

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: March 27, 2023

Mailed: September 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Lindsay Hoopes

Serial Nos. 90498749 and 90498755¹

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Mari-Elise Paul and Trevor Graves of Stites & Harbison PLLC,
for Lindsay Hoopes.

Christina Sobral, Trademark Examining Attorney, Law Office 109,
Michael Kazazian, Managing Attorney.

—
Before Kuhlke, Heasley and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

¹ Although these appeals were not formally consolidated, we issue a single decision because the issues and records are substantially similar and the appeals were heard jointly. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1043 (TTAB 2013) (two appeals involving common issues of law and fact decided in a single opinion). Each proceeding, however, retains its separate character and will result in the entry of a separate judgment for each application. *In re Hudson News Co.*, 39 USPQ2d 1915, 1916 n.5 (TTAB 1996) (Board issued a single opinion in the interest of judicial economy, but each appeal stands on its own merits), *aff'd mem.*, 114 F.3d 1207 (Fed. Cir. 1997). A copy of this decision will be placed in each proceeding file.

We cite to the record in application Serial No. 90498749. Citations to documents contained in the Trademark Status & Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents. Citations to the briefs refer to TTABVUE, the Board's online docket system.

Lindsay Hoopes (“Applicant”) seeks registration on the Principal Register of the two standard-character marks NAPANAC and NAPAÑAC, each identifying “brandy; fortified wines; spirits”² in International Class 33 and each disclaiming NAPA.

The Trademark Examining Attorney has refused registration of the marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the following two standard-character certification marks:

1. NAPA VALLEY for “wine” in Class A.³ The registration includes the following certification statement:

The certification mark, as used by authorized persons, certifies wines derived from grapes grown in the Napa Valley American Viticultural Area and labeled and advertised in compliance with United States laws for the Napa Valley American Viticultural Area appellation of origin.

2. NAPA GREEN (GREEN disclaimed) for:

- “wines derived from grapes grown in Napa County, California, labeled and advertised in compliance with U.S. laws for either the Napa County appellation of origin or the Napa Valley American Viticultural Area appellation of origin” in Class A; and
- “promoting sustainable winery practices in Napa County, California to protect the environmental quality of the region by wineries located in Napa County, California; promoting sustainable grape-growing practices in Napa County, California to protect the environmental quality of the region by grape growers located in Napa County, California” in Class B.⁴

The registration includes the following certification statement:

² Application Serial No. 90498749 and 90498755, respectively; each filed on January 29, 2021 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

³ Registration No. 4853438 issued on November 17, 2015. A Section 8 declaration has been accepted and a Section 15 declaration has been acknowledged.

⁴ Registration No. 3704740 issued on November 3, 2009 and has been renewed.

The certification mark, as used by authorized persons, certifies that the winery or vineyard is located in Napa County, California and produces wine or wine grapes according to sustainable practices that protect the environmental quality of the Napa County region.

When the refusal in each application was made final, Applicant requested reconsideration and appealed. The requests for reconsideration were denied and the appeals resumed. The appeals are fully briefed.

For the reasons explained below, we reverse the refusal to register as to each application.

I. Evidentiary Issues

Applicant attached to her appeal briefs a declaration from her attorney dated the same day the appeal briefs were filed. “[T]he record should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.” Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); *see also In re ZeroSix, LLC*, 2023 USPQ2d 705, at *1 (TTAB 2023) (quoting Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), and excluding evidence attached to the applicant’s appeal brief). The declaration was not filed during prosecution and it is too late for Applicant to file it now.⁵ Accordingly, we do not consider the declaration attached to Applicant’s appeal briefs.

In her appeal briefs, the Examining Attorney asks that we take judicial notice of the dictionary definitions for “fortified wine” and “brandy” from THE AMERICAN

⁵ If Applicant wished to make this evidence of record, its recourse was to request remand of the applications to the Examining Attorney accompanied by the proposed evidence. *In re NextGen Mgmt., LLC*, 2023 USPQ2d 14, at *4-5 (TTAB 2023) (explaining that a request for remand must be accompanied by the evidence sought to be introduced).

