

<p><b>This Opinion is Not a Precedent of the TTAB</b></p>
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Sonoma Estate Vintners, LLC*

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Serial No. 85842056

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Barry Strike of Strike & Techel,  
for Sonoma Estate Vintners, LLC.

Raul Cordova, Trademark Examining Attorney, Law Office 114,  
K. Margaret Le, Managing Attorney.

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Before Quinn, Bergsman and Gorowitz,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Sonoma Estate Vintners, LLC (“Applicant”) seeks registration on the Principal  
Register of the mark BLACKHAWK (in standard characters) for

Wine in International Class 33.<sup>1</sup>

The Trademark Examining Attorney has refused registration of Applicant’s  
mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the  
ground that Applicant’s mark so resembles the registered mark BLACK HAWK

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<sup>1</sup> Application Serial No. 85842056 was filed on February 5, 2013, based upon Applicant’s  
claim of first use anywhere and use in commerce since at least as early as February 22,  
2006.

STOUT, (in standard characters), for “malt beverages, namely, beer, ales, and stout,” in Class 32, as to be likely to cause confusion.<sup>2</sup> Registrant disclaimed the exclusive right to use the term “Stout.”

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

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”). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

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<sup>2</sup> Registration No. 3205652, issued February 6, 2007; Section 8 and 15 affidavits accepted and acknowledged.

- A. The similarity or dissimilarity of the marks in their entireties in terms of appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* likelihood of confusion 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 a particular case, “[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.’” *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (citations omitted). *See also In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). 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). In this appeal, the average customer is an ordinary consumer of wine, beer, ale and stout.

Applicant is seeking to register the mark BLACKHAWK and the mark in the cited registration is BLACK HAWK STOUT. The name “Black Hawk” is the dominant element of Registrant’s mark because the term “Stout” is a generic term for a type of malt beverage and Registrant has disclaimed the exclusive right to use it. Although we must compare the marks in their entirety, it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). With respect to descriptive or generic matter constituting part of a mark, it is well-settled that descriptive or generic matter has less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting*, *In re National Data Corp.*, 224 USPQ at 752 (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion”); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001).

The term “Blackhawk” in Registrant’s mark consists of two ordinary words, namely, “Black” and “Hawk” which have been combined to form the single term BLACKHAWK. The presence or absence of a space in the terms BLACKHAWK and BLACK HAWK STOUT is of little significance in our comparison of the marks. *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff’d*,

737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical”); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”).

In view of the foregoing, we find that the marks are very similar in terms of appearance, sound, connotation and commercial impression.

B. The similarity or dissimilarity and nature of the goods.

Having found that Applicant’s mark is very similar to Registrant’s mark, we turn to the similarity or dissimilarity and nature of Registrant’s beer, ale, and stout and Applicant’s wine. As the Board has stated many times, it is not necessary that the goods of Applicant and Registrant be similar or competitive to find that they are related for purposes of demonstrating a likelihood of confusion. That is, the issue is not whether consumers would confuse the goods or services themselves, but rather whether they would be confused as to the source of the goods or services. It is sufficient that the respective goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d at 1722; *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The Examining Attorney asserts that Applicant's "wine" is related to the "beer" identified in the cited registration, and has submitted, in support of that position, 15 use-based third-party registrations showing that various entities have registered a single mark for both goods. *See, for example*, Reg. No. 3456841 for the mark DEFENDERS OF FREEDOM CHOICE, Reg. No. 3632408 for the mark VILLA D'AQUINO, and Reg. No. 352239 for the mark WORK TRUCK.<sup>3</sup> Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785–86 (TTAB 1993).

In its October 8, 2013 response to an Office Action, Applicant asserts that of the 15 third-party registrations submitted by the Examining Attorney, only three of the registrants have sold both beer and wine using the registered mark.

The Alcohol and Tobacco Tax and Trade Bureau's ("TTB") regulations require that all wine and beer have a Certificate of Label Approval ("COLA") before the product may leave the plant where it is bottled or packed. *See* 27 C.F.R. §§ 4.50, 7.41. A search of all 15 marks in the COLA search database (<https://ttbonline.gov/colaonline/public/SearchColas.do>) reveals that only MOTOR CITY BREWING WORKS DETROIT, SCHILLINGBRIDGE, and D'SPAGNIA, were issued COLAs for both beer and wine in the past five years. *See* attached COLAs. In ten cases, no COLAs were issued under the trademark for either beer or wine, indicating that the marks are not in use in U.S. commerce at all; and in two cases, a COLA was issued for beer, but not for wine. Accordingly, the Examiner's conclusion that the registrations relied upon show that beer and wine may come from a common source

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<sup>3</sup> April 8, 2013 Office Action.

is not supported by the Examiner's own evidence, because in only three of the 15 examples cited is it even possible that both beer and wine were legally sold by the registrant under the same name.<sup>4</sup>

Applicant's evidence does not completely rebut the probative value of the third-party registrations submitted by the Examining Attorney. Applicant found evidence that only three of the 15 registrants filed COLA applications. Applicant did not submit, however, any evidence regarding whether any of the registrants were using the marks in the registrations. The certificates of registration are prima facie evidence of the validity of the registered marks, the registrants' ownership of the marks, and of the owners' exclusive right to use the marks in commerce. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). It is possible that the registrants are using the marks for beer and wine and there is some reason or explanation that Applicant did not find their COLA applications.

Taking Applicant's argument a step further, Applicant could also argue that because 13 registrants did not file COLA applications, any use of their marks in connection with beer and/or wine is unlawful. Determining whether the use of a mark is lawful under one or more of the myriad of regulatory acts involves two questions: (1) whether a court or government agency having competent jurisdiction

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<sup>4</sup> 27 CFR § 4.50 reads as follows: "(a) No person shall bottle or pack wine, other than wine bottled or packed in U.S. Customs custody, or remove such wine from the plant where bottled or packed, unless an approved certificate of label approval, TTB Form 5100.31, is issued by the appropriate TTB officer."

27 CFR § 7.41 reads as follows: "(a) Requirement: No person may bottle or pack malt beverages, or remove malt beverages from the plant where bottled or packed unless an approved certificate of label approval, TTB Form 5100.31, is issued."

under the statute involved has previously determined that party is not in compliance with the relevant statute; or (2) whether there is a *per se* violation of a statute regulating the sale of a party's goods. *General Mills Inc. v. Healthy Valley Foods*, 24 USPQ2d 1270, 1273 (TTAB 1992). *See also Automedx Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1984 (TTAB 2010). In this case, there has been no final determination of noncompliance by a court or agency regarding registrants' shipments of their beer and wine. Rather, Applicant has attempted to show that registrants' failure to file COLA applications for beer and wine constitute *per se* violations of Bureau of Alcohol, Tobacco and Firearms regulations. However, Applicant failed to show that the registrants were not using the marks to identify beer and wine. Applicant showed only that it could not find COLA applications.<sup>5</sup> Thus, it is not clear whether there has been a violation of the regulations and, in this *ex parte* setting, the registrants cannot be heard.

Further, the fact that the Examining Attorney submitted only 15 third-party registrations listing beer and wine does not mean that they are the only registrations that include these goods. There is no requirement for the Examining Attorney to submit all the evidence that supports his position and, indeed, we would be very critical if the examining attorney were to submit an inordinate number of registrations. *In re Kysela Pere et Fils Ltd.*, 98 USPQ 1261, 1265 (TTAB 2011). *Cf.*

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<sup>5</sup> There is no evidence or explanation as to whether shipping beer or wine without a COLA certificate of approval is of such a nature that it would invalidate a registration as opposed to being a collateral defect that could be rectified. *General Mills Inc. v. Healthy Valley Foods*, 24 USPQ2d at 1274, citing *Santinine Societa v. P.A.B. Produits*, 209 USPQ 958, 967 (TTAB 1981) (J. Kera, concurring).



*In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) (“The Board has frequently stated, in connection with the submission of articles retrieved by a NEXIS search, that it is not necessary that all articles be submitted” and “the same is true for materials retrieved through Internet searches”).

In his November 6, 2013 Office Action, the Trademark Examining Attorney also submitted excerpts from nine third-party websites showing the use of the same mark for beer and wine. *See, for example*, the following:

1. Dewey Cannon Winery & Brewery ([deweycannonwinery.com](http://deweycannonwinery.com))



2. Schnebly Redland's Winery & Brewery ([schneblywinery.com](http://schneblywinery.com))



3. Gold Hill Vineyard (goldhillvineyard.com).



In its October 8, 2013 response to an Office Action, Applicant submitted copies of 11 sets of the same or similar marks registered to different entities for beer and wine or other alcoholic products to rebut the inference we may draw from the Trademark Examining Attorney's third-party registrations. *See for example:*

1. Registration No. 3152948 for the mark SLEEPING DOG WINES for "table wine" and Registration No. 3233978 for the mark SLEEPING DOG STOUT for "beers and ales";

2. Registration No. 3226585 for the mark OBSIDIENNE for "wine" and Registration No. 1756209 for the mark OBSIDIAN STOUT for "beer"; and

3. Registration No. 3624142 for the mark EPICENTER for "wine" and Registration No. 4327599 for the mark EPICENTER AMBER for "beer."

