

This Opinion is not a  
Precedent of the TTAB

Mailed: February 7, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Pretentious Beer LLC*

Serial No. 88815635

Wade R. Orr of Luedeka Neely Group, P.C.,  
for Pretentious Beer LLC.

Tricia L. Brown, Trademark Examining Attorney, Law Office 121,  
Richard White, Managing Attorney.

Before Zervas, Kuczma and Coggins,  
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Pretentious Beer LLC (“Applicant”) seeks registration on the Principal Register of



the composite mark , with “BEER CO. KNOXVILLE  
TENNESSEE” disclaimed, for:

“Beer” in International Class 32.<sup>1</sup>

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), citing Registration No. 4607261 for the mark PRETENTIOUS (in standard characters) for “wine” in International Class 33, as a bar to registration.<sup>2</sup>

After the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration. The request for reconsideration was denied, the appeal was resumed, and Applicant and the Examining Attorney submitted briefs. For the reasons set forth below, the refusal to register is affirmed.

## **I. Likelihood of Confusion**

Our determination under § 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion enunciated in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563,

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<sup>1</sup> Application Serial No. 88815635 was filed on February 28, 2020, based upon Applicant’s assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The application contains the following description of the mark: The mark consists of a design of a raccoon in navy with wings wearing a hat and blowing glass over the stylized words PRETENTIOUS BEER CO. KNOXVILLE TENNESSEE. The wording PRETENTIOUS is in navy and light blue in the middle of a stylized polygon shape with a black outline and a stylized navy and light blue inner border with yellow curved lines surrounding the word PRETENTIOUS. The word KNOXVILLE in navy appears above PRETENTIOUS and the word TENNESSEE in navy appears below. The wording BEER CO[.] is below and to the right of the word PRETENTIOUS.

The colors navy, light blue and yellow are claimed as features of the mark.

<sup>2</sup> Registration No. 4607261 issued September 16, 2014; Sections 8 & 15 declaration of use accepted and acknowledged. On December 2, 2020 an assignment of Registration No. 4607261 to McGibbs, Inc. dated September 24, 2020, was recorded in the USPTO.

567 (CCPA 1973) (cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015)). See *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

“Two key 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.’” *In re Embiid*, 2021 USPQ2d 577, at \*10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

“In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-*

*UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at \*3 (Fed. Cir. 2020) (citing *In re Dixie Rests.*, 41 USPQ2d at 1533).

We have considered each *DuPont* factor for which there is evidence and argument of record. See *In re Guild Mortg.*, 129 USPQ2d at 1162-63. Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”); see also *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018).

#### **A. Similarity of the Marks**

It is well settled that marks are compared in their entireties for similarities in appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). “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) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019).

When considering the similarity of the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether

the marks are sufficiently similar in terms of overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d at 1813.

Because similarity is determined based on the marks in their entirety, our analysis is not predicated on dissecting the marks into their various components. *Stone Lion v. Lion Capital*, 110 USPQ2d at 1161; *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 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 entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). As the U.S. Court of Appeals for the Federal Circuit has observed, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark....” *Id.* at 751.

The Examining Attorney argues that “Applicant’s mark creates a confusingly similar impression to that of registrant’s mark based on the similarity of the word ‘PRETENTIOUS’ used in both marks.”<sup>3</sup> “PRETENTIOUS” is the first word in

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<sup>3</sup> Examining Attorney’s Brief at 11 TTABVue 5.

Citations to the application are to the online database of the USPTO’s Trademark Status & Document Retrieval (TSDR) system by page number in the downloadable .pdf format.

Applicant's mark and is the only word in Registrant's mark. Customers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark, especially where the first portion is followed by a highly descriptive or generic term, such as "BEER CO. KNOXVILLE TENNESSEE" in Applicant's mark. *See Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1692 (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as 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) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because "consumers must first notice th[e] identical lead word"); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). Thus, marks have frequently been found to be similar where one mark incorporates the entirety of another mark especially when the first part of the two marks begins with the same word, as is the case here.

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Citations to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number and after this designation are the page references, if applicable.

The additional wording “BEER CO. KNOXVILLE TENNESSEE” in Applicant’s mark does not alter the connotation of “PRETENTIOUS.” The wording “BEER CO.” and “KNOXVILLE TENNESSEE” in Applicant’s mark is, respectively, descriptive and geographically descriptive of Applicant’s entity and a type of alcoholic beverage from Knoxville, Tennessee; moreover, it has been disclaimed.<sup>4</sup> Therefore, it is less significant in creating a commercial impression. *See In re Viterra*, 101 USPQ2d at 1908; *Citigroup v. Capital City Bank*, 98 USPQ2d at 1257 (when a mark consists of two or more words, some of which are disclaimed, the word not disclaimed is generally regarded as the dominant or critical term); *In re Dixie Rests.*, 41 USPQ2d at 1534 (finding “delta” the dominant part of the mark THE DELTA CAFÉ because “café” was disclaimed); *see also In re Nat’l Data*, 224 USPQ 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. Indeed, this type of analysis appears to be unavoidable.”).

The commercial impression engendered by Applicant’s mark in context with beer is the PRETENTIOUS-brand beer company. When Applicant’s mark is considered in its entirety, the descriptive wording “BEER CO. KNOXVILLE TENNESSEE” does little or nothing to distinguish Applicant’s mark from Registrant’s mark. *See In re Chatam*, 71 USPQ2d at 1946 (“Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under *DuPont*. As a generic term, ALE simply delineates a class of goods.”).

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<sup>4</sup> *See* November 3, 2020 Response to Office Action.

For customers already familiar with Registrant's mark in connection with wine, they may readily believe that the added wording "BEER CO. KNOXVILLE TENNESSEE" is simply being used in connection with a variant mark to designate Registrant's expansion into brewing and/or selling beer.

The presence of the additional terms and a stylized character in Applicant's mark does not necessarily eliminate the likelihood of confusion with the cited mark because the term PRETENTIOUS is identical. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). If the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. Thus, adding or deleting matter from a registered mark generally does not obviate the similarity between the marks. *See e.g., Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1692 (affirming TTAB's holding that contemporaneous use of appellant's mark, VEUVE ROYALE, for sparkling wine, and appellee's marks, VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, for champagne, is likely to cause confusion, noting that the presence of the "strong distinctive term [VEUVE] as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE"); *In re Chatam*, 71 USPQ2d at 1946 ("Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR'S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical."). Therefore, consumers are likely to focus on the word "PRETENTIOUS" when they encounter Applicant's mark. And, of course, PRETENTIOUS is the totality of Registrant's mark.



Applicant contends that the “highly distinctive glassblowing winged raccoon” character located in the upper right-hand side of the mark is “the dominant portion” of its mark.<sup>5</sup> In support, Applicant submits the Declaration of Mark Keegan of Keegan & Donato Consulting, “an expert, consultant, and practitioner in the field of marketing,” holding the title Professional Certified Marketer from the American Marketing Association since 2015.<sup>6</sup> Mr. Keegan identifies “the glass-blowing winged raccoon design” as “the most striking and important element...in terms of capturing consumer attention and interest” of Applicant’s mark.<sup>7</sup> In support of this finding, Mr. Keegan states that:

- The [raccoon] design is whimsical and fanciful, depicting a fabled winged raccoon wearing a bowler hat. The activity in which the raccoon is engaged—glass blowing—is simultaneously uncommon yet recognizable, encouraging a second (or third) look from viewers. The overall impact of this design is robust and unique, and could, with appropriate development and support, come to identify and represent the Pretentious Beer Co. brand on its own without any supporting elements.<sup>8</sup>
- With respect to its placement vis-à-vis the other elements of [Applicant’s Mark], the raccoon brand icon occupies a position of dominance at the upper right-hand corner of the logo. Consumers tend to begin their examination of a marketing communication at the top of the design and move down in a Z-pattern, ending at the lower right-hand corner. Thus, graphic designers often, and in this instance, place the most important visual components of a logo at the top of the overall design. Additionally, . . . , the raccoon is

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<sup>5</sup> Applicant’s Brief p. 4 (9 TTABVUE 5).

<sup>6</sup> See May 6, 2021 Request for Reconsideration, Exhibit A, Declaration of Mark Keegan ¶ 1, at TSDR 19.

<sup>7</sup> *Id.* ¶ 5, at TSDR 20.

<sup>8</sup> *Id.* ¶ 7, TSDR at 21.

slightly offset from the other design elements, with only the raccoon's feet overlapping the rest of the design to any meaningful degree. This offset placement ensures that the raccoon brand icon stands out from the remaining design elements and draws the viewer's eye for the critical first initial impression of the logo.<sup>9</sup>

Mr. Keegan goes on to explain the significance of the other design elements of Applicant's design mark, including the blue and yellow color scheme and the decorative "paraph,"<sup>10</sup> concluding:

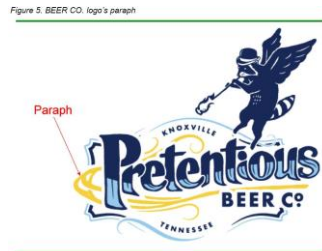
[Applicant's Mark] contains strong design elements as described throughout this declaration. These elements come together to create a cohesive whole that is an effective communication device for the Pretentious Beer Co. brand. With its sophisticated graphic design elements working as a whole, [Applicant's Mark] provides an effective means of engaging with consumers that rises above the impact of any single textual element.<sup>11</sup>

Based on the foregoing, Applicant concludes "the Examining Attorney's assertion that the 'pretentious' term is the dominant portion of Applicant's Design Mark is in error. Instead, the glass-blowing winged raccoon portion of Applicant's Design Mark should be considered dominant." At minimum, Applicant argues the likelihood of confusion

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<sup>9</sup> *Id.* ¶ 8, TSDR at 21.

<sup>10</sup> Applicant's Brief p. 5 (9 TTABVUE 6). Mr. Keegan explains that a paraph, "[o]riginally associated with signatures, . . . is a type of typographic flourish that adds a unique ornamental flare to a design." May 6, 2021 Request for Reconsideration, Keegan Declaration ¶ 12 referring to Figure 5, *see* Request for Reconsideration at TSDR 23:



<sup>11</sup> May 6, 2021 Request for Reconsideration, Keegan Declaration at ¶ 22, TSDR 25.

analysis in this case should compare Applicant's mark in its entirety to the cited mark "without any extra significance being place on the 'pretentious' term . . . ." <sup>12</sup>

As mentioned above in the Keegan Declaration, "consumers tend to begin their examination of a marketing communication at the top of the design and move down in a Z-pattern, ending at the lower right-hand corner."<sup>13</sup> Because the "glassblowing winged raccoon" character design is located in the upper right-hand corner of



Applicant's mark, Applicant contends that the "glassblowing winged raccoon" design dominates the mark. However, given the large-size font and the left-hand side location and emphasis of the recognized word "PRETENTIOUS" as presented in Applicant's mark, even if consumers viewed Applicant's design in a Z-pattern, the word "PRETENTIOUS," which appears as a larger element of the mark than the raccoon, would be recognized as the dominant part of the mark. But we acknowledge that even where an element of a mark is dominant, this does not mean that other elements may simply be ignored in the likelihood of confusion analysis. *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007); *see also In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) ("There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue").

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<sup>12</sup> Applicant's Brief p. 6 (9 TTABVUE 7).

<sup>13</sup> *See* May 6, 2021 Request for Reconsideration, Exhibit A, Keegan ¶ 8, at TSDR 21.

In support of its position that the “glassblowing winged raccoon” character in its mark is the dominant portion of the mark, Applicant presents a table summarizing TTAB decisions where the design elements of particular marks were found to be dominant.<sup>14</sup> A closer look at the marks involved in those decisions reveals that they are different in nature than Applicant’s mark:

Applicant cites *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) in support of its argument that the “glassblowing winged raccoon” character design in its mark dominates and is sufficient to differentiate its mark from the cited mark. However, unlike Applicant’s mark, the literal portion of the mark at issue in *Covalinski*, i.e., REDNECK RACEGIRL, was difficult to distinguish from the design portion of the mark consisting of two large capital letters “R,” each including a black and white checkerboard pattern resembling a racing flag, forming the first letter in the literal terms with the other letters appearing on tails extending forward therefrom, which



ended with depictions of hearts, i.e., . The wording in that mark was merged together with the design, with some of the letters being so small as to be almost illegible. The “overall commercial impression of [that a]pplicant’s mark” was found to be “dominated by its design features, particularly the large double-letter RR configuration,” which weighed heavily against a conclusion that confusion was likely with the cited mark RACEGIRL in standard character format. 113 USPQ2d at 1169.

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<sup>14</sup> See Applicant’s Brief pp. 6-7 (9 TTABVUE 7-8).

In this appeal, the literal portion of Applicant's mark is "PRETENTIOUS BEER CO. KNOXVILLE TENNESSEE," and is separate and apart from the raccoon design, with "PRETENTIOUS," which is identical to the cited mark, presented in a large stylized font. In addition, the change in color from navy to light blue draws the eye and anchors this central, literal element. The dominant word portion of Applicant's mark is thus presented very differently than the words "REDNECK RACEGIRL" in *Covalinski*.

In *Parfums de Coeur v. Lazarus*, 83 USPQ2d at 1016, the Board noted that the



**BODYMAN**

design portion of the mark prominently displaying the design "of a grotesque image—a torso that acts as a face, with the nipples being eyes and the navel acting as a mouth" wearing a cape bearing the initials "BM," was "very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN," and was therefore found to be the dominant element of the applicant's mark. The opposition was dismissed because opposer's BOD MAN and BOD marks were word marks having different literal portions from "the strong visual impact of the design element of" applicant's mark and were registered for unrelated goods to applicant's animated television series services. *Id.* In the current case, unlike *Parfums de Coeur v. Lazarus*, the literal, dominant portion of Applicant's mark is identical to the only element of Registrant's mark, and the marks are both used on alcoholic beverages.

In *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1987), the applicant's mark was STEVE'S (in block letters) for ice cream and the opposer's mark was STEVE'S and a design consisting of two fanciful hot dogs with



human features, walking together, i.e., , for hot dog restaurants.

The Board found that “STEVE’S,” the literal word in the marks was weak in the restaurant and food store fields and therefore, both the differences in the marks and the differences between the applicant’s goods and opposer’s restaurant services avoided a likelihood of confusion. In the current case, there is no evidence that the identical literal portion of the marks is weak for alcoholic beverages including beer and wine. Further, as addressed below, Applicant’s and Registrant’s goods are related.<sup>15</sup>

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<sup>15</sup> Applicant also cites two non-precedential cases, addressed below. Although non-precedential decisions may be cited, the Board does not encourage the practice. Board decisions which are not designated as precedent are not binding on the Board, but may be cited and considered for whatever persuasive value they may hold. *See In re Fiat Grp. Mktg. & Corp. Commc’ns S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 101.03, 1203.02(f) (2021). The Board has frequently noted that parties to Board cases are best served by restricting their citations to decisions issued as precedents of the Board.

*In re Lema*, Serial No. 87892342, 2020 TTAB LEXIS 120, \*5-6, 2020 BL 135077 (TTAB 2020), Applicant sought registration of the mark DADA CHAPEL for beer, spirits and liquors which



was refused registration in view of the registered mark for wines. The design of the hand pointing to the numeral 1 in the cited mark was found to “catch[] the eye.” In addition, the wording “Art Wine” in the cited mark was found to reinforce the connotation and commercial impression of the term “DADÁ” as referencing an art movement. The word “DADA” as used in the context of applicant’s mark DADA CHAPEL, was considered to alter the overall connotation; and the word “CHAPEL” was found to evoke a distinct connotation

As the above cases confirm, “there is no per se rule that words must always predominate over design elements.” *Parfums de Coeur v. Lazarus*, 83 USPQ2d at 1016. However, comparing Applicant’s mark in its entirety, as we must, *In re Nat’l Data*, 224 USPQ at 751, the “glassblowing winged raccoon” design portion of Applicant’s mark does not predominate over the wording “PRETENTIOUS.”

While Applicant’s composite mark includes a “glassblowing winged raccoon” design and other stylistic embellishments, they do not overcome the impression made by the large, central, and dominant word in Applicant’s mark, i.e., PRETENTIOUS. The design elements of Applicant’s mark are entitled to less weight in our analysis because consumers will use the distinctive wording of “PRETENTIOUS” to identify and call for Applicant’s beer. *See In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (“Beer is often ordered by name, in a bar or restaurant, or from a menu, where only the name of the beer will be used ...”). Thus, as presented, the word “PRETENTIOUS” is the dominant portion of Applicant’s mark. *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015) (“the verbal portion of the mark

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or commercial impression of religion or a small church. Thus, the first *DuPont* factor weighed against a likelihood of confusion.

*In re Primeway Int’l LLC*, Serial No. 87059786, 2019 TTAB LEXIS 167, \*5, 2019 BL 47209 (TTAB 2019), Applicant sought registration of the mark INCOGNITO for footwear which was



refused registration in view of the cited registered mark for clothing items. The wolf design and letters STS in the cited mark were found to immediately draw one’s attention and engage the viewer before the smaller word “incognito” in quotation marks below the picture of the wolf is noticed. Thus, the marks were found to be dissimilar and the refusal to register was reversed.

is the one most likely to indicate the origin of the goods to which it is affixed”) citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Vittera*, 101 USPQ2d at 1908, 1911 (“In 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” (internal quotation marks omitted)); *In re Dakin’s Miniatures*, 59 USPQ2d 1593, 1596 (TTAB 1999) (“In the case of marks which consist of words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods”).

Applicant contends that the registered mark is entitled to a narrower scope of protection because “‘pretentious’ is a common word used to describe wine drinkers,” citing to a sampling of articles it submitted during prosecution of its application.<sup>16</sup>

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<sup>16</sup> Applicant’s Brief p. 8 (9 TTABVue 9). See May 6, 2021 Request for Reconsideration, Exhibit B at TSDR 15, 37-101 (uses of “pretentious” shown below in bold):

- **Pretentious** Things to Say at a Wine Tasting, Should You Want to . . . [blogyourwine.com/pretentious-things-to-say-at-a-wine-tasting-should-you-want-to/](http://blogyourwine.com/pretentious-things-to-say-at-a-wine-tasting-should-you-want-to/) at TSDR 37-40;
- Urban Dictionary definition of wine snob: A wine enthusiast . . . , particularly one who is **pretentious**, . . . because of their “immense . . . wine knowledge.” [www.urbandictionary.com/define.php?term=wine%20snob](http://www.urbandictionary.com/define.php?term=wine%20snob) at TSDR 41;
- How Can One Become **Pretentious** About Red Wine? What’s the best way to become a **pretentious** wine drinker? HuffPost Life blog, [www.huffpost.com/entry/how-can-one-become-pretentious\\_b\\_3564200](http://www.huffpost.com/entry/how-can-one-become-pretentious_b_3564200) at TSDR 45-47;
- Meet the most **pretentious** wine list in America, [www.oregonlive.com/dining/2015/09/meet\\_the\\_most\\_pretentious\\_wine.html](http://www.oregonlive.com/dining/2015/09/meet_the_most_pretentious_wine.html) at TSDR 48-52;
- Culture Fail: **Pretentious** Wine Tasting . . . Not a Hint of Awesome [www.corvallisadvocate.com/2013/0711-pretentious-wine-tasting-not-a-hint-of-awesome/](http://www.corvallisadvocate.com/2013/0711-pretentious-wine-tasting-not-a-hint-of-awesome/) at TSDR 53-54;
- A satirical take on the pedantic and **pretentious** wine taster, Union des Maisons de Champagne, [maisons-champagne.com/en/houses/the-art-of-tasting/article/a-satirical-take-on-the-pedantic-and-pretentious](http://maisons-champagne.com/en/houses/the-art-of-tasting/article/a-satirical-take-on-the-pedantic-and-pretentious) at TSDR 55;



Additionally, Applicant notes that the Examining Attorney “asserts that this connotation exists with beer drinkers as well,” (as supported by copies of articles offered by the Examining Attorney from The Growler, The Week, Richmond Times-Dispatch, Bloomberg CityLab and SBS News).<sup>17</sup> As a result, Applicant argues,

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- The Wine Slob For those that love cheap wine without all the **pretentious** B.S., wine slob.blogspot.com/ at TSDR 56-58;
  - Why is Wine Talk Considered **Pretentious**?, . . . In the popular imagination wine talk is the province of **pretentious** snobs putting on airs of superiority while extolling the virtues of a glass of fermented grape juice. But why is wine conversation uniquely **pretentious**? foodandwineaesthetics.com/2018/08/06/why-is-wine-talk-considered-pretentious/ at TSDR 59-63;
  - There’s No Way Not to Look **Pretentious** Swirling Wine, food52.com/blog/ 16484-there-s-no-way-not-to-look-pretentious-swirling-wine at TSDR 64-71;
  - Stuck in Lodi, California’s Less **Pretentious** Wine Region, Travel Mindset, inspiration.travelmindset.com/lo-di-wine-tour/ at TSDR 72-75;
  - The Wine Loft South End’s Premier Wine Bar, We are not **pretentious** or snobby about wine., www.wineloftcharlotte.com/ at TSDR 76-79;
  - The Spirit, The Seven **Pretentious** Words to Avoid When Describing Wine, www.westsidespirit.com/news/the-seven-pretentious-words-to-avoid-when-describing-wine-MDNP132 0120628306289992 at TSDR 80-83;
  - . . . Leave **pretentious** wine tasting notes and impenetrable jargon at the door, Wineries and Vineyards in North Carolina at www.newwine.org/ at TSDR 84-85;
  - . . . Here’s Our Non-**Pretentious** Guide to Sparkling Wine, . . . Peruse our non-**pretentious** guide to sparkling wine . . . www.paeats.com/feature/guide-to-sparkling-wine/ at TSDR 86-92;
  - Westmount: Oregon’s Winery that is Adventurous, Not **Pretentious**, . . . Westmount understands this and makes wines that are **unpretentious** . . . honestcooking.com/westmount-oregons-winery-adventurous-not-pretentious/ at TSDR 93-94;
  - Tripadvisor Livermore Valley. Beautiful and non **pretentious** wine tasting. www.tripadvisor.com/ShowUserReviews-g32635-d117170-r614174316-Livermore\_Valley-Livermore\_Tri\_Valley\_California.html at TSDR 95-101.

<sup>17</sup> Applicant’s Brief at p. 8 (9 TTABVue 9) citing to the June 3, 2021 Request for Reconsideration Denied at TSDR 5, where the Examining Attorney presented the following evidence in support of her contention that the same connotation also exists with beer drinkers (uses of “pretentious” shown below in bold):

- A **pretentious** celebration of craft beer at Strangeways

Registrant's PRETENTIOUS mark "is entitled to a narrower scope of protection than an arbitrary or coined word," and the "highly distinctive design elements of Applicant's Design Mark and other factors discussed herein should be considered to obviate any likelihood of confusion in this case."<sup>18</sup>

While the word "pretentious" may be suggestive of some of the people who drink wine or the desire to be seen as a knowledgeable drinker of fine wine, Applicant has not shown use of "Pretentious" as a source identifier by others. Thus, Registrant's mark has not been demonstrated to be conceptually weak. However, even if Registrant's mark is entitled to a narrower scope of protection than an "arbitrary or coined term," likelihood of confusion is to be avoided as much between weak marks

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In Richmond, Strangeways Brewing thumbed its nose at Bud by releasing . . . The event invited participants to be **pretentious** and embrace the stereotypes. . . . June 3, 2021 Request for Reconsideration Denied, see February 4, 2015 Richmond Times-Dispatch at TSDR 7.

- The Non-Beer Snob's Guide to Ordering at a Craft Beer Bar

For help cutting through the jargon, we spoke to Greg Engert, . . . The world of craft beer can be "overwhelming," Engert admits, and even "a little bit **pretentious**" – but it doesn't have to be. . . . June 3, 2021 Request for Reconsideration Denied, see January 29, 2015 Bloomberg CityLab at TSDR 8.

- Comment: Craft beer exists so guys who don't drink wine still get to be **pretentious** . . . June 3, 2021 Request for Reconsideration Denied, see 05/02/2014 SBS News at TSDR 9.

- *The Week* contest – **Pretentious** microbrews

. . . Given the soaring prospects from microbrews, we asked you to concoct the most **pretentious** name for a beer ever. . . . June 3, 2021 Request for Reconsideration Denied, see January 8, 2015 The Week [theweek.com/articles/476240/week-contest-pretentious-microbrews](http://theweek.com/articles/476240/week-contest-pretentious-microbrews) 06/03/2021 at TSDR 69-70.

<sup>18</sup> Applicant's Brief p. 8 (9 TTABVUE 9).

as between strong marks, *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108, 109 (CCPA 1974), and even weak marks are entitled to protection against registration of similar marks, especially identical ones, for related goods. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); *see also In re Max Capital Grp.*, 93 USPQ 1243, 1246 (TTAB 2010) (even suggestive or weak marks are entitled to protection from the use of a very similar mark for legally identical services). The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil*, 26 USPQ2d at 1690.

Although we assess each mark in its entirety, wording often is considered the dominant feature of a mark comprising both literal and design elements because it is most likely to indicate the source of the goods. *See Jack Wolfskin v. New Millennium*, 116 USPQ2d at 1134; *In re Viterra*, 101 USPQ2d at 1908. While there is no bright line rule, the word portion is normally accorded greater weight in determining whether the marks are similar because they are likely to make a greater impression upon purchasers than the design and would be remembered by them and used by them to request the goods. *See In re Viterra*, 101 USPQ2d at 1908, 1911 (citing *CBS v. Morrow*, 218 USPQ at 200); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011); *In re Dakin's Miniatures*, 59 USPQ2d at 1596. This general principle applies here, where the word "PRETENTIOUS" appears in Applicant's mark in a substantially larger, eye catching, and dual-color font than the other terms. Potential

customers viewing Applicant's mark would be drawn first to the large and centrally placed word "PRETENTIOUS" before taking in the "glassblowing winged raccoon" design and the other wording in the mark set forth in smaller font.

To the extent it begins with the word "PRETENTIOUS," Applicant's mark is similar in sound and appearance to Registrant's mark. This close similarity in sound is important because it is common knowledge that wine and beer are often offered and requested orally. Registrant's mark may also be displayed in the same lettering style as the word "PRETENTIOUS" in Applicant's mark since Registrant's mark is a standard character mark which may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra*, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 94 USPQ2d at 1260. Similarity in appearance or sound alone may be enough to establish that the marks are confusingly similar. *In re 1st USA Realty Prof., Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

"PRETENTIOUS," which is presented in the largest font and located in the central position, is the dominant element of Applicant's mark. Therefore, it is given more weight than the other elements in Applicant's mark in our likelihood of confusion analysis. Applicant's mark incorporates the entirety of Registrant's mark, and Registrant's mark forms a significant portion of Applicant's mark. In making this finding, we do not ignore the presence of the additional wording or the design elements in Applicant's mark. However, for the reasons discussed above, we believe consumers are more likely to remember the term "PRETENTIOUS" than the other

parts of Applicant's mark. Accordingly, Applicant's and Registrant's marks are similar in terms of their sight, sound, meaning and commercial impression under the first *DuPont* factor.

## **B. Goods, Trade Channels and Classes of Customers**

To find a likelihood of confusion, the goods need not be identical or even competitive. Rather, the question is whether the goods are marketed in a manner that "could give rise to the mistaken belief that [the] goods emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services."); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods"). The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In re Majestic Distilling*, 65 USPQ2d at 1205; *In re Shell Oil*, 26 USPQ2d at 1689. It is sufficient that the respective 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 producer. *See In re*

*Kysela*, 98 USPQ2d at 1263; *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Applicant's beer and Registrant's wine are alcoholic beverages that result from fermentation; beer is made from fermenting grains and wine is made from fermenting grapes.<sup>19</sup> However, we have long held that "[t]here is no per se rule that holds that all alcoholic beverages are related." *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009). Even though beer and wine have been found related in other cases, we must decide the outcome of this proceeding based on the facts and evidence submitted in this case.

In support of the relatedness of Applicant's beer and Registrant's wine, the Examining Attorney submits screenshots from websites offering beer and wine offered for sale by the same entity under the same trademarks:

- Bias Winery (operating "as a Winery and Microbrewery combined") offers beer and wine (May 25, 2020 Office Action at TSDR 31-33);
- The Vineyard and Brewery at Hershey offers beer and wine bearing labels marked "The Brewery of Hershey" and "The Vineyard at Hershey" and (May 25, 2020 Office Action at TSDR 34-40);
- Barrel Oak Winery and Farm Taphouse offers beer under the name "Barrel Oak Farm Taphouse" and wine bearing labels marked "Barrel Oak Winery" (May 25, 2020 Office Action at TSDR 41-51);

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<sup>19</sup> Definitions: beer "a carbonated, fermented alcoholic beverage that is usually made from malted cereal grain (especially barley), is flavored with hops, and typically contains less than a 5% alcohol content;" and wine "the alcoholic fermented juice of fresh grapes used as a beverage." Merriam-webster.com/dictionary/wine, © 2022 Merriam-Webster, Incorporated; 2/4/2022. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions, and we do so here. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

- Fenton Winery & Brewery offers beer under the name “Fenton Winery & Brewery” with one of its beers identified as “Fenton Light,” and wine bearing labels marked “Fenton Winery & Brewery” (November 6, 2020 Office Action at TSDR 7-17);
- McMenamins offers beer bearing labels marked “McMenamins” and wine produced by McMenamins Edgefield Winery (November 6, 2020 Office Action at TSDR 18-22);
- Motor City Brewing Works offers beer bearing labels marked “Motor City Brewing Works” and wine bearing labels marked “Motor City Brewing Works” (November 6, 2020 Office Action at TSDR 23-25);
- Schram Vineyards Winery & Brewery offers beer marketed in connection with “Schram Haus” and “Schram,” and wine bearing the “Schram Vineyards” name on its label; its beers from its Schram Haus brewery “are available at the vineyard.” (November 6, 2020 Office Action at TSDR 26-30);
- Schilling Bridge offers beer under the name “SchillingBridge Brewing Company” and wine bearing the “Schilling Bridge Winery” name on its label (November 6, 2020 Office Action at TSDR 31-37);
- Wagner Vineyards and Wagner Valley Brewing Co. offers beer bearing “Wagner Valley Brewing Company” on the label and wine bearing “Wagner Vineyards” on the label (June 3, 2021 Request for Reconsideration Denied at TSDR 77-82);
- Von Jakob Winery & Brewery offers beer bearing the name “Von Jakob Brewery” and wine bearing the name “Von Jacob” (June 3, 2021 Request for Reconsideration Denied at TSDR 83-88);
- Mackinaw Trail Winery & Brewery (Mackinaw Trail Brewing Company “opened during the Summer of 2014 to accompany the winery”) offers beer and wine (June 3, 2021 Request for Reconsideration Denial at TSDR 89-95).

Applicant contends that the providers of the goods differentiate between their beers and wines by “using additional terms or otherwise explicitly identifying itself to consumers as being both a winery and a brewery.” Applicant argues that this evidence, as shown in “the exemplary reproductions” of the evidence submitted by the Examining Attorney (see below), “is highly misleading as each of these entities use

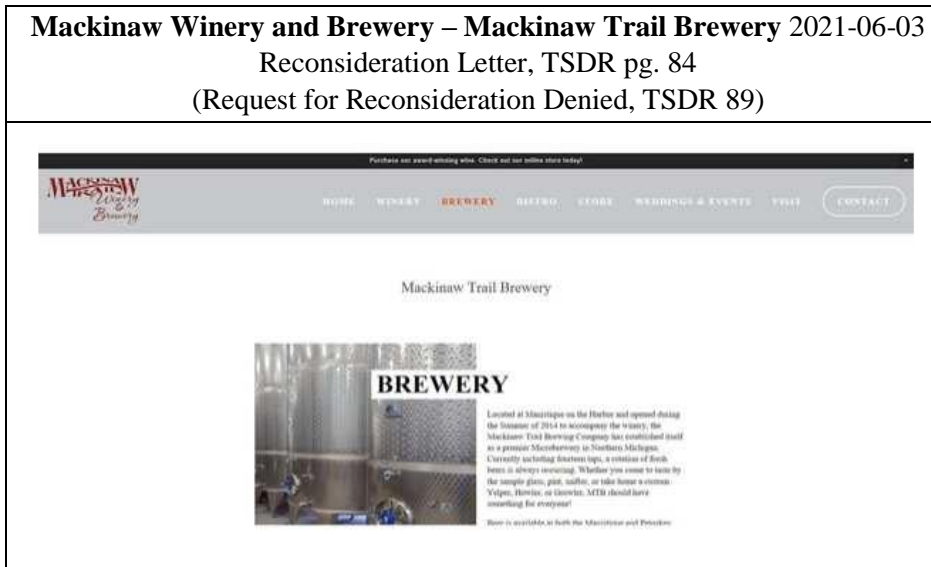
varying marks to distinguish their wine/winery and beer/brewery or otherwise indicate in the mark that it is both a winery and a brewery”:<sup>20</sup>

<p><b>Wagner Valley Brewing Co</b> 2021-06-03 Reconsideration Letter, TSDR pg. 75 (Request for Reconsideration Denied, TSDR 80)</p>	<p><b>Wagner Vineyards Estate Winery 2021-06-03</b> Reconsideration Letter, TSDR pg. 72 (Request for Reconsideration Denied, TSDR 77)</p>
	

<p><b>Von Jakob Winery &amp; Brewery</b> 2021-06-03 Reconsideration Letter, TSDR pg. 78 (Request for Reconsideration Denied, TSDR 83)</p>


<sup>20</sup> Applicant’s Brief pp. 10-11 (9 TTABVUE 11-12).






This evidence does not support Applicant's argument. The marks used by each of the entities above show use of the same dominant term in connection with their wine and beer products. Wagner Valley Brewing Co and Wagner Vineyards Estate Winery are shown above, with the stylized images of Wagner Vineyards and Wagner Valley Brewing Co appearing on the top of both webpages. The image on the Von Jakob Winery & Brewery webpage shows use of: Von Jakob Brewery on a bottle and on a stein of beer, and Von Jakob Vineyard on a glass of wine and Von Jakob on the label of a bottle of wine. Lastly, the Mackinaw Trail Winery & Brewery website shows use of Mackinaw Trail Brewing Company in connection with its brewery. The additional page from the Mackinaw Trail Winery & Brewery included in the Examining Attorney's submission, but not shown in Applicant's images above, is from the Winery section of the website and addresses the History of the Mackinaw Trail Winery.<sup>21</sup> The

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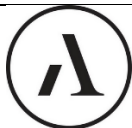

<sup>21</sup> See June 3, 2021 Request for Reconsideration Denied at TSDR 92.

marks as used by each of the entities show use of the same dominant term in connection with their wine and beer products. Thus, this evidence supports the Examining Attorney's argument that beer and wine are related.

The Examining Attorney also submits evidence from the USPTO's X-Search database consisting of the following twenty third-party registrations (owned by eighteen different owners), for marks that are registered for use in connection with both "beer," as identified in the application and "wine," as identified in the cited registration<sup>22</sup>:

<b>Registration No.</b>	<b>Mark</b>	<b>Owner</b>	<b>Goods</b>
5159453	A CRAFTED EXPERIENCE	Novosel LLC	Beer in Class 32 and wine in Class 33 (and services in Class 43)
5217075	VGO GREEN YOUR SENSES	Vgo Holdings LLC	Beer in Class 32 and wine in Class 33 (and food items in Class 30)
5326773		Vgo Holdings LLC	Beer in Class 32 and wine in Class 33 (and food items in Class 30)
5381909	UBC	Underground Brewing Company, LLC	Beer in Class 32; Wine in Class 33 (and coffee and tea in Class 30)
5225022 (Supplemental Register)	DELICIOUS RED HARD APPLE CIDER	Troubled Minds Inc.	Beer in Class 32; Wine in Class 33
5662013	BEAT CULTURE	Alan Espino	Beer in Class 32; Wine in Class 33 (and clothing items in Class 25;

<sup>22</sup> June 3, 2021 Request for Reconsideration Denied at TSDR 10-63.

			bar and restaurant services in Class 43)
6119243	FIVE STORIES	OTR Distillers, LLC	Beer in Class 32; wine in Class 33 (and clothing items in Class 25)
5301317	SPRING GATE	Schoffstall Farm, LLC	Beer in Class 32; wine in Class 33
5973378	SPRINGGATE	Schoffstall Farm, LLC	Beer in Class 32; wine in Class 33
5551925	CHEERS BEACHES	Keith Lauer	Beer in Class 32; wine in Class 33 (and back packs and various types of bags in Class 18)
5531596		RWMD, Inc.	Beer in Class 32; wine in Class 33 (and retail grocery store services in Class 35; bar and restaurant services in Class 43)
5480757	SCHILLINGBRIDGE	Stonebridge Vineyard Inc.	Beer in Class 32; wine in Class 33
5603137	LAKE LIFE	New Holland IP, LLC	Beer in Class 32; wine in Class 33
5733907		Abnormal Company, Inc.	Beer in Class 32; wine in Class 33
5957365		Vasko Raytchev	Beer in Class 32; wine in Class 33
6165397	BAD JOKER BREWING COMPANY	Bad Joker Brewing Company, Inc.	Beer in Class 32; wine in Class 33

6032892	WASH IT DOWN	HNJ Group Inc.	Beer in Class 32; wine in Class 33
6215946	 Nova Brewing Co.	Nova Brewing LLC	Beer in Class 32; wine in Class 33
6338913	DINGO DOG BREWING COMPANY	Dingo Dog Brewing Company Ltd	Beer in Class 32; wine in Class 33 (and beer garden services in Class 43)
6355262	DEVIL'S FIRE	Toddy Inc.	Beer in Class 32; wine in Class 33

While these use-based, third-party registrations alone are not evidence that the marks shown therein are in commercial use or that the public is familiar with them, they nonetheless have probative value to the extent they serve to suggest that the identified goods, i.e., beer and wine, are of a kind that emanate from a single source. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1738 (TTAB 2018); *In re Kysela*, 98 USPQ2d at 1264 (holding HB for wine likely to be confused with HB and design for beer); *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). Accordingly, this evidence further supports the relatedness of Applicant's beer and Registrant's wine. *See, e.g., Anheuser-Busch, LLC v. Innovopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1826-27 (TTAB 2015) (citing cases in which "this Board has found beer and wine related on a number

of occasions<sup>23</sup> . . . the parties have not cited any precedential decision holding beer and wine unrelated for purposes of a likelihood of confusion analysis”).

The evidence establishes that the practice of selling wine and beer under the same, or nearly identical, marks is common enough that those familiar with

PRETENTIOUS wine may assume that  beer comes from the same source.

Furthermore, the website evidence discussed above showing that wine and beer are related goods also establishes that beer and wine travel in the same channels of trade to the same classes of customers. *See also Anheuser-Busch*, 115 USPQ2d at 1827 (“it is clear that beer and other alcoholic beverages (including wine) are sold to consumers in many of the same channels of trade, including retail outlets such as liquor stores, supermarkets, convenience stores, restaurants, and bars ...”).

Accordingly, we find that Applicant’s and Registrant’s goods are sufficiently related. In making this determination, we rely on the evidence that beer and wine are offered by the same parties under the same marks, or marks having the same initial dominant feature, and these goods are marketed together in channels of trade directed to the same general adult drinking population.

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<sup>23</sup> *Anheuser-Busch v. Innovopak Sys.* citing: *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261 (TTAB 2011); *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719 (TTAB 1992); *In re Gebr. Eckel GMBH*, 196 USPQ 198 (TTAB 1976) (mem.); *Krantz Brewing Corp. v. Henry Kelly Importing & Distrib. Co. Inc.*, 96 USPQ 219 (Exm’r in Ch. 1953); *Fruit Indus., Ltd. v. Ph. Schneider Brewing Co.*, 46 USPQ 487 (Comm’r Pats. 1940).

### C. Applicant's Existing Registration

Lastly, Applicant argues “[o]ne important factor that must be considered in this case is that Applicant is already the owner of an existing registration for a ‘Pretentious’ related design mark for the identical goods of the present application.” Applicant owns Registration No. 5840191 issued on August 20, 2019 for the mark




for “beer.”<sup>24</sup> Applicant cites *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012) for support.

In that case, which involved co-existing registrations each more than five years old and immune to attack on likelihood of confusion grounds, the Board granted registration to the applicant’s application for the mark ANYWEARS on the basis of its ownership of a prior registration for the mark ANYWEAR. The Board acknowledged that “under usual circumstances” it would have concluded that

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<sup>24</sup> In the November 3, 2020 Response to Office Action, Applicant claimed ownership of Registration Nos. 5383429 for the standard character mark THE PRETENTIOUS BEER & GLASS COMPANY (for beer glasses, cocktail glasses, and drinking glasses), and 5840191 for

the composite word-and-design mark  (for beer), each with BEER & GLASS COMPANY disclaimed.

It is noted that the application from which Applicant’s Registration No. 5840191 issued was initially refused registration based on Registrant’s Registration No. 4607261 for PRETENTIOUS for wine (the same Registration that is cited against Applicant’s current application), and suspended for a potential cite based on another then-pending application. Although the March 13, 2018 Suspension Notice indicated that the refusal of registration based on Registration No. 4607261 was continued and maintained, the application was subsequently approved for publication after a response to the Suspension Notice advised that the pending application had been abandoned. The record is silent with respect to the § 2(d) refusal based on Registration No. 4607261.

confusion is likely to occur; however, an “unusual situation” compelled the Board “to balance the similarities between the marks and goods against the facts that applicant already own[ed] a registration for a substantially similar mark for the identical goods, and that applicant’s registration and the cited registration ha[d] coexisted for over five years.” *Id.* at 1399. Basing its decision on the thirteenth *DuPont* factor, which “relates to ‘any other established fact probative of the effect of use,’” *id.* at 1399 (quoting *DuPont*, 117 USPQ at 567), the Board determined that “this factor outweighs the others” and found confusion unlikely, reversing the refusal to register. *Id.* at 1400.

Following *Strategic Partners*, Section 1207.01 of the TRADEMARK MANUAL OF EXAMINING PROCEDURE (July 2021) explains what factors the examining attorney should consider when dealing with the coexistence of an applicant’s prior registration:

In view of *Strategic Partners*, when determining whether the coexistence of the applicant’s prior registration with another party’s registration weighs against citing the latter registration in a §2(d) refusal of the applicant’s applied-for mark, the examining attorney should consider: (1) whether the applicant’s prior registered mark is the same as the applied-for mark or is otherwise not meaningfully different; (2) whether the identifications of goods/services in the application and the applicant’s prior registration are identical or identical in relevant part; and (3) the length of time the applicant’s prior registration has co-existed with the registration being considered as the basis for the §2(d) refusal. *See id.* at 1400. The duration of coexistence is not dispositive as to whether a §2(d) refusal should issue; instead, this factor should be considered together with all the other relevant *du Pont* factors. *See id.* at 1400; *cf. In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1748 (TTAB 2018) (finding that applicant’s earlier registration of a partially similar mark was a neutral factor in the §2(d) analysis, because the applied-for mark was

more similar to the cited registered mark than applicant's previously registered mark); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (distinguishing *Strategic Partners* and finding that the 3½-year coexistence of applicant's prior registration and the cited registration was a relevant consideration but did not outweigh the other relevant *du Pont* factors).



Turning to the first factor, whether Applicant's prior registered mark is



the same as its applied-for mark , or is otherwise not meaningfully different, we find that Applicant's marks differ greatly. Although conceding that "the designs are quite different," Applicant nonetheless argues that because the wording of both marks includes the term "Pretentious" in combination with other disclaimed wording, the two marks are "not meaningfully different."<sup>25</sup> To the contrary, when considering the marks as a whole, the differences in these two marks are readily apparent. There are obvious differences in the literal portions of the marks and even greater differences in their stylized caricatures and designs. This represents a key factual distinction from *Strategic Partners*.

Looking to the next factor, whether the identifications of goods in Applicant's application and its prior registration are identical or identical in relevant part, the identifications of goods in the subject application and Applicant's prior registration are identical. Moving to the last factor, the length of time Applicant's prior

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<sup>25</sup> Applicant's Brief p. 13 (9 TTABVue 14).




registration has co-existed with the cited registration, Applicant's prior registration issued August 20, 2019, has co-existed with Registrant's registration (the basis for the § 2(d) refusal) less than 2 ½ years, i.e., from August 20, 2019 to the present. In *Strategic Partners*, the applicant owned a registered mark that had coexisted with the cited mark for over five years. This was significant, and represents another key factual distinction from *Strategic Partners*. Because the applicant's prior registration was over five years old, it was not subject to attack by the owner of the cited registration based on a claim of likelihood of confusion. *Strategic Partners*, 102 USPQ2d at 1399.

Here, Applicant's existing registration has coexisted with the cited registration for substantially less than five years. "This is significant not only because it is less time, but because the five-year milestone carries added weight because of its legal significance under the Lanham Act: it means that Applicant's registration, . . . , is still subject to a cancellation action by Registrant based on likelihood of confusion." *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (citing Section 14 of the Trademark Act, 15 U.S.C. § 1064).

In the case before us, while Applicant's prior registration and the cited registration have co-existed for 2 ½ years, this does not outweigh the other *DuPont* factors in this case – particularly because Applicant's prior registered mark is not substantially similar to the mark at issue in this appeal.

## II. Conclusion

Applicant's mark  incorporates the entirety of Registrant's standard character mark PRETENTIOUS, and the sole word in Registrant's mark is the dominant portion of Applicant's mark. The similarity and sound, appearance, and commercial impressions between the marks weighs heavily in favor of a finding of a likelihood of confusion. The evidence supports that Applicant's beer is related to Registrant's wine and offered together in channels of trade directed to the same general adult drinking population. In view of the similarity of the marks, the relatedness of the goods, and the overlapping trade channels and potential customers, we conclude that confusion is likely between Applicant's mark for beer and Registrant's mark for wine.

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