HERITAGE DICTIONARY.⁶ The Board may take judicial notice of dictionary definitions, including online dictionaries. *NextGen Mgmt.*, 2023 USPQ2d 14, at *9 n.5; *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Accordingly, and because Applicant has not objected to this request in its reply briefs, the Examining Attorney’s request is granted. We have considered the definitions.

II. Background – Geographic Certification Marks

“There are differences between certification marks and trademarks which potentially impact a likelihood of confusion analysis between such marks.” *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *1 (TTAB 2020). “A certification mark ‘is a special creature created for a purpose uniquely different from that of an ordinary service mark or trademark ...’” *Id.* (quoting *In re Fla. Citrus Comm’n*, 160 USPQ 495, 499 (TTAB 1968)). Under Section 4 of the Trademark Act, 15 U.S.C. § 1054, “certification marks, including indications of regional origin” are entitled to registration. A certification mark is:

any word, name, symbol, or device, or any combination thereof—

- (1) used by a person other than its owner, or
- (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or

⁶ Examining Attorney’s Brief, 8 TTABVUE 11-12; *Id.* at 16-19 (attached definitions).

services or that the work or labor on the goods or services was performed by members of a union or other organization.

15 U.S.C. § 1127.

A certification mark, as distinguished from a trademark, does not indicate commercial source or distinguish the goods or services of one person from those of another person, but “indicates that the goods or services of authorized users are certified as to a particular aspect of the goods or services.” *St. Julian Wine*, 2020 USPQ2d 10595, at *2 (citing 15 U.S.C. §§ 1054, 1127 and the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1306.01); *see also In re Nat’l Ass’n of Veterinary Technicians in Am., Inc.*, 2019 USPQ2d 269108, at *15 (TTAB 2019). “The message conveyed by a certification mark is that the goods or services have been examined, tested, inspected, or in some way checked by a person who is not their producer, using methods determined by the certifier/owner ... [and] that the prescribed characteristics or qualifications of the certifier for those goods or services have been met.” TMEP § 1306.01(b) (July 2022).

Here, the cited marks are geographic certification marks, also referred to as certification marks of regional origin. 15 U.S.C. § 1054 (providing for registration of “certification marks, including indications of regional origin”). Geographic certification marks are used to certify that authorized users’ goods or services originate in a specific geographic region. *See, e.g., St. Julian Wine*, 2020 USPQ2d 10595, at *2 (MICHIGAN APPLE composite marks for apples grown in the state of Michigan); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477 (TTAB 2017) (involving application to register TEQUILA to certify spirits distilled

from blue tequilana weber variety of agave plant of Mexican origin); *Swiss Watch Int'l, Inc. v. Fed. of the Swiss Watch Ind.*, 101 USPQ2d 1731 (TTAB 2012) (involving registered marks SWISS and SWISS MADE to certify watches, clocks and their components made in Switzerland).

The cited NAPA VALLEY mark further designates an American Viticultural Area (AVA), “located within Napa County California,” 27 C.F.R. §§ 9.23 and 9.23(c), while the cited NAPA GREEN mark also certifies that the wine is produced “according to sustainable practices that protect the environmental quality of the Napa County region.”

III. Likelihood of Confusion Analysis

Trademark Act Section 2(d) prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

We must consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). This principle applies with equal force to cases involving geographic

certification marks, but “there are slight differences in the likelihood of confusion analysis in cases involving geographic certification marks.” *St. Julian Wine*, 2020 USPQ2d 10595, at *3 (quoting *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012)).

One difference is that we must consider not only whether there is a likelihood of confusion as to source, sponsorship or affiliation, but also whether consumers are likely to mistakenly believe that the goods of Applicant are certified by Registrant. *Community of Roquefort v. Santo*, 170 USPQ 205, 208 (CCPA 1971) (“We therefore do not think that the marks here so resemble each other that the public will be mistakenly led to believe that appellee’s salad dressing is one certified by appellant.”); *cf. Institut National des Appellations d’Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1888 (TTAB 1998) (rejecting argument “that the only type of confusion that is legally possible or cognizable in certification mark cases is confusion as to whether the defendant’s goods are certified goods. ... [A]s in any other Section 2(d) case, the ‘likelihood of confusion’ which may bar registration of applicant’s mark, if proven, includes likelihood of confusion as to source, sponsorship, affiliation, or connection.”); *cf.* 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19:92.50 (5th ed. Sept. 2023 update) (“Examples of infringement of a certification mark” include “the use of the mark on goods that have not in fact been certified.”). We discuss any other differences as necessary in addressing the relevant *DuPont* factors below.

A. Similarity or Dissimilarity of the Goods, Trade Channels and Classes of Consumers

Under the second and third *DuPont* factors, we consider “[t]he similarity or dissimilarity and nature of the goods or services,” and “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19 (TTAB 2021). We must base our comparisons under the second and third *DuPont* factors on the identifications in Applicant’s application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). However, because a certification mark may not be used by the owner of the mark, but is instead used by certified users, the analysis is based on the **certified users’** goods which in this case consist of wine derived from grapes grown in the Napa Valley American Viticultural Area and/or Napa County.

Applicant argues that “brandy, distilled spirits, and fortified wine have specific legal definitions and the certification marks at issue are limited to wine. As a result, the owner of the certification marks ... cannot certify all the products identified under Applicant’s Mark[s]; it is therefore granting the certification marks overly broad protection to conclude that the goods offered under the marks are related.”⁷ This line

⁷ Appeal Brief, 6 TTABVUE 7; *see also id.* at 19.

of argument is unpersuasive. In assessing the second *DuPont* factor, we are not limited to the “legal definitions” of terms. Rather, we consider the plain meaning of the words in the identifications and presume that the identifications include all goods of the type described. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 (TTAB 2015); *Sabhnani*, 2021 USPQ2d 1241, at *20 (same). Further, whether Applicant’s goods can be certified by Registrant is not controlling as to whether the goods are related.

The dictionary definition of “fortified wine” is “[w]ine, such as sherry, to which alcohol in the form of grape brandy, has been added during or after fermentation.”⁸ Because Applicant’s identification of goods is unrestricted, we must presume that Applicant’s fortified wine includes fortified wine made from grapes grown in the Napa Valley American Viticultural Area or Napa County, California. Accordingly, Applicant’s “fortified wine” is encompassed within and in part identical to the certified user’s wine.

In addition, there is an inherent relationship between wine and brandy, as brandy is “an alcoholic beverage distilled from wine or fermented fruit juice.”⁹ Just as we must presume that Applicant’s fortified wines may be made from grapes grown in the Napa Valley American Viticultural Area or Napa County, California, we must presume that Applicant’s brandy may also incorporate such grapes. *See St. Julian Wine*, 2020 USPQ2d 10595, at *4 (finding a “commercial relationship” between apples

⁸ Examining Attorney’s Brief, 8 TTABVUE 16 (THE AMERICAN HERITAGE DICTIONARY). Indeed, Applicant agrees that “[f]ortified wine is a wine to which a distilled spirit has been added to increase the alcohol content of the product.” Appeal Brief, 6 TTABVUE 20.

⁹ We take judicial notice of the Merriam-Webster dictionary definition for brandy: <https://www.merriam-webster.com/dictionary/brandy> (last visited September 6, 2023).

and hard cider because “[b]y definition, apples are a necessary component of ‘hard cider.’”); *Bureau Nat’l Interprofessionnel Du Cognac v. Int’l Better Drinks Corp.*, 6 USPQ2d 1610, 1616 (TTAB 1988) (“‘COLAGNAC’ liqueurs and ‘COGNAC’ brandy are very closely related products” because “applicant’s identification of goods, ‘liqueurs,’ encompasses brandy liqueurs; [and] the product on which applicant actually uses its mark contains both brandy and cola”).

The Examining Attorney also introduced Internet printouts corroborating the inherent relationship between wine and brandy and showing that wine, brandy and spirits are related:¹⁰

- Charbay Distillery and Winery offering CHARBAY whiskey, vodka, tequila and wines;
- Flag Hill winery and distillery producing gin and vodka;
- Koenig distillery and winery “combin[ing] Old World brandy, vodka, and winemaking traditions with some of the Northwest’s finest fruit to produce classic eau-de-vie fruit brandies, premium varietal wines, and Potato Vodka”;
- Mazza Chautauqua Cellars – “Western New York’s Premier Winery and Distillery” producing plum brandy and offering “fortification spirits” to wineries;
- Round Barn, a winery, distillery and brewery promoting “Wines, Beers and Spirits, hand-crafted one bottle at a time”;

¹⁰ May 12, 2021 Office Action, TSDR 16-35.

- Santa Cruz Mountain Vineyard selling wine and OSOCALIS brandy: “What is [OSOCALIS brandy] doing at the Santa Cruz Mountain Vineyard website, you might ask? Jeff Emery, proprietor and wine maker at Santa Cruz Vineyards, is also the winemaker for Osocalis. Before you distill brandy you first have to make wine from grapes, apples or any other kind of fruit you want to work with.”;
- Woodstone Creek – “[A] true artisan winery and boutique distillery” that “produces 100-200 cases of wine, mead and distilled spirits yearly”; “Woodstone’s potstill produces brandy, honey liqueur, five grain bourbon, single malt whiskey (peated and unpeated), rum, gin, bierschnapps and vodka. ... Our winemaker is a certified brewmaster, mead mazer and master distiller all in one!”;
- Sweetgrass winery and distillery;
- January 5, 2012 article in the Midwest Wine Press titled “More Midwest Wineries Adding Distilled Spirits”: “As the economy continues to limp along ... more wineries are starting a distillery, producing vodkas, gins, whiskeys, [and] brandies in addition to wine;
- December 3, 2010 article on Napa Valley Register.com titled “Napa Valley Distillery creates vodka from sauvignon blanc”; the company “has additional spirits in the works, including a sauvignon blanc-based brandy and rum made from Hawaiian molasses.” The proprietor commented: “I’d like to think we are

part of the wine country establishment[.] ... We don't make wine, but we work with it.”; and

- November 16, 2010 blog titled “A winery and distillery in Seattle” discussing Almquist Family Vintners making wine and distilling spirits.

Evidence of a third-party selling the types of goods identified in Applicant's application and sold by Registrant's certified users supports a finding of relatedness. *Hewlett-Packard v. Packard Press*, 62 USPQ2d at 1004 (evidence, such as whether a single company sells the goods ... of both parties, if presented, is relevant to a relatedness analysis....”); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009) (finding two third-party webpages showing applicant's and registrant's goods “can be manufactured and sold by a single source” supported relatedness); *cf. Accelerate s.a.l.*, 101 USPQ2d at 2050 (five third-party registrations covering both goods of certified users and services of applicant “suggest” that the goods and services “may emanate from a common source”); *Motion Picture Ass'n of Am. Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1562-63 (TTAB 2007) (testimony and photographs showed that “users of opposer's certification mark utilize the same mark to identify both their [certified] entertainment services and clothing that is identical or closely related to applicant's goods”).

Turning to the third *DuPont* factor, there are no restrictions as to trade channels or target consumers in Applicant's applications. Nor are there limitations on the trade channels and consumers of Registrant's certified users. With respect to Applicant's fortified wines that are encompassed within and legally identical in part

to the certified users' wine, we must presume that the goods travel in overlapping trade channels to some of the same classes of purchasers. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

For the non-identical goods, we must presume that they move in all normal channels of trade for such goods – liquor stores, bars, restaurants, wineries and distilleries, and online retailers – and flow to purchasers of alcoholic beverages. *See Schieffelin & Co. v. Molson Cos., Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“[S]ince there are no restrictions with respect to channels of trade in either applicant’s application or opposer’s registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages” including “bars, restaurants, and liquor stores”); *see also Majestic Distilling*, 65 USPQ2d at 1204 (malt liquor and tequila “similar by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers”); *Monarch Wine Co. v. Hood River Dist., Inc.*, 196 USPQ 855, 857 (TTAB 1977) (whisky, vodka, rum, brandy, wine and champagne travel in same channels of trade to the same classes of purchasers); *In re AGE Bodegas Unidas, S.A.*, 192 USPQ 326, 326 (TTAB 1976) (“[T]here is clearly a relationship between wine and whiskey, both of

which alcoholic beverages are sold through the same specialized retail outlets to the same purchasers, and are frequently bought at the same time[.]”).

