

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
December 15, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re C G Asset Management Pty Ltd

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Serial No. 87033933

Alexander S. Lazouski of Lasouski IP LLC for C G Asset Management Pty Ltd.

Paul Ferrer, Trademark Examining Attorney, Law Office 122 (John Lincoski, Managing Attorney).

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Before Zervas, Wolfson, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

C G Asset Management Pty Ltd (“Applicant”), in its capacity as trustee for C G Asset Management Trust, filed an application for registration on the Principal Register of the mark THE SAISON D’HERETIQUE in standard characters for the following goods:

Alcoholic beverages, being beer; beer; ale; lager; stout; bitter beer; black beer; dark beer; malt beer; pilsner beer; low carbohydrate beer; de-alcoholised beer; low alcohol beverages containing not more than 1.15% (by volume) of alcohol, namely, beer; root beer; fruit beers; ginger beer; beer wort; extracts of hops for making beer; beer brewing kits; mineral and aerated waters; non-alcoholic beer flavored beverages; fruit beverages and fruit juices;

syrops and other preparations for making non-alcoholic beverages, in International Class 32.¹

The application states that “[t]he English translation of SAISON D’HERETIQUE in the mark is the season of a heretic.” The Australian registration upon which the application is based contains the statement, “The applicant has advised that the English translation of the French words SAISON D’HERETIQUE appearing in the trade mark is SEASON HERETIQUE.”²

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, for Applicant’s goods, so resembles the registered mark HERETIC BREWING COMPANY in standard characters as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered for “Light beverages, namely, beer,” in International Class 32.³ When the refusal was made final, Applicant appealed to this Board. The case is fully briefed. Notably, the Examining Attorney, in his brief, expressly withdrew his refusal with respect to certain goods, so that *the refusal currently stands only with respect to the following goods:*

Alcoholic beverages, being beer; beer; ale; lager; stout; bitter beer; black beer; dark beer; malt beer; pilsner beer; low carbohydrate beer; de-alcoholised beer; low alcohol beverages containing not more than 1.15% (by volume) of

¹ Application Serial No. 87033933 was filed on May 11, 2016 under Trademark Act Section 44(e), 15 U.S.C. § 1126(e), on the basis of Australia Reg. No. 1697059, issued April 14, 2016.

² Application at 8.

³ Reg. No. 4071703, issued December 13, 2011. Section 8 affidavit accepted; Section 15 affidavit acknowledged. No claim is made to the exclusive right to use BREWING COMPANY apart from the mark as shown.

alcohol, namely, beer; fruit beers; ginger beer; beer wort; extracts of hops for making beer; beer brewing kits.

1. Evidentiary matter.

The Examining Attorney, in his brief, referred several times to Registrant's ownership of three registrations for marks that include the term HERETIC.⁴ Applicant objects to such evidence on grounds that it is untimely and not of record.⁵

Applicant's objection is well taken. The Examining Attorney did not make the registrations of record during examination; and had he submitted them with his brief we would have rejected them as untimely. 37 C.F.R. § 2.142(d);⁶ Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1207.01 (June 2017). Nor does the Board take judicial notice of the ownership of registrations. *See* TBMP § 1208.04. Accordingly, we have given no consideration to the three registrations.

2. Refusal under Section 2(d).

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 as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard*

⁴ Examining Attorney's brief, 6 TTABVUE 6, 11.

⁵ Reply brief at 3-4, 7 TTABVUE 4-5.

⁶ "Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination."

Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also presented arguments regarding trade channels and classes of customers.

(a) The goods; customers; trade channels.

We first consider the similarity or dissimilarity of the goods as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Registrant's goods are "Light beverages, namely, beer"; this identification is sufficiently broad to include within its scope all types of beer, *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006), and therefore encompasses all of the types of beer identified in the application. Some of Applicant's identified goods are not types of beer, but we need not find similarity as to each and every product listed in the application and registration. For purposes of our analysis, it is sufficient that relatedness be established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). In this case, many of Applicant's goods are identical or legally identical to Registrant's goods. Thus, the *du Pont* factor of the similarity of the goods favors a finding of likelihood of confusion.

With respect to those goods of Applicant and Registrant that are identical or legally identical, we must presume that they move through the same channels of trade and are sold to the same classes of purchasers. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, these *du Pont* factors also weigh in favor of a finding of likelihood of confusion.

(b) The marks.

