

This Opinion is Not a
Precedent of the TTAB

Mailed: November 9, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Heritage Distilling Company, Inc.
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Serial No. 86896656
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Jeffrey A. Nelson of Cairncross & Hempelmann,
for Heritage Distilling Company, Inc.

Megan R. Askew, Trademark Examining Attorney, Law Office 105,
Jennifer L. Williston, Managing Attorney.

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Before Kuhlke, Bergsman and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Heritage Distilling Company, Inc. (“Applicant”) seeks registration on the Principal Register of the mark BSB (in standard characters) for “distilled spirits,” in Class 33.¹

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

¹ Application Serial No. 86896656 was filed on February 3, 2016, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce.

CO and design, shown below, for “brewpub services; taproom services; taproom services featuring beer brewed on premises,” in Class 43, as to be likely to cause confusion.²



Registrant disclaimed the exclusive right to use “Brewing Co.”

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 reverse 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) (“*du Pont*”) (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus

² Registration No. 4583764, registered on August 2, 2014.

our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (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.”); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 303 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The similarity or dissimilarity of the marks.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. 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) (quoting *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82

USPQ2d 1901, 1905 (TTAB 2007); *see also San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods and services at issue are distilled spirits and brewpub and taproom services without any restrictions or limitations as to price point or classes of consumers, the average customer is an ordinary consumer of the respective services.

Applicant's standard character mark BSB is similar to Registrant's mark BSB BLACK SHIRT BREWING CO and design because they share the letters BSB and, to that extent, they are similar in appearance and sound.

In analyzing Registrant's mark, the letters BSB are the most prominent feature by virtue of their size and location in the middle of the logo. There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). "[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral

differences.” *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985). As discussed below, the peripheral differences between the marks fail to distinguish them.

The stylized presentation of the letters BSB in Registrant’s mark is not so distinctive as to distinguish the marks in any meaningful manner. *See e.g., Lincoln Nat’l Corp. v. Anderson*, 110 USPQ2d 1271, 1284 (TTAB 2014); *Jansen Enter. Inc. v. Rind*, 85 USPQ2d 1104, 1109 (TTAB 2007); *Wet Seal Inc. v. FD Mgt. Inc.*, 82 USPQ2d 1629, 1639 (TTAB 2007). This is especially true because Applicant’s mark is in standard characters. Marks presented in standard characters are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording, and not in any particular display. Thus, Applicant seeks registration of a mark that might be depicted in any manner, regardless of the font style, size, or color, and might at any time in the future be displayed in a manner similar to Registrant’s mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that for purposes of determining whether two marks are similar, a mark in a typed drawing (equivalent to modern standard character format) is distinct from such mark in a logo format; “[b]y presenting its mark in a typed drawing, a *difference* cannot legally be asserted by that party” (emphasis in original)).

Applicant argues to the contrary that the mark in the cited registration is so stylized that the marks are visually different.³ We disagree with Applicant's contention that the facts in this appeal are similar to *In re TSI Brands, Inc.*, 67 USPQ2d 1657 (TTAB 2002). *TSI Brands* did not involve a mark in standard character form. The marks involved in *TSI Brands* are displayed below:

Applicant's Mark



Registrant's Mark



Both marks in *TSI Brands* were stylized.⁴ Accordingly, the Board held that the marks in *TSI Brands* were so highly stylized that they are more properly treated ... as being akin to pure design marks rather than simply stylized displays of word marks.” 67 USPQ2d at 1663. Also, the Board found that the term “American Khakis” was a more significant element of the applicant's mark because, in part, it was superimposed over the letters AK. 67 USPQ2d at 1662.

We recognize that the additional wording “Black Shirt Brewing Co” in Registrant's mark creates differences in appearance from Applicant's mark. Moreover, the trade name provides meaning for the letters BSB which Applicant's mark lacks. Moreover,

³ Applicant's Brief (7 TTABVUE 4).

⁴ Also, in *TSI Brands*, the applicant submitted evidence of “several other registrations by third-parties for marks in the clothing field which contain the letters ‘AK’.” 67 USPQ2d 1660.

we note that Applicant's use of BSB is an abbreviation for "brown sugar bourbon."⁵ However, because the marks share the letters BSB, consumers mistakenly may perceive the marks to have the same meaning and commercial impression if they are applied to related goods and services.

While there is no explicit rule that marks must be found similar where one contains in part the whole of another, the fact that Applicant's mark is entirely subsumed by Registrant's mark increases the similarity between the two. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant's mark ML is similar to registrant's mark ML MARK LEES); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (applicant's mark PRECISION is similar to opposer's mark PRECISION DISTRIBUTION CONTROL).

We find that any differences between the marks is outweighed by the similarities so that when the marks are considered in their entireties, the marks are similar.

