

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

Mailed: August 23, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Steele Wines, Inc.

Serial No. 85683619

Evan Anderson of Brand Ventures Intellectual Property Law
for Steele Wines, Inc.

Fred Carl III, Trademark Examining Attorney, Law Office 108
(Andrew Lawrence, Managing Attorney).

Before Cataldo, Wellington and Adlin,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Steele Wines, Inc. filed, on July 22, 2012,
an application asserting use in commerce since May 30,
2012, under Section 1(a) of the Trademark Act, 15 U.S.C.
1051(a), to register the mark displayed below for "wines"
in International Class 33.



2009 LAKE COUNTRY RED WINE is disclaimed apart from the mark as shown. In response to the examining attorney's requirement, applicant submitted the following revised description of the mark:

The mark consists of the wording A SCARLET 2009 LAKE COUNTY RED WINE. The letter A, the word SCARLET and the top of the wine bottle appear in red. The wording LAKE COUNTY RED WINE appears in white. The remaining elements are in brown and white and comprise an image of a woman in puritan costume carrying a bottle of wine wrapped in cloth. The background elements are out of focus.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark THE SCARLET LETTER for "wine" in International Class 33 as to be likely to cause confusion.¹

¹ Registration No. 4106359 issued February 28, 2012.

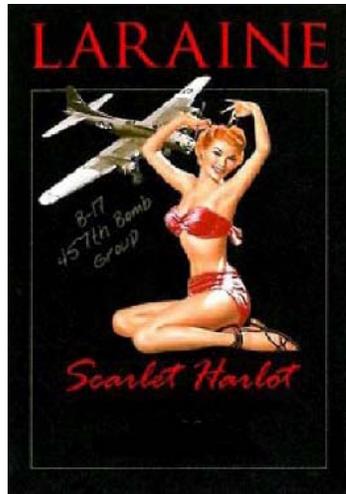
In addition, the examining attorney refused registration to applicant under Trademark Act §§ 1 and 45 in the absence of an acceptable specimen of use that displays the applied-for mark.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs.

Refusal to Register Under Section 2(d)

Applicant argues that the mark in the cited registration is weak and thus entitled to a narrow scope of protection. Applicant further argues that, as a result, the differences between its mark and the mark in the cited registration are sufficient to distinguish them. In support of its contention, applicant made of record copies of the following third-party registrations:

Registration No. 4063036 for the mark SCARLET HARLOT and Registration No. 4107973 for the mark displayed below, both issued to the same entity for "wine;"



Registration No. 3218299 for the mark SCARLET RIDGE for "wines, sparkling wines, fortified wines, liqueurs;" and

Registration No. 2005383 for the mark SCARLATTA (translation into English as "Scarlet") for "alcoholic beverages, namely, wine."

The examining attorney maintains that the goods, channels of trade and consumers are identical. The examining attorney further argues that the marks are similar inasmuch registrant's mark is the name of the classic American novel The Scarlet Letter by Nathaniel Hawthorne, which is about an accused puritan adulteress who must wear a scarlet-colored "A" on her clothing, and applicant's mark, which includes the word SCARLET, and two puritan figures including a woman with a scarlet-colored letter "A" on her clothing, connotes the same novel. In

support of the refusal, the examining attorney submitted the following Internet materials:

An article from Wikipedia.org discussing the novel The Scarlet Letter, indicating that "The story starts during the summer of 1642, near Boston Massachusetts, in a Puritan village," with a young woman named Hester Prynne being led from the town prison with an infant in her arms and a scarlet colored letter "A" on the breast of her gown to symbolize the act of adultery she has committed;

A screenshot from goodreads.com listing The Scarlet Letter as the sixth most popular book among high school readers in the United States;

A screenshot from northport.k12.ny.us listing The Scarlet Letter among the 43 most frequently taught books in Grades 7-12;

A screenshot from nylusmilk.wordpress.com listing The Scarlet Letter as the sixth most taught book in US high schools; and

An article from today.msn.com listing The Scarlet Letter among the ten books "you should have read in high school."

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 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 first turn to consider the *du Pont* factor regarding the similarity between the goods. To state the obvious, applicant's goods, identified as "wines" are identical to the "wine" identified in the cited registration. Further, because as identified the goods are identical, they must be presumed to travel in the same channels of trade and be sold to the same classes of consumers. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001 (Fed. Cir. 2002); and *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). The identity between the goods, trade channels and classes of purchasers are factors

that weigh heavily in favor of a finding of likelihood of confusion.

We next turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. 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 Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). Moreover, in comparing the marks, we are mindful that where, as here, the goods are legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85

USPQ2d 1104, 1108 (TTAB 2007); and *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

In this case, the marks at issue are similar to the extent that both contain the term SCARLET as a prominent feature thereof. More significantly, registrant's mark, in its entirety, consists of the wording THE SCARLET LETTER. Evidence made of record by the examining attorney supports a finding that the primary significance of THE SCARLET LETTER is the title of a classic American novel The Scarlet Letter, which is widely read, if not widely loved, by junior high and high school students throughout the country. Applicant's mark consists of the prominent word SCARLET and the image of a woman dressed in puritan garb with a large, scarlet colored letter "A" affixed to the bodice of her dress, and carrying a swaddled wine bottle in place of a child. Applicant's mark additionally includes the image of a second figure dressed in puritan garb behind and to the left of the first. The imagery, use of the color red, letter "A" and word SCARLET in applicant's mark combine to unmistakably evoke the novel The Scarlet Letter. Indeed, the evidence does not reveal any possible connotation of applicant's mark other than the same novel for which the goods offered under the cited mark are named.

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The additional, disclaimed wording 2009 LAKE COUNTRY RED WINE in applicant's mark clearly is merely descriptive, if not generic, as applied to applicant's wines and contributes little to the overall connotation of applicant's mark.

As a result, in addition to the marks being similar in appearance and sound solely to the extent that both contain the word "SCARLET," the marks' similarity is further enhanced inasmuch as registrant's mark is THE SCARLET LETTER and applicant's mark connotes the well-known novel of the same name. Accordingly, we find that the marks are highly similar in connotation and, as a whole, convey highly similar commercial impressions. Similarity in any one of the elements of sound, appearance, meaning, or commercial impression is sufficient to support a determination of likelihood of confusion. *See, e.g., Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion"); and *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) ("In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone 'may be sufficient to support a holding that the marks are confusingly similar'" (citations omitted)). In this case,

we find that the similarities in connotation and commercial impression would lead consumers to mistakenly believe that the identical goods identified thereby emanate from a common source.

The existence of the four third-party registrations owned by three entities does not compel a different result. The mark SCARLET HARLOT in standard characters connotes a provocative woman dressed in red. The composite mark owned by the same entity, including the image of a woman clad in a red bikini, does not evoke 17th century Hester Prynne so much as a 1940s pinup; an image reinforced by the B-17 bomber and wording "B-17 457TH BOMB GROUP" in the mark. The mark SCARLET RIDGE connotes a geographic location and the mark SCARLATA connotes a woman's name. Thus, the marks in all of the third-party registrations differ in connotation, appearance and sound from both applicant's mark and that of registrant. Further, it is settled that third-party registrations are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982).

Finally, to the extent that any of applicant's arguments raise a doubt about likelihood of confusion, we must resolve that doubt in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Specimen Requirement

Applicant submitted the specimen reproduced below with its application. The specimen is a photograph of the mark on a label affixed to a bottle of wine.



The examining attorney rejected this specimen on the ground that it fails to display the entire applied-for mark. In response, applicant submitted as a substitute specimen a photograph that is essentially identical to the original specimen, displaying the mark as above.²

The question is whether the mark sought to be registered, reproduced below:



is a substantially exact representation of the mark as it appears on the specimens of use, reproduced below, that were submitted in connection with the recited goods.

² The original and substitute specimens differ only to the extent that the substitute specimen displays slightly less of the photograph's background. The mark as displayed on the wine bottle in both photographs is identical.



The drawing of a mark in an application filed under Section 1(a) of the Trademark Act such as the one under consideration herein is governed by Trademark Rule 2.51(a), which provides as follows:

In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

See Trademark Rule 2.51(a). As noted above, applicant describes the applied-for mark as follows:

The mark consists of the wording A SCARLET 2009 LAKE COUNTY RED WINE. The letter A, the word SCARLET and the top of the wine bottle appear in red. The wording LAKE COUNTY RED WINE appears in white. The remaining elements are in brown and white and comprise an image of a woman in puritan costume carrying a bottle of wine wrapped in cloth. The background elements are out of focus.

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The original and substitute specimens filed by applicant display a portion of the word "SCARLET" with only part of the letter "S" visible and none of the letter "T" visible. Furthermore, the specimens fail to display the design of the second puritan figure appearing on the left side of the mark in the drawing. Simply put, the mark as it appears in the specimens displays the majority, but not the entirety, of the word "SCARLET" and only the right hand of the puritan figure in the left background of the drawing. This contrasts with the mark in the drawing which displays the entirety of the word "SCARLET" and the majority of the additional puritan figure. Thus, it is readily apparent that the mark in applicant's specimens displays only a portion of the mark as shown in the drawing.

This is not a situation in which there exists some minor, inconsequential variation between the mark as it appears on the drawing page and in the trademark specimen. *See In re Hacot-Columbier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997). Rather, the display of only a portion of the word "SCARLET" and absence of the second puritan figure from the mark as shown in the drawing on the specimens is a major, significant difference. As a result, we agree with the examining attorney that the mark shown on applicant's drawing is not a substantially exact

representation of the mark as used on the specimens.³

Summary

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

The refusal to register on the ground that the mark in applicant's drawing does not match the mark as displayed on the specimens submitted with applicant's application is affirmed.

³ We observe that the difficulty in submitting an acceptable photograph of the mark on the goods may result from the curvature of the wine bottle to which the label bearing the mark is affixed. Nonetheless, as discussed above, the specimens of record fail to display the entirety of the applied-for mark.