We next consider the similarity or dissimilarity of the marks at issue in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In this case, the two marks have obvious differences in appearance, sound, and meaning arising from the words BREWING COMPANY in Registrant's mark, the words THE SAISON in Applicant's mark, and the differences between the terms HERETIC and D'HERETIQUE. There is some similarity in appearance between the words HERETIC and D'HERETIQUE, and their pronunciation could be similar, but not identical.

With respect to meaning or connotation, the Examining Attorney argues that much of the wording in both marks is highly descriptive or generic, and that the descriptive or generic elements of the two marks should be given less significance in determining the commercial impressions created by the marks. Obviously, BREWING COMPANY names the type of entity that produces beer. The evidence also shows that SAISON is a generic term for a type of beer. A Wikipedia entry for

“Saison” explains that a “saison” is “a pale ale that is generally around 7% ABV, highly carbonated, fruity, spicy, and often bottle conditioned,” and that this style of beer originated in “Wallonia, the French-speaking region of Belgium.”⁷ The record also includes 9 excerpts from news items in which “saison” is used in a clearly generic manner to designate a type of beer.⁸ We note in particular the following:

The rustic and earthy saison is among the most food-friendly beers

Josh Noel, *Pizza-beer pairings that deserve a toast*, CHICAGO TRIBUNE, September 14, 2016, at C6.

Hein provided the leadership, Rivard pushed the envelope with his balanced, yet exotic beers (he has a passion for saisons, India pale ales and sour varieties), and Abbruzze ... reinvented the menu

Big changes at Portola Hotel & Spa eateries, THE MONTEREY COUNTY HERALD, September 14, 2016, at B15.

Beer drinkers are fickle. Put us in a bar in front of dozens of taps – IPAs, gooses, saisons, blond ales, stouts, beers from all over the world – and our eyes instantly gravitate to what we’ve never had before.

Fritz Hahn, *When bars rush to the new, they abandon the tried and true*, THE WASHINGTON POST, September 14, 2016, at E02.

This beer is true to the Saison style, with a refreshing bright foundation that comes from wheat, barley and rye, with a bit of extra citrus and spice from the addition of orange peel and coriander, and, of course, a clean bittering finish from the hops.

Tom Gilbert, *What the Ale: Hanson Brothers Beer Company set to release a new beer*, THE TULSA WORLD, September 10, 2016.

⁷ Office Action of September 15, 2016 at 10.

⁸ *Id.* at 38-46.

“These are generally considered tart beers, things like saison, Berliner weisse and sometimes fruits added to them, and not everybody wants that.”

Rozanna M. Martinez, *Santa Fe brewery offers variety of beers, ‘upscale’ comfort food*, ALBUQUERQUE JOURNAL, September 9, 2016, at 15.

Some of his test beers include a blueberry saison (a European-style farmhouse ale), a strawberry rhubarb saison and a beet rye IPA.

Tony Kiss, *Another brewery set for Fairview*, THE ASHEVILLE CITIZEN-TIMES, September 8, 2016, at A3.

Steam Bell has six beers on tap produced by a seven-barrel brewing system with a focus on saisons, farmhouse ales and sour beers.

Darrell Wood, *New breweries south of the James fuel craft beer growth*, RICHMOND TIMES DISPATCH, September 8, 2016 at 1E.

Terreux Saison Rue, a Saison / Farmhouse Ale style beer brewed by The Bruery.

Maggie Hoffman, *What beer is San Francisco really drinking?*, SAN FRANCISCO CHRONICLE, September 4, 2016 at L6.

The brewery experiments with many styles, and current beers include the SM Saison, Grapefruit Gose sour wheat ale, Bitter Recognize English/American IPA, Barely Wine barley wine, and Tres Alamos Tripel aged in Chardonnay barrels.

Kellie Hwang, *Craft beer flows freely in Arizona brew scene*, THE ARIZONA REPUBLIC, September 3, 2016, at Z1128.