⁵ September 6, 2016 Response to Office Action (TSDR 2 and 9). Specifically, Applicant stated that "Applicant's BSB mark has no meaning or significance in the industry other than as an indicator of the source of Applicant's distilled spirits. As applied to Applicant's goods, BSB is an acronym for Applicant's brown sugar bourbon." In addition, the Examining Attorney submitted an excerpt from Applicant's website (heritagedistilling.com) submitted by the Examining Attorney displaying Applicant's bourbon label showing BSB over "brown sugar bourbon." (October 12, 2016 Office Action (TSDR 20)). We assume the Examining Attorney considered whether Applicant's mark is merely descriptive but decided that it was not. Thus, the issue of whether Applicant's mark is merely descriptive is not before us.

Citations to the TSDR database are in .pdf format.

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

Applicant is seeking to register its mark for distilled spirits while the cited mark is registered for brewpub and taproom services. A “brewpub” is defined as “an establishment selling beer brewed on the premises and often including a restaurant.”⁶ A “taproom” is defined as “a room in which alcoholic drinks, especially beer, are available on tap; a bar in a hotel or inn.”⁷

The fact that taprooms and brewpubs serve food and beverages is not enough to render those goods and services related. Instead, “[t]o establish likelihood of confusion a party must show *something more* than that similar or even identical marks are used for food products and for restaurant services.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (quoting *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982)) (emphasis added).

In *Coors*, the Court of Appeals for the Federal Circuit explained why more evidence than just showing restaurants sell beer is required to prove that those goods and services are related:

It is not unusual for restaurants to be identified with particular food or beverage items that are produced by the same entity that provides the restaurant services or are sold by the same entity under a private label. Thus, for example, some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered

⁶ **Oxford Living Dictionaries** (en.oxforddictionaries.com) (United States version) (2016) attached to the October 12, 2016 Office Action (TSDR 7).

⁷ *Id.* (TSDR 8).

trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant. The *Jacobs* case [*Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982)] stands for the contrary proposition, and in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.

Coors, 68 USPQ2d at 1063. In other words, there is no *per se* rule that certain goods and services are related. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (no *per se* rule about confusion, where similar marks are used in connection with restaurant services and food products).

The Federal Circuit recognizes that the diversity and expansion of businesses in a modern economy is not, in and of itself, sufficient to support an inference that purchasers are apt to believe that disparate products or services emanate from the same source. *See In re American Olean Tile Co.*, 1 USPQ2d 1823, 1826 (TTAB 1986). Taking the Examining Attorney's position to its logical extreme, not only would a senior user of a mark for restaurant services have prior rights for that mark for spirits, but the senior user of a mark for restaurant services could have prior rights for that mark for other food, beverages and condiments (*e.g.*, wine or spirits, salsa or mustard, and chips or desserts, *etc.*) and a variety of broadly described promotional items (*e.g.*, clothing, glassware, toys, jewelry, sunglasses, paper products, *etc.*).

The Board has found the "something more" requirement to be met under the following circumstances:

- Applicant's mark made clear that its restaurant specialized in registrant's type of goods. *See In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services confusingly similar to GOLDEN GRIDDLE for table syrup); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services confusingly similar to AZTECA for Mexican food items);

- The record showed that registrant's wines were actually sold in applicant's restaurant. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) ("the record in this case reveals that registrant's OPUS ONE wine is offered and served by applicant at its OPUS ONE restaurant."); and

- Registrant's mark was found to be "a very unique, strong mark." *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988) ("the Examining Attorney has indicated that he has been unable to find, in the records of the Patent and Trademark Office, any registration, other than the cited registration, for a mark containing the expression 'Mucky Duck,'" nor has applicant offered any evidence of third-party use of marks containing the expression.).

We now analyze whether the record includes evidence sufficient to meet the "something more" requirement. The Trademark Examining Attorney submitted excerpts from third-party websites listed below showing the third parties using the same marks to identify their distilled spirits and taproom, brewpub, or restaurant services:

- Ballast Point (ballastpoint.com)⁸
- Bent Brewstillery (bentbrewstillery.com)⁹
- Maplewood (maplewoodbrew.com)¹⁰
- Portside (portsidedistillery.com)¹¹
- Rogue (rogue.com)¹²
- Warfield Distillery & Brewery (warfielddistillery.com)¹³

The Trademark Examining Attorney also submitted an excerpt from Registrant's website (blackshirtbrewingco.com)¹⁴ advertising its taproom services including the sale of "Black Shirt Bourbon."

Finally, the Trademark Examining Attorney submitted excerpts from third-party websites listed below showing third parties rendering taproom, brewpub, or restaurant services in connection with a brewery and distillery although there was no evidence regarding how the third party branded its distilled spirits:

- Little Toad Creek Brewery & Distillery (littletoadcreek.com)¹⁵
- Dogfish Head Brews & Spirits (dogfish.com)¹⁶

⁸ October 12, 2016 Office Action (TSDR 9-10).

⁹ October 12, 2016 Office Action (TSDR 11-12).

¹⁰ October 12, 2016 Office Action (TSDR 15-16).

¹¹ October 12, 2016 Office Action (TSDR 17-18).

¹² October 12, 2016 Office Action (TSDR 19-20).

¹³ October 12, 2016 Office Action (TSDR 21-22).

¹⁴ October 12, 2016 Office Action (TSDR 24); *see also* September 6, 2016 Response to Office Action (TSDR 11) and April 12, 2017 Request for Reconsideration (4 TTABVUE 15).

¹⁵ October 12, 2016 Office Action (TSDR 13-14). On this website, Maplewood advertises that its Maplewood Spirits will be "coming soon" with projected dates of availability.

¹⁶ March 2, 2016 Office Action (TSDR 8-9).

- New Holland Brewing (newhollandbrew.com)¹⁷
- Round Barn Winery (roundbarnwinery).¹⁸

Applicant contends that the above-noted evidentiary showing is not sufficient to prove that brewpubs and taprooms are associated with distilled spirits because the 10 third-party websites, as well as Registrant's website, submitted by the Examining Attorney are not a significant sample of the market.¹⁹ According to Applicant, there are over 1,300 craft distilleries²⁰ and 5,000 craft breweries²¹ in the United States and that based on the record only a handful of brewpubs and taprooms distill their own spirits. As noted above, the definitions of taproom and brewpub refer to beer and food, not spirits.

In light of the requirement that "something more" be shown to establish the relatedness of spirits and brewpub and taproom services for purposes of demonstrating likelihood of confusion, the evidentiary record does not support finding that consumers are likely to conclude that spirits and taproom and brewpub services with similar marks emanate from the same source. On a more comprehensive record,

¹⁷ March 2, 2016 Office Action (TSDR 10).

¹⁸ March 2, 2016 Office Action (TSDR 11).

¹⁹ Applicant's Brief (7 TTABVUE 7).

²⁰ "What is the growth potential of craft spirits in the U.S.?", *Craft Brew Business* (craftbrewingbusiness.com) (October 20, 2016) attached to Applicant's April 12, 2017 Request for Reconsideration (4 TTABVUE 10). According to the article, the market share of spirits produced by craft distilleries as of 2015 is 2.2 percent in volume and 3.0 percent in value.

²¹ "America Now Has a Record-High 5,000 Breweries and Counting," *Time* (time.com) (December 9, 2016) attached to Applicant's April 12, 2017 Request for Reconsideration (4 TTABVUE 13).

the Federal Circuit found that the degree of overlap between the sources of restaurant services and sources of beer *de minimis*. See *Coors*, 68 USPQ2d at 1063.²²

The Examining Attorney contends that “the arbitrary and non-dilute initialism ‘BSB’ for the relevant goods and services” and the fact that brewpubs and taprooms feature “alcoholic beverages,” including spirits satisfies the “something more” requirement.²³ We disagree. The Federal Circuit in *Coors* found on a more comprehensive record that “[t]he evidence of overlap between beer and restaurant services is so limited that to uphold the Board's finding of relatedness would effectively overturn the requirement of *Jacobs* that a finding of relatedness between food and restaurant services requires ‘something more’ than the fact that restaurants serve food.” 68 USPQ2d at 1063.

On this record, we find that the goods and services are not similar or related.

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

Because brewpubs and taprooms sell spirits, we find that the goods and services move in some of the same channels of trade.

D. The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.

Applicant contends that consumers of “craft” beer and spirits “are highly engaged and exercise great care in the process of researching and selecting breweries and craft

²² In addition to evidence of restaurants serving food and beverages, the Board considered articles showing the brewpubs, which brew their own beer, often feature restaurant services and third-party registrations showing a single mark has been registered for beer and restaurant services. *Coors*, 68 USPQ2d at 1063.

²³ Trademark Examining Attorney’s Brief (9 TTABVUE 7).

beer brands” and craft spirits.²⁴ Even assuming that Applicant’s characterization is accurate, Applicant’s distilled spirits are not limited to “craft” spirits and Registrant’s taproom and brewpub services are not restricted to serving “craft” beer or even beer brewed on the premises. Because we must consider the goods and services as they are described in the application and registration, Applicant’s contention is not applicable. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”); *see also In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). Therefore, we must presume that Registrant’s brewpub and taproom services are sold to all classes of consumers including sophisticated purchasers and ordinary consumers.

Accordingly, this *du Pont* factor is neutral.

²⁴ Applicant’s Brief (7 TTABVUE 8).

E. Analyzing the factors.

Even though the marks are similar and the goods and services move in the same channels of trade, because the record fails to show that the goods and services are related, we find that Applicant's mark BSB for "distilled spirits" is not likely to cause confusion with the registered mark BSB BLACK SHIRT BREWING CO and design for "brewpub services; taproom services; taproom services featuring beer brewed on premises."

Decision: The refusal to register Applicant's mark BSB BLACK SHIRT BREWING CO and design is reversed.