The Board has previously held that such sets of third-party registrations submitted to suggest that the goods are not related, while relevant, do not necessarily prove that the goods are not related. :

It [the evidence submitted by applicant] simply consists of registrations that list one of applicant's goods but do not include any goods that are in the cited registration, or registrations that list one of the goods in the cited registration but do not include any of applicant's identified goods. We give this evidence much less weight. There is no requirement for goods to be found related that all or even a majority of the sources of one product must also be sources of the other product. Therefore, evidence showing only that the source of one product may not be the source of another product does not aid applicant in its attempt to rebut the evidence of the examining attorney. Second, the mere fact that some goods are not included in a registration's identification of goods does not establish that *the owner of the mark* has not registered the mark for those goods in another registration since, for example, the registrant may have begun using the mark on those goods at a later date.... The fact that applicant was able to find and submit for the record these registrations of marks for individual items does not rebut the examining attorney's evidence showing the existence of numerous third-party registrations using the same marks on a variety of items, including applicant's and registrant's goods. Therefore, contrary to applicant's argument (Reply Brief at 7), while this evidence provides some indication that there are many trademarks that are not registered for both products, it does not rebut the examining attorney's evidence that the goods are related.

*In re G.B.I. Tile and Stone Inc.*, 92 USPQ2d 1366, 1370 (TTAB 2009).

We find the evidence of third-party registrations and websites is sufficient to demonstrate the relatedness of “wine” and “beer.” *See In re Kysela Pere et Fils Ltd.*, 98 USPQ at 1266 (beer and wine found to be related goods); *In re Sailerbrau Franz*

*Sailer*, 23 USPQ2d 1719 (TTAB 1992) (wine and beer found related goods based on third-party registrations).

C. Established, likely-to-continue channels of trade.

Beer and wine are general consumer products sold to adult members of the general public. *See In re Kysela Pere et Fils Ltd.*, 98 USPQ at 1266–67. Moreover, the Examining Attorney submitted numerous websites for retail stores selling beer and wine.<sup>6</sup> It is also common knowledge that, in some cases, beer and wine may be purchased in supermarkets and convenience stores. This *du Pont* factor favors a finding of likelihood confusion.

D. Other facts probative of the effect of use.

A third party applied to register the mark BLACKHAWK for “bourbon; gin; scotch; vodka; whiskey; wine.”<sup>7</sup> Applicant asserts that the PTO did not cite Registrant’s mark as a bar to registration. Applicant opposed the registration of the BLACKHAWK mark because the description of goods included wine. The parties reached an agreement allowing the above-noted BLACKHAWK mark to register without wine in the description of goods.<sup>8</sup>

Applicant contends that the refusal to register Applicant’s mark is inequitable because Applicant’s application “stands in exactly the same place as Blackhawk 2<sup>9</sup> with respect to whether it is confusingly similar to the Registered Mark:

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<sup>6</sup> November 6, 2013 Office Action.

<sup>7</sup> Serial No. 85677426, filed July 15, 2012. Applicant submitted a copy of the TESS printout and the Notice of Allowance with the October 8, 2013 response to Office Action.

<sup>8</sup> Registration No. 4489134 issued December 11, 2012.

<sup>9</sup> Applicant refers to the prior, third-party BLACKHAWK application as “Blackhawk 2.”

Applicant's Marks and Blackhawk 2 are the same mark and both are used on a different type of alcoholic beverage than the Registered Mark."<sup>10</sup> In this regard, Applicant argues as follows:

Blackhawk 2 would not have been in a position to be registered were it not for the consent agreement and Applicant's subsequent agreement to dismiss its Opposition. Applicant noted that the PTO did not issue an office action citing the Registered Mark against Blackhawk 2, and therefore reasonably concluded that its BLACKHAWK mark would be treated the same. Accordingly, it is difficult to justify disparate treatment under the circumstances.<sup>11</sup>

The PTO is not barred from examining the registrability of marks despite what appears on the register. As the Board stated in *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986):

The cases are legion holding that each application for registration of a mark for particular goods or services must be separately evaluated. See, for example, *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed.Cir. 1985) [other citations omitted]. Section 20 of the Trademark Act, 15 USC Section 1070, gives the Board the authority and duty to decide an appeal from an adverse final decision of the Examining Attorney. This duty may not be delegated by adoption of conclusions reached by Examining Attorneys on different records.

Suffice it to say that each case must be decided on its own merits based on the evidence of record. We obviously are not privy to the record in the files of the registered mark and, in any event, the issuance of a registration by an Examining Attorney cannot control the result of another case. See *In re Sunmarks Inc.*, 32

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<sup>10</sup> Applicant's Brief, p. 8.

<sup>11</sup> *Id.*

USPQ 1470, 1472 (TTAB 1994). *See also In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits. [Internal citation omitted]. Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”).

E. Balancing the factors.

Because the marks are similar, the goods are related and move in the same channels of trade, we find that Applicant’s mark BLACKHAWK for “wine” is likely to cause confusion with the registered mark BLACK HAWK STOUT for “malt beverages, namely, beer, ales, and stout.”

**Decision:** The refusal to register Applicant’s mark BLACKHAWK is affirmed.