Finally, the Examining Attorney has submitted 8 registrations of marks for beer or ale in which the registrant has disclaimed the exclusive right to use SAISON apart from the mark as a whole.⁹

Applicant concedes that SAISON is a type of ale.¹⁰ Applicant argues, however, that SAISON also means “season” in French;¹¹ that this is its primary meaning to

⁹ *Id.* at 12-34.

speakers of French; and that SAISON D'HERETIQUE would be understood to mean “season of a heretic.” Applicant argues:

[T]he Examining Attorney err[ed] in determining “SAISON” is less significant in terms of affecting the applied-for mark’s commercial impression, and renders the wording D'HERETIQUE the more dominant element of the applied for mark. “SAISON” plays a crucial role in creating a double entendre and cannot be viewed as “less significant.”¹²

Applicant argues that a *double entendre* is a unitary expression, and that “[i]n a true double entendre there are no more or less significant parts by definition because prospective customers understand a double entendre by giving equal weight to all parts of the phrase.”¹³ Applicant points out that the wording THE SAISON D’ is the first part of its mark, and that “when the term ‘THE SAISON D’ is given fair weight (as it should to understand a double entendre), confusion with the cited mark is significantly reduced.”¹⁴

In our analysis, we will consider each of the two marks in its entirety and base our decision 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

¹⁰ Applicant’s brief at 5, 4 TTABVUE 6 (“Applicant does not contest that a French term ‘SAISON’ may describe a type of ale.”).

¹¹ *See* Applicant’s response of March 8, 2017 at 17-18.

¹² Applicant’s brief at 8, 4 TTABVUE 9.

¹³ *See id.* at 3-4, 4 TTABVUE 4-5.

¹⁴ *See id.* at 8-10, 4 TTABVUE 9-11.

considered as a whole in determining likelihood of confusion.”). In order to fully appreciate a mark’s commercial impression, we must consider every word in it, including all salient meanings of those words. Our primary reviewing Court has stated:

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks. [Citations omitted.] When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied. ...

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline. [Citations omitted.] The doctrine should be applied only when it is likely that the ordinary American purchaser would “stop and translate [the word] into its English equivalent.”

Palm Bay Imps. v. Veuve Clicquot Ponsardin, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). The Court and the Board have recognized that, in some contexts, even a person familiar with the foreign language at issue will not “stop and translate,” but rather “take it as it is.” In *In re Spirits International N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009), the Court stated that in some cases, “the literal translation is irrelevant” to customers (providing the examples of VEUVE CLICQUOT and CORDON BLEU); or the context in which the marks appear may render translation unlikely (providing the example of TIA MARIA Mexican restaurant *versus* AUNT MARY canned

vegetables). *Id.*, 73 USPQ2d at 1492. See *In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975).

In the present case, we must bear in mind not only the fact that customers who understand French would appreciate that SAISON means “season,” but that in the commercial context of beer sales, customers would recognize SAISON as denoting a type of beer. Such customers would perceive the first two words of Applicant’s mark as describing the nature of the goods (THE SAISON) and the remainder of the mark (D’HERETIQUE) as a an arbitrary term. Such customers, even if they know French, are unlikely to stop and translate and would take the mark “as it is.” They would perceive the mark as the generic name of the goods followed by the distinctive term D’HERETIQUE.

Comparing the two marks in their entireties, we find that Registrant’s mark creates the commercial impression of the trade name of a business that brews beer. Applicant’s mark creates the impression of a product brand, *i.e.*, a brand of saison-style beer. The fact that one mark includes the wording BREWING COMPANY and the other includes the word SAISON is not inconsistent with control by a single source, as any brewing company could offer a saison and use that word in its product brand. As for the terms HERETIC and D’HERETIQUE, they are sufficiently similar in appearance to be recognized as variants of one another; and despite the difference in their endings, the two terms look alike due to their shared letters and could be pronounced substantially alike. *In re Viterra*, 101 USPQ2d at

1912 (“there is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner.”).

Giving due regard to the differences between THE SAISON D’HERETIQUE and HERETIC BREWING COMPANY, we bear in mind that marks must be considered in light of the fallibility of memory, *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014), and that the average customer retains a general rather than specific impression of the marks. *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014). “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). In this case, there is sufficient similarity in the overall commercial impressions created by the marks to render confusion likely.

Finally, we note that even if customers were to translate Applicant’s mark, Applicant’s own argument that the initial D’ in D’HERETIQUE creates a possessive form¹⁵ leads to the conclusion that Applicant’s mark may be translated to mean “Heretic’s saison-style beer.”

For the reasons stated, we find that the *du Pont* factor of the similarity or dissimilarity of the marks favors a finding of likelihood of confusion.

¹⁵ Applicant’s brief at 6, 4 TTABVUE 7; *see also* Applicant’s response of March 8, 2017 at 19-26 (explication of French usage of the preposition “de.”).

