

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 Thomas Barton

Serial No. 85826787

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

Michael Webster, Trademark Examining Attorney, Law Office 102,
Mitchell Front, 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 (in standard characters) for “wine; wines” 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 his mark for the identified goods is likely to cause confusion with the mark THOMAS BARTON (in standard character format) for “alcoholic

¹ Application Serial No. 85826787 was filed on January 18, 2013, on the basis of Applicant’s first use and first use of the mark in commerce at least as early as December 31, 1997.

beverages, namely, wines” in International Class 33² and with the mark BARTON & GUESTIER in typeset letters³ for “wines” in International Class 33.⁴ The two cited registrations are owned by the same entity. An initial refusal under Section 2(e)(4) that the mark is primarily merely a surname was withdrawn after Applicant claimed the benefit of Section 2(f) with respect to BARTON FAMILY.

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 resumed. We affirm the refusal to register.

The cited mark THOMAS BARTON is closer to Applicant’s mark BARTON FAMILY than is the cited mark BARTON & GUESTIER because the name “Guestier” is a more distinctive point of difference with Applicant’s mark. Thus, we confine our analysis to the issue of likelihood of confusion between Applicant’s mark and the cited registration for the mark THOMAS BARTON. That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with BARTON & GUESTIER. On the other hand, if there is no confusion between THOMAS BARTON and BARTON FAMILY, then there would be no likelihood of confusion between BARTON FAMILY and BARTON & GUESTIER. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

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

³ Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (2014).

⁴ Reg. No. 1548560; issued July 18, 1989; renewed.

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).

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 application and cited registration. *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.

Because the goods in the application and the cited registration are identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *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). 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."⁵ The third *du Pont* factor also strongly 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

⁵ Request for reconsideration, 4 TTABVue 1.

(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).

In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘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). See also *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 mem.*, 972 F.2d 1353 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Since the goods are broadly offered to the general public, the average customer is an ordinary consumer.

We now turn to an analysis of the similarity or dissimilarity between the cited mark THOMAS BARTON and Applicant's mark BARTON FAMILY. Because both marks share the designation BARTON, the marks are similar in appearance and pronunciation. It is readily apparent that in both marks, the term BARTON will be perceived as a surname, 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 designating its own "Barton family" as the maker of such wines. The fact that the cited mark also includes the name THOMAS "could well be interpreted as a more specific reference to a person or company" that is otherwise identified by the designation BARTON FAMILY. *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1446-7 (TTAB 2014) (finding the marks BRUCE WINSTON and WINSTON confusingly similar).

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). Prospective purchasers of Applicant's wine will understand the mark BARTON FAMILY as identifying wines produced by a family business whose common surname is Barton. The cited mark THOMAS BARTON also emphasizes the "Barton" portion. *See, e.g., In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1219 (TTAB 2008) ("The first name 'Sam' in applicant's mark modifies the surname 'Edelman,' in effect, telling which Edelman it is, and therefore emphasizes the 'Edelman' portion. Because the marks share the surname 'Edelman,' which is the only element in the registered mark and is a clearly recognizable and prominent element in applicant's mark, we find that there are strong similarities between the marks in terms of appearance, sound, meaning and commercial impression."). Accordingly, as the first and most distinctive term, it is not improper to give more weight to 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 first *du Pont* factor favors a finding of likelihood of confusion with respect to Registrant's mark THOMAS BARTON.

Third-party Registrations

Applicant has submitted copies of six third-party registrations for marks containing the surname BARTON in an attempt to show that Registrant's mark exists in a crowded field and should be afforded a limited scope of protection. The registrations, however, 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. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). Moreover, 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 and do not cover wine. 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.

Applicant argues in its reply brief that it "need not submit proof of actual use in the marketplace of all the third-party registrations"⁶ because of the legal presumption that Applicant's and the cited mark travel in the same trade channels. However, the third-party registrations that Applicant submitted herein are not offered to show the goods travel in the same trade channels.⁷ Rather, they are offered in connection with our determination as to the commercial strength of the cited marks. They are simply not probative for the reasons noted above: they do not show that the marks involved are in actual use. While we have considered

⁶ 11 TTABVue 4.

⁷ We do not intend to suggest that third-party registrations by themselves would be at all probative of an applicant's or registrant's channels of trade in any event.

Applicant's entire submission, the prior registrations do not evince a crowded field or that Registrant's marks are weak.

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 classes of ordinary purchasers; and that the 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 for "wine; wines" is likely to cause confusion with the registered mark THOMAS BARTON for "alcoholic beverages, namely, wine." Given that we have determined a likelihood of confusion exists on the basis of this cited registration, we need not decide whether Applicant's use of the mark BARTON FAMILY for "wine; wines" is likely to cause confusion with the registered mark BARTON & GUESTIER for "wines."

Decision: The refusal to register Applicant's mark BARTON FAMILY under Section 2(d) of the Trademark Act is affirmed.