

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 White Birch Vineyards, LLC

Serial No. 86218002

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White Birch Vineyards, LLC.

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Susan Hayash, Managing Attorney.

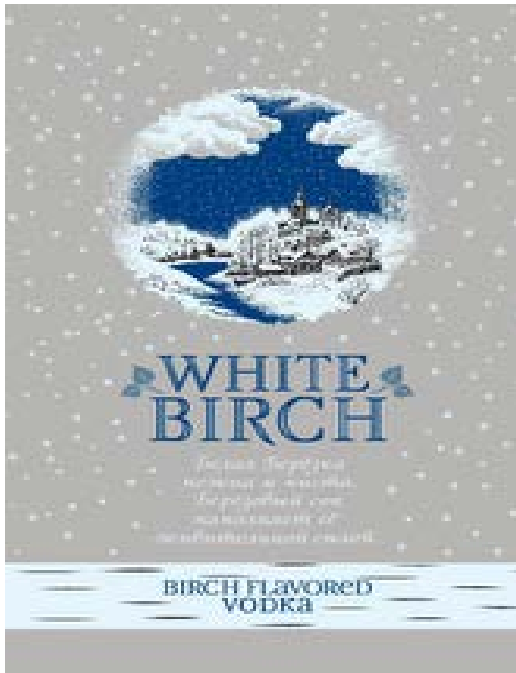
Before Kuczma, Adlin and Heasley,
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

White Birch Vineyards (“Applicant”) seeks registration of the mark WHITE BIRCH, in standard characters, for “Wine.”¹ The Examining Attorney refused registration under Section 2(d) of the Act on the ground that Applicant’s mark so resembles:

¹ Application Serial No. 86218002, filed March 11, 2014 under Section 1(a) of the Trademark Act, based on first use dates of 2006.

the identical mark (WHITE BIRCH in standard characters),² and the two marks shown below



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all three of which are owned by KPO Marketing Company LLC and registered for “vodka” (collectively the “KPO Marks”); and

the registered mark WHITE BIRCH BREWING, in standard characters, for “beer; beer, ale and lager; beer, ale and porter; all of the foregoing being handcrafted artisanal products,” owned by White Birch Brewing, LLC (the “White Birch Brewing Mark”)⁵

that use of Applicant’s mark in connection with Applicant’s goods is likely to cause confusion or mistake or to deceive. After the refusal became final, Applicant appealed and Applicant and the Examining Attorney filed briefs.

² Registration No. 3659495 issued July 21, 2009, with a disclaimer of BIRCH; Section 8 Affidavit accepted, Section 15 Affidavit acknowledged.

³ Registration No. 3687619, issued September 22, 2009, with disclaimers of BIRCH and BIRCH FLAVORED VODKA.

⁴ Registration No. 4144630, issued May 22, 2012, with a disclaimer of BIRCH.

⁵ Registration No. 3967306, issued May 24, 2011, with a disclaimer of BREWING.

Likelihood of Confusion

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 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.”).

In considering the KPO Marks, we focus our analysis on the cited registration for WHITE BIRCH in standard characters, because if we find confusion likely between that cited mark and Applicant’s mark, we need not consider the likelihood of confusion between Applicant’s mark and the other cited KPO Marks, while if we find no likelihood of confusion between Applicant’s mark and the identical mark for vodka, we would not find confusion between Applicant’s mark and the other cited KPO Marks, which include design elements. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

The cited KPO standard character mark is identical to Applicant’s mark. This weighs heavily in favor of a finding of likelihood of confusion.

The cited White Birch Brewing Mark is highly similar to Applicant's mark. In fact, the only difference between WHITE BIRCH and WHITE BIRCH BREWING is the disclaimed word BREWING, which is descriptive if not generic for beer, and thus entitled to less weight in our analysis. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("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.'") (quoting *In re Nat'l Data*, 224 USPQ at 752); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (BINION'S, not disclaimed word ROADHOUSE, is dominant element of BINION'S ROADHOUSE); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). Furthermore, both marks begin with WHITE BIRCH, and the first part of a mark is often its most prominent and dominant feature. *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 Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In short, WHITE BIRCH and WHITE BIRCH BREWING look and sound quite similar and convey highly similar meanings.