(c) Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. The goods at issue are identical in part, and would move through identical trade channels to the same classes of customers. When identical goods are at issue, the degree of similarity of the marks that is necessary to find a likelihood of confusion is not as great as where the goods are disparate. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Although the marks include different descriptive or generic wording, their dominant portions are so similar as to cause the marks to create similar commercial impressions. Accordingly, we find that Applicant's mark, as intended to be used for beer, so resembles the cited registered mark as to be likely cause confusion, or to cause mistake, or to deceive.

Decision: The refusal under Section 2(d) is AFFIRMED. Because the Examining Attorney limited his refusal to specific identified goods, Applicant is entitled to registration of the mark with respect to the remaining goods. In due course, the identification of goods in the application will be amended by deletion of the following goods:

Alcoholic beverages, being beer; beer; ale; lager; stout; bitter beer; black beer; dark beer; malt beer; pilsner beer; low carbohydrate beer; de-alcoholised beer; low alcohol beverages containing not more than 1.15% (by volume) of alcohol, namely, beer; fruit beers; ginger beer; beer wort; extracts of hops for making beer; beer brewing kits.

The application will proceed to publication for opposition with respect to the following remaining goods:

Root beer; mineral and aerated waters; non-alcoholic beer flavored beverages; fruit beverages and fruit juices; syrups and other preparations for making non-alcoholic beverages.

Opinion by Wolfson, concurring:

I concur in the decision of the Board to affirm the Examining Attorney's refusal of registration under Trademark Act Section 2(d). However, in my view, the majority applied the doctrine of foreign equivalents when it need not have. As articulated in *Palm Bay*, the doctrine applies to "foreign marks." Under the doctrine of foreign equivalents, foreign marks in common languages are translated into English before being compared with English word marks. However, "[w]hen it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied." *Palm Bay*, 73 USPQ2d at 1696. A mark that comprises a foreign word, or words, combined with English words, is not, in my estimation, a "foreign mark," and the concept of "stop and translate" embodied in the doctrine does not apply.

In the case at hand, the presence of words with English-language meanings in the Applicant's mark removes it from the set of marks that should be translated into English before being compared with another English mark. The article "the" and the word "saison," identifying a type of beer, remove the overall mark from the realm of "foreign marks," and, therefore, from application of the doctrine of foreign

equivalents. While I agree that we must consider all “salient meanings” of the words in Applicant’s mark, and that one such meaning of the word “saison,” when translated into French is “season,” I disagree with the majority’s conflation of that concept with the doctrine of foreign equivalents. I would simply compare the marks for similarities in sight, sound, meaning and overall commercial impression, including any foreign-language connotations and would not “stop and translate” pursuant to the doctrine of foreign equivalents. *See French Transit Ltd. v. Modern Coupon Sys. Inc.*, 818 F. Supp. 635, 29 USPQ2d 1626, 1626-27 (SDNY 1993) (holding that the doctrine of foreign equivalents does not apply when a mark is a combination of foreign and English words; finding the doctrine inapplicable to the mark LE CRYSTAL NATUREL); *In re Johanna Farms*, 8 USPQ2d 1408, 1413 (TTAB 1988) (finding LA YOGURT not to be a foreign word but rather a combination of an English word and a French article and declining to apply the doctrine of foreign equivalents) (citing *In re Universal Package Corp.*, 222 USPQ 344, 347 (TTAB 1984) (doctrine does not apply to transform LE CASE into THE CASE)).

The decision in *Palm Bay* does not teach otherwise. In that case, the court was confronted with a mark entirely in French: VEUVE ROYALE. The court recognized that it translated into “royal widow,” but decided that customers were unlikely to “stop and translate” the French word “veuve” into the English word “widow.” Thus, the court reversed the Board’s decision that VEUVE ROYALE was likely to cause confusion with THE WIDOW. Unlike in *Palm Bay*, however, here we have a mark

that is not entirely in a foreign language. In a situation such as this, the mixed nature of the mark will not prompt consumers in the same manner as encountering a mark composed entirely of foreign terms. Consumers are not likely to “stop and translate” the mark because, taken in its entirety, there is no suitable “translation” for this non-foreign mark. *See Universal Package Corp.*, 222 USPQ at 347.

Thus, while I agree with the conclusion that Applicant’s mark THE SAISON D’HERETIQUE, is confusingly similar to the cited mark HERETIC BREWING COMPANY and that confusion is likely, I disagree with the application of the doctrine of foreign equivalents and therefore concur in the decision of the Board to affirm.