

This Opinion is Not a
Precedent of the TTAB

Hearing: May 20, 2020

Mailed: June 24, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hidden Ridge Vineyard, LLC

Serial No. 87868652

Matthew D. Francis of Brownstein Hyatt Farber Schreck, LLP,
for Hidden Ridge Vineyard, LLC.

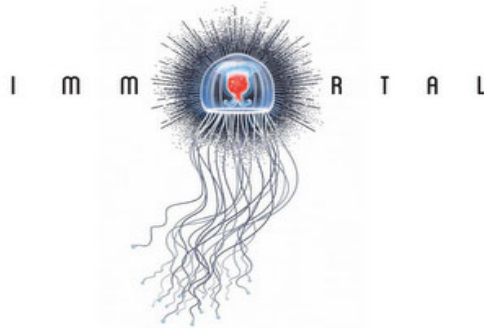
Raymond Harmon, Trademark Examining Attorney, Law Office 103,¹
Stacy Wahlberg, Managing Attorney.

Before Zervas, Mermelstein, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Hidden Ridge Vineyard, LLC (“Applicant”) seeks registration on the Principal
Register of the mark IMMORTAL and design, as shown below

¹ Trademark Examining Attorney Laura Golden examined the involved application and issued the final refusal to register that is the subject of this appeal. Trademark Examining Attorney Harmon, who was subsequently assigned to the case, filed the brief for the United States Patent and Trademark Office (“USPTO”) and appeared for the USPTO at the oral hearing. We will refer to them both as “the Examining Attorney.”



for “wine,” in International Class 33.²

The 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 it so resembles the registered standard-character mark THE IMMORTAL ZIN (ZIN disclaimed) for “wines”³ as to be likely, when used on the goods identified in the application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, which was denied. The appeal is fully briefed,⁴ and counsel

² Application Serial No. 87868652 was filed on April 9, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. Applicant subsequently amended its application to claim use in commerce. Applicant’s amended description of its mark reads as follows: “The mark consists of the black wording ‘IMMORTAL’, where the ‘O’ is depicted by the stylized immortal jellyfish. The jellyfish has a red shape internally, surrounded in blue and white bubbles, with white rays emanating from it. A background of black rays with black and blue dots emanating appears behind the immortal jellyfish. The tentacles of the immortal jellyfish hang beneath the body, and are white within the black background, and black, blue, and gray beneath it.” The colors red, black, blue, gray, and white are claimed as features of the mark.

³ The cited Registration No. 4205173 issued on September 11, 2012 and has been maintained.

⁴ Citations in this opinion to the briefs refer to TTABVue, the Board’s online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVue corresponds to the docket entry number, and any numbers following TTABVue refer to the page number(s) of the docket entry where the cited materials appear.

for Applicant and the Examining Attorney appeared at a video hearing before the panel on May 20, 2020. We affirm the refusal to register.

I. Record on Appeal⁵

The record on appeal includes Applicant's specimen of use filed in support of its Amendment to Allege Use, and the following materials:

- Pages from the USPTO's X-Search database regarding the cited registration, made of record by the Examining Attorney;⁶
- Webpages reflecting the use of the cited mark, made of record by Applicant;⁷
- A printout from the website of the Alcohol and Tobacco Tax and Trade Bureau ("TTB") regarding United States alcoholic beverage labeling requirements, made of record by Applicant;⁸
- Dictionary definitions of the word "zin," and a Wikipedia entry and other materials regarding the word "zin," made of record by the Examining Attorney;⁹

⁵ Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the USPTO's Trademark Status & Document Retrieval ("TSDR") database.

⁶ May 8, 2018 Office Action at TSDR 2-3.

⁷ November 8, 2018 Response to Office Action at TSDR 8.

⁸ *Id.* at TSDR 9.

⁹ December 14, 2018 Final Office Action at TSDR 2-5.

- Webpages regarding the various price points for wine and the sale of different varietals by the same winery, made of record by the Examining Attorney;¹⁰
- The declaration of Timothy Martin, a member of Applicant,¹¹ and Exhibits A-B thereto, consisting of Applicant's website at immortalestate.com (Ex. A),¹² and one of Applicant's front and back bottle labels (Ex. B);¹³ and
- The declaration of Applicant's counsel Matthew D. Francis,¹⁴ and Exhibits A-T thereto, consisting of pages from the website at discovermagazine.com regarding the "immortal jellyfish" (Ex. A);¹⁵ pages from the website of the owner of the cited registration at peirano.com (Exs. B, D, and T);¹⁶ pages from the website at totalwine.com (Exs. C and E);¹⁷ USPTO electronic records regarding third-party registrations of, or applications to register, the marks 8 IMMORTALS, IMMORTAL HERO, MONARCH IMMORTAL,

¹⁰ *Id.* at TSDR 6-21; July 23, 2019 Denial of Request for Reconsideration at TSDR 2-9.

¹¹ June 14, 2019 Request for Reconsideration at TSDR 17-19. We will cite Mr. Martin's declaration by paragraph and exhibit number (e.g., "Martin Decl. ¶ 11; Ex. B") and, where helpful in following our analysis, by TSDR pages as well.

¹² Martin Decl. ¶¶ 8, 10; Ex. A (June 14, 2019 Request for Reconsideration at TSDR 20-102).

¹³ Martin Decl. ¶ 11; Ex. B (June 14, 2019 Request for Reconsideration at TSDR 103-04).

¹⁴ June 14, 2019 Request for Reconsideration at TSDR 105-07. We will cite Mr. Francis's declaration by paragraph and exhibit number (e.g., "Francis Decl. ¶ 2; Ex. A") as well as by TSDR pages.

¹⁵ Francis Decl. ¶ 2; Ex. A (June 14, 2019 Request for Reconsideration at TSDR 108-113).

¹⁶ Francis Decl. ¶¶ 3, 5; Exs. B, D, T (June 14, 2019 Request for Reconsideration at TSDR 114-16, 119-20, 636-68).

¹⁷ Francis Decl. ¶¶ 4, 6; Exs. C, E (June 14, 2019 Request for Reconsideration at TSDR 117-18, 121-22).

IMMORTAL SPIRITS & DISTILLING and design, and IMMORTAL IPA, and the file histories of those registrations and applications (Exs. F-O);¹⁸ USPTO electronic records regarding the Combined Declaration of Use and Incontestability under Sections 8 & 15 filed by the owner of the cited registration to maintain it (Ex. P);¹⁹ pages from the website at wine-searcher.com (Ex. Q);²⁰ pages from the TTB website regarding wine labeling regulations (Ex. R);²¹ and photographs of a Total Wine store in Reno, Nevada showing the display of various varietals (Ex. S).²²

II. Analysis of Refusal

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

¹⁸ Francis Decl. ¶¶ 7-16; Exs. F-O (June 14, 2019 Request for Reconsideration at TSDR 123-611).

¹⁹ Francis Decl. ¶ 17; Ex. P (June 14, 2019 Request for Reconsideration at TSDR 612-19).

²⁰ Francis Decl. ¶ 18; Ex. Q (June 14, 2019 Request for Reconsideration at TSDR 620-22).

²¹ Francis Decl. ¶ 19; Ex. R (June 14, 2019 Request for Reconsideration at TSDR 623-25).

²² Francis Decl. ¶ 20; Ex. S (June 14, 2019 Request for Reconsideration at TSDR 626-35).

Two key *DuPont* factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Applicant focuses on the first key factor, 8 TTABVUE 8-18; 11 TTABVUE 2-10, but does not directly address the second. Applicant also directly or indirectly invokes the fourth *DuPont* factor, the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing,” *DuPont*, 177 USPQ at 567, 8 TTABVUE 18-20; the fifth *DuPont* factor, the “fame of the prior mark (sales, advertising, length of use),” *DuPont*, 177 USPQ at 567, 8 TTABVUE 24; the sixth *DuPont* factor, the “number and nature of similar marks in use on similar goods,” *DuPont*, 177 USPQ at 567, 8 TTABVUE 20-24; 11 TTABVUE 10; the eighth *DuPont* factor, the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *DuPont*, 177 USPQ at 567, 8 TTABVUE 24; the tenth *DuPont* factor, the “market interface between applicant and the owner of a prior mark,” *DuPont*, 177 USPQ at 567, 8 TTABVUE 24; and the twelfth *DuPont* factor, the “extent of possible confusion, i.e., whether *de minimis* or substantial,” *DuPont*, 177 USPQ at 567, 8 TTABVUE 24.

Without referring to any *DuPont* factor, Applicant also argues that the Examining Attorney improperly ignored Applicant’s “argument and supporting evidence that the alcohol industry is highly regulated and the United States government, and

specifically the TTB, has strict laws governing the sales of alcoholic beverages,” including requirements that “wine labels must contain specific information, including which estate bottled the wine, what valley the wine originated in, and the name and address of the bottler and importer.” 8 TTABVUE 24-25. Applicant argues that the required information that appears on its labels “makes clear that Applicant’s Cabernet Sauvignon is not produced or bottled by [registrant] Peirano, and confusion is therefore unlikely.” *Id.* at 25.

These arguments are unavailing. “The marks at issue in this [appeal] are not the . . . respective labels, or the information required for such labels under TTB regulations.” *Stawski v. Lawson*, 129 USPQ2d 1036, 1052 (TTAB 2018). “Thus, Applicant’s focus on the entirety of the labels is inappropriate.” *Id.* See also *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1185-86 (TTAB 2018) (“Applicant’s mark is not the equivalent of a wine label, which necessarily contains more information pursuant to labelling requirements. . . . We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information.”).

A. Similarity or Dissimilarity of the Goods and Channels of Trade

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Our analysis under these

factors is based on the identifications of the goods in the application and the cited registration. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).

The goods identified in the application are “wine,” and the goods identified in the cited registration are “wines,” the plural of “wine.” The goods are thus identical, *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986), and the second *DuPont* factor strongly supports a finding of a likelihood of confusion.

“Here, where the . . . goods, wine, are identical, we must presume that they would be marketed to the same classes of customers—ordinary adult wine drinkers and purchasers—through the same channels of trade.”²³ *Stawski*, 129 USPQ2d at 1053-54 (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); and *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018)). The third *DuPont* factor also strongly supports a finding of a likelihood of confusion.

B. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396

²³ The Martin and Francis declarations identify some of these channels as wine stores, Martin Decl. ¶ 7, Francis Decl. ¶ 20; Ex. T, and we take judicial notice that wine is also sold in liquor stores, grocery stores, and “on-premise” outlets such as bars and restaurants. *Cf. In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (channels of trade for beer “include liquor stores, beer sections of grocery and convenience stores, and the like, as well as bars and restaurants, and the customers would include ordinary consumers.”).

F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. Sept. 13, 2019).

The proper test regarding similarity “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.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).

Because the “goods, wine, are identical, less similarity between the marks is needed to find a likelihood of confusion.” *Stawski*, 129 USPQ2d at 1052 (citing *Viterra*, 101 USPQ2d at 1908; and *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010)).

1. Summary of Arguments

Applicant argues that the first *DuPont* factor is dispositive, 8 TTABVue 8-9, and that “consumer confusion is unlikely between the subject marks because Applicant’s design Mark creates a visually distinct connotation and a different commercial impression than the Cited Mark.” *Id.* at 9. Applicant “does not dispute that

‘IMMORTAL’ is the dominant portion of the Cited Mark,” 11 TTABVUE 7, but claims that the Examining Attorney “erred by finding that the allegedly dominant portion of Applicant’s Mark is the word ‘IMMORTAL,’ not the jellyfish.” 8 TTABVUE 11. Applicant “acknowledges that in certain cases involving design marks, words are accorded greater weight than a design when determining whether a likelihood of confusion exists, [but that] the Board in appropriate circumstances may also ‘give greater weight to the design component of a composite mark.’” *Id.* (quoting *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co., KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135 (Fed. Cir. 2015)). “While Applicant does not dispute that the immortal jellyfish design replaces the Latin character ‘O,’ Applicant strongly disputes that this creates the dominant word ‘IMMORTAL’ in standard characters,” 11 TTABUVE 4, and Applicant “submits that in this case, greater weight should be given to the large colorful jellyfish which is the centerpiece of Applicant’s Mark, as opposed to letters ‘IMM’ and ‘RT AL’ on either side of it.” 8 TTABVUE 11. Applicant argues that “[w]ithout question, consumers viewing Applicant’s Mark will immediately focus on the large, colorful jellyfish displayed at the center of Applicant’s mark before noticing the small, black lettering on each side of the colorful jellyfish—lettering that taken by itself does not even spell a word.” *Id.* Applicant claims that the Examining Attorney “did not accord proper weight to these distinctive elements, nor did the [Examining Attorney] account for the fact that consumers must use their imagination to reach the conclusion that the jellyfish replaces the ‘O’ to form the word ‘IMMORTAL.’” *Id.* at 12.

Applicant cites a number of cases for the proposition that “[w]here a pictorial representation in a mark is so highly stylized or abstract that it would not readily evoke in the consumer’s mind the wording featured in another mark, the marks may not be confusingly similar.” *Id.* at 12-13. Applicant argues that “[l]ike these cases, Applicant’s pictorial representation of a colorful jellyfish is highly stylized and consumers viewing Applicant’s Mark will view it as the dominant feature of Applicant’s Mark.” *Id.* at 13.

Applicant also argues that the Examining Attorney improperly found in the denial of Applicant’s Request for Reconsideration that because the cited mark is a standard character mark, “it is protected in all stylizations, including with a jellyfish standing in for its ‘O,’²⁴ and therefore the replacement of the ‘O’ in ‘IMMORTAL’ with Applicant’s stylized jellyfish design does not avoid a likelihood of confusion.” *Id.* at 13-14. Applicant argues that “[w]hile the Cited Mark may be protected in all stylizations of *font* that replace a standard Latin character, the Cited Mark is not protected by a *design* that is placed in the position that a Latin character otherwise would have been.” *Id.* at 14.

Finally, citing the actual use of the involved marks on specimens, Applicant argues that the “marks are even more different as they appear in the marketplace,” *id.* at 16, and that the marks have different connotations and overall commercial impressions because the cited mark “refers to ‘immortal’ Zinfandel vines that are 120

²⁴ July 23, 2019 Denial of Request for Reconsideration at TSDR 1. As discussed below, the Examining Attorney maintained this position on appeal.

years old,” *id.* at 17, while “Applicant’s stylized jellyfish is clearly the dominant element of Applicant’s Mark and a consumer must carefully examine the Mark before realizing the letters in conjunction with a jellyfish form the term ‘IMMORTAL.’” *Id.*

In its reply brief, Applicant argues that the cited mark “is suggestive of the nature of Registrant’s old Zinfandel wine,” and is also “a play on words of ‘the immortal sin,’ creating a completely different meaning” from Applicant’s mark, 11 TTABVUE 8, which Applicant argues “is wholly arbitrary as applied to wine.” *Id.* Applicant also argues on reply that the marks are different in sound because “Applicant’s Mark does not contain two of the three words present in the Cited Mark,” *id.*, although Applicant also “recogniz[es] the aural similarities” between the marks. *Id.* at 9.

The Examining Attorney argues that Applicant’s “mark consists of wording that has the appearance of incorporating a design element in place of a central letter ‘O’ in the wording ‘IMMORTAL.’” 10 TTABVUE 6. He acknowledges that “where a pictorial representation is so highly stylized or abstract that it would not readily evoke in the consumer’s mind the wording featured in another mark, the marks may not be confusingly similar,” *id.*, but argues that in Applicant’s mark, “the design readily evokes in the mind of the consumer a letter ‘O’ within applicant’s own mark; the design itself does not evoke wording in another mark.” *Id.* at 6-7. He argues that “consumers are likely to refer to applicant’s mark as ‘IMMORTAL’ rather than reading it as ‘IMM-jellyfish-RTAL’ or referring to the goods by the jellyfish design alone, especially given the presence of word elements in the mark,” *id.* at 7, and concludes that “the design does not obviate the similarity between the marks.” *Id.*

The Examining Attorney also argues that the word IMMORTAL is the dominant portion of the cited mark because the mark “contains descriptive text, ‘ZIN’, which the registrant has disclaimed, as well as the wording ‘THE’ at the beginning of the mark,” *id.* at 8, which the Examining Attorney argues “will generally not affect or otherwise diminish the overall similarity between the marks.” *Id.* According to the Examining Attorney, “the distinctive wording ‘IMMORTAL’ in the registered mark is simply rendered the most significant element and given the most weight in determining that mark’s overall commercial impression; it is not the only element regarded.” *Id.* at 9.

The Examining Attorney further argues that the registrant “is permitted to display its registered mark in any manner it desires, including in a manner highly similar to applicant’s proposed mark, including incorporating a jellyfish design in a similar position within its mark.” *Id.* He rejects Applicant’s reliance on the actual uses of the involved marks because “the marks are compared as they appear in the *drawing* of the application and in the registration; the USPTO does not consider how an applicant and registrant actually use their marks in the marketplace.” *Id.* at 10. He concludes that “because the dominant elements of the drawing of the mark in the application and the drawing of the mark in the registration are both the wording ‘IMMORTAL,’ the marks create the same commercial impression.” *Id.*

2. Analysis of Similarity

The marks must be considered in their entirety, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, 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.” *Detroit Athletic Co.*, 128 USPQ2d at 1051 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)). As noted above, “Applicant does not dispute that ‘IMMORTAL’ is the dominant portion of the Cited Mark,” 11 TTABVue 7,²⁵ but argues that the design element of its mark, not the word IMMORTAL that is formed by the letters IMM and RTAL and the design, is the dominant portion. Because the Examining Attorney takes the contrary position, we turn first to a determination of the dominant portion of Applicant’s mark.

Applicant “acknowledges that in certain cases involving design marks, words are accorded greater weight than a design when determining whether a likelihood of confusion exists.” 8 TTABVue 11. Applicant’s argument suggests that such cases are the exception, not the rule, but generally “[i]n the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.” *Viterra*, 101 USPQ2d at 1908 (quoting *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). As the Board explained in *Aquitaine Wine*, “the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Aquitaine Wine*,

²⁵ In that regard, we note that the definite article THE, and the descriptive and disclaimed term ZIN, which is an abbreviation of “zinfandel,” “are not distinctive terms, and they add no source-identifying significance to the mark as a whole.” *In re The Place, Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (finding that the words THE and BAR in the mark THE GREATEST BAR added no source-identifying significance to the mark).

126 USPQ2d at 1184. For the reasons discussed below, we find that the general principle set forth in *Viterra* applies to Applicant's mark.

In *Viterra*, the Federal Circuit reviewed the Board's finding that the applicant's standard character mark XCEED was similar to the cited composite mark shown below:



The Board had found that “the literal portion of the X-Seed Mark (i.e., the words ‘X-Seed’) formed the dominant portion of the registrant’s mark.” *Viterra*, 101 USPQ2d at 1911. The applicant challenged that finding on appeal, arguing that “the dominant portion of the X-Seed Mark actually is the stylized letter ‘X’ and cannot include ‘-Seed,’ particularly because the registrant uses a hyphen to separate ‘X’ from ‘Seed’ and disclaimed the term ‘Seed.’” *Id.* The Federal Circuit rejected that argument because

the design feature of the X-Seed Mark is not entirely distinct from the literal portion of the mark; rather, the color and design features are incorporated in the letter “X” and are covered in part by the “-Seed” portion of the mark. This is not a case, therefore, where a larger design is separate and independent from the literal features of the mark. The design itself is a stylized letter that overlaps with, and is covered by, other literal portions of the mark. Accordingly, the Board's determination that the entire literal portion “X-Seed” is the dominant portion of the mark, and not just the stylized “X,” is supported by substantial evidence.

Id.

Applicant's mark is shown again below for ease of reference in following our analysis:



Applicant “does not dispute that the immortal jellyfish design replaces the Latin character ‘O,’” 11 TTABUVE 4, and, as with the mark in *Viterra*, the design element in Applicant's mark is integrated into and forms a part of the word element. Indeed, there would be no identifiable word in the mark without the design.

Applicant argues that this case is an exception to the general principle set forth in *Viterra* because its mark is similar in nature to the composite marks in various cases in which the Board has found that the general principle did not apply. Applicant cites *Jack Wolfskin*; *In re Serac, Inc.*, 218 USPQ 340 (TTAB 1983); *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014); *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009); *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987); and *In re Primeway Int'l LLC*, Serial No. 87059786 (TTAB Jan. 9, 2019) (non-precedential).²⁶

²⁶ Non-precedential decisions are not binding on the Board, *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, *3 n.23 (TTAB 2020), “but may be cited for whatever persuasive weight to which they are entitled.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section 101.03 (June 2019).

8 TTABVUE 12-13. At the oral hearing, Applicant’s counsel also discussed the Board’s recent decision in *In re Information Builders Inc.*, 2020 USPQ2d 10444 (TTAB 2020), which issued after the close of briefing in this appeal. It is axiomatic that “[e]ach case must be decided on its own facts and the differences are often subtle ones,” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, *2 (TTAB 2019) (quoting *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973)), but the cited composite mark cases are distinguishable in any event.²⁷

As shown in Applicant’s appeal brief, 8 TTABVUE 12-13, the *White Rock Distilleries*, *Parfums de Coeur*, *Steve’s Ice Cream*, and *Primeway* cases cited by Applicant all involved marks “where a larger design [was] separate and independent from the literal features of the mark[s].” *Viterra*, 101 USPQ2d at 1911. The opposer’s mark in *Jack Wolfskin*, which we display below, was similarly “separate and independent from the literal features of the mark.” *Id.*:



Jack Wolfskin, 116 USPQ2d at 1131.

In the *Covalinski* case cited by Applicant, the Board found that the mark shown below

²⁷ The cited *Serac* case did not involve a composite mark, but rather a design mark that the examining attorney contended was a ram’s head and thus the pictorial equivalent of the cited word mark RAM’S HEAD. The majority of the divided Board panel found that “the design mark before us is so highly stylized that an image of a ram’s head would not be immediately discerned and the connection with ‘RAM’S HEAD’ would not be readily evoked with the resulting generation of a likelihood of source confusion.” *Serac*, 218 USPQ at 341.



was “dominated by its design features, particularly the double-letter RR configuration.” *Covalinski*, 113 USPQ2d at 1169. The Board held that “these graphic devices serve not only to draw attention to the RR letters apart from the wording, but also make the letters that form the ‘a-c-e’ of the word ‘RACEGIRL’ difficult to notice.” *Id.* at 1168. The jellyfish design that is integrated into Applicant’s mark is intended to form the word IMMORTAL, not to make the word “difficult to notice.” *Id.*

Applicant’s mark here is most similar in nature to the applicant’s mark in the *Information Builders* case, which is shown below:



As in Applicant’s mark here, the design element of the applicant’s mark in *Information Builders* “function[ed] as the letter ‘O’.” *Information Builders*, 2020 USPQ2d 10444 at *7. Registration was refused based on the cited design mark shown below, which was registered for legally identical goods:



The Board affirmed the refusal to register, “recogniz[ing] that greater weight is often given to the wording in a mark because it is the wording that purchasers often use to refer to or request the goods or services,” *id.*, but instead giving greater weight to the design element in the applicant’s mark. *Id.* at *7-8. In doing so, the Board found that “the record demonstrates that the terms ‘INFORMATION’ and ‘BUILDERS’ individually are descriptive in relation to Applicant’s goods and services, which relate to building information systems, and fail to create a meaningful, distinguishable overall commercial impression to avoid a finding of likelihood of confusion.” *Id.* at *7.²⁸

Here, by contrast, the word IMMORTAL that is formed by the letters and design in Applicant’s mark is not descriptive of the identified goods, and as discussed below, the record shows that the word formed by the letters and design, not the design itself, is the “portion of the mark [that] is the one most likely to indicate the origin of the goods to which it is affixed,” *Viterra*, 101 USPQ2d at 1908 (quoting *CBS*, 218 USPQ at 200), and “to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Aquitaine Wine*, 126 USPQ2d at 1184.

²⁸ During examination of the subject application in *Information Builders*, the examining attorney required the applicant “to disclaim the wording INFORMATION BUILDERS apart from the mark as shown on the ground that the wording, in its entirety, [was] merely descriptive of [the applicant’s] goods and services.” *Information Builders*, 2020 USPQ2d 10444 at *10. The applicant “did not provide the disclaimer as required,” *id.*, but instead disclaimed the words INFORMATION and BUILDERS separately. *Id.* The Board found that this disclaimer was a concession “that the terms INFORMATION and BUILDERS, when considered individually, are merely descriptive of Applicant’s identified goods and services.” *Id.* at *7.

Applicant describes its mark as “consist[ing] of the black wording ‘IMMORTAL’, where the ‘O’ is depicted by the stylized immortal jellyfish.”²⁹ The *Viterra* court explained that such a “literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers,” *Viterra*, 101 USPQ2d at 1908, and the record shows that to be the case here, as Applicant promotes its wine as “Immortal” wine, not as “Immortal Jellyfish” or “Jellyfish” wine.

Mr. Martin’s declaration refers to Applicant’s wine as its “new Immortal brand” and “Immortal,” and to Applicant itself as “Immortal.” Martin Decl. ¶¶ 6, 10-11. He states that Applicant has “sold our 2014 Slope ‘Immortal’ wine bearing the applied-for mark since March of 2019.” Martin Decl. ¶ 8; Ex. A. The referenced packaging displays the applied-for composite mark on the front label and the word IMMORTAL on the back label in what appears to be the same font as the lettering in the application drawing and in the composite mark that appears on the front label:

²⁹ June 14, 2019 Request for Reconsideration at TSDR 16. Applicant argues that “[w]hen analyzing a design mark, it is the drawing of the mark, as opposed to the words used in describing the mark, that determines what the mark is.” 8 TTABVUE 10 (citing Trademark Rule 2.52, 37 C.F.R. § 2.52; *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1488 (TTAB 2017); and *In re Change Wind Corp.*, 123 USPQ2d 1453, 1459 n.6 (TTAB 2017)). The *Kohler* and *Change Wind* cases are inapposite because they were functionality cases in which the applicants improperly attempted to narrow the scope of their product configuration marks from what was shown in the application drawings to their narrower descriptions of the marks. Nevertheless, we agree with Applicant that the drawing of its mark shows what it seeks to register, and that its description of its mark, which is unknown to consumers, does not control how the mark will be perceived. *See Serac*, 218 USPQ at 342. The description does reflect, however, how **Applicant** perceives its mark and, as discussed below, Applicant uses the word “Immortal,” not the word “jellyfish” or the jellyfish design, to identify its wines in public-facing materials and communications.



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Applicant's website at immortalestate.com also uses "Immortal Estate," "Immortal Vineyard," and "Immortal" to refer to Applicant and its wines.³¹ Various articles accessible through Applicant's website similarly use "Immortal Estate" and "Immortal."³² A number of these articles refer to the immortal jellyfish and a few

³⁰ Martin Decl. ¶ 11; Ex. B (June 14, 2019 Request for Reconsideration at TSDR 103-04). The word IMMORTAL also appears to be displayed in the same font on the neck label of at least one of Applicant's wines. *Id.* at TSDR 74.

³¹ Martin Decl. Ex. A (June 14, 2019 Request for Reconsideration at TSDR 22-24, 31, 37, 100).

³² *Id.* at TSDR 40 (Lonny.com article referring to "Immortal Estate"), 44-46 (*Gentry* magazine article referring to "Immortal Estate"), 48-49 (*Robb Report* article referring to "The Immortal Collector Pack" of an etched magnum and two 750ml bottles), 51-53 (*1 Wine Dude* article discussing the jellyfish on the label of "2014 Immortal Estate Cabernet Sauvignon"), 64-66 (winetraveler.com article quoting a representative of Applicant referring to "[t]he new Immortal brand" and "The Immortal Brand [that] officially launched July 10, 2018 with the flagship wine Impassible Mountain"), 67-69 (*Capture* magazine article interviewing Mr. Martin and asking him to describe "the style of Immortal's new release-the Impassible Mountain Reserve"), 71-73 (auvedaily.com article entitled "Immortal Wines Shows the Wine Industry How to do Sonoma Cabernet" and stating that "*Impassible Mountain*, Immortal Wine's signature Cabernet, has received rave reviews from critics and collectors alike," that "*Slope*, the other Cabernet in Immortal's debut collection, is a more accessible option for wine lovers to enjoy," and that Mr. Martin is "excited about the many business possibilities that Immortal has to offer"), 86 (press release in *Advisor Wine Industry Network* with the headline "Immortal Estate to Launch First Wines"), 88-91 (*Napa Valley Register* article with the headline "Immortal: a Sonoma Cabernet Sauvignon worth finding," referring to Applicant's

show it, or the stylized design in the applied-for mark, but none of them uses the words “Immortal Jellyfish” or “Jellyfish” to refer to Applicant or its wines.

We infer from these uses of “Immortal” by Applicant and the media that consumers will similarly use “Immortal,” not “Immortal Jellyfish” or “Jellyfish,” to refer to Applicant or its wines. *See CBS*, 218 USPQ at 200 (finding that it is “particularly true” that the “verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed . . . when a mark appears in textual material . . . in which it is often impossible or impractical to include the design features of the mark.”). Use of “Immortal” to refer to and to call for Applicant’s wines is especially likely in bars and restaurants, channels of trade in which we must assume that goods identified as “wine” are sold notwithstanding Applicant’s current actual marketing practices, *Stawski*, 129 USPQ2d at 1053-54, because in those on-premise channels of trade, wines appear on lists or menus, and customers may never see bottle labels. *Aquitaine Wine*, 126 USPQ2d at 1185 (“if the wine were ordered by the glass from a wine list, as in a restaurant, which typically shows only the names of available wines, the image would not be available to the consumer.”);³³ *cf. Bay State Brewing*, 117 USPQ2d at 1960-61 (finding that beer “is often ordered by name, in a

wines and winery as “Immortal,” and stating that “[w]hile searching for the right graphic or imagery to represent the new name, Martin happened upon the perfect subject to grace the new labels: The Immortal Jellyfish”).

³³ Applicant’s claim that on a wine list or menu, “the owner or vineyard name is always included along with the region,” 11 TTABVUE 9, is “unsupported by sworn statements or other evidence, and [a]ttorney argument is no substitute for evidence.” *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, *15 (TTAB 2019) (quoting *Cai*, 127 USPQ2d at 1799 (internal quotation omitted)).

bar or restaurant, or from a menu, where only the name of the beer will be used” and that “[m]any consumers ordering these goods from a bartender or waiter/waitress will not have the opportunity to see a label when they order the product.”).

The nature of the applied-for mark and the involved goods, and the uses of “Immortal” by Applicant and others to refer to Applicant’s wines, including Applicant’s use of the word “IMMORTAL” on the same bottle of wine on which the applied-for mark appears, provide rational reasons to find that the word IMMORTAL formed by the letters and design in Applicant’s mark, and not the jellyfish design itself, is the dominant portion of the mark. *Aquitaine Wine*, 126 USPQ2d at 1185. We turn now to the required comparison of the marks “in their entirety as to appearance, sound, connotation and commercial impression,” *Palm Bay Imps.*, 73 USPQ2d at 1691, giving greater weight in that comparison to the word IMMORTAL that is common to the marks than to their other elements.

With respect to appearance, we agree with Applicant that there are differences between the cited standard character mark THE IMMORTAL ZIN and Applicant’s stylized mark. Although both marks contain the word IMMORTAL, the jellyfish design that helps to form it in Applicant’s mark is a striking visual element that has no counterpart in the cited mark. We further agree with Applicant, 11 TTABVUE 7-8, that the Examining Attorney is incorrect in arguing that the cited “registrant is permitted to display its registered mark in any manner it desires, including in a manner highly similar to applicant’s proposed mark, including incorporating a jellyfish design in a similar position within its mark.” 10 TTABVUE 9. In *Aquitaine*

Wine, the Board held that “when we are comparing a standard character mark to a word + design mark for Section 2(d) purposes, we will consider variations of the depictions of the standard character mark *only with regard to* ‘font style, size, or color’ of the ‘words, letters, numbers, or any combination thereof,” *Aquitaine Wine*, 126 USPQ2d at 1187, noting that in *Viterra*, the Federal Circuit had “addressed only the fact that applicant’s standard character mark could be depicted in the stylized fashion of the *literal* portion of registrant’s design mark; the court did not extend that finding to the background ‘splatter’ dot design of the registrant’s mark.” *Id.* at 1186-87 (citing *Viterra*, 101 USPQ2d at 1911 n.4). Accordingly, while we must assume that the words in the cited standard character mark THE IMMORTAL ZIN could be displayed in the same font style of the letters IMM and RTAL in Applicant’s mark, we cannot similarly assume that the letter “O” in the cited mark could be displayed as the immortal jellyfish or as another design.

As the Board noted in *Aquitaine Wine*, wine marks may appear without accompanying designs on menus and wine lists, *Aquitaine Wine*, 126 USPQ2d at 1185, but we must compare Applicant’s mark as shown in the drawing to the cited standard character mark as it may be displayed in the font style of the letters in Applicant’s mark. *Id.* at 1185-86. We find, in that comparison, that the marks are more dissimilar than similar in appearance because of the presence of the jellyfish design in Applicant’s mark.

With respect to sound, because “[a] design is viewed, not spoken,” *In re Electrolyte Labs., Inc.* 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990), Applicant’s mark

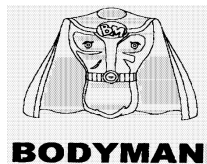
will be verbalized as the word IMMORTAL, without articulation of the jellyfish design that is integrated into the word and helps to form it. The cited mark contains the three words THE IMMORTAL ZIN, but “consumers often have a propensity to shorten marks when ordering them orally.” *Aquitaine Wine*, 126 USPQ2d at 1188 (finding that consumers “may order Registrant’s wines, especially if purchased by the glass, under the designation LAROQUE alone” and not by reference to the entire cited mark CHATEAU LAROQUE).

When Applicant’s mark is verbalized as “IMMORTAL,” it is identical in sound to the dominant word “IMMORTAL” in the cited mark, which is the key source-identifier when the mark “THE IMMORTAL ZIN” is verbalized, especially from the standpoint of a consumer with a “general rather than specific impression” of the sound of the cited mark. *i.am.symbolic*, 127 USPQ2d at 1630. The close similarity of the marks in sound is critical to our analysis of the likelihood of confusion because alcoholic beverages such as wine are goods “of the type ordered verbally in bars and restaurants,” *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (discussing malt liquor, beer, ale, and cognac brandy); *see also Bay State Brewing*, 117 USPQ2d at 1960 (taking judicial notice that beer is “often ordered orally in a bar or restaurant”), and because wine is frequently recommended and referred to by word of mouth. *Cf. In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (restaurants are often recommended by word of mouth and referred to orally).³⁴

³⁴ As noted above, Applicant argues that “consumers viewing Applicant’s mark will immediately focus on the large, colorful jellyfish displayed at the center of Applicant’s mark” before noticing that the jellyfish forms the word IMMORTAL, 8 TTABVUE 11-12, suggesting that the design and its appearance are more significant under the first *DuPont* factor than

Finally, with respect to connotation and commercial impression, Applicant's argument for dissimilarity in its appeal brief focuses on the actual use of the cited mark THE IMMORTAL ZIN on bottles and labels, 8 TTABVUE 15-17, which we cannot consider. *Aquitaine Wine*, 126 USPQ2d at 1185-86. In its reply brief, Applicant argues that THE IMMORTAL ZIN "is suggestive of the nature of Registrant's old Zinfandel wine," and is also "a play on words of 'the immortal sin,' creating a completely different meaning" from Applicant's mark, 11 TTABVUE 8, which Applicant argues "is wholly arbitrary as applied to wine." *Id.* Applicant appears to argue that in its mark, the word IMMORTAL refers only to a jellyfish because "even consumers unaware of the specific jellyfish species will nonetheless make an

the word and its sound. In the *Parfums de Couer* case cited by Applicant, the Board found that the differences in appearance between the standard character mark BOD MAN for fragrances and the mark shown below for entertainment services in the nature of animated television series



were more significant in the analysis of the first *DuPont* factor than the similarities in sound between the marks, which the Board found to be "much stronger than the similarities in appearance," *Parfums de Couer*, 83 USPQ2d at 1016, because "television is a visual medium," and "the 'consumers' of applicant's show, i.e., the viewers, will see the mark, and see the prominent design element." *Id.* at 1016-17. The Board found that even if such consumers "recommend the program to others by word of mouth, it will be a recommendation for a television program, not for a fragrance product," and that "for those consumers who have no familiarity with applicant's mark other than hearing it referred to as the name of an animated television series, if they encounter opposer's fragrance products sold under the mark BOD or BOD MAN, because of the differences between men's fragrances and an animated cartoon series . . . they would have no basis to associate the fragrance products with the television series." *Id.* at 1017. The Board found, as a result, that "the similarity in the sound of the marks is not a dispositive factor when the marks are compared in their entireties." *Id.* Here, by contrast, the goods are identical and are prone to purchase and recommendation by word of mouth, and the similarity in sound is more significant than the dissimilarity in appearance.

association with a jellyfish based on the Applicant's design alone" and a "consumer need not conduct external research as the Examiner contends to determine that a jellyfish comprises Applicant's Mark." 8 TTABVUE 17.

Applicant's suggestion that IMMORTAL means one thing in its mark and a "vastly different" thing in the cited mark, *id.* at 18, is unsupported and unpersuasive. The Board may take judicial notice of dictionary definitions, including from online dictionaries, *see, e.g., In re Omniome, Inc.*, 2020 USPQ2d 3222, *2 n.17 (TTAB 2019), and we take judicial notice that the adjective "immortal" means, *inter alia*, "living or lasting forever."³⁵ No wine literally "liv[es] or last[s] forever," of course, but the word IMMORTAL in both marks has a similar figurative connotation that the wines are long-lasting and timeless. In that regard, Mr. Martin described the significance of Applicant's mark as follows:

Our new Immortal brand was created as a tribute to all things timeless. With Immortal, my business partner Randy Nichols and I, along with Timothy Milos, have aimed to create something beautiful that will outlive those currently working to conceive it. . . . The immortal jellyfish is the only animal on the planet we know of that can live forever. It continuously reproduces its cell back to a youth state. Our mission at Immortal is to continue to reproduce our energy into this vineyard with wines that will last longer than the team creating them. We may be gone 50 years from now, but the wines we create will still be very much alive and drinkable. Our hard work and legacy will be left behind in each of the bottles we artfully produce.

Martin Decl. ¶ 6.³⁶

³⁵ CAMBRIDGE DICTIONARY (dictionary.cambridge.org, last accessed on June 24, 2020).

³⁶ The record suggests that wine drinkers may not recognize the jellyfish in Applicant's mark as the "immortal" jellyfish, as this particular jellyfish appears to be relatively obscure. The *Robb Report* article states that "[i]t turns out there's a miniscule species with capability of

The record does not show that the dominant word IMMORTAL in the cited mark THE IMMORTAL ZIN has a materially different meaning from its meaning in Applicant's mark. Applicant offers no evidence regarding the meaning or public recognition of the phrase "the immortal sin" that Applicant claims is evoked by the cited mark,³⁷ and while the word ZIN in the cited mark is a recognized abbreviation of "zinfandel" that has been disclaimed, there is nothing on the face of the cited mark suggesting that the adjective IMMORTAL that modifies ZIN connotes "old" or

reverting to its primitive, polyp stage and then forming a new polyp colony, theoretically living forever." June 14, 2019 Request for Reconsideration at TSDR 49. The *1 Wine Dude* article states that Applicant's label bears "[n]ot just any jellyfish . . . but the small *Turritopsis dohrnii*, which possesses the Medusozoa equivalency of near immortality. There's no good way of explaining this, so I'll point you to an excerpt from www.immortal-jellyfish.com . . ." *Id.* at TSDR 52. The *Capture* magazine article quotes Mr. Martin as stating that after he began thinking that his "vineyard seemed to take on a spirit of immortality in my mind," he "stumbled onto information about the Immortal Jellyfish, which when it gets old reproduces itself." *Id.* at TSDR 69. An article in *California Home + Design* states that the "longevity of the wine inspired Martin to select for its logo the elusive and immortal *Turritopsis Dohrnii* jellyfish. For more information check the website." *Id.* at TSDR 77. The *Napa Valley Register* article states that "[w]hile searching for the right graphic or imagery to represent the new name, Martin happened upon the perfect subject to grace the new labels: the Immortal Jellyfish. Yes, it's a real living thing." *Id.* at TSDR 91. A *Discover* magazine article regarding the immortal jellyfish states that the "story of the immortal jellyfish starts in 1988" and that the species is the subject of ongoing scientific inquiry. Francis Decl. ¶ 2; Ex. A (*Id.* at TSDR 109-13). To the extent that the jellyfish design in Applicant's mark is recognized as the immortal jellyfish, however, the design simply reinforces the meaning of the word IMMORTAL that it helps form. *In re Wine Soc'y of Am.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (the "design features merely emphasize, in a pictorial way, the main word portion of the cited mark."). As Mr. Martin put it in an interview with *Forbes* magazine, "[l]ike the immortal jellyfish on our labels, we want clients' memories with Immortal Estate wines to live forever." June 14, 2019 Request for Reconsideration at TSDR 82.

³⁷ We take judicial notice that a "mortal sin" is "a sin (such as murder) that is deliberately committed and is of such serious consequence according to Thomist theology that it deprives the soul of sanctifying grace." MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on June 22, 2020). We also take judicial notice of the absence of a definition for the term "immortal sin" advanced by Applicant. Applicant has not argued, much less shown, that the cited mark suggests the term "mortal sin."

“gnarly” zinfandel grapes, or wine made from such grapes. The cited mark THE IMMORTAL ZIN connotes a zinfandel wine that is long-lasting or timeless.³⁸

The marks “must be considered . . . in light of the fallibility of human memory’ and ‘not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). As noted above, we must assume use of Applicant’s mark with all varietals, including zinfandel wine. A consumer with a “general rather than specific impression” of the cited mark THE IMMORTAL ZIN, *i.am.symbolic*, 127 USPQ2d at 1630, who separately encounters Applicant’s mark for a zinfandel wine would be likely to believe that the marks are one and the same, but even if the consumer encountered Applicant’s mark for a cabernet sauvignon wine or some other non-zinfandel varietal, he or she “may believe that [A]pplicant’s mark is a variation of [the cited] mark that [the registrant] has adopted for use on a different [wine].” *Schieffelin & Co.*, 9 USPQ2d at 2073. We find that the marks are quite similar in connotation and commercial impression.

³⁸ Applicant argues that the claimed “very different connotations and . . . vastly different commercial impressions” of the marks are “especially true since the Applicant’s and Registrant’s goods are not sold side-by-side and the price points for their different types of wines differ in one instance by hundreds of dollars.” 8 TTABVue 18 n.2. As discussed above, because neither identification contains any limitations to a particular type of wine sold in a particular channel of trade at a particular price point, we must assume that the identifications cover all types of wine sold in all customary channels of trade at all price points, and we thus must assume that Applicant’s mark could be used with zinfandel wine, perhaps combined with other varietals, in addition to the cabernet sauvignon wine that Applicant currently sells. “Parties that choose to recite [goods] in their trademark application that exceed their actual [goods] will be held to the broader scope of the application.” *Stone Lion*, 110 USPQ2d at 1163 (citation omitted).

Although the marks differ in appearance, they are quite similar in sound, connotation, and commercial impression, and the first *DuPont* factor supports a finding of a likelihood of confusion.

C. Purchase Conditions and the Degree of Purchaser Care

“The fourth DuPont factor considers ‘[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.’” *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567).

Without explicitly referring to the fourth factor, Applicant argues that “[t]he law assumes that the ordinary buyer acts with some degree of care to see that he or she gets the brand of product or service desired.” 8 TTABVUE 18 (citing 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23.93 (citing *Hiram Walker & Sons, Inc. v. Penn-Maryland Corp.*, 79 F.2d 836, 839 (2d Cir. 1935)). Applicant avers that “Applicant and Registrant do not sell wines at the same ‘grocery stores’ or at the same winery, and it is highly unlikely that they will be available in the same liquor store, on the same website or anywhere else,” *id.*, and argues “[w]hile both parties operate separate and distinct websites for their wineries where their respective consumers can purchase wine, there is no chance that Internet customers will be confused regarding the source or origin of the parties’ respective goods.” *Id.* Applicant argues that it “only sells one type of wine—Cabernet Sauvignon—on its website;” that its wines “range in price from \$97-\$303 per bottle;” that a “consumer that purchases Applicant’s wine through Applicant’s website, or at Applicant’s private tastings or dinners, is an individual willing to spend a substantial amount of money to purchase

Applicant's wine;" and that such "individuals will not likely believe Applicant is affiliated with or sponsored by Registrant and there is zero chance that a reasonably prudent buyer who is not indifferent or foolish will make an impulse purchase of Applicant's \$97-\$303 per-bottle wine at a grocery store, where Applicant's wine is not sold." *Id.* at 19.

Applicant's focus on the claimed sophistication of its actual current customers is improper. In *Stone Lion*, which involved legally identical investment advisory, investment fund management, and capital investment consultation services, the Federal Circuit held that the Board properly "focused on the sophistication of all *potential* customers of the parties' services as they are recited in the application and registrations," *Stone Lion*, 110 USPQ2d at 1162 (quotation omitted), not just the parties' actual customers for their services, who the parties agreed were sophisticated. *Id.* The court recognized that "Board precedent requires the decision to be based 'on the least sophisticated potential purchasers'" of the goods or services as they are identified in the subject application and registration. *Id.* at 1163 (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (T.T.A.B. 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)).

Applicant's arguments are also similar to ones that were rejected in *Bercut-Vandervoort*. As in that case, "[b]oth applicant's goods and the goods covered by the cited registration are identified as wine," *Bercut-Vandervoort*, 229 USPQ at 764, and "Applicant does not dispute the identity of the goods but, rather, argues that its wine . . . [is] expensive, high-quality wine sold to a small group of extremely sophisticated

wine connoisseurs” and “that these well-informed consumers,” *id.*, will not be confused as to the source or sponsorship of Applicant’s wine. “The problem with this argument is that [A]pplicant is attempting to restrict the scope of its goods in its application and the scope of the goods covered in the cited registration by extrinsic argument and evidence while neither the recitation of goods in [A]pplicant’s application nor the recitation of goods in the cited registration is so restricted.” *Id.* “[T]he question of likelihood of confusion must be determined by an analysis of the marks as applied to the goods identified in the application vis-a-vis the goods recited in the registration, rather than what extrinsic evidence shows those goods to be.” *Id.* at 764-65. As noted above, “[p]arties that choose to recite [goods] in their trademark application that exceed their actual [goods] will be held to the broader scope of the application.” *Stone Lion*, 110 USPQ2d at 1163. Accordingly, Applicant’s evidence and argument that its wine is an expensive one sold “to discriminating, sophisticated purchasers . . . must be disregarded since there is no restriction in the application or registration limiting the goods to particular channels of trade or classes of customers.” *Bercut-Vandervoort*, 229 USPQ at 765.

As noted above, we must determine the degree of care that will be exercised by the least sophisticated potential purchasers of goods, and “[w]e emphasize again that we are bound by the identifications, which are not limited to particular [wines].” *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, *5 (TTAB 2020). “[W]here, as here, the goods are identified without any limitations as to trade channels, classes of consumers or conditions of sale, we must presume that Applicant’s and Registrant’s

wine encompasses inexpensive or moderately-priced wine.” *Aquitaine Wine*, 126 USPQ2d at 1195. “Wine purchasers are not necessarily sophisticated or careful in making their purchasing decisions,” *id.*, and because “there is no restriction in the subject application[] and registration as to price or quality, there is no reason to infer that the consumers or purchasers of these alcoholic beverages will be particularly discriminating or careful in distinguishing Applicant’s wine from Registrant’s.” *Stawski*, 129 USPQ2d at 1054 (citing *Aquitaine Wine*, 126 USPQ2d at 1195; *Somerset Distilling Inc. v. Speymalt Whisky Dist. Ltd.*, 14 USPQ2d 1539, 1542 (TTAB 1989); and *Bercut-Vandervoort*, 229 USPQ at 765)). We find that the least sophisticated potential purchaser of wine will exercise at most ordinary care in purchasing, and the fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

D. The Fame of the Cited Mark

Applicant argues that “the Cited Mark is not famous,” 8 TTABVUE 24, which indirectly involves the fifth *DuPont* factor, the “fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. “Because of the nature of the evidence required to establish the fame of a registered mark, the Board does not expect Trademark Examining Attorneys to submit evidence as to the fame of the cited mark in an *ex parte* proceeding, and they do not usually do so.” *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016) (citing *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006)). “Rather, in an *ex parte* appeal the ‘fame of the mark’ factor is normally treated as neutral because the record generally includes no evidence as to fame.” *Id.* (citing *Thomas*, 79 USPQ2d at 1027 n.11; and *In re Davey Prods. Pty Ltd.*,

92 USPQ 1198, 1204 (TTAB 2009)). On this record, we will treat the fifth *DuPont* factor as neutral in our analysis of the likelihood of confusion.

E. The Number and Nature of Similar Marks in Use on Similar Goods

The sixth *DuPont* factor considers “[t]he number and nature of similar marks in use on similar goods.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Applicant claims that the Examining Attorney “failed to properly consider third-party registrations submitted by Applicant as evidence that ‘IMMORTAL’ marks are relatively weak.” 8 TTABVue 20. Applicant argues that “four third-party registrations and one third-party application containing ‘IMMORTAL’ exist on the Principal Register.” *Id.*³⁹ The marks in the referenced registrations are 8 IMMORTALS for wines, IMMORTAL HERO for wine, IMMORTAL SPIRITS & DISTILLING COMPANY and design for distilled spirits, and IMMORTAL IPA for beer.⁴⁰ Applicant also made of record specimens of the use of these registered marks from their respective file histories,⁴¹ as well as photographs of bottles of wine bearing

³⁹ “[P]ending applications are evidence only that the applications were filed on a certain date; they are not evidence of use of the marks,” *Inn at St. John’s*, 126 USPQ2d at 1745 (citations omitted), and thus are not considered under the sixth *DuPont* factor. As discussed immediately below, however, Applicant made of record photographs of bottles bearing the applied-for mark, and we will consider that evidence for whatever probative value it may have.

⁴⁰ Francis Decl. ¶¶ 7-8, 10-11; Exs. F-G, I-J (June 14, 2019 Request for Reconsideration at TSDR 123-26, 131-34).

⁴¹ Francis Decl. ¶¶ 12-13, 15-16; Exs. K-L, N-O (June 14, 2019 Request for Reconsideration at TSDR 158, 216, 501, 563). The specimens do not show current use of the registered wine marks, as they were filed with the USPTO in July 2017 (IMMORTAL HERO), and September 2013 (8 IMMORTALS), and it is not clear when the webpage showing a bottle bearing the

the MONARCH IMMORTAL mark that is shown in the pending application.⁴² Applicant’s appeal brief contains the photograph reproduced below, which shows the three third-party wines together with Applicant’s wine and the wine sold by the owner of the cited registration:

Cited Mark	IMMORTAL HERO	8 IMMORTALS*	MONARCH IMMORTAL	Applicant’s Mark
				

Id. at 21.⁴³

Applicant argues that the “coexistence of third-party applications and registrations, each covering wine or other alcoholic beverages, demonstrates that the Cited Mark can only be afforded a very narrow scope of protection,” *id.* at 22, and that

applied-for MONARCH IMMORTAL mark was downloaded. In addition, the photographs of these packages do not show the duration and extent of the uses of these marks.

⁴² Francis Decl. ¶ 18; Ex. Q (June 14, 2019 Request for Reconsideration at TSDR 620-22).

⁴³ Applicant’s mark and the cited mark are obviously irrelevant under the sixth *DuPont* factor, which focuses on the impact, if any, of third-party marks on the strength of the cited mark and its similarity to the applied-for mark.

“an ample amount of space exists for Applicant’s mark to join this field without any confusion.” *Id.*

The Examining Attorney responds that “the few third-party registrations submitted by applicant that merely contain the wording “IMMORTAL” are insufficient to establish that the wording is weak or diluted.” 10 TTABVUE 11. He further argues that the wine “marks in U.S. Registration Nos. 4456107 [8 IMMORTALS] and 5297616 [IMMORTAL HERO] feature additional registrable wording giving the marks different commercial impressions from each other and from the applicant’s and the cited registrant’s marks, and the marks in U.S. Registration Nos. 4339085 [IMMORTAL SPIRITS & DISTILLING COMPANY and design] and 4201322 [IMMORTAL IPA] are for disparate other goods.” *Id.*

“The Federal Circuit has held that evidence of the extensive registration and use of a term by others can be powerful evidence of the term’s weakness.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) (citing *Jack Wolfskin*, 116 USPQ2d at 1136; and *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). “Use evidence may reflect commercial weakness, while third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Id.*

We agree with the Examining Attorney that the handful of registrations, augmented by specimens of use of the registered marks and one additional third-party use, are insufficient to show that the cited mark is weak and “can only be

afforded a very narrow scope of protection.” 8 TTABVUE 22. Only two of the third-party registrations cover “wine,” the goods identified in the application and cited registration, and the other two third-party registrations covering distilled spirits and beer have little, if any, probative value regarding the weakness of the cited mark for wines.⁴⁴ *Inn at St. John’s*, 126 USPQ2d at 1746 (“four third-party registrations of varying probative value (two for non-identical services and the other two for non-identical terms)” were insufficient to show that the cited mark was weak); *cf. Omaha Steaks*, 128 USPQ2d at 1695 (where “the parties’ respective marks were both used on ‘meat’ products” and the Board “concluded that the parties’ goods were identical,” third-party uses on popcorn, alcoholic beverages, and other food products had “no real probative value” on the issue of the weakness of the opposer’s mark); *Information Builders*, 2020 USPQ2d 10444 at *8 (five third-party registrations that did “not identify goods and services related to the goods and services at issue” had “no bearing on the scope of protection to be accorded to Registrant’s” mark). The amount of evidence here “is a far cry from the large quantum of evidence of third-party use and

⁴⁴ With respect to the IMMORTAL IPA and IMMORTAL SPIRITS & DISTILLING COMPANY and design marks, Applicant argues that “the use of IMMORTAL for different goods in the same class (beer and spirits in Class 33) is necessarily relevant to comparison of marks that use IMMORTAL for wine in the same Class 33.” 8 TTABVUE 24. Beer is classified in Class 32, not Class 33, but “Applicant’s focus on the international classes in which the [involved] goods . . . reside is misplaced” in any event because “[t]he classes are irrelevant” to the relatedness of goods. *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, *11 n.16 (TTAB 2019) (citing *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993)). Applicant has provided no evidence or additional argument to show that beer and distilled spirits are related to wine. *See Omaha Steaks*, 128 USPQ2d at 1694. But even assuming that those alcoholic beverages are related to wine, as discussed below, the number of third-party registrations and uses in the record is miniscule in comparison to those in *Juice Generation* and *Jack Wolfskin*, and the involved marks are more similar to each other than to either of the marks for beer and distilled spirits.

third-party registration that was held to be significant in both” *Jack Wolfskin* and *Juice Generation. Inn at St. John’s*, 126 USPQ2d at 1746.⁴⁵ See also *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, *13 (TTAB 2020) (evidence of three third-party registrations, coupled with the lack of evidence of third-party use, “falls short of the ‘voluminous evidence’ that would establish” that the common ERA element of the involved marks is so commonly registered in connection with the involved goods that it is a conceptually weak term).

Moreover, none of the third-party “marks is as close to the cited mark as . . . Applicant’s mark,” *Information Builders*, 2020 USPQ2d 10444 at *8, which provides an additional reason why they “do not diminish the distinctiveness of the cited mark or its entitlement to protection against Applicant’s mark.” *Id.* The marks IMMORTAL IPA and IMMORTAL SPIRITS & DISTILLING COMPANY and design both specifically identify alcoholic beverages other than wine, while the cited mark refers specifically to wine. With respect to the wine marks, in the mark 8 IMMORTALS the word IMMORTAL appears in its plural noun form, which causes the mark as a whole to refer to eight people “who [are] so famous that they are remembered for a long time after they are dead,”⁴⁶ while the marks IMMORTAL HERO and MONARCH

⁴⁵ “We note for comparison to the registrations [and uses] here that, in *Juice Generation*, there were approximately twenty-six relevant, third-party uses or registrations of record, see 115 USPQ2d at 1672 n.1, and in *Jack Wolfskin*, there were at least fourteen, see 116 USPQ2d at 1136 n.2.” *TPI Holdings, Inc. v. Trailertrader.com, LLC*, 126 USPQ2d 1409, 1428 n.92 (TTAB 2018).

⁴⁶ CAMBRIDGE DICTIONARY (dictionary.cambridge.org, last accessed on June 24, 2020).

IMMORTAL similarly refer to a person. Neither of the involved marks refers to a person, immortal, heroic, regal, or otherwise.

We find that the sixth *DuPont* factor is neutral in our analysis of the likelihood of confusion. *Id.*; *Inn at St. John's*, 126 USPQ2d at 1746.⁴⁷

F. The Absence of Evidence of Actual Confusion

As discussed above,

our analysis as to the second, third, and fourth *du Pont* factors, discussing the similarity or dissimilarity of the services, channels of trade, and relevant consumers, is based, as dictated by precedent from the Federal Circuit, on the identifications **as set forth** in the application and the cited registration. The eighth *du Pont* factor, by contrast—the length of time during and conditions under which there has been concurrent use without evidence of actual confusion—requires us to look at **actual market conditions**, to the extent there is evidence of such conditions of record.

