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Subject: U.S. TRADEMARK APPLICATION NO. 86293520 - OLD AMERICANA - LMDL-103-TM - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86293520

MARK: OLD AMERICANA



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Luca Mariano Distillery LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

LMDL-103-TM

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Office's final refusal to register the trademark "OLD AMERICANA" (in standard characters) on the ground that the mark is likely to be confused with the mark in U. S. Registration No. 3454378 ("AMERICANA" in a stylized depiction) under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). In addition, Applicant has appealed the Office's final requirement that the wording "OLD" is descriptive with regard to the mark and therefore it must be disclaimed under Trademark Act Section 2(e)(1), 1056(a), 15 U.S.C. 1052(e)(1).

FACTS

Applicant, Luca Mariano Distillery, applied for registration on the Principal Register for the standard character mark "OLD AMERICANA" for "Alcoholic beverages, except beers" in International Class 033. See Applicant's original application. The mark was refused registration under Section 2(d) of the Trademark Act based upon a likelihood of confusion with the mark "AMERICANA" (U.S. Registration No. 3454378) for "Vodka" in International Class 033. The disclaimer of the word "OLD", as merely descriptive, was also required.

Applicant argued against the Section 2(d) refusal and the disclaimer requirement. Subsequently, a final refusal was issued, citing Registration No. 3454378 under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), and making final the disclaimer requirement. This appeal follows the final refusal and a denial of the request for reconsideration.

OBJECTION TO NEW EVIDENCE

Applicant has submitted new evidence with its appeal brief. Specifically, at no time during the prosecution of the application did the Applicant attempt to introduce the image of the Registrant's goods or the TESS results for "AMERICANA" submitted with the Applicant's brief. The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because Applicant's new evidence was untimely submitted during an appeal, Examining Attorney objects to this evidence and requests that the Board disregard it.

See *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).¹

I. THE MARKS OF THE APPLICANT AND REGISTRANT ARE HIGHLY SIMILAR AND THE GOODS ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260.

¹ In the alternative, if the Board does not disregard the evidence, then there is no way to determine whether these results are for goods or services that are predominantly different or unrelated to those identified in applicant's application. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods. See *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991). Evidence of widespread third-party use of similar marks with similar goods "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). However, evidence comprising third-party registrations for similar marks with different or unrelated goods or services, as in the present case, is of limited probative value in determining the strength of a mark. See *Kay Chems., Inc. v. Kelite Chems. Corp.*, 464 F.2d 1040, 1042, 175 USPQ 99, 101 (C.C.P.A. 1972). Thus, these third-party results for registrations and applications submitted by applicant are insufficient to establish that the wording "AMERICANA" is weak or diluted. By presenting evidence that is absent any specific reference to alcoholic beverages, Applicant has failed to demonstrate that Registrant's mark is weak.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterro Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

A. The marks of the Applicant and Registrant are highly similar. The dominant portions of both marks are identical.

Applicant's mark is "OLD AMERICANA" in standard characters and Registrant's mark is "AMERICANA" in stylized form. The dominant portion of both marks is "AMERICANA." Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) ("[Regarding the issue of confusion,] there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.") (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))).

Adding a term to a registered mark, namely, the word "old," generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See In re Energy Images, Inc.*, 227 USPQ 572, 573 (TTAB 1985) (holding SMART-SCAN (stylized) for optical line recognition and digitizing processors, and SMART for telemetry systems and remote-data gathering and control systems, likely to cause confusion, noting that, because

of the descriptive significance of the term "SCAN," it would be the portion of applicant's mark that consumers would least likely rely upon to distinguish applicant's goods).

The wording "OLD" merely describes Applicant's goods in that they are alcoholic beverages derived from recipes "advanced in years or age" and "of relating to, or originating in a past era." See discussion below. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant in relation to other wording in a mark. See *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)). Thus, "OLD" is less significant in terms of affecting the mark's commercial impression, and renders the wording "AMERICANA" the more dominant element of the mark. Where the dominant portion of both marks is "AMERICANA," both marks are similar in sound, meaning, and commercial impression. Thus, "OLD AMERICANA" and "AMERICANA" are sufficiently similar to find a likelihood of confusion.

Applicant contends that its mark is not likely to cause confusion with the cited mark, based upon the supposition that "AMERICANA" is "weak" and "OLD" is not descriptive, but rather, it is the dominant element in the mark. Applicant's assertion of the weakness of "AMERICANA" is based upon Applicant's evidence showing widespread use of the term in the marketplace, defined as "things produced in the United States and thought to be typical of the United States or its culture." See Applicant's brief at Page 6. The evidence includes definitions, magazine articles on music and soft drinks, and lists of decoration hardware. *Ibid* at Exhibits "B" and "C." There is no specific evidence relating to "Americana" and alcoholic beverages.

Applicant submitted printed copies of third-party registrations for marks containing the wording “AMERICAN” to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. See Applicant’s 3/18/2015 response to Office action, Pages 6-32. However, the relevant mark is AMERICANA, not AMERICAN. Thus, these third-party registrations submitted by applicant are insufficient to establish that the wording “AMERICANA” is weak or diluted. In terms of trademarks and alcoholic beverages in Class 033, the wording “AMERICANA” is not weak. In the body of the 4/11/2015 Office action, the Examining Attorney attached the X-Search search results for “AMERICANA” for Class 033. The “hotlist” contained only two entries, the marks of the Applicant and the Registrant.² See Page 1 of 04/11/2015 Office action.

Moreover, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108,

² Display of X-Search Hit List for application #86293520

#	Hits	Live	Dead	Tagged	Printed	Pl.	Search term
		Viewed	Mark				
03	2	2	0				2 and ("033" a b 200) [ic]

#	Serial	Filed	Status	Mark
1	86293520	20140528	V	OLD AMERICANA
2	77025657	20061020	V®	AMERICANA

109 (C.C.P.A. 1974) (likelihood of confusion is “to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and ‘strong mark’)); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (“even weak marks are entitled to protection against registration of similar marks”).

Applicant contends that “OLD” in “OLD AMERICANA” is the dominant, distinctive element in the mark. Rather than descriptive, “OLD” is suggestive of a past era. See Applicant’s brief at Page 3. Applicant produces no evidence to prove that “OLD” is the dominant element in the mark. “OLD” is an adjective that modifies the noun “AMERICANA.” It describes some quality or attribute of the latter, such as, old “things produced in the United States and thought to be typical of the United States and its culture.” Applicant’s mark is highly similar in appearance, sound, meaning, and commercial impression and sufficiently similar to find a likelihood of confusion.

Finally, the stylization of the registrant’s mark does not distinguish it from the Applicant’s mark because a mark in standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”).

B. The goods of the Applicant and Registrant are closely related because they are alcoholic beverages that may emanate from a common source.

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant’s goods are “Alcoholic beverages, except beers” in International Class 033. The goods in Registration No. 3454378 are “Vodka” in International Class 033. In the 9/18/2015 Office action, Examining Attorney submitted a definition of “Vodka” as “a strong, clear alcoholic drink that is originally from Russia.” See Page 2-3 of 9/18/2015 Office action. The goods of the Applicant and Registrant are directly related as alcoholic beverages in International Class 033. Various alcoholic beverages have been shown to be related goods for purposes of a Trademark Act Section 2(d) analysis. See *Somerset Distilling, Inc. v. Speymalt Whiskey Distribs. Ltd.*, 14 USPQ2d 1539 (TTAB 1989) (holding JAS. GORDON and design for scotch whiskey likely to be confused with GORDON’S for distilled gin and vodka).

With respect to Applicant’s and Registrant’s goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the goods, namely, “Alcoholic beverages, except beers” and this wording is presumed to encompass all goods of the type described, including those in Registrant’s more narrow identification of “Vodka.”

II. THE WORDING “OLD” MERELY DESCRIBES A QUALITY OR FEATURE OF THE APPLICANT’S GOODS AND THEREFORE IS AN UNREGISTRABLE COMPONENT OF THE MARK AND MUST BE DISCLAIMED.

Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), states, in part, that “[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” *See In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986). Thus, the Office may require an applicant to disclaim wording in a mark that merely describes, or is misdescriptive of, an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods. *See* 15 U.S.C.

§§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a). If an applicant does not provide a required disclaimer, the Office may refuse to register the entire mark. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant applied for “OLD AMERICANA” for “Alcoholic beverages, except beer” in International Class 033. Examining Attorney made the following definitions of “OLD” of record: “advanced in years or age” and “of relating to, or originating in a past era.” See Pages 9-11 of 9/11/2014 Office action and Pages 7-9 of 4/11/2015 Office action. Additionally, Examining Attorney attached advertising from the Applicant’s website and the following statement: “Luca Mariano Old Americana is a brand dedicated to bringing back Prohibition’s Original Recipes, the Viola Family Whiskey recipes have been closely guarded secrets kept by the family since 1914...Pledge of Authenticity...We do not add or remove from the Original Recipes handed down from Baldassare.” [Emphasis added.] Pages 2-5 of 4/11/2015 Office action. The wording “OLD” merely describes Applicant’s goods, alcoholic beverages derived from recipes “advanced in years or age” and “of relating to, or originating in a past era.”

Applicant contends that “OLD” is suggestive of a past era, not descriptive. Additionally, the term refers to the recipe, not the product. Applicant’s brief at Page 3. Examining Attorney agrees that it can suggest a past era. But in this case, it describes a recipe from the past that is used to concoct the alcoholic beverages of the Applicant. “A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012).

CONCLUSION

Because the marks are highly similar and the goods are directly related, consumers encountering Applicant's mark and the Registrant's mark in the marketplace are likely to mistakenly believe that the goods emanate from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act, should therefore, be affirmed. Furthermore, because the wording "OLD" merely describes a feature of the Applicant's goods, the disclaimer requirement, should therefore, be affirmed.

Respectfully submitted,

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