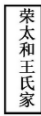
This factor not only weighs heavily in favor of a finding of likelihood of confusion between Applicant's mark and both the KPO standard character mark and the White Birch Brewing Mark, but also reduces the degree of similarity between the goods that is required to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002); and *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

Turning to the goods, they need not be identical or even competitive in order to support a finding of likelihood of confusion. It is enough that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used, to a mistaken belief that Applicant's and Registrants' goods originate from or are in some way associated with the same source or that there is an association between the sources of the goods. *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1432 (TTAB 1993); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984).

Here, the Examining Attorney has established that wine is related to both vodka and beer. For example, the Examining Attorney has made of record third-party use-based registrations showing that a single mark has been registered for wine on the one hand and vodka or beer on the other, including the following:

SALTY DOG in standard characters (Reg. No. 4136155) is registered for “beer, ale, lager, porter and stout” on the one hand and “wine” on the other.

D’SPAGNIA & Design (Reg. No. 3934483) is registered for “beer” on the one hand and “wine” on the other.



(Reg. No. 4548100) is registered for “vodka” on the one hand and “wine” on the other.

GRAYCLIFF in standard characters (Reg. No. 4518477) is registered for “vodka” on the one hand and “wine” on the other.

GUITAR CAFÉ & Design (Reg. No. 4515596) is registered for “alcoholic beverages, namely, wine ... vodka”

MONDANO in standard characters (Reg. No. 4497670) is registered for “vodka” on the one hand and “wine” on the other.

FOREX in standard characters (Reg. No. 4510739) is registered for “alcoholic beverages, namely ... wine” on the one hand and “vodka” on the other.

COUNT DE BRIM in standard characters (Reg. No. 4542681) is registered for “vodka” on the one hand and “wine” on the other.

Office Action of June 16, 2014. “Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that

the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998); see also *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).

In addition, the Examining Attorney introduced website printouts establishing that Charbay, Koenig Distillery and Winery, Flag Hill and Still Pond Winery all offer wine and vodka under the same mark or trade name; that Round Barn offers wine, beer and vodka under the same mark or trade name; that Schnebly Winery, Fenton Brewery and Winery⁶ and Wagner Valley Brewing Co. offer wine and beer under the same mark or trade name; and that Old North State Winery and Brewery offers both beer and wine. Office Action of January 12, 2015. This further establishes a relationship between wine and beer and between wine and vodka.

While each case must be decided on its own merits and record, we recently relied on the same types of evidence, and in fact some of the very same evidence, in finding wine and beer related. *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261 (TTAB 2011); see also, *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719 (TTAB 1992); *Krantz Brewing Corp. v. Henry Kelly Importing & Distributing Co., Inc.*, 96 USPQ 219 (1953); *Fruit Industries, Ltd. v. Ph. Schneider Brewing Co.*, 46 USPQ 487 (Commr. Pat. 1940). Similarly, we have previously found that wine is related to vodka and other spirits. *Monarch Wine Co., Inc. v. Hood River Distillers, Inc.*, 196

⁶ Fenton Brewery and Winery also offers “beer vs. wine pairings” and “beer vs. wine tastings.”

USPQ 855 (TTAB 1977) (MONARCH for, *inter alia*, vodka likely to be confused with MONARCH for wines and champagne). *See also In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (JOSE GASPAR GOLD for tequila confusingly similar to GASPAR'S ALE for beer and ale); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (RED BULL for tequila confusingly similar to RED BULL for malt liquor); *In re AGE Bodegas Unidas, S.A.*, 192 USPQ 326 (TTAB 1976) (RIOJA SIGLO, with RIOJA disclaimed and SIGLO meaning "century" for wines likely to be confused with CENTURY for whiskey).

As for channels of trade, the website printouts introduced by the Examining Attorney establish that wine travels in the same channels of trade as both beer and vodka. Office Action of January 12, 2015. Moreover, because neither Applicant's nor Registrants' identifications of goods include any limitations with respect to channels of trade, we must presume that those identifications encompass all wine, beer and vodka of the types identified, and Applicant's and Registrants' alcoholic beverages are presumed to move in all normal channels of trade and be available to all classes of consumers therefor. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) ("An application with 'no restriction on trade channels' cannot be 'narrowed by testimony that the applicant's use is, in fact, restricted to a particular class of purchasers.'"); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). To the extent that the White Birch

Brewing registration's limitation to "handcrafted artisanal products" is a trade channel limitation, the Examining Attorney's website evidence establishes that "handcrafted artisanal" beers travel in the same channels of trade as other alcoholic beverages. As we stated in *Monarch Wine Co.*

... there is no doubt but that purchasers could readily distinguish the products of opposer from those of applicant. However, the products of both parties are alcoholic beverages which flow through the same channels of trade to the same class of purchasers, and we believe that a prospective purchaser of an alcoholic beverage upon entering and browsing through the various alcoholic products located or displayed on the various shelves or counters in retail liquor establishments would, upon encountering a whiskey, rum, brandy or vodka identified by the term "MONARCH", and then continuing on his jaunt to another counter or section of the same store and seeing a wine or champagne sold under the identical mark "MONARCH", be likely to believe that both products originated with the same producer.

Monarch Wine Co., 196 USPQ at 857. See also, *In re Majestic Distilling*, 65 USPQ2d at 1204 ("malt liquor and tequila are similar by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers"); *In re Kysela Pere*, 98 USPQ2d at 1267 ("It is also common knowledge that [beer and wine] can be purchased in liquor stores and, in some cases, supermarkets and other retail outlets."); *In re Sailerbrau*, 23 USPQ2d at 1720 ("both beer and wine may be found in the same outlets, whether they be liquor stores or supermarkets"); *Schieffelin & Co. v. The Molson Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) ("A typical consumer of alcoholic beverages may drink more than one type of beverage and may shop for different alcoholic beverages

in the same liquor store. Moreover, a person may serve more than one kind of alcoholic beverage before or during a meal or at a party.”).

In short, the goods are related and their channels of trade overlap. These factors also weigh in favor of a finding of likelihood of confusion.⁷

Applicant’s argument that the coexistence of the cited registrations establishes that WHITE BIRCH is weak for alcoholic beverages is not well taken. The cited registrations are owned by only two owners, which is not sufficient to establish that WHITE BIRCH or variations thereof is weak.

Applicant’s argument that confusion is unlikely because the relevant consumers are “sophisticated” and “discerning” is irrelevant, because neither Applicant’s nor Registrants’ identifications of goods specify the types of purchasers for Applicant’s or Registrants’ goods. Therefore, we must presume that Applicant’s and Registrants’ identified goods encompass inexpensive and expensive varieties of the identified goods, and that the goods are offered to all types of customers therefor. *See e.g., Stone Lion Capital*, 110 USPQ2d at 1162-63 (“Stone Lion effectively asks this court to disregard the broad scope of services recited in its application, and to instead rely on the parties’ current investment practices ... the Board properly considered *all* potential investors for the recited services, including ordinary consumers seeking to invest in services with no minimum investment requirement.”) (emphasis in original). This factor is neutral.

⁷ Applicant’s attempts to distinguish the goods and their channels of trade are unavailing, because the differences Applicant cites are not reflected in Applicant’s or Registrants’ identifications of goods. *Octocom Systems, Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The lack of actual confusion is also irrelevant, because there is no evidence regarding the nature and extent of any contemporaneous use in the marketplace by Applicant and Registrants that would show that there has been an opportunity for confusion to occur if it were likely to occur. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). In any event, the lack of evidence of actual confusion carries little weight, especially in an *ex parte* context. *In re Majestic Distilling*, 65 USPQ2d at 1205. We therefore find that this *du Pont* factor is also neutral.

Conclusion

Applicant's and Registrants' marks are quite similar, and their goods are related and presumed to travel in overlapping channels of trade to some of the same consumers. Accordingly, confusion is likely.

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed.