

ESTTA Tracking number: **ESTTA1005190**

Filing date: **09/27/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	87868652
Applicant	Hidden Ridge Vineyard, LLC
Applied for Mark	IMMORTAL
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Submission	Appeal Brief
Attachments	Applicant Ex Parte Appeal Brief App. No. 87868652.pdf(3765571 bytes)
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Date	09/27/2019

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No. : 87/868,652



Mark :

Applicant : Hidden Ridge Vineyard, LLC

Examining Attorney : Laura Golden
Law Office 101

APPLICANT'S *EX PARTE* APPEAL BRIEF

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I. INTRODUCTION

Applicant Hidden Ridge Vineyard, LLC (“Applicant”), appeals the Examining Attorney’s refusal

to register Applicant’s stylized trademark , which is comprised of a large colorful jellyfish with the letters IMM and RTAL on either side of the jellyfish (“Applicant’s Mark” or “Mark”) that is the subject of U.S. Application Serial No. 87/868,652 (“‘652 App.”).

The Examining Attorney has refused registration of the ‘652 App. pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d) on the basis that Applicant’s Mark is likely to cause confusion with Registrant Peirano Estate Winery, Inc.’s (“Registrant”) standard character mark “THE IMMORTAL ZIN,” which is the subject of U.S. Registration No. 4,205,173 (“‘173 Reg.”) (“Cited Mark”). Applicant submits that consumer confusion is unlikely and respectfully requests that the Examining Attorney’s Section 2(d) refusal be withdrawn.

II. PROSECUTION HISTORY

Applicant filed the ‘652 App. on April 9, 2018, seeking registration on the Principal Register for its Mark in connection with “wine” in International Class 33. *Id.*, TSDR 1-2. On April 18, 2018, Applicant received an Official USPTO Notice of Design Search Code for the ‘652 App., which identified five (5) distinguishing colors and six (6) search codes. *Id.*, TSDR 1.

On May 8, 2019, The Examining Attorney issued a Non-Final Office Action (“First Office Action”), refusing registration under Trademark Act Section 2(d) on the ground that Applicant’s Mark was likely to cause confusion with the Cited Mark because the marks were allegedly confusingly similar and the goods were related. The Examining Attorney also requested Applicant to clarify whether color was claimed as a feature of the Mark, and also modify the description of the Mark. First Office Action, TSDR 1.

On November 8, 2018, Applicant responded to the May 8, 2019 Office Action (“First ROA”) by arguing that no likelihood of confusion existed between the ‘652 App. and the ‘173 Reg. because Applicant’s Mark and the Cited Mark were different; the Cited Mark was (is) weak and entitled to a

narrow scope of protection; the consumers of the parties' respective products were (are) sophisticated; the relevant industry is highly regulated, which mitigates against a likelihood of confusion finding; and numerous other third party registrations for "Immortal" marks exist for identical and highly related goods. *Id.*, TSDR 2-7. Applicant also entered color claim and mark description. *Id.*, TSDR 7.

On December 14, 2018, the Examining Attorney issued a Final Action ("Final Office Action"), rejecting Applicant's arguments against the Examiner's Section 2(d) arguments and also requiring Applicant to submit an amended description of the Mark. *Id.*, TSDR 1.

On June 6, 2019, Applicant submitted an Amendment to Allege Use. *Id.*, TSDR 1-3. On June 14, 2019, a Notice of Acceptance of Amendment to Allege Use issued, advising Applicant its June 6, 2019 Amendment to Allege Use had been accepted. *Id.*, TSDR 1.

On June 14, 2019, Applicant submitted its Request for Reconsideration ("RFR") after Final Action, along with the June 13, 2019 Declaration of undersigned counsel Matthew D. Francis ("Francis Decl."), with Exhibits A-T, and the June 12, 2019 Declaration of Timothy Martin ("Martin Decl."), a Member of Applicant, with Exhibits A-1 – A-3, and B, which responded to the Examiner's continued Section 2(d) arguments and the Examiner's requirement of submitting an amended description of the Mark. *Id.*, TSDR 1-668; 4-5 TTABVUE. Also on June 14, 2019, Applicant filed this Ex Parte Appeal, which was acknowledged and instituted the same day. 1 & 2 TTABVUE. The Board then remanded the matter to the Examining Attorney for consideration of Applicant's Request for Reconsideration. 2 TTABVUE.

On July 23, 2019, the Examining Attorney issued a Reconsideration Letter, in which she refused registration of Applicant's Mark based on Section 2(d), but accepted Applicant's description of its Mark. *Id.*, TSDR; 6 TTABVUE. On July 30, 2019, the Board issued an order resuming this appeal. 4 TTABVUE.

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III. ARGUMENT

A. THE EXAMINING ATTORNEY HAS NOT PROVEN THAT A LIKELIHOOD OF CONFUSION EXISTS THAT WARRANTS DENIAL OF APPLICANT'S '652 APP.

Likelihood of confusion between a mark for which registration is sought and another mark is determined on a case by case basis, applying relevant factors set out in *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973). When refusing a trademark for registration on the Principal Register, the Examining Attorney has the burden of proving that the applied-for mark is likely to cause confusion with an existing registration. TMEP § 1207.01. To find a likelihood of confusion between two marks, confusion cannot be remote, or a mere possibility, and the Examiner must demonstrate a probability of likelihood of confusion among the marks. *See Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 717, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (“We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.”) (quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 U.S.P.Q. 43, 44-45 (CCPA 1969)); *see also Triumph Mach. Co. v. Kentmaster Mfg. Co., Inc.*, 1 U.S.P.Q.2d 1826, 1829 (TTAB 1987) (“The Trademark Act, however, does not talk in terms of remote possibilities of confusion but, rather, the likelihood of such confusion's occurring [sic.] in the marketplace”).

As evidenced in the RFR and discussed below, the Examining Attorney's conclusion that Applicant's Mark is likely to cause confusion with the Cited Mark is contradicted by the evidence presented by Applicant and controlling authority, and the Examining Attorney has not satisfied her burden of providing that a likelihood of confusion is probable, not just a mere possibility.

1. The First *DuPont* Factor Supports Registration of the '652 Reg. Because Applicant's Mark and the Cited Mark are Different in Their Entireties as to Appearance, Connotation, and Commercial Impression

Where marks are sufficiently dissimilar, this factor alone may be dispositive in determining whether a likelihood of confusion exists because noted differences between the subject mark outweighs the other *DuPont* factors. *See Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376,

1381-82, 119 U.S.P.Q.2d 1286, 1290 (Fed. Cir. 2016) (“a single *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 1347 (Fed. Cir. 2010) (“[E]ven if all other relevant *DuPont* factors were considered in [opposer’s] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 U.S.P.Q.2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed finding of no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where the Board relied solely on dissimilarity of marks); *Kellogg Co. v. Pack’em Enters. Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive”).

As discussed below, under the facts of this case, an analysis of the first *DuPont* factor proves 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. Applicant submits that this *DuPont* factor alone is dispositive of this appeal, but even if this were not the case, other *DuPont* factors weigh in Applicant’s favor.

(a) The Examining Attorney Erred by Finding that the Word “IMMORTAL” is the Dominant Feature of Applicant’s Mark

Trademarks must be considered and examined as a whole. *See In re National Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750 (Fed. Cir. 1985); 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (“McCarthy”) § 23:41 (5th ed. 2019) (The “anti-dissection” rule prohibits breaking composite marks into their component parts). Marks must be examined in appearance, connotation, and commercial impression in their entireties. *See Massey Junior College, Inc. v. Fashion Institute of Technology, Inc.*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273-274 (CCPA 1974); *see also Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1109, 18 U.S.P.Q.2d 1587, 1594 (6th Cir. 1991) (“It is the overall impression of the mark, not an individual feature, that counts.”).

Consumers are impressed by a mark as they see it or hear it, and they do not ordinarily stop to analyze it. *See Industria Espanola De Perlas Imitacion, S.A. v. Nat'l Silver Co.*, 459 F.2d 1049, 1052, 173 U.S.P.Q. 796, 798 (CCPA 1972), quoting *Ex parte Maya de Mexico*, 103 U.S.P.Q. 158 (Comm'r Pat. 1954) .

While the Board must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. *In re Covalinski*, 113 U.S.P.Q.2d 1166, 1168 (TTAB 2014); *see also In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 U.S.P.Q. at 751 (“[T]here 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.”).

When 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. *See Trademark Rule 2.52, 37 C.F.R. § 2.52* (“A drawing depicts the mark sought to be registered.”); *see also Kohler Co. v. Honda Giken Kogyo K.K.*, 125 U.S.P.Q.2d 1468, 1488 (TTAB 2017) (“Applicant’s application ‘drawing depicts the mark to be registered.”) (internal citations omitted)); *In re Change Wind Corp.*, 123 U.S.P.Q.2d 1453, n.6 at 1459 (TTAB 2017) (“the drawing of the mark, not the words an application uses to describe it, controls what the mark is.”). Applied to this case, the drawing of the large colorful jellyfish controls what the mark is,



not the letters “IMM” and “RTL” on either side of it:

In this case, the Examiner first erred by improperly dissecting the Cited Mark and Applicant’s Mark in determining whether a likelihood of confusion exists. The Examiner dissected “THE IMMORTAL ZIN into three separate components “THE,” “IMMORTAL,” and “ZIN” and found that Applicant’s Mark is “IMMORTAL” and design.¹ *See* 6 TTABVUE p. 5; July 23, 2019 Reconsideration



¹ Applicant’s Mark is not IMMORTAL & Design, the mark is:

Letter, TSDR. The Examiner disregarded the “THE” and “ZIN” when comparing the Cited Mark and Applicant’s Mark, and compared “IMMORTAL” to “IMMORTAL.” 6 TTABVUE p. 5. July 23, 2019 Reconsideration Letter, TSDR. This was improper since the Cited Mark “must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks” TMEP § 1213.10 (disclaimers to generic designations like ZIN or articles like THE are irrelevant when comparing marks in relation to likelihood of confusion.).

The Examiner next erred by finding that the allegedly dominant portion of Applicant’s Mark is the word “IMMORTAL,” not the jellyfish. *See* 6 TTABVUE p. 3; July 23, 2019 Reconsideration Letter, TSDR. While 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, the Board in appropriate circumstances may also “give greater weight to the design component of a composite mark.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1372, 116 U.S.P.Q.2d 1129, 1135 (Fed. Cir. 2015). 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 “RTAL” on either side of it.

The Examiner’s contention that the small, stylized lettering of “IMM” and “RTAL” on each side of jellyfish is the dominant portion of the Mark is unavailing. The mere fact that the marks at issue share the Latin lettering “IMM” and “RTAL” does not compel a likelihood of confusion finding. *See Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) (“The use of identical, even dominant, words in common does not automatically mean that two marks are similar.”). Any risk of confusion stemming from the use of “IMM – RTAL” is erased by the fact that the Applicant’s Mark is highly stylized with the centerpiece being a large, image of a jellyfish in five (5) colors, which creates a completely different commercial impression from the Cited Mark.


Without 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. Only after



examining the jellyfish, consumers may then recognize the small stylized lettering:

While the Examiner contends “consideration has been given to this element,” 6 TTABVUE p. 3; July 23, 2019 Reconsideration Letter, TSDR, the Examiner did not accord proper weight to these distinctive elements, nor did the Examiner 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.”

Where 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. TMEP § 1207.01(c)(i); *see, e.g., In re Serac, Inc.*, 218 U.S.P.Q. 340, 341 (TTAB 1983) (concluding that applicant’s design mark was “so highly stylized that an image of a ram’s head would not be immediately discerned and the connection with [the registered mark] ‘RAM’S HEAD’ would not be readily evoked with the resulting generation of a likelihood of source confusion”); *see also Jack Wolfskin*, 797 F.3d at 1372-73, 116 U.S.P.Q.2d at 1135 (Fed. Cir. 2015) (citing *In re Comput. Commc’ns, Inc.*, 484 F.2d 1392, 1393-94, 179 U.S.P.Q. 51, 52 (CCPA 1973) (the Board did not err in focusing on the design portion because the Board found the large design portion to be the mark’s “most visually prominent feature”)); *see also In re Covalinski*, 113 U.S.P.Q.2d at 1169 (no likelihood of

confusion between RACEGIRL (in standard characters) and  for clothing due to prominence of overlapping letters “R”); *In re White Rock Distilleries, Inc.*, 92 U.S.P.Q.2d 1282, 1284 (TTAB 2009) (no likelihood of confusion between VOLTA (in standard characters) for caffeine-infused



vodka and TERZA VOLTA & Design due to the prominent design in the registered mark); *Parfums de Coeur Ltd. v. Lazarus*, 83 U.S.P.Q.2d 1012, 1017-18 (TTAB 2007) (prominently displayed design of a torso wearing a cape considered to be dominant element of the mark BODYMAN &



Design **BODYMAN** because the design catches the eye and engages the viewer before the viewer looks at the word “Bodyman”); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 U.S.P.Q.2d 1477, 1478-79



(TTAB 1987) (no likelihood of confusion between **STEVE'S** for restaurant services and STEVE’S (in typed characters) for ice cream; “Even with the word ‘STEVE’S’ appearing above the hot dog figures, applicant’s mark is distinguishable from the registered mark of opposer, which is simply the word ‘STEVE’S’ in block letter form.”); *In re Primeway International LLC*, Serial No. 87059786 (January 9, 2019 Final Decision: Reversed (11 TTABVUE 8)) [not precedential] (no likelihood of confusion between



INCOGNITO (in standard characters) and STS INGONITO & Design **INGONITO** because the word “incognito is subordinate” to the dominant design of the wolf).

Like 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. Consumers will not view “IMMORTAL” as the dominant feature of Applicant’s Mark or call to mind the Cited Mark not only because the jellyfish is the dominant feature of the mark, but also because the word IMMORTAL does not exist in Applicant’s Mark, without a consumer’s exercise of imagination to transform the jellyfish into the Latin letter “O” to create the word. The Examining Attorney therefore erred by finding that the word “IMMORTAL” is the dominant feature of Applicant’s Mark.


(b) The Examining Attorney Erred by Finding that a Standard Character Mark Protects Design Elements Such as a Jellyfish


In the Reconsideration Letter, the Examining Attorney argued that since the Cited Mark is a standard character mark, it is “protected in all stylizations, including with a jellyfish standing in for its ‘O,’” and therefore the replacement of the “O” in “IMMORTAL” with Applicant’s stylized jellyfish


design does not avoid a likelihood of confusion. 6 TTABVUE p. 3; July 23, 2019 Reconsideration Letter, TSDR. The Examiner’s argument should be rejected because it is contrary to the TMEP and the cases cited by the Examiner are distinguishable.

The Cited Mark is a standard character mark that makes no “claim to any particular font style, size, or color.” See ‘173 Reg. Accordingly, “all letters and words in the [Cited Mark] are depicted in Latin characters” and the Cited Mark “does not include a design element[.]” TMEP § 807.03(a). However, the Cited Mark may appear “in any *font style*; may use bold or italicized letters; and may use both uppercase and lowercase letters . . . [.]” TMEP § 807.03(a) (emphasis added). While 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. The cases cited by the Examiner do not stand for the proposition that a standard character mark protects design elements such as a jellyfish.

In all of the authorities cited by the Examining Attorney for this proposition, the stylized marks at issue utilize a drawing clearly depicting a Latin character (i.e. a font style protected by a standard character mark), not a design that is not a Latin character such as a jellyfish. See *In Re Viterra Inc.*, 671 F.3d 1358, 1363-64, 101 U.S.P.Q.2d 1905, 1909 (Fed. Cir. 2012) (analyzing a stylized X-Seed utilizing a

large red Latin character “X” ( Seed) compared to the standard character mark XCEED); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48, 94 U.S.P.Q.2d 1257, 1260 (Fed. Cir. 2010) (analyzing a

stylized ML Mark Lees utilizing stylized Latin characters ML ( MARK LEES) compared to the standard character mark ML); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 U.S.P.Q. 937, 939 (Fed. Cir.


1983) (analyzing a stylized “Squirt” using Latin characters for SQUIRT inside a bubble ()

compared to the standard character mark “SQUIRT SQUAD”). These cases do not support the Examining Attorney’s conclusion.

Applicant’s jellyfish is a design, not a style of font or lettering. Because “a standard character claim is not acceptable where the characters form shapes or designs,” the Cited Mark is not protected in instances where a jellyfish design replaces a standard Latin character. TMEP § 807.03(c). Further, it is not reasonable to assume that the Cited Mark would be presented with the jellyfish design element appearing in the Cited Mark, especially in light of how Registrant displays the Cited Mark in commerce. Exhibit P, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 653 (.pdf format); Exhibit A-1, Martin Decl., June 14, 2019 Request for Reconsideration, TSDR 62 (.pdf format). Again, the Board is concerned with real-world practicalities, not “mere theoretical possibilities of confusion.” *Witco Chem. Co.*, 418 F.2d at 1405. The standard character Cited Mark does not protect a jellyfish or another design.

(c) The Examining Attorney Failed to Rebut Applicant’s Evidence that Applicant’s Mark and the Cited Mark Have Different Connotations and Overall Commercial Impressions

The two marks contained in the ‘173 Reg. and the ‘652 App. appear below:

Cited Mark	Applicant’s Mark
<p>THE IMMORTAL ZIN</p>	

The two marks displayed on specimens submitted by Registrant and Applicant in support of the ‘173 Reg. and the ‘652 App. respectfully, and/or as they appear in the marketplace, appear below:

Cited Mark in Marketplace	Cited Mark in ‘173 Reg.	Applicant’s Mark



Exhibit B, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149 (.pdf format) ('173 Reg. in the marketplace, with halo and wine glass water-mark); Exhibit A-1, Martin Decl., June 14, 2019 Request for Reconsideration, TSDR 62 (.pdf format); *cf* Exhibit P, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 653 (.pdf format) ('173 Reg. Section 8/15 Declaration, without halo).

As shown above, the Cited Mark as it appears in the '173 Reg. is comprised of three standard letters, "THE IMMORTAL ZIN," as opposed to Applicant's five (5) - color stylized jellyfish with "IMM" and "RTAL" on either side of it. These marks are even more different as they appear in the marketplace. Exhibit P, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 653 (.pdf format) ('173 Reg. Section 8/15 Declaration, without halo or wine-glass water-mark); Exhibit B, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149 (.pdf format) ('173 Reg. in the marketplace, with halo and wine glass water-mark); Exhibit A-1, Martin Decl., June 14, 2019 Request for Reconsideration, TSDR 62 (.pdf format). The Cited Mark is presented to the public with a halo over "The IMMORTAL ZIN" over the words "OLD WINE," or simply "The IMMORTAL ZIN" over the word "OLD WINE" and wine glasses in a water-mark behind the words "IMMORTAL ZIN." *See*

Exhibits B, D, and P, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149, 154, 653 (.pdf format); *see also* Exhibit A, November 8, 2018 Response to Office Action, TSDR 8.

Furthermore, the Cited Mark refers to “immortal” Zinfandel vines that are 120 years old. Exhibits B and D, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149, 154 (.pdf format); *see also* Exhibit A, November 8, 2018 Response to Office Action, TSDR 8. The Examiner incorrectly states that information regarding very old Zinfandel vines “is not evident on the face of the marks and is not information the consumers have when merely looking at the two marks.” *See* July 23, 2019 Reconsideration Letter, TSDR. To the contrary, consumers do in fact encounter this information when viewing the Cited Mark on the owner’s website and directly on Registrant’s wine label. *See* Exhibits B and D, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149, 154 (.pdf format); *see also* Exhibit A, November 8, 2018 Response to Office Action, TSDR 8-9. The Cited Mark, “THE IMMORTAL ZIN,” is positioned at the top of the front label, beneath which are the words “OLD VINE.” *Id.* This immediately conveys to the consumer that the wine is a Zinfandel (“Zin” for short) that is produced from old Zinfandel vines. On Registrant’s website, Registrant describes the old/immortal nature of its Zinfandel vines in conjunction with the Cited Mark by stating that the vines are “Gnarley, twisted and over 100 years old,” and also that the vines are “120-year-old Zinfandel vines.” Exhibits B and D, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149, 154 (.pdf format); *see also* Exhibit A, November 8, 2018 Response to Office Action, TSDR 9.

In contrast to the Cited Mark, 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.” When consumers initially encounter the Mark, they first see the jellyfish with “IMM” on the left side of it, and “RTAL” on the right side of it. Only after carefully examining the Mark, will consumers realize that the body of the jellyfish forms the letter “O.” At a minimum, even consumers unaware of the specific jellyfish species will nonetheless make an association with a jellyfish based on the Applicant’s design alone. A consumer need not conduct external research as the Examiner contends to determine that a jellyfish comprises Applicant’s Mark.

Consequently, when properly evaluated in context, and taking into consideration the substantial and material differences between the subject marks, the Cited Mark and Applicant's Mark have very different connotations and convey vastly different commercial impressions.² As such, consumer confusion is not likely. The Examiner therefore erred in dismissing Applicant's arguments addressing the first *DuPont* factor, which favor registration of the '652 App. and should dispose of the entire *DuPont* analysis.

2. The Examining Attorney Erred by Dismissing the Applicant's Evidence and Arguments that Ordinary Buyers Who are Not Indifferent or Foolish Will Exercise Care when Purchasing Registrant's and Applicant's Respective Goods

The "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." 4 McCarthy § 23.93, *citing Hiram Walker & Sons, Inc. v. Penn-Maryland Corporation*, 79 F.2d 836, 839 (2nd Cir. 1935). A reasonably prudent buyer is not indifferent or foolish. *See* 4 McCarthy § 23.94. In the Examiner's Reconsideration Letter, the Examiner alleges that wine purchasers are not careful purchasers and are instead prone to impulse purchases of Registrant's and Applicant's wines at grocery stores.

However, 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. Martin Decl., ¶¶ 7-8, June 14, 2019 Request for Reconsideration, TSDR 52-53 (.pdf format) & Exhibit A thereto, TSDR 54-136 (.pdf format); Exhibits C, S-T, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 152, 662-703 (.pdf format). While 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.

²This is 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. Martin Decl., ¶¶ 7-8, June 14, 2019 Request for Reconsideration, TSDR 52-53 (.pdf format) & Exhibit A thereto, TSDR 54-136 (.pdf format); Exhibits C, S-T, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 152, 662-703 (.pdf format).

Registrant's website is located at www.peirano.com, and "The Immortal Zin" is one of twelve Peirano wines available on its website. *See* Exhibits B and D, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149, 154 (.pdf format); Exhibit A, November 8, 2018 Response to Office Action, TSDR 8-9. Registrant's "The Immortal Zin" appears in stylized format with a halo that appears over "The Immortal Zin," wine glasses in a watermark behind the words, and next to information about Peirano Estate Vineyards and other information about the winemaker and tasting notes. *Id.* There is only one wine offered for sale by Registrant under the Cited Mark. *Id.* Registrant does not sell any Cabernet under the Cited Mark. *Id.* A bottle of Registrant's 2014 "The Immortal Zin" costs \$16 on the Registrant's website and as cheap as \$11.99 on www.totalwine.com. Exhibits B and E, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149, 156 (.pdf format).

By contrast, Applicant only sells one type of wine—Cabernet Sauvignon—on its website. Exhibit A, Martin Decl., June 14, 2019 Request for Reconsideration, TSDR 54-136 (.pdf format) Applicant's Cabernet Sauvignon wine bottles bear the distinctive jellyfish design and range in price from \$97-\$303 per bottle. *Id.* 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. Martin Decl., ¶8, June 14, 2019 Request for Reconsideration, TSDR 52-53 (.pdf format). These 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.

In the Reconsideration Letter, the Examiner argues that confusion is likely because "it is common for a wine producer to produce and sell various types of wine." The Examiner's argument is without merit because the facts provided by Applicant show that Applicant *only* sells its Cabernet Sauvignon at a high price point (\$97-\$303 per bottle), and Registrant *only* sells its Zinfandel at a low price point (\$16 or less). Exhibit A, Martin Decl., June 14, 2019 Request for Reconsideration, TSDR 54-136 (.pdf format); Exhibits B and E, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 149, 156 (.pdf

format). Further, Applicant does not currently sell wine below \$97 per bottle, nor does Applicant intend to lower its prices in the future. Martin Decl., ¶8, June 14, 2019 Request for Reconsideration, TSDR 52-53 (.pdf format).

Finally, in the Examiner’s Reconsideration Letter, the Examiner attempts to distinguish *Star Industries, Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 390, 75 U.S.P.Q.2d 1098, 1108 (2nd Cir. 2005), which holds that “unhurried customers in the relaxed environment of a liquor store, making decisions about \$12. to \$24. purchases, may be expected to exhibit sufficient sophistication to distinguish between [plaintiff’s] and Bacardi’s products, which are differently labeled.” As shown in the comparison above, and as discussed above, the evidence in this case proves that the labels of Registrant’s and Applicant’s wine are significantly different and this factor favors registration. *See supra*.

3. The Examining Attorney Erred by Refusing Registration of the ‘652 App. Because Numerous Other Third Party Registrations Exist for “Immortal” Trademarks

As part of the *Du Pont* analysis, the Board considers the “number and nature of similar marks in use on similar goods.” *DuPont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. The Examiner failed to properly to consider third party registrations submitted by Applicant as evidence that “IMMORTAL” marks are relatively weak.

Applicant has made a record of a number of third party registrations of marks that include the term “IMMORTAL,” owned by different entities for wine and other Class 33 goods. Exhibits F-J, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 157-169 (.pdf format). As shown below, in addition to the Cited Mark, four third-party registrations and one third-party application containing “IMMORTAL” exist on the Principal Register:

Third-Party Mark	Goods	Owner
8 IMMORTALS Registration No. 4456107	Int’l Class 33: wines	Joselito G. Real
IMMORTAL HERO Registration No. 5297616	Int’l Class 33: wine	Brandessence Limited

MONARCH IMMORTAL Serial No. 79247817	Int'l Class 33: wine	Pik Oplenac Limited liability company Topola
IMMORTAL SPIRITS & DISTILLING COMPANY & Design Registration No. 4339085 Disclaimer: "SPIRITS & DISTILLING COMPANY"	Int'l Class 33: distilled spirits	Gallagher & Carini, LLC
IMMORTAL IPA Registration No. 4201322 Disclaimer: "IPA"	Int'l Class 33: beer	Elysian Brewing Company, Inc.

Exhibits F-J, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 157-169 (.pdf format).

As depicted below, Registrant, three third party winemakers, and Applicant all coexist in the marketplace without any evidence of confusion:

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





See Exhibits K-L, P-Q, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 208, 251, 653, 703 (.pdf format).

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. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection”) (citations omitted). Because the public is accustomed to seeing a variety of marks featuring the word IMMORTAL, consumers will naturally look to other elements, including stylized design features, to distinguish the source of the goods. *See* TMEP § 1207.01(d)(iii).

The marks identified above are particularly informative: 8 IMMORTALS (not stylized), IMMORTAL HERO (not stylized), and MONARCH IMMORTAL (not stylized). Each of these marks for wine was filed *after* the Cited Mark, but none of these marks were issued a likelihood of confusion refusal based on the Cited Mark. Francis Decl. (Exhibits K-M). Additionally, IMMORTAL SPIRITS & DISTILLING COMPANY & Design (with “SPIRITS & DISTILLING COMPANY” disclaimed) and IMMORTAL IPA (un-stylized with “IPA” disclaimed) were filed after the Cited Mark and registered with disclaimers. Exhibits N-O, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 520, 606 (.pdf format) Francis Decl. (Exhibits N-O). As Applicant’s Mark is far more distinctive with a highly stylized jellyfish design that is the centerpiece of the Mark, an ample amount of space exists for Applicant’s Mark to join this field without any confusion.

In addition, the Examiner argues that IMMORTAL HERO is more distinct from Applicant’s Mark because IMMORTAL modifies the non-descriptive wording HERO to allegedly create a more distinct commercial impression than Applicant’s Mark. *See* July 23, 2019 Reconsideration Letter, TSDR. Applicant respectfully submits that the Examiner’s argument is conclusory and without the requisite amount of evidence to overcome Applicant’s arguments. Of note, the Examiner seemingly ignored Applicant’s submission of a third party registration for 8 IMMORTALS—the Examiner was unable to explain why this mark is more distinct and capable of registration than Applicant’s Mark. Exhibits F, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 158, 174 (.pdf format); July 23, 2019

Reconsideration Letter, TSDR. Applicant also submits additional evidence of MONARCH IMMORTAL for wines, which as noted above, did not receive a Section 2(d) Office Action refusal based on the Cited Mark. Exhibits H, M, Francis Decl., June 14, 2019 Request for Reconsideration, TSDR 162-165, 297-514 (.pdf format). The side-by-side comparison below clearly shows that Applicant’s Mark is a highly stylized design and far more far more distinctive mark than any of the third party citations to IMMORTAL-formative word marks, such that Applicant’s Mark is worthy of registration among these existing marks.

Cited Mark	Third-Party Registrations	Applicant’s Mark
THE IMMORTAL ZIN	IMMORTAL HERO	
THE IMMORTAL ZIN	8 Immortals	
THE IMMORTAL ZIN	MONARCH IMMORTAL	
THE IMMORTAL ZIN	Immortal IPA	

In light of the significant coexistence of Applicant’s Mark and IMMORTAL-formative marks on the Principal Register and the resulting narrow scope of protection for the Cited Mark, Applicant submits it has established that there is no likelihood of confusion with the Cited Mark due to distinct differences in the respective marks and the distinct commercial impressions created by the subject marks—namely Applicant’s stylized jellyfish design and font.

The Examining Attorney also erred when stating that “marks for use with spirits and beers” that include IMMORTAL “are entitled to a more narrow scope of protection,” but the Examining Attorney did not rely upon those “different goods, despite the similarity in the marks.” *See* July 23, 2019 Reconsideration Letter, TSDR. This analysis ignores the fact 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. *See* TMEP § 1207.01(a)(i) (goods or services need not be identical), citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 U.S.P.Q.2d 1424, 1433 (TTAB 2013) (holding GOTT LIGHT for various water beverages likely to cause confusion with GOTT and JOEL GOTT for wine). Conceding that IMMORTAL is entitled to a more narrow scope of protection

among all goods in the class necessarily favors registration of Applicant’s Mark:

4. The Remaining *DuPont* Factors Favor Registration

In the RFR, Applicant presented arguments and evidence showing that (1) the Cited Mark is not famous, (2) there has never been any actual confusion despite concurrent use (Martin Decl., ¶¶ 9-10, June 14, 2019 Request for Reconsideration, TSDR 53 (.pdf format)), (3) There is zero market interface between Applicant and Registrant (Martin Decl., ¶ 9, June 14, 2019 Request for Reconsideration, TSDR 53 (.pdf format)), and (4) no potential confusion exists. June 14, 2019 Request for Reconsideration, TSDR 49 (.pdf format). The Examiner did not respond or attempt to rebut any of these arguments. *See* 6 TTABVUE.

Furthermore, the Examiner did not address, respond to, or rebut 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. *See* Francis Decl. (Exhibit R). Under applicable law, 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 or importer. *Id.* Applicant’s wine labels all state that they are “PRODUCED & BOTTLED BY HIDDEN RIDGE VINEYARD, AMERICAN CANYON, CA.” Martin Decl., ¶ 11 June 14, 2019 Request for Reconsideration, TSDR 53 (.pdf format) & Exhibit B thereto, TSDR 138 (.pdf format). This makes clear that Applicant’s Cabernet Sauvignon is not produced or bottled by Peirano, and confusion is therefore unlikely. This undisputed evidence favors registration.

IV. CONCLUSION

For all of the foregoing reasons, Applicant respectfully requests that the Examining Attorney’s refusal to register the ‘652 App. be withdrawn, and the ‘652 App. be published for opposition.

Respectfully Submitted,

/Matthew D. Francis/

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