registrations are owned by the same entity. The remaining registrations are based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a), for which no claim of use is required prior to registration. These registrations have no probative value. While we have considered Applicant's entire submission, the prior registrations do not evince a crowded field or that Registrant's mark is weak.

The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Conclusion

In view of the fact that the goods are identical; that they are presumed to move in the same trade channels and be sold to the same purchasers; and that the

Serial No. 85554813

marks are similar in terms of their sight, sound, connotation and overall commercial impressions, we find that Applicant's use of the mark BARTON FAMILY WINERY for "wine" is likely to cause confusion with the registered mark THOMAS BARTON for "alcoholic beverages, namely, wines."

Decision: The refusal to register Applicant's mark BARTON FAMILY WINERY is affirmed.