The same examples of third-party use set forth above demonstrate that wine, brandy and distilled spirits may be encountered by the same classes of consumers in at least one common trade channel – the websites and physical locations of wineries and distilleries.

In view of the foregoing, the second and third *DuPont* factors weigh in favor of finding a likelihood of confusion.

B. Strength of the Cited Marks

We turn next to the strength of the cited NAPA VALLEY and NAPA GREEN marks, which may affect the scope of protection to which the marks are entitled. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (TTAB 2016) (“[T]he strength of the cited mark is — as always — relevant to assessing the likelihood of confusion under the *DuPont* framework”).

At the outset, we note that Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e), which bars registration of primarily geographically descriptive marks absent a showing of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f), does not apply to geographic certification marks. *St. Julian Wine*, 2020 USPQ2d 10595, at *2; *see also Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (“we consider DARJEELING inherently distinctive as a certification mark indicating geographic origin as it inherently identifies the geographic source of the tea.”). Thus, the marks NAPA VALLEY and NAPA GREEN are inherently

distinctive in their entirety and “should not be considered ‘weak’ or subject to a narrower scope of protection” based on the geographic nature of the marks. *See St. Julian Wine*, 2020 USPQ2d 10595, at *2. Nonetheless, we may find that a presumptively distinctive registered mark, or portion thereof, is weak in the course of a *DuPont* analysis. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517-18 (TTAB 2016).

Applicant argues:

The Examining Attorney did not properly weigh the overwhelming relevant evidence of third-party use of the component NAPA in the wine space, affording overly broad protection to the Cited Registrations. The proliferation of NAPA-formative marks weighs heavily against the Examining Attorney’s finding of a likelihood of confusion. The Cited Registrations are clearly weakened by the unusually large volume of third-party registrations for NAPA-formative marks for use in connection with wine and related goods or services.¹¹ ...

The market context makes clear that consumers are accustomed to distinguishing between the marks shown in the Cited Registrations and other NAPA-formative marks. The co-existence and use of these third-party marks and the certification marks shown in the Cited Registrations presents no likelihood of confusion. Likewise, the differences between Applicant’s Mark and the certification marks NAPA VALLEY and NAPA GREEN are such that there is no likelihood of consumer confusion between them.¹²

In support of its argument, Applicant introduced printouts from the Office’s Trademark Status and Document Retrieval (TSDR) database showing more than 80 use-based registrations for marks incorporating NAPA or NAPA VALLEY for, in pertinent part, “wine(s),” “wines derived from grapes grown in Napa County,

¹¹ Appeal Brief, 6 TTABVUE 8.

¹² *Id.* at 12-13.

California” and “wines derived from grapes grown in the Napa Valley American Viticultural area.”¹³ More than 30 of the registered marks incorporate NAPA (without the word VALLEY).

The record does not include any evidence demonstrating the extent to which the registered marks are in use. Contrary to Applicant’s argument, third-party registrations alone do not demonstrate “market context” or “make[] clear that consumers are accustomed to distinguishing between”¹⁴ NAPA-formative marks because they are not evidence of the extent of use in the marketplace. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *see also In re In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“[T]hird-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.”).

Third-party registrations, however, are “relevant to the conceptual strength of a mark because they ‘show the sense in which a mark is used in ordinary parlance,’ that is, some segment that is common to both parties’ marks may have ‘a normally

¹³ June 2, 20222 Request for Reconsideration, TSDR 68-506. A few entities own several registrations but generally the third-party registrations have a number of different owners. Some of the registrations appear to be for wine labels that may incidentally include the NAPA VALLEY certification mark. But even if we were to exclude these registrations, there are still a substantial number of third-party registrations for product names and house marks that incorporate NAPA VALLEY or NAPA.

¹⁴ Appeal Brief, 6 TTABVUE 12-13.

understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak [.]” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters., LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015)); see also *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) (“[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry”). The third-party registrations of record here reflect that NAPA VALLEY serves not only as a certification mark but is used, along with the sole word NAPA, as part of third-party marks to identify the source of goods.

Applicant argues that this case is similar to the facts in *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ2d 773 (TTAB 1993). That case involved an opposition to the registration of NATURE’S PLUS for vitamins by the owner of the mark PLUS, also for vitamins. The applicant made of record eight third-party registrations that issued prior to opposer’s registration and seven registrations that issued after, all for marks containing the word PLUS for identical and closely related goods. The Board drew the following inferences from the co-existence of these registrations:

1. The opposer was satisfied to register PLUS side-by-side with eight existing registrations.
2. The Patent and Trademark Office has historically registered PLUS marks for vitamins to different parties so long as there has been some difference, not necessarily created by a distinctive word, between the marks as a whole, e.g., VITAMINS PLUS and IRON PLUS.

3. A number of different trademark owners have believed, over a long interval of time, that various PLUS marks can be used and registered side by side without causing confusion provided there are minimal differences between the marks.

Id. at 779; *see also Jerrold Elecs. Corp. v. Magnavox Co.*, 199 USPQ 751, 758 (TTAB 1978) (third-party registrations “reflect a belief, at least by the registrants, who would be the most concerned about avoiding confusion and mistake, that various ‘STAR’ marks can coexist provided that there is a difference.”).

In response, the Examining Attorney contends that “[e]very Napa-formative registration is the subject of a consent or executed agreement with the [R]egistrant of the certification marks.”¹⁵ No such agreements are of record.¹⁶ But even if we were to accept the Examining Attorney’s representation as true, the coexistence of so many third-party registrations, even with coexistence agreements, supports the three inferences from *Plus Products*, including the inference that a number of different owners of trademarks have believed, over a long interval of time, that various NAPA and NAPA VALLEY marks can be used and registered side by side without causing confusion or mistake as to source, sponsorship or affiliation provided there are minimal differences between the marks.

¹⁵ Examining Attorney’s Brief, 8 TTABVUE 7-8.

¹⁶ The record does include a June 20, 2014 Office action response that Registrant filed during prosecution of the application that matured into the cited registration for the NAPA VALLEY. June 2, 2022 Request for Reconsideration, TSDR 562-71. In that Office action response, Registrant represented to the Office that it has agreements with at least 22 of the third-party registrants of record here “demonstrat[ing] each registrant’s or applicant’s compliance with the certification standards and such party’s agreement as to Applicant’s authority to control the use of the NAPA VALLEY certification mark by Applicant.” *Id.* at 563. Consent to use a certification mark is not the same as a consent to register a mark incorporating the certification mark or a portion thereof.

There are “pitfalls” to allowing users of a certification mark to incorporate the certification mark as part of their own trademarks. *Swiss Watch*, 101 USPQ2d at 1739. Specifically, “the inclusion by many different entities of a certification mark in their individual trademarks may make it more difficult for the owner of the certification mark to prove likelihood of confusion by a third party that attempts to use that same term in its own mark.” *Id.* at n.14. We find that to be the case here with respect to confusion as to source, affiliation and sponsorship.

C. Similarity or Dissimilarity Between the Marks

Under the first *DuPont* factor, we consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion*, 110 USPQ2d at 1160-61 (recognizing that more or less weight may be given to a particular feature of a mark, but the ultimate conclusion must rest on the marks in their entireties); *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The focus is on the recollection of the average purchaser of wine, fortified wines, brandy and spirits, who normally retains a general rather than specific impression of trademarks. *St. Julian Wine*, 2020 USPQ2d 10595, at *4 (considering the similarities and differences between a certification mark and trademark); *see also Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971).

The Examining Attorney argues that NAPA is the “dominant feature” of Applicant’s marks. Applicant’s marks start with the word NAPA and Applicant voluntarily entered a disclaimer of NAPA when it filed the applications, signaling Applicant’s belief that consumers may recognize the NAPA prefix in its marks.

Consumers may recognize the word NAPA in Applicant’s marks, but “that simple fact alone does not create a basis for dissecting” Applicant’s marks into NAPA- and NAC/ÑAC and finding the NAPA prefix dominant. *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1289 (Fed. Cir. 2016) (“While there is no dispute that MAYA is understood by consumers as a word with established meanings, that simple fact alone does not create a basis for dissecting MAYARI into MAYA- and -RI. .”). We find the elements of Applicant’s marks so merged together that the average consumer is likely to perceive the marks as unitary, coined terms. *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (defining unitary mark as “so merged together” so as to “create a single and distinct commercial impression”). Accordingly, consumers are likely to focus on and remember each of Applicant’s coined marks as an “inseparable whole,” *id.*, rather than focus on and remember the marks’ prefix NAPA.

Because Applicant’s marks and the Cited Marks begin with NAPA, they share some visual and phonetic similarities, but when considered in their entireties, Applicant’s unfamiliar, coined marks NAPANAC and NAPAÑAC look and sound very different from Registrant’s marks NAPA VALLEY and NAPA GREEN, each composed of two familiar words.

With respect to meaning and commercial impression, the cited marks have readily understood meanings. The cited mark NAPA VALLEY refers to the Napa Valley wine region in California while the cited mark NAPA GREEN calls to mind the Napa region of California and connotes environmentally-friendly goods or sustainable production practices. Applicant's coined, unitary marks have no particular meaning. Even if some consumers were to recognize the NAPA prefix in Applicant's marks, the marks in their entities would be perceived as unfamiliar, coined terms, with no meaning. *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 USPQ 848, 851 (TTAB 1983) ("One recognizes instantly that which is familiar. Conversely, that which is unfamiliar would be given closer scrutiny and in this way could be distinguished from the familiar."); *see also Oakville Hills Cellar*, 119 USPQ2d at 1290 ("Board correctly found that the unfamiliar MAYARI is distinguishable from the familiar MAYA," both for wine).

Overall, we find the marks in their entirety are distinguishable in appearance, sound, connotation and commercial impression. The first *DuPont* factor therefore weighs against finding likely confusion.

D. Thirteenth *DuPont* Factor

Under the thirteenth *DuPont* factor, we may consider "any other established fact probative of the effect of use." *DuPont*, 177 USPQ2d at 567. The Examining Attorney argues:

The owner of a geographic certification mark must control the use of its mark in order for it to retain its distinctiveness and ensure the origin and quality of the products that bear the certification mark. See TMEP §1306.05(a). Additionally, a certification mark owner must deny

authorization to use the geographic certification mark if an applicant's goods do not meet the standards set out in the certification mark. It is presumed that the certification mark owner refused to grant applicant authorization to use the geographic certification mark because its goods do not meet the standards set out in the certification mark.

The evidence does not support this inference. Applicant submitted a declaration attesting that her products “meet[] the criteria for use of the certification marks” as “100% of the grapes used for goods in connection with the NAPAÑAC and NAPANAC marks will be sourced from the Napa Valley American Viticultural Area.”¹⁷ Moreover, a certification mark is subject to cancellation if the registrant “discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.” 15 U.S.C. § 1064(5). Accordingly, we find plausible Applicant's argument that Registrant “cannot certify” Applicant's products because “brandy, distilled spirits, and fortified wine have specific legal definitions and the certification marks at issue are limited to wine.”¹⁸

The thirteenth *DuPont* factor is neutral.

E. Weighing the *DuPont* Factors

The goods are legally identical in part and closely related. The trade channels and consumers overlap and the goods otherwise may be encountered through at least one of the same trade channels by some of the same consumers. Notwithstanding these factors that weigh in favor of a likelihood of confusion, the number of third-party registrations co-existing for marks incorporating NAPA VALLEY or NAPA support

¹⁷ June 2, 2022 Request for Reconsideration, TSDR 534-35, Hoopes Declaration, ¶¶ 3, 6.

¹⁸ Appeal Brief, 6 TTABVUE 7.

our finding that confusion as to source, sponsorship or affiliation is unlikely. We further find that the marks are sufficiently different in overall appearance, sound, connotation and commercial impression to preclude a likelihood of confusion, including the likelihood that consumers may mistakenly believe that Registrant has certified Applicant's goods.

Decision: The refusal is reversed as to each application.