

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Quercus Coffee LLC
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Serial No. 88484601
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Francis John Ciaramella of Francis John Ciaramella PLLC,
for Quercus Coffee LLC.

Crystal Yi, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

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Before Taylor, Mermelstein and Heasley,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Quercus Coffee LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark QUERCUS COFFEE (with COFFEE disclaimed) for “coffee” in International Class 30.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that

¹ Application Serial No. 88484601 was filed on June 22, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use of the mark on June 1, 2017 and first use in commerce on November 1, 2017.

Applicant's mark, when used in connection with the identified goods, so resembles the typed drawing mark in Registration No. 2801388, QUERCUS, for "wine,"² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed and requested reconsideration.³ After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm.

I. Applicable Law

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. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). We discuss below these and other relevant factors. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *DuPont* factor for which there is evidence and argument).

² Issued December 30, 2003; renewed. A typed mark is the legal equivalent of a standard character mark. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017).

³ The Examining Attorney also finally refused registration under Trademark Act Sections 2(e)(1), and 1 and 45. Both refusals were withdrawn on reconsideration.

II. The Marks

We first address the *DuPont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (citing *DuPont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

Because this factor is based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, there is nothing improper in assigning more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Nat’l Data*, 224 USPQ at 751.

We compare Applicant’s mark QUERCUS COFFEE with the cited registered mark QUERCUS. QUERCUS is the dominant portion of Applicant’s mark because

the word COFFEE has little to no source-indicating significance; the word COFFEE is generic for Applicant identified goods and has been disclaimed. As such, the word COFFEE is entitled to less weight in our determination. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (descriptive terms are properly given less weight).

The significance of the word QUERCUS as the dominant element of Applicant's mark is further reinforced by its position as the first word in the mark. *See Presto Products, Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). *See also Palm Bay Imps. Inc.*, 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word). "[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985). The peripheral difference here is an unquestionably generic and latter term and, as noted, fails to distinguish the marks. "Consequently, if a junior user takes the entire mark of another and adds a generic, descriptive or highly suggestive term, it is generally not sufficient to avoid confusion." *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, *7 (TTAB 2019).

Regarding connotation and commercial impression, the word QUERCUS is defined as “a genus of hardwood often evergreen trees or shrubs (family Fagaceae) that comprise the typical oaks and include sources of nutgall.”⁴ Applicant, on its website states that “[w]e call this coffee *Quercus*, after the scientific name for the Andean Oak used to build our rum barrels,”⁵ and its specimen of record indicates that Applicant’s coffee is “BARREL AGED.”⁶ Additionally, wine is sometimes aged in barrels.⁷ As such, insofar as consumers of Applicant’s and Registrant’s goods appreciate the meaning of the word QUERCUS, that meaning would be the same, *i.e.*, a reference to the barrels in which wine or coffee or aged.

To the extent Applicant argues that the marks differ in commercial impression due to how they appear in the marketplace on respective product packaging, this argument is misplaced. Our task in this appeal is to compare Applicant’s mark as it appears in the drawing page of the application to Registrant’s mark as it is shown in the cited registration. *See In re i.am.symbolic*, 123 USPQ2d at 1749 (“The correct inquiry requires comparison of the applied-for mark, which only includes the words ‘I AM,’ to the registrants’ marks.”); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“[W]e do not consider how applicant and registrant actually use their marks in the marketplace, but rather how they appear in the registration

⁴ March 20, 2020 Final Office Action; TSDR 97. (www.merriam-webster.com/medical/quercus).

⁵ September 16, 2019 Office Action; TSDR 34.

⁶ *See also* March 20, 2020 Final Office Action; TSDR 35.

⁷ September 16, 2019 Office Action; TSDR 27.

and the application.”); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1508 (TTAB 2007) (must compare applicant’s mark with the cited mark as shown in the registration certificate). “As for the stylization of the wording in Applicant’s mark, we note that the cited mark is registered in standard characters, so we must assume that it could be displayed in any size, color, or font, including a size, color, and font identical to those in Applicant’s mark.” *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1742-43 (TTAB 2016).

Keeping in mind the fallibility of average consumers’ memories, while differences exist between the respective marks, we find that in their entirety, the marks are not only highly similar in appearance and sound due to common term QUERCUS but that they are also highly similar in connotation and convey a substantially similar commercial impression. *See, e.g., Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992) (The fallibility of human memory is a factor when comparing marks, given that a side-by-side comparison is not the ordinary way that a prospective consumer would be exposed to marks.).

The *DuPont* factor of the similarity of the marks thus favors a finding of likelihood of confusion.

III. The Goods, Channels of Trade, and Classes of Consumers

We now compare the goods under the second *DuPont* factor. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the application and the cited registration. *See Stone Lion Capital*

Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). The goods of Applicant and Registrant need not be identical or competitive, or even be offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Coach Servs. v. Triumph Learning* 101 USPQ2d 1713 at 1723; *Hilson Research, Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423, 1432 (TTAB 1993).

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the

source of these goods. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984).

Applicant's goods are identified as "coffee" and the Registrant's goods are identified as "wine." The Examining Attorney maintains that these goods are related because they commonly emanate from a single source in the marketplace under the same name. As support, the Examining Attorney made of record website screenshots from the web sites of H & L Coffees and Wine Shop. (<https://coffeesandwine.com>),⁸ Harry & David (www.harryanddavid.com),⁹ Hoodspout Winery (<https://hoodspout.stores.yahoo.net/>),¹⁰ Biltmore (<https://shop.bitmore.com>),¹¹ Fly Creek Cider Mill & Orchard (<https://shop.flycreekcidermill.com>),¹² Cherry Republic (<https://cherryrepublic.com>),¹³ Devils Gulch Ranch (www.devilsgulchranch.com),¹⁴ Nocking Point (<https://nockingpointwines.com>),¹⁵ Pepper Bridge Winery (<https://pepperbridgelorderport.net>),¹⁶ and Vampire (www.vampire.com)¹⁷ that show

⁸ September 16, 2019 Office Action; TSDR 8-20 and March 20, 2020 Final Office Action; TSDR 17-29. Complete URLs at referenced citation. We have given the website of Biltmore less consideration because the marks as used in connection with coffee and wine differ slightly (namely, by the addition of generic matter). Also, we have not considered the screen shots from MJA Vineyards (September 16, 2019 Office Action; TSDR 26-29) because the same mark does not appear on both coffee and wine.

⁹ September 16, 2019 Office Action; TSDR 21-22.

¹⁰ *Id.* at 23-25.

¹¹ *Id.* at 30-31.

¹² *Id.* at 32-33.

¹³ March 20, 2020 Final Office Action; TSDR 11-12.

¹⁴ *Id.* at TSDR 13-16.


¹⁵ *Id.* at TSDR 29-30.


¹⁶ *Id.* at TSDR 31-32.

¹⁷ *Id.* at TSDR 33-34.

both “coffee” and “wine” sold under the same mark, i.e., H & L (stylized), Harry & David, Hoodsport, Biltmore and Biltmore Estate, Fly Creek, Cherry Republic, Devils Gulch Ranch, Nocking Point NP, PB Pepper Bridge Winery and Vampire.

The Examining Attorney also made of record twenty (20) use-based, third-party registrations showing registration of the same mark by a single entity for both coffee and wine.¹⁸ Third-party registrations that cover goods from both an application and a cited registration are relevant to show that the goods are of a type that may emanate from a single source under one mark. *See, e.g., In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Record examples highlighted in the Examining Attorney’s brief

include: Registration No. 5418551 for the mark ; Registration No. 5204493 for

the mark ; Registration No. 5381909 for the mark UBC; Registration No. 5166429 for the mark TERP; Registration No. 5246927 for the mark CENTER RING; and Registration No. 5023210 for the mark THE CAJUN BUDDHA, each reciting goods including coffee and wine.

¹⁸ March 20, 2020 Final Office Action; TSDR 36-96. The registrations include other goods and services. We give less value to Registration Nos. 4347244, 4522852, 4458987, and 5194239 because the identified wine is specified as “cooking wine” Although Registrant’s identified wine is broadly worded as “wine” and may be used for “cooking,” “cooking wine” usually is not treated as a drink or merchandised in the same areas of stores where both items are sold.

After a careful review, the third-party registration and use evidence convinces us that consumers may expect to find coffee and wine to be offered together under the same mark. We thus find the goods to be commercially related for likelihood of confusion purposes.

Applicant relies on two unpublished and one published Board decisions¹⁹ to support its position that there is no likelihood of confusion between its mark and the cited registered mark. Applicant's reliance is misplaced. Not only do the marks at issue here differ from those involved in the other Board decisions, we are not privy to the records of the involved registrations and therefore we must assess the registrability of Applicant's mark on its own merits. It has been noted many times that each case must be decided on its own facts. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court.")

Applicant also essentially argues that there is no likelihood of confusion because the respective goods are not identical. As noted, the goods need not be identical; they need only be related in some manner that would give rise to a mistaken belief that they come from a common source. *Coach Servs. v. Triumph Learning*, 101 USPQ2d at 1723. For the reasons explained above, the respective goods are sufficiently related

¹⁹ We point out with regard to the published decision cited by Applicant, *In re Sazerac Co.*, 156 USPQ 466 (TTAB 1967), that likelihood of confusion was found between the applicant's mark BOKAR for brandy and the cited identical mark BOKAR for coffee.

to impart a mistaken belief of common source when used on highly similar marks using the identical, distinctive term QUERCUS.

Furthermore, because there are no limitations as to channels of trade or classes of purchasers in Applicant's or Registrant's identification of goods, we must presume that Applicant's and Registrant's goods move in all channels of trade usual for these goods including, as demonstrated by the record, online and specialty food stores and wineries, and are purchased by the usual classes of purchasers which, in this case, include ordinary consumers. *See In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). We accordingly find the channels of trade and classes of consumers to overlap.

Accordingly the *DuPont* factors concerning the similarity of the goods, trade channels and classes of purchasers favor of a finding of likelihood of confusion.

IV. Consumer Sophistication and Purchaser Care

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Applicant opines that “[h]ere, the buyers of the respective goods and services will be a sophisticated [sic]. In other words, consumers making purchases of services [sic] from either Applicant or the Prior Owner are well educated, and not likely to purchase on impulse.” Applicant's brief p. 5.²⁰

We find this argument unavailing. As noted above, the respective identifications list coffee or wine without limitation. Accordingly, Applicant's and Registrant's goods are considered to include all types of coffee and wine sold through normal channels

²⁰ 6 TTABVUE 5.

of trade; their respective consumers encompass the general public as well as the possibly more sophisticated connoisseurs of specialty coffee or fine wine and we must make our determination based on the least sophisticated consumer. *See In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1959 n.4 (TTAB 2016) (“[b]ecause the respective identifications include ‘beer’ without any limit regarding a particular price point, we must treat the goods as including inexpensive as well as more costly beers, and therefore presume that purchasers for ‘beer’ include ordinary consumers who may buy inexpensive beer on impulse.”) (citing *Stone Lion Capital v. Lion Capital* 110 USPQ2d at 1163-64, (decision requires consideration of the “least sophisticated consumer in the class”)). *See also In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (finding that not all purchasers of wine may be discriminating because while some may have preferred brands, “there are just as likely to be purchasers who delight in trying new taste treats.”); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration).

Notably, contrary to Applicant’s assertion that “the respective goods and services [sic] can be extremely expensive,” Applicant’s brief, p. 5,²¹ the record shows the cost of Applicant’s actual goods to be relatively inexpensive, ranging from \$15-\$25 for roasted coffee and some wines offered at similar prices.²² As such, they may be subject

²¹ *Id.*

²² Applicant’s request for consideration; TSDR 33-34, September 16, 2019 Office Action; TSDR 23-24 and 33, and March 20, 2020 Final Office Action; TSDR 12, 17-25, 33 and 35.

to impulse buying. Moreover, even if we assume that Applicant's and Registrant's consumers were limited to discriminating purchasers who would exercise a higher degree of care in their purchasing decisions, even sophisticated buyers are not immune from source confusion. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (“[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods”) (citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers ... are not infallible.”)). In this case, where the marks share the identical, distinctive term QUERCUS, we cannot expect consumers' sophistication to allay the likelihood of confusion. Rather, “with identical or similar marks used on such goods, even a careful, sophisticated consumer of these goods is likely to believe that the goods emanate from a common source. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). In other words, even careful purchasers who do notice the difference in the marks will not ascribe it to differences in the source of the goods, but will see the marks as variations of each other, pointing to a single source.” *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1739 (TTAB 2018).

Accordingly this *DuPont* factor is neutral.

V. Fame of the Cited Mark

Applicant intimates that because there is no evidence that the cited mark is famous, it is weak and entitled to a relatively narrow scope of protection. That

argument is unavailing. While Applicant correctly points out that there is no record evidence that the cited mark is famous, that is not relevant to our analysis. “[T]he owner of the cited registration is not a party to this ex parte appeal, and the Examining Attorney is under no obligation to demonstrate the fame of a cited mark.” *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (“Although we have previously held that the fame of a registered mark is relevant to likelihood of confusion, *DuPont*, 476 F.2d at 1361, 177 USPQ at 567 (factor five), we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark’s not being famous.”); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016) (“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.”); *In re Big Pig Inc.*, 81 USPQ2d 1436, 1439 (TTAB 2006) (“It is not necessary that a registered mark be famous to be entitled to protection against a confusingly similar mark.”).

VI. Absence of Actual Confusion

We also find unavailing Applicant’s reliance on the absence of actual confusion, because “it is unnecessary to show actual confusion in establishing likelihood of confusion.” *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Particularly, in an ex parte proceeding, an applicant’s assertion of the absence of actual confusion is of little probative value in the determination on the issue of likelihood of confusion because the Board cannot

readily determine whether there has been a significant opportunity for actual confusion to have occurred, such that the absence of confusion is meaningful. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984). This factor is neutral.²³

VII. Conclusion

When we consider all of the arguments and evidence relating to the relevant likelihood of confusion factors, we find that confusion is likely between Applicant's mark QUERCUS COFFEE for "coffee" and the cited registered mark QUERCUS for "wine." We find so due to the similarity of the marks, the relatedness of the goods and the overlapping trade channels and classes of purchasers.

Decision: The refusal to register Applicant's mark QUERCUS COFFEE is affirmed.

²³ Furthermore, we simply do not find persuasive Applicant's unsupported argument that any instances of actual confusion in the future would be de minimis.