

This Opinion is Not a
Precedent of the TTAB

Mailed: May 18, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Magnolia Brewing Company, LLC.

Serial No. 86385603

Candace L. Moon of The Craft Beer Attorney, APC
For Magnolia Brewing Company, LLC.

Fred Carl, III, Trademark Examining Attorney, Law Office 108,
Andrew Lawrence, Managing Attorney.

Before Mermelstein, Lykos, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Magnolia Brewing Company, LLC (“Applicant”) seeks registration on the
Principal Register of the mark SMOKESTACK LIGHTNING in standard characters

for “Beer” in International Class 32.¹ The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark SMOKESTACK SERIES in standard characters, with SERIES disclaimed, for “Beer, ale and malt liquor” in International Class 32.²

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

I. Evidentiary Issue

Applicant attached to its appeal brief new evidence in the form a Wikipedia entry on the musician “Howlin’ Wolf,” and the Examining Attorney objects. “The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.” Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Thus, the Wikipedia evidence that was submitted for the first time with the appeal brief is untimely and we give it no consideration.³ *See In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1857-58 (TTAB 2014).

¹ Application Serial No. 86385603 was filed September 4, 2014 based upon Applicant’s allegation of use of the mark in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

² Registration No. 3509698, issued September 30, 2008; Section 8 accepted and Section 15 acknowledged.

³ Regardless, we note that this entry would not change the result herein. Applicant properly introduced during prosecution another Wikipedia entry on the song at issue by musician “Howlin’ Wolf”, to which the Examining Attorney did not object. Therefore, despite the exclusion of this entry on the musician, Applicant’s argument regarding the song had other

II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a 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, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *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.”).

A. Relatedness of the Goods and Trade Channels

We first address the second and third *du Pont* factors, the similarity of the goods and channels of trade. The focus must be on the goods as identified in the application and cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In this case, both the subject application and the cited registration identify beer, and therefore the goods are in part identical. Applicant offers no argument on this factor.

evidentiary support in the record, and we considered the argument, as discussed later in this decision.

Given the lack of restriction in both identifications, we presume, as we must, that both Applicant's beer and Registrant's beer move in all channels of trade normal for such goods and are available to all potential classes of ordinary consumers. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods"); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Moreover, because the goods described in the application and the cited registration are in part identical, we must presume that those identical goods travel through the same channels of trade to the same class of purchasers, considerations under the third *du Pont* factor. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra*, 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). Thus, the second and third *du Pont* factors strongly weigh in favor of likely confusion.

B. Similarity of the Marks

With respect to the marks, we must compare them "in their entirety 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 test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather

whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). Moreover, where, as here, the goods are identical, the degree of similarity of the marks necessary to find likelihood of confusion need not be as great. *Coach Servs., Inc.*, 101 USPQ2d at 1722; *Viterra*, 101 USPQ2d at 1908 (citing *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)).

Applicant's proposed mark is SMOKESTACK LIGHTNING in standard characters, and the mark in the cited registration is SMOKESTACK SERIES in standard characters, with SERIES disclaimed. Thus, the marks share a significant visual and phonetic similarity because of the common first word SMOKESTACK. We note that "it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). *See also Palm Bay Imports Inc.*, 73 USPQ2d at 1692. We further find that SMOKESTACK dominates the cited mark in large part because the other word, SERIES, is disclaimed as descriptive and consumers would not be inclined to rely on the disclaimed word as a source indicator. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Applicant's mark contains the additional term LIGHTNING, which obviously constitutes a difference from the cited mark. Applicant contends that this part of its mark creates a distinction in sound and sight. Applicant also argues that SMOKESTACK LIGHTNING gives rise to a different commercial impression than SMOKESTACK SERIES, both because it "conveys imagery of billowing smokiness impregnated by branches of powerful light" and because it refers to the title of a classic blues song by musician "Howlin' Wolf."⁴ Applicant contends that the "Smokestack Lightning" song reference constitutes a "double entendre," and "is meant to evoke a connection between the strength and darkness of the beer and the soulful emotion" of the song.⁵

The Examining Attorney, however, responds that the cited registration's inclusion of SERIES in the mark gives the impression that Registrant offers a series of SMOKESTACK beers, such that consumers likely would view Applicant's SMOKESTACK LIGHTNING as one of the series. To support this argument, the Examining Attorney submitted a list by Beer Advocate of the top-rated 250 beers that shows numerous instances of a beer maker naming multiple beers using a shared literal element along with additional wording.⁶ For example, Russian River Brewing

⁴ 8 TTABVUE at 10-11; *see also* March 9, 2015 Response to Office Action at 6-8 (Wikipedia entry on the song). We have considered the Wikipedia entry because the Examining Attorney, as the non-offering party, had an opportunity to rebut this evidence by submitting other evidence that may have called into question the accuracy of the Wikipedia entry. *See In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1382 n.2 (TTAB 2012).

⁵ 8 TTABVUE at 11.

⁶ March 25, 2015 Office Action at 2-14.

Company appears on the list as the source of PLINY THE YOUNGER and PLINY THE OLDER, and Founders Brewing Company appears on the list as the source of FOUNDERS CBS IMPERIAL STOUT, FOUNDERS KBS (KENTUCKY BREAKFAST STOUT), FOUNDERS BREAKFAST STOUT, FOUNDERS IMPERIAL STOUT, and FOUNDERS BACKWOODS BASTARD.⁷ As to the song reference, the Examining Attorney also expresses doubt about widespread consumer awareness of the blues song, first released in 1956, which she characterizes as “never popular with the public at large.”⁸

Regardless of whether the commercial impression of Applicant’s mark involves the imagery from the plain meaning of “smokestack” and “lightning,” or a reference to the blues song, we find it similar enough to the impression of SMOKESTACK SERIES to promote likely confusion. Even Applicant acknowledges, and we agree, that Registrant’s mark gives the impression of “a naming structure for a series of beer products.”⁹ The evidence of record shows a practice in the beer industry of a brewery naming multiple different beers – or a series of beers – with a common literal element. Thus, we find that Applicant’s SMOKESTACK LIGHTNING beer likely would be viewed as one of Registrant’s SMOKESTACK SERIES of beers, even by consumers familiar with the blues song. So, although the commercial impressions of these two marks in their entirety differ somewhat, the significant shared element and their

⁷ *Id.*

⁸ 10 TTABVUE at 7.

⁹ 8 TTABUVE at 11.

impressions as a whole are such that they encourage likely source confusion. *See Nat'l Data Corp.*, 224 USPQ at 751 (while marks must be compared in their entirety, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety”).

Given the similarity in sight, sound, and commercial impression of the marks in their entirety, the first *du Pont* factor weighs in favor of likely confusion.

C. Strength of the Cited Mark

Applicant attempts to minimize the significance of the common term by asserting that SMOKESTACK is weak and “Registrant’s mark is only entitled to a narrow scope of protection.”¹⁰ In an effort to show the alleged weakness, Applicant submitted a variety of evidence, including third-party registrations and applications for marks consisting of or containing the term “Smokestack” and third-party use of “Smokestack” in connection with beer, a brewery or a retail beer store. Third-party registration evidence may show that a term carries a highly suggestive connotation in the relevant industry and therefore may be considered somewhat weak. *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

¹⁰ 8 TTABVue at 11.

However, Applicant’s third-party registration evidence does not involve the same goods as are in the Registration. Rather, the registrations identify unrelated goods and services such as food products, restaurant services, wood chips for barbecue grilling, and promoting public awareness of agriculture and industry.¹¹ Thus, unlike in *Juice Generation* and *Jack Wolfskin*, where the third-party evidence involved the very same services and goods at issue, here the third-party registration evidence is far afield from the relevant beer industry. The third-party applications, in addition to identifying similarly irrelevant goods,¹² lack the status of registrations and therefore would not be probative regardless. *See In re Binion*, 93 USPQ2d 1531, 1535 (TTAB 2009) (“The applications are evidence of nothing more than that they were filed”).

Applicant’s evidence of third-party use consists of webpages promoting or reviewing three beers that include “Smokestack” in their names – “Smokestack Red Ale” by Vertigo Brewing, apparently made by a microbrewery and taproom located in Hillsboro, Oregon,¹³ “Smoke Stack Brown Ale” made by Tin Roof Brewing Co.,¹⁴ and “Smokestack Heritage Porter” made by East End Brewing Company¹⁵ – as well as use of “6 Pack Smokestack” for a retail beer store in Swannanoah, North Carolina,¹⁶

¹¹ September 17, 2015 Office Action at 25-28, 31-38.

¹² *Id.* at 29-30, 39-40.

¹³ *Id.* at 41, 43 and 47.

¹⁴ *Id.* at 49.

¹⁵ *Id.* at 51.

¹⁶ *Id.* at 58.

and use of “Smokestack Brew” for “a locally owned sports bar, restaurant and entertainment venue” in Mishawaka, Indiana.¹⁷ We do not find the latter two geographically localized uses as trade names or service marks for business establishments probative of weakness of the term as a beer name. The three remaining uses in beer names certainly qualify as more relevant, but given the small number and the nature of the uses, we find their probative value to show weakness relatively minimal. “Smokestack Red Ale” appears to be a geographically localized use. The webpage photo of “Smoke Stack Brown Ale” only shows the beer in a glass, along with a link to “15 Ratings” and 12 photos or icons representing “Loyal Drinkers.” The record gives no indication that this beer is widely distributed or known by consumers. Therefore, considering the evidence in its entirety, we conclude that it fails to support weakness of “Smokestack” in connection with beer.

D. Actual Confusion

Finally, Applicant argues that the record lacks evidence of actual confusion in the marketplace despite some years of co-existence. The cited registration issued September 30, 2008. We note that Applicant’s application claims a date of first use anywhere of February 1, 2003, and a date of first use in commerce of October 31, 2010. Regardless of the years of alleged co-existence, the lack of evidence of actual confusion carries little weight, especially in an *ex parte* context, where the owner of the cited registration had no opportunity to offer evidence. *In re Majestic Distilling*

¹⁷ *Id.* at 60.

Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (“uncorroborated statements of no known instances of actual confusion are of little evidentiary value”).

This *du Pont* factor is neutral.

III. Conclusion

Based on the similarity of the marks, the identical goods at issue, and the identical trade channels, we find that Applicant’s mark is likely to cause confusion with the mark in the cited registration, which we do not consider weak. The absence of actual confusion evidence in this *ex parte* record lacks probative value to overcome the likelihood of confusion.

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