

This Opinion is Not a  
Precedent of the TTAB

Hearing: September 7, 2023

Mailed: February 29, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Vinedo de Zorro, LLC*

Serial No. 90055100

John L. Slafsky of Wilson Sonsini Goodrich & Rosati  
for Vinedo de Zorro, LLC.

Laura Golden, Trademark Examining Attorney, Law Office 103,  
Stacy Wahlberg, Managing Attorney.

Before Taylor, Adlin and Lebow, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Vinedo de Zorro, LLC seeks registration of VINEDO DE ZORRO, in standard characters, with “VINEDO” disclaimed, for “limited-production, hand-made, premium wine,” in International Class 33.<sup>1</sup> The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the previously-registered mark BAR ZORRO, in standard characters, with “BAR” disclaimed, for “restaurant and bar

---

<sup>1</sup> Application Serial No. 90055100, filed July 15, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce. According to the application, “[t]he English translation of VINEDO DE ZORRO in the mark is FOX’S VINEYARD.”

services,” in International Class 43,<sup>2</sup> that it is likely to cause confusion. After the refusal became final, Applicant appealed. The appeal is fully briefed.

## **I. Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“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.”).

### **A. The Marks**

We consider marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). Here, the marks are obviously similar in some ways (they

---

<sup>2</sup> Registration No. 5908548, issued November 12, 2019 (the “Cited Registration”).

share the distinctive term “ZORRO”), and different in others (their non-distinctive lead terms are completely different and not even in the same language).

We start by finding that the marks’ shared term “ZORRO” is the dominant feature of both of them, notwithstanding that in each mark other term(s) come first. While Applicant is of course correct that all else being equal we “should give the greatest weight to the first word of each mark,” 4 TTABVUE 8,<sup>3</sup> all else is not equal here.

To the contrary, the first parts of Applicant’s mark and the cited mark are generic or at best merely descriptive of the identified goods and services, and thus disclaimed. Specifically, “VINEDO,” the lead term in Applicant’s mark, means “vineyard,” which is descriptive of the source of Applicant’s “limited-production, hand-made, premium wine” (Applicant’s vineyard). November 2, 2020 Office Action TSDR 12-13 (translation of Applicant’s mark and an English language definition of “vineyard”).<sup>4</sup> Similarly, “BAR,” the lead term in the cited mark, is generic or at best merely descriptive of Registrant’s identified “bar services.” Applicant’s disclaimer of “VINEDO” and Registrant’s disclaimer of “BAR” are concessions that these terms are merely descriptive at best. *In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008); *see also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d

---

<sup>3</sup> Citations to the appeal record are to TTABVUE, the Board’s online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

<sup>4</sup> Citations to the application file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system’s online database, by page number, in the downloadable .pdf format.

1750, 1762 (TTAB 2013), *aff'd mem.*, 565 Fed. App'x 900 (Fed. Cir. 2014). It is settled that descriptive and disclaimed terms such as “BAR” and “VINEDO” are entitled to less weight in our analysis. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (DELTA, not the disclaimed term CAFÉ, is the dominant portion of the mark THE DELTA CAFÉ).

We also take no issue with another general proposition Applicant asserts, that “[e]ven a first word that is descriptive may dominate the commercial impression of the mark if it is used in a prominent manner.” 4 TTABVUE 8. The problem for Applicant is that here, we cannot assume that either “VINEDO DE”<sup>5</sup> or “BAR” will be used in a “prominent manner,” as all words in Applicant’s and Registrant’s standard character marks are on equal footing. That is, because the marks are both in standard characters, as opposed to being in a “special form,” they (and each of their constituent words) could be displayed in any font or size (or style or color), meaning that “VINEDO DE” in Applicant’s mark and “BAR” in the cited mark could be

---

<sup>5</sup> As made clear by the evidence of record, including Applicant’s translation statement in the involved application, the two letter word “de” in Applicant’s mark denotes that the “VINEDO” (vineyard) named in Applicant’s Spanish-language mark is owned by a “ZORRO” (“fox”). In other words, as used in Applicant’s mark, “de” conveys possession. November 2, 2020 Office Action TSDR 12-13; Applicant’s translation statement. The term “de” is significantly less important in our analysis because it is a small, two-letter word the meaning of which merely clarifies the rest of Applicant’s mark.

displayed in an equally, or even **less**, prominent manner than the shared term “ZORRO.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011).

In circumstances like this, where the first term(s) in a mark are descriptive and no more prominent than the rest of the mark, as “VINEDO DE” and “BAR” are here, they may be accorded less weight than a mark’s trailing term(s). *See e.g. Monster Energy Co. v. Chun Hua Lo*, 2023 USPQ2d 87, at \*33 (TTAB 2023) (“disclaimed and descriptive terms may be considered less significant features of the mark, even when they appear first”); *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 BL 504730 (TTAB 2019) (ROAD WARRIOR likely to be confused with WARRIOR in stylized form); *Anheuser-Busch, LLC v. Innovopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1815 (TTAB 2015) (“the dominant part of Applicant’s mark [WINEBUD] is clearly ‘BUD’”); *In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1935 (TTAB 2012) (finding “ASSURANCE” to be the dominant part of the marks TALENT ASSURANCE and JOB ASSURANCE because “the additional words TALENT and JOB are merely descriptive” of the applicant’s personnel/employment placement, recruitment and counseling services). Thus, we find that “ZORRO” is the dominant feature of both marks.

The marks look and sound similar because they share this dominant term. We recognize that the other elements of the marks – “VINEDO DE” and “BAR” – look and sound completely different, but consumers are more likely to focus on the most distinctive, identical portion of the marks, rather than the terms that describe the

Serial No. 90055100

source of Applicant’s wine, or are the common name of one of Registrant’s identified services. Thus, in their entirety, the marks are more similar than dissimilar in sound and appearance.

The marks are also more similar than dissimilar in meaning and commercial impression. As the Examining Attorney argues, both marks create the commercial impression of “alcohol-related goods and services being offered under the ZORRO brand.” 6 TTABVUE 6. Applicant’s argument that its mark “brings to mind a vineyard where wine is grown, together with an animal, a fox,” while Registrant’s mark “brings to mind a place for people to have drinks, a bar, together with a dashing and masked swashbuckler” character named Zorro, 4 TTABVUE 7, is not well-taken. According to a CTbites article about Registrant’s BAR ZORRO, “‘Zorro,’ in this case, isn’t just the infamous Mexican masked vigilante that you’re thinking of, it’s the Spanish term for fox,’ and if you know anything about Evarito’s, you know that their mascot is the emoji fox.” November 10, 2022 Denial of Request for Reconsideration TSDR 28. In fact, Evarito’s, the restaurant affiliated with and on the ground floor of BAR ZORRO, displays its fox mascot on its menu and website, immediately above the BAR ZORRO mark, as shown below:



*Id.* at 43 (highlighting added); *see also id.* at 34. Thus, consumers could very well associate both Applicant's wine and Registrant's bar with a fox. And, to the extent consumers perceive "Zorro" as "the infamous Mexican masked vigilante" rather than a fox, they could do so with respect to both Applicant's and Registrant's marks. In other words, some consumers could perceive the ZORRO in VINEDO DE ZORRO as "the infamous Mexican masked vigilante" rather than a fox. Furthermore, as the Examining Attorney points out, the leading terms "VINEDO DE" in Applicant's mark and "BAR" in Registrant's "highlight the production or sale of alcoholic beverages," 6 TTABVUE 4, with "VINEDO DE" describing where Applicant's wine is produced and "BAR" describing the types of services Registrant offers.

Thus, this factor weighs in favor of finding a likelihood of confusion.

**B. The Goods and Services, Channels of Trade and Classes of Consumers**

The goods and services need not be identical or even competitive in order to find a likelihood of confusion. Rather, the question is whether the goods and services are marketed in a manner that "could give rise to the mistaken belief that they 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) (“[E]ven 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”).

Here, the Examining Attorney argues that third-party websites establish a relationship between the goods and services, because they show that some wine producers and sellers also use their wine trademarks for bar or restaurant services (often featuring their wine). *See In re Detroit Athl. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (crediting relatedness evidence showing that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co.*, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

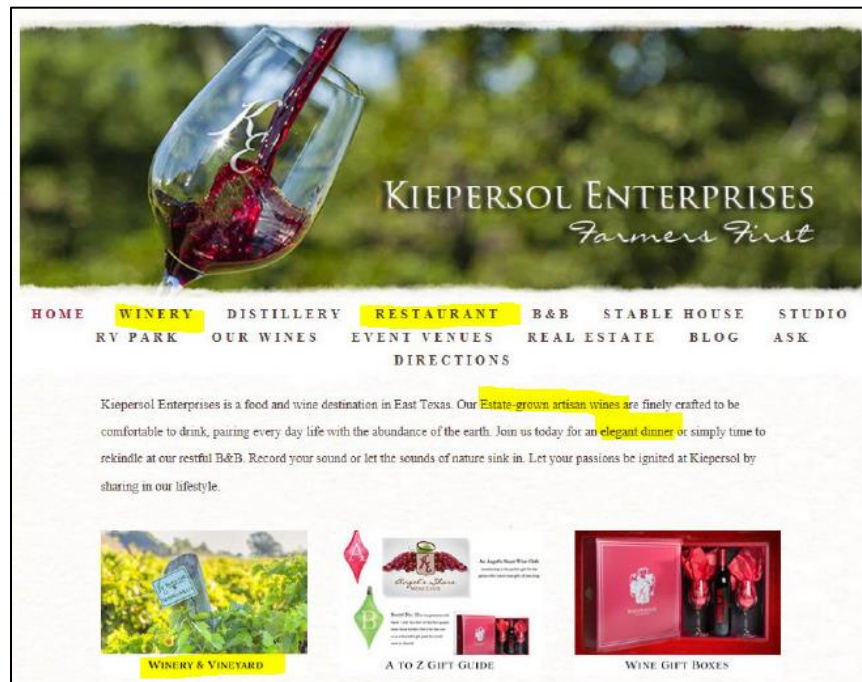
For example, one third party operates a winery and a bistro under the RED NEWT CELLARS mark, as shown below:





November 2, 2020 Office Action TSDR 14. One of the winery/bistro's "cyber week deals" was "FREE shipping on full cases of wine," and the winery also offers a "wine club." *Id.* at 15. Red Newt Cellars features a "tasting room," which is functionally akin to, if not essentially, a bar. *Id.* at 16.

Similarly, Kiepersol Enterprises operates a restaurant and sells wine from its "Winery & Vineyard," as shown below:



*Id.* at 18 (highlighting added).

Another third party uses its LITTLE HILLS WINERY mark for not just its winery, wine shop and associated goods and services, but also a restaurant:



*Id.* at 20 (highlighting added). Similarly, one winery uses its KNAPP mark for wine and a “vineyard restaurant”:



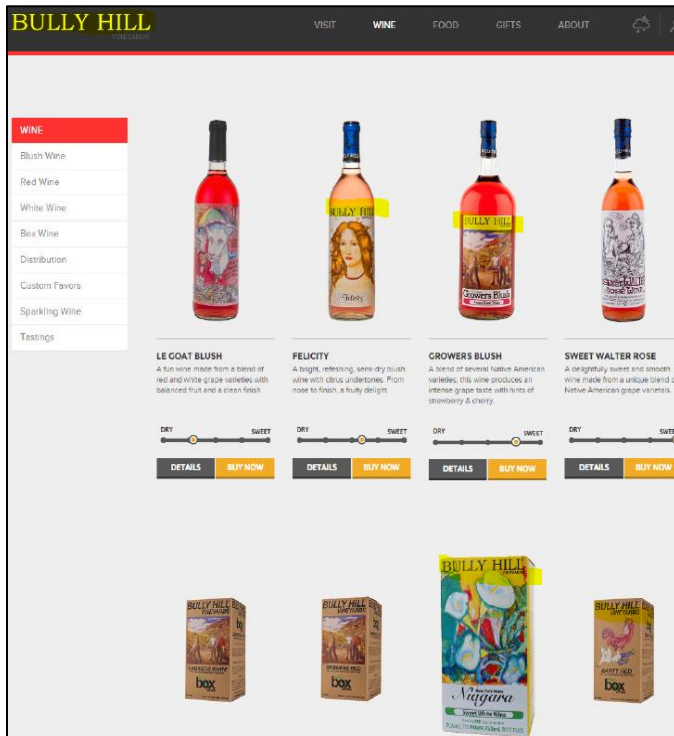
*Id.* at 22 (highlighting added).

“The Blind Horse Restaurant and Winery offers a ‘Napa Valley Style’ experience,” including “food and wine pairing” and the opportunity to “[d]elight in a glass of Pinot Grigio and gourmet pizza on our outdoor patio”:

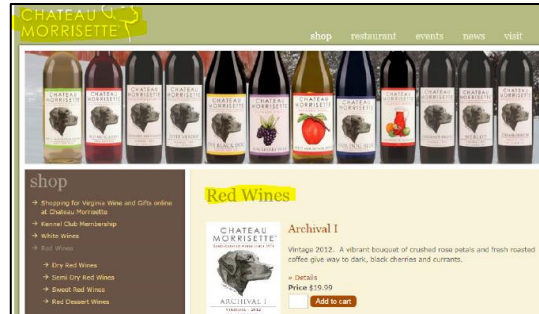


*Id.* at 24, 26 (highlighting added).

Bully Hill Vineyards uses its BULLY HILL mark for restaurant services and wine, as shown below:



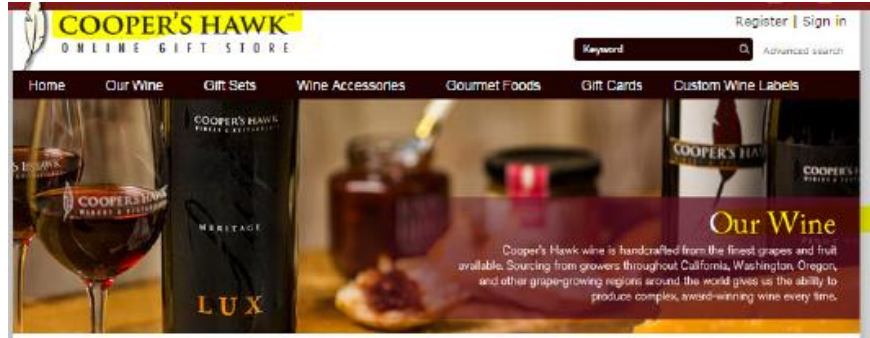
*Id.* at 28, 29 (highlighting added). Another third party vineyard uses its CHATEAU MORRISETTE mark for the vineyard, associated wine sales and a restaurant, as shown below:



Id. at 32, 33 (highlighting added).

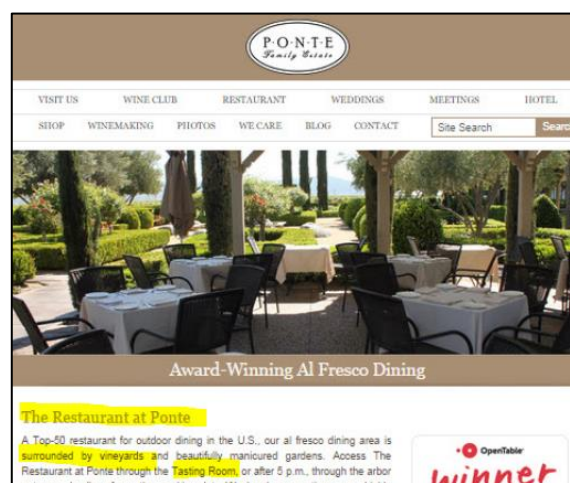
Cooper's Hawk Winery & Restaurants uses its COOPER'S HAWK mark for wine, a restaurant and a "Napa-style tasting room," while another third party uses its MAGNANINI mark for a "Winery & Restaurant," with the "Winery Restaurant overlooking the picturesque vineyards":





Id. at 37-39 (highlighting added).

The third-party PONTE mark is used for a winery, vineyard, and restaurant with a tasting room and dining area “surrounded by vineyards,” while the third party TABOR HILL mark is used for another “Winery & Restaurant,” as shown below:





*Id.* at 41, 43, 44 (highlighting added). WENTE Vineyards is another example. It uses its WENTE mark for a restaurant as well. *Id.* at 48, 49.

The Examining Attorney also introduced evidence that: restaurants often offer wine or are affiliated with bars that do; and wineries, wine bars and wine shops are sometimes affiliated with restaurants that share the same name or use the same mark(s). September 19, 2022 Office Action<sup>6</sup> TSDR 7-84 (evidence concerning Bacchanal Wine, Delachaise, Barcelona Wine Bar, Maxwell Park, Uncorked, Stone Tower Winery, Barboursville Vineyards, Amaterra, Hyde Park Fine Wines, Parma Ridge, Belle Fiore, Allora Wine Bar & Restaurant, King Estate and Y Knot Winery). This evidence further supports a finding that the goods and services are related because consumers are accustomed to wine and bar or restaurant services being offered under the same marks or names.

Finally, the Examining Attorney introduced the following use-based third-party registrations showing that the same marks are registered for wine on the one hand and restaurant or bar services on the other:

THATCH (Reg. No. 6380743) is registered for “wine,” “restaurant and bar services” and “bar services, namely, wine bars.”

---

<sup>6</sup> The September 19, 2022 Office Action “is supplemental to and supersedes the previous Office Action issued on September 6, 2022.” September 19, 2022 Office Action TSDR 2.

QUARRY RIDGE WINERY (Reg. No. 6278606) is registered for “wines,” “wine bars” and “restaurant and bar services.”

EL CARAJO (Reg. No. 6357094) is registered for “wine” and “restaurant and bar services.”



(Reg. No. 6120129) is registered for “wine and prepared alcoholic cocktails” and “restaurant and bar services.”



(Reg. No. 6028529) is registered for “wine” and “restaurant and bar services.”

HAZY BARBEQUE (Reg. No. 6670131) is registered for “wine” and “restaurant and bar services.”

BEAT CULTURE (Reg. No. 5662013) is registered for “wine,” “taproom services featuring craft beer, wine, mead, cider” and “restaurant and bar services.”



(Reg. No. 5391752) is registered for “wine” and “restaurant and bar services.”

GERVASI VINEYARD (Reg. No. 5315597) is registered for “wine” and “restaurant and bar services.”

CARBOY WINERY (Reg. No. 5203765) is registered for “wine” and “restaurant and bar services.”

A CRAFTED EXPERIENCE (Reg. No. 5159453) is registered for “wine” and “restaurant and bar services.”

CITY WINERY (Reg. No. 5025268) is registered for “wine” and “restaurant and bar services.”



(Reg. No. 2865101) is registered for “wine” and “restaurant and bar services.”

LEFT FOOT CHARLEY (Reg. No. 5199852) is registered for “wine” and “restaurant and bar services.”



(Reg. No. 6274290) is registered for “wines,” “restaurant and bar services” and “wine bars.”

BIN 36 (Reg. No. 2768057) is registered for “wine” and “restaurant and bar services.”



(Reg. No. 3652326) is registered for “wine” and “restaurant and bar services.”

September 19, 2022 Office Action TSDR 85-118. “Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998). Thus, this evidence corroborates the third-party use evidence upon which the Examining Attorney relies.

For its part, Applicant relies primarily on what its counsel describes as “over 300 pairs” of “co-existing trademark registrations at the USPTO for the same mark, with different owners, reflecting identifications of goods or recitations of services including, on the one hand, wine or beer or liquor, and on the other, restaurant or



restaurant and bar services.” October 5, 2022 Request for Reconsideration TSDR 52-1258; *id.* at 1259 (Declaration of John Slafsky ¶ 2); *see also* December 23, 2020 Office Action response TSDR 41-400 (additional third-party registrations submitted without accompanying declaration testimony). *Cf. In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015) (considering similar argument).

There are issues with these “pairs” of third-party registrations, however. First, the third-party registration evidence Applicant introduced with its Request for Reconsideration does not include ownership information, and we therefore cannot confirm Applicant’s counsel’s testimony that these are pairs of registrations “with different owners.” Second, the third-party registrations Applicant submitted that cover bar or restaurant services on the one hand, and beer or liquor (but not wine) on the other, are of little relevance here, where the question is whether wine specifically, as opposed to alcoholic beverages generally, is related to bar or restaurant services. Nonetheless, we accept Applicant’s counsel’s testimony that these pairs of registrations have “different owners,” and acknowledge that even when we exclude the pairs in which neither registration covers wine, the number of pairs remaining is still large.

When we weigh the Examining Attorney’s evidence against Applicant’s, we find that wine is related to at least bar services, and that wine and bar services travel in some of the same channels of trade to overlapping classes of consumers (primarily wine drinkers). Indeed, it is common knowledge, and the record amply reflects, that

bars serve alcoholic beverages, often and typically including wine.<sup>7</sup> In fact, the record shows that restaurants, bars and vineyards promote “pairings” of certain dishes or types of food they prepare with particular wines or types of wines. The record also establishes that wine drinkers may purchase wine not only in wine stores, wineries or vineyards, but also in restaurants or bars. More specifically, wine consumers may purchase glasses of wine at restaurants or bars, and many vineyards, and bottles of wine at restaurants, wine stores and vineyards.

Applicant’s “pairs” of third-party registrations do not outweigh the Examining Attorney’s evidence, for several reasons. First, this case is different than *Thor Tech*. The *Thor Tech* decision was based in large part on the “significant” fact that “seven sets of third-party registrations [in that case] appear to be owned, respectively, by the [*Thor Tech*] Registrant [owner] of the cited registration and [the *Thor Tech*] Applicant or one of [the *Thor Tech*] Applicant’s related companies.” 113 USPQ2d at 1548. In this case, by contrast, there is no evidence that either Applicant or the owner of the Cited Registration own any of the registrations among the “pairs” upon which Applicant relies. Second, proving that the third-party marks Applicant relies upon have coexisted on the Register “does not prove that they coexisted during that time without confusion in the marketplace.” *In re Thomas*, 79 USPQ2d 1021, 1028 (TTAB 2006). Third, we do not know whether there are licenses or coexistence agreements, much less the terms thereof, which could explain the coexistence of these

---

<sup>7</sup> Of course, as the record shows, many restaurants also offer alcoholic beverages, with wine being among the most prominent examples.

registrations. Fourth, there is no evidence concerning how many times applications covering wine were refused based on existing registrations of similar marks for restaurant or bar services, or vice versa. Finally, “neither the Trademark Examining Attorney nor the Board is bound to approve for registration an Applicant’s mark based solely upon the registration of other assertedly similar marks for other goods or services having unique evidentiary records.” *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); *see also In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits. .... Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”).

In addition to relying on the “pairs” of registrations it introduced, Applicant points out that under *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1063 (Fed. Cir. 2003) the “record must show ‘something more’ than that similar or even identical marks are used for beverage or food products and for restaurant services.” 4 TTABVUE 12. In *Coors Brewing* the Federal Circuit extended *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982), and applied the “something more” requirement in a case involving beer on the one hand and restaurant (but not bar) services on the other. It found that even though the record showed that “several” restaurants offered private or house brands of beer, “several” third-party registrations showed that a single mark was registered for beer and restaurant services, and some brewpubs offered restaurant services, that evidence

did not meet the “something more” requirement. *Coors Brewing*, 68 USPQ2d at 1063. More specifically, the applicant failed to establish that consumers would be likely to conclude that beer and restaurant services emanate from the same source because “even if all brewpubs, microbreweries, and regional specialty breweries featured restaurant services, those establishments would constitute only about 18 one-hundredths of one percent of all restaurants, or fewer than one in 500,” and there were not “numerous” restaurants selling private label beer. *Id.*

Perhaps the biggest problem with this argument is that here, unlike in *Coors Brewing*, the Cited Registration does not identify restaurant services alone; rather, it identifies “restaurant **and bar services**” (emphasis added). This is a major difference.

Indeed, it is common knowledge, and this record amply reflects, that bars serve wine. *See e.g.* September 19, 2022 Office Action TSDR 12 (Bacchanal Wine’s bar serves wine). There is even a category of bars known as “wine bars.” *Id.* at 15 (Delachaise Wine Bar & Bistro), 19 (Barcelona Wine Bar), 22 (Wine Enthusiast magazine referring to Maxwell Park as “Not Your Typical Buttoned Up Wine Bar”), 28 (Uncorked! Wine Bar) and 74 (Alloro Wine Bar). Moreover, the record reveals that wineries sometimes offer “tasting rooms” that are essentially bars, or, at the very least, render “bar services” such as those identified in the Cited Registration. November 2, 2020 Office Action TSDR 16 (Red Newt Cellars’s tasting room), 37 (Cooper’s Hawk tasting room) and 43 (Ponte tasting room). *See also* September 19,

2022 Office Action TSDR 85-118 (third-party registrations covering both wine and bar services or, more specifically, wine bars).

The record here shows generally that there is an inherent relationship between wine and bar services, because it is so common for bars to serve wine, to the point that a number of them (sometimes called “wine bars”) specialize in wine. While the record does not establish the percentage of bars that offer wine, it strongly suggests that it is significantly higher than 0.18%. In fact, the evidence at least suggests that most bars offer wine.<sup>8</sup>

---

<sup>8</sup> The “something more” requirement may be satisfied and confusion found likely when restaurants offer the types of food or beverages at issue. *See e.g. In re Accelerate s.a.l.*, 101 USPQ2d 2047 (TTAB 2012) (affirming refusal to register COLOMBIANO COFFEE HOUSE for “providing food and drink” based on registered certification mark COLOMBIAN for “coffee,” in part because “applicant’s own website evidence indicates that it is in the business of rendering coffee house services”); *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) (affirming refusal to register OPUS ONE for restaurant services based on a likelihood of confusion with the same mark for wine, and stating “[t]he fact that applicant’s restaurant serves the type of goods (indeed the actual goods) identified in the cited registration is certainly probative evidence which supports a finding under the second *du Pont* factor that applicant’s services and opposer’s goods are related”); *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999) (in affirming refusal to register AZTECA MEXICAN RESTAURANT for restaurant services due to prior registration of AZTECA for prepared Mexican foods, “something more” was found because “Mexican food items are often principal items of entrees served by restaurants, certainly by Mexican restaurants. The average consumer, therefore, would be likely to view Mexican food items and Mexican restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks”); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074, 1075 (TTAB 1990) (affirming refusal to register GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services based on registration of GOLDEN GRIDDLE for table syrup, finding that “Applicant’s mark makes it clear that its restaurant serves pancakes and, no doubt, pancake (or table) syrup, as well. There is an undeniable connection between the goods of the registrant and the services of applicant.”). *See also Roush Bakery Products Co., Inc. v. Ridlen, et al.*, 190 USPQ 445, 447 (TTAB 1976) (finding relationship between restaurant services and bread, stating that “[w]hatever gap exists is substantially narrowed by applicants’ business of selling packaged bread as a retail food product at their restaurant.”).

More specifically and importantly, the record shows that wineries, vineyards and even wine stores offer bars, or “tasting rooms” that provide “bar services.” In fact, the record establishes that vineyards, winemakers and wine sellers offer bar services at least in part for the purpose of introducing their wines to potential customers, hoping that consumers will decide to purchase bottles of the wine they sample at the bar/tasting room. There was no similar or analogous evidence in *Coors Brewing*.<sup>9</sup>

The Examining Attorney’s third-party evidence also makes clear that the channels of trade and classes of consumers for wine overlap with those for bar services. In fact, bargoers may choose to drink wine in bars, after selecting it from the bar’s wine list or menu. Similarly, wine consumers may consume wine not only at home or in restaurants, but also at bars, including tasting rooms when they visit vineyards or wineries. In fact, the record shows that bar services and wine are often promoted and offered together, to wine drinkers. Those wine drinkers may “consume” wine and bar services together.

---

<sup>9</sup> Moreover, in *Coors Brewing* the Federal Circuit stated, albeit in dicta, that: “[t]his case would be different ... if the registrant’s mark had been for a brewpub ... In that case, the goods and services associated with the two marks would clearly be related and the case for a likelihood of confusion therefore much stronger. But the registered mark in this case is simply for restaurant services in general ....” *Coors Brewing*, 68 USPQ2d at 1064. While there is no evidence that the owner of the Cited Registration produces its own wine, in some ways this is nevertheless the type of “different” case the Federal Circuit hypothesized about in *Coors Brewing*, because purchasers of Applicant’s wine would be prospective consumers of Registrant’s bar services and vice versa. *Id.* (citing *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993)).

In short, the record shows that wine and bar services are related, and that their channels of trade and classes of consumers overlap. These factors also weigh in favor of finding a likelihood of confusion.

### **C. Consumer Sophistication and Care**

Applicant amended its identification of goods from “wine” to “limited-production, hand-made, premium wine.” October 5, 2022 Request for Reconsideration TSDR 35. Moreover, the co-owner of an entity that “provides wine-making services to Applicant” testifies that Applicant’s wine: (1) “is offered to consumers at prices in the range of approximately \$100-350 per bottle;” and (2) “is of interest to people who are wine enthusiasts and who exercise a high degree of care when making their purchasing decisions.” *Id.* at 1260 (Declaration of Cody Muhly ¶¶ 1, 4, 5). Applicant argues based on its amended identification of goods and this evidence that “[w]ine that is high-end and not inexpensive tends to be purchased by sophisticated, discriminating purchasers.” 4 TTABVUE 18.

We accept that consumers of “premium wine” will likely exercise more care in purchasing than consumers of low-end wine. At the same time, as the Examining Attorney points out, there is no limitation on Registrant’s “bar services,” and thus we must assume that Registrant’s BAR ZORRO could offer “limited-production, hand-made, premium wine,” perhaps even including the wine Applicant intends to offer

under VINEDO DE ZORRO. This factor weighs slightly against finding a likelihood of confusion.<sup>10</sup>

## II. Conclusion

The marks are more similar than dissimilar, the goods and services are inherently related and often offered together, and the channels of trade and classes of consumers overlap. These factors outweigh any consumer sophistication or care in purchasing. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970); *see also, HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweighed sophisticated purchasers, careful purchasing decision, and expensive goods). Confusion is likely.

**Decision:** The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.

---

<sup>10</sup> Applicant points out that there is no evidence that the cited mark is "well-known or famous," or that there has been any actual confusion between the mark in the Cited Registration and the mark in Applicant's involved intent to use application. 4 TTABVUE 19. Neither point is relevant here. *See e.g. Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) ("The absence of any showing of actual confusion is of very little, if any, probative value here because (1) no evidence was presented as to the extent of ETF's use of the VITTORIO RICCI mark on the merchandise in question in prior years ...."); *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").