Guild Mortg., 2020 USPQ2d 10279 at *6 (quotation and quotation marks omitted).

Applicant argues that “there has never been any actual confusion despite concurrent use,” 8 TTABVUE 24, citing Mr. Martin’s declaration, in which he states that “[w]e have not received any phone calls, emails, letter, or any other type of correspondence

⁴⁷ Applicant also argues that the USPTO “strives for consistency in examining trademarks, and considering the third-party registrations cited in Applicant’s Appeal Brief were not refused based on the Cited Mark, Applicant requests that the same, consistent treatment be applied in examining’s Applicant’s Mark.” 11 TTABVUE 10. “The Board recently reiterated that ‘[w]hile we recognize that ‘consistency is highly desirable,’ . . . consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules.’” *In re Ala. Tourism Dept.*, 2020 USPQ2d 10485, *11 (TTAB 2020) (quoting *In re Am. Furniture Warehouse Co.*, 126 USPQ2d 1400, 1407 (TTAB 2018)). “We do not believe that our decision here is inconsistent with the registration of the third-party marks cited by Applicant, but to the extent that it is, it is the decision required under the statute on the record before us.” *Id.*

or communication from any third party asking or assuming we are affiliated or connected with [registrant] Peirano.” Martin Decl. ¶ 9.⁴⁸

The Martin and Francis declarations provide information regarding the “actual market conditions” that we must consider under this *DuPont* factor. Mr. Martin testified about the possible length of the period of concurrent use of the involved marks in his statements that Applicant launched its website in February 2018, that the full version of the website as it exists today went live in July 2018, that sales of a modified version of the applied-for mark commenced in October 2018, and that “sales of goods bearing the exact applied-for mark commenced in March of 2019.” Martin Decl. ¶ 10. He testified that he is familiar with the registrant and its wine sold under the cited mark THE IMMORTAL ZIN, Martin Decl. ¶ 7, and he contrasted the extent of Applicant’s and the registrant’s sales in his testimony that “we produce only approximately 4,000 12-pack cases of wine per-year, which is profoundly different than large vineyards, including Peirano’s.” Martin Decl. ¶ 9. He also testified that while “some of Applicant’s wine is in distribution which occasionally ends up for sale on sophisticated websites aimed at wine connoisseurs [sic], most sales are made via our website, wine tastings, and private dinners,” Martin Decl. ¶ 8, while “Peirano’s inexpensive Zinfandel is not available on our website, at our private wine tastings or

⁴⁸ “[I]n this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion” and “[w]e therefore are getting only half the story.” *Guild Mortg.*, 2020 USPQ2d 10279 at *7 (citing *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001)). “This constraint inherent in the ex parte context necessarily limits the potential probative value of evidence bearing on the eighth *du Pont* factor, compared with an inter partes proceeding, where the registrant has an opportunity to present argument and evidence in response.” *Id.* at *8.

at private dinners.” Martin Decl. ¶ 8. He concluded that “[w]e have absolutely zero market interface with Peirano.” Martin Decl. ¶ 9.

The “absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by [Applicant] of its mark for a significant period of time in the same markets as those served by [the registrant] under its mark[].” *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Mr. Martin’s testimony shows that the period of co-existence between the involved marks is, at most, slightly more than two years, and he asserts that Applicant’s goods and the registrant’s goods have not been sold during that period in the same channels to the same customers, and that Applicant’s wine has been produced in low volume. Applicant thus admits that there has been no use of the respective marks “for a significant period of time in the same markets,” *id.*, which makes the absence of instances of actual confusion of little probative value. *See id.* (finding that there was “simply no evidence that the parties’ goods have been sold together in the same locality for a significant period of time so that, if confusion were likely to occur, circumstances have been such that it could be expected to have happened.”); *see also Guild Mortg.*, 2020 USPQ2d 10279 at *8 (more than 40 years of concurrent use of the involved marks without reported instances of actual confusion not probative of no likelihood of confusion where there was “a lack of evidence that **in the actual marketplace**, the **same** consumers have been exposed to **both** marks for the respective services, such that we could make a finding as to the ‘length of time during and conditions under which there has been concurrent use without evidence

of actual confusion.”); *cf. In re Gen. Motors Corp.*, 23 USPQ2d 1465, 1470-71 (TTAB 1992) (holding that evidence of the absence of actual confusion for nearly 30 years was probative of no likelihood of confusion in view of a “confluence of facts,” including large sales of both sets of goods and expansion of the applicant’s use of its mark into the goods identified in the cited registration). We find that the eighth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

G. Market Interface Between Applicant and the Cited Registrant

The tenth *DuPont* factor considers the

market interface between applicant and the owner of a prior mark:

- (a) a mere “consent” to register or use.
- (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
- (c) assignment of mark, application, registration and good will of the related business.
- (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

DuPont, 177 USPQ at 567. Applicant’s brief argument that there is “zero market interface between Applicant and Registrant,” 8 TTABVUE 24, is based on the statement in the Martin Declaration noted above. Martin Decl. ¶ 9. That statement in turn reflects Applicant’s claim that it and the registrant do not sell the same types of wine in the same channels of trade to the same customers.

The tenth factor does not implicate the relatedness of the involved goods or services, channels of trade, or classes of customers, which are considered under the

second, third, and fourth *DuPont* factors based on the identifications of the goods or services in the subject application and registration, not the actual use of the involved marks. “*DuPont* lists several possible market interfaces, such as: (1) consent to register or use; (2) contractual provisions designed to preclude confusion; (3) assignment; and (4) laches and estoppel attributable to the challenger that would indicate lack of confusion.”⁴⁹ *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). *See, e.g., Bay State Brewing*, 117 USPQ2d at 1959 (noting that a consent agreement between the applicant and the cited registrant “relates to one of the *du Pont* factors, namely the market interface between Applicant and Registrant.”). “There is no indication that any evidence or argument was submitted regarding any one of these market interfaces or any other market interface. Therefore, *DuPont* requires no consideration of this factor.” *Cunningham*, 55 USPQ2d at 1847. The tenth *DuPont* factor is neutral in our analysis of the likelihood of confusion. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *15 (TTAB 2020).

H. The Extent of Potential Confusion

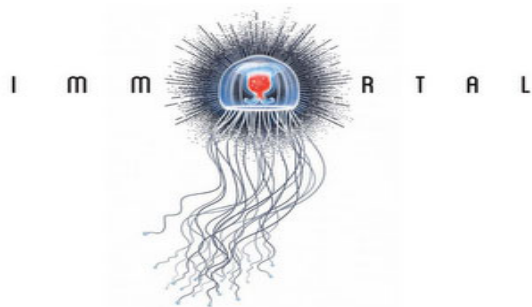
The twelfth *DuPont* factor considers the “extent of potential confusion, i.e., whether de minimis or substantial.” *DuPont*, 177 USPQ at 567. Applicant argues that “no potential confusion exists,” 8 TTABVue 24, citing the argument made in its Request for Reconsideration that “[n]o potential confusion exists in light of the

⁴⁹ A consent agreement intended to avoid confusion was at issue in *DuPont*, 177 USPQ at 568-69, but such market interfaces are present only in the relatively rare cases where there is a business or marketplace relationship between the involved parties.

parties' separate and distinct marks, goods, and trade channels.”⁵⁰ The twelfth *DuPont* factor is assessed from the standpoint of the goods identified in the application and cited registration, not from the standpoint of the actual uses of the involved marks. *Cunningham*, 55 USPQ2d at 1847. We disagree with Applicant that no potential confusion exists because, as explained above, the goods are identical and are deemed to travel in the same channels of trade to the same classes of customers. Accordingly, this factor is neutral in our analysis of the likelihood of confusion.

III. Conclusion

The first, second, and third *DuPont* factors support a finding of a likelihood of confusion. The goods, channels of trade, and classes of consumers are identical, and the marks are quite similar in sound, a key means of comparison with respect to wine, and in meaning, particularly taking into account the reduced degree of similarity required for confusion to be likely in the case of identical goods. The fourth, fifth, sixth, eighth, tenth, and twelfth *DuPont* factors are neutral. We find, on the basis of the record as a whole, that a consumer familiar with the cited mark THE IMMORTAL ZIN for wines who separately encounters Applicant's mark



⁵⁰ June 14, 2019 Request for Reconsideration at TSDR 15.

for wine is likely to believe mistakenly that those goods originate with, or are sponsored or authorized by, the owner of the cited registered mark.

Decision: The refusal to register is affirmed.