

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Mailed: April 28, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Chatam International Incorporated
and
750 ML, LLC¹
v.
Tequila Cuervo La Rojena, S.A. de C.V.

Opposition No. 91170109
to Application No. 78585998

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and 750 ML, LLC.

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Frayne & Schwab for Tequila Cