

This Opinion is not a  
Precedent of the TTAB

Mailed: August 24, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Red Whale, LLC*  
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Serial No. 86037950  
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Daniel J. Schacht, Eric W. Doney, and Carolyn E. Barreno of Donahue Fitzgerald  
LLP, for Red Whale, LLC.

Linda A. Powell, Trademark Examining Attorney, Law Office 106,  
Mary Sparrow, Managing Attorney.

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Before Wellington, Kuczma, and Hightower,  
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Red Whale, LLC (“Applicant”) seeks registration on the Principal Register of the  
mark RED WHALE (in standard characters) for “beer” in International Class 32  
and “distilled spirits” 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, 15 U.S.C. § 1052(d), on the grounds

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<sup>1</sup> Application Serial No. 86037950 was filed on August 14, 2013, based on Applicant’s  
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the  
Trademark Act. The application also originally identified “wine” in International Class 33,  
but those goods have been divided into a separate application, which is not before us.

of a likelihood of confusion with two marks registered to different owners: WHALE for “beer” in International Class 32 (the “613 Registration”)<sup>2</sup> and BLUE WHALE VODKA, with “vodka” disclaimed, for “vodka” in International Class 33 (the “859 Registration”).<sup>3</sup> Both cited marks are in standard characters.

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 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 Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, 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.”).

#### I. Similarity of the Goods and Channels of Trade

We first address the similarity of the goods and channels of trade, the second and third *du Pont* factors. Applicant’s goods are “beer” and “distilled spirits.” The

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<sup>2</sup> Registration No. 4096613, issued February 7, 2012.

<sup>3</sup> Registration No. 3838859, issued August 24, 2010.

goods identified in the cited registrations are “beer” and “vodka,” respectively. Applicant’s identified goods “beer” are identical to the “beer” identified in the ’613 Registration. With respect to the ’859 Registration, the record shows the identified goods, “vodka,” to be a type of “distilled spirits.”<sup>4</sup> Applicant’s more broadly identified “distilled spirits” necessarily encompass “vodka.” Thus, these goods are legally identical.

Because there are no limitations as to channels of trade or classes of purchasers in the description of goods in the cited registration, we presume that Registrants’ goods move in all channels of trade normal for such goods and are available to all potential classes of ordinary consumers. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Moreover, because the goods described in the application and both cited registrations are identical or legally identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

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<sup>4</sup> Definition of “vodka” from Dictionary.com, based on the Random House Dictionary (2014) (“an unaged, colorless distilled spirit, originally made in Russia”), May 26, 2014 final Office action at 22; *see also* “Distilled Spirits” from cocktails.about.com (“Vodka is a clear liquor that is often made of grain or potato and is the most popular distilled spirit worldwide.”), *id.* at 17.

In our likelihood of confusion analysis, these findings under the second and third *du Pont* factors strongly support a conclusion that confusion is likely between Applicant's mark and both cited marks.

## II. Similarity of the Marks

We turn next 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.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The 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).

Because the similarity or dissimilarity of the marks is determined on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, there is nothing improper

in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat'l Data*, 224 USPQ at 751. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013).

When, as here, marks would appear on goods that are identical, “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); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

A. '613 Registration

Applicant's mark is RED WHALE, and the mark in the '613 Registration is WHALE. We first note that Applicant's mark incorporates Registrant's entire mark, heightening the similarity between the two. *See, e.g., Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo likely to cause confusion with CONCEPT for cold permanent wave lotion and neutralizer); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN confusingly similar to TITAN for medical diagnostic apparatus); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE for automotive service centers confusingly similar to ACCU-TUNE for automotive testing equipment).

The record indicates that the term “red” is used to designate styles of beer known as red ales.<sup>5</sup> Consistent with this evidence, the Examining Attorney made of record six use-based, third-party registrations for “beer” or “beers” for marks from which the term “red” has been disclaimed.<sup>6</sup> Given the descriptive significance of the term “red” for beer, we accord it less weight than the other word in Applicant’s mark, WHALE, which as noted is identical to the entirety of the cited registration.

Considering the marks as a whole, we find Applicant’s mark RED WHALE to be similar to the cited mark WHALE in meaning and overall commercial impression. Consumers are likely to view RED WHALE beer as emanating from the same source as WHALE beer, possibly designating Registrant’s red-style beer.

The first *du Pont* factor supports a finding that confusion is likely.

#### B. ’859 Registration

The mark in the ’859 Registration is BLUE WHALE VODKA, with “vodka” disclaimed. We compare the cited mark and Applicant’s mark in their entireties, but because “vodka” is the generic name for Registrant’s goods, we accord it less weight in our analysis. The distinctive portions of each mark are the identical term WHALE preceded by the color RED or BLUE; in the case of Registrant’s mark, this phrase is followed by the generic name of its goods. The marks thus convey similar meanings and overall commercial impressions.

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<sup>5</sup> May 26, 2014 final Office action at 12-16 (article from sfgate.com titled “American red ale – easy to drink, hard to define”); *id.* at 10 (“Red ale” entry from Wikipedia.org referring to Irish red ale and Flanders red ale).

<sup>6</sup> January 15, 2015 reconsideration letter at 17-21, 24-25, 29-34.

The Examining Attorney introduced evidence that some manufacturers of spirits use colors to differentiate goods within a product line sold under the same mark.

These include:

- Johnnie Walker Red Label, Black Label, Double Black, Gold Label Reserve, Platinum Label, and Blue Label scotch whisky<sup>7</sup>
- Jim Beam White, Black, and Red Stag bourbon<sup>8</sup>
- Evan Williams White Label and Red Label bourbon<sup>9</sup>

Bearing in mind that the goods are legally identical, we find that RED WHALE and BLUE WHALE VODKA are sufficiently similar that confusion is likely. Specifically, based on the record evidence, we find that consumers are likely to view distilled spirits, which may include vodka, sold under the mark RED WHALE as a variation on Registrant's BLUE WHALE VODKA.

### III. Third-Party Use

Applicant's arguments in support of registration center on its contention that the cited marks are weak and entitled to only a narrow scope of protection because third parties have used and registered marks incorporating the term WHALE, as well as the names of other animals (e.g., dogs, cats, horses), for alcoholic beverages and other goods. Applicant's arguments loosely pertain to the sixth *du Pont* factor, that is, the number and nature of similar marks in use on similar goods.

Of the more than 500 pages of evidence submitted by Applicant, however, very little constitutes probative evidence of *similar marks in use on similar goods* by

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<sup>7</sup> October 24, 2013 Office Action at 13-14.

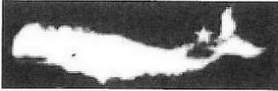
<sup>8</sup> *Id.* at 15-16.

<sup>9</sup> *Id.* at 22-31.

third parties. Applicant's submissions include, for example, lists of the results of searches of the PTO's Trademark Electronic Search System (TESS) database; copies of cancelled third-party registrations and pending and abandoned third-party applications, including applications filed on an intent-to-use basis; and Internet evidence relating to goods other than those identified by Applicant and Registrant, including wine and mixers. Applications are evidence only that they were filed. *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007). As the Examining Attorney notified Applicant during examination,<sup>10</sup> lists obtained by searches of PTO databases are insufficient to make the underlying registrations of record and have virtually no probative value. *See In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998) ("The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record.").

The following of Applicant's evidence may have some relevance to its arguments:

'613 Registration:

- Design of a whale for beer , Registration No. 3973013<sup>11</sup>
- Internet printouts relating to common-law use of:
  - "The Whale" brown ale<sup>12</sup>
  - "Killer Whale Cream Ale"<sup>13</sup>
  - "Whale's Tale Pale Ale"<sup>14</sup>

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<sup>10</sup> May 26, 2014 final Office action.

<sup>11</sup> November 25, 2014 request for reconsideration at 15.

<sup>12</sup> Communitybeerworks.com, *id.* at 41.

<sup>13</sup> Boldcitybrewery.com, *id.* at 44.

<sup>14</sup> Sites.google.com/site/ciscobeers/beer, *id.* at 45.



'859 Registration:

- Internet printouts relating to common-law use of:
  - “jonah + the whale ~ Premium Vodka”<sup>15</sup>
  - “Dark Moon Singing Whale Vodka”<sup>16</sup>
  - “Whaler’s Rum” (in dark, vanilla, and spiced flavors)<sup>17</sup>

Third-party registrations are not evidence of use, and there is no evidence regarding use of the whale design registration. *See AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1200 (TTAB 2007). Nor is there any evidence concerning the duration or extent of the common-law uses of “whale”-formative marks in association with beer and distilled spirits (three each). There is simply insufficient evidence by which we could ascertain that the term “whale” has been used so extensively for either beer or distilled spirits that consumers “have been educated to distinguish between different [such] marks on the bases of minute distinctions.” *Palm Bay*, 73 USPQ2d at 1694 (quotation omitted). Where the record includes no evidence about the extent of third-party uses, the probative value of such evidence is minimal. *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001). Furthermore, we must make our decision based on the specific marks and goods before us, not “types” of marks, e.g., marks naming animals.<sup>18</sup>

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<sup>15</sup> [Mmminimal.com/jonah-the-whale-premium-vodka/](http://Mmminimal.com/jonah-the-whale-premium-vodka/), *id.* at 53.

<sup>16</sup> [Shop.wineworldspirits.com](http://Shop.wineworldspirits.com), *id.* at 54.

<sup>17</sup> [BevMo.com](http://BevMo.com), *id.* at 57-60; [whalersrum.com](http://whalersrum.com), *id.* at 83.

<sup>18</sup> *See* Applicant’s Brief at 9, 8 TTABVUE 10.

Based on the evidence of record, we find the sixth *du Pont* factor to be neutral. We also remind Applicant that even if it had established the cited marks to be weak, they nonetheless would be entitled to protection from registration by a subsequent user of a confusingly similar mark for identical goods. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).

#### IV. Conclusion

We have considered all of the evidence of record and Applicant's arguments, even if not specifically discussed, as they pertain to the relevant *du Pont* factors. To the extent that any other *du Pont* factors for which no evidence was presented by Applicant or the Trademark Examining Attorney may nonetheless be applicable, we treat them as neutral. In view of our findings that the marks are similar and the goods are identical and move in the same channels of trade and to the same customers, we find that Applicant's mark is likely to cause confusion with the marks in cited Registration Nos. 4096613 and 3838859 when used in association with, respectively, beer and distilled spirits.

**Decision:** The refusal to register Applicant's mark RED WHALE is affirmed as to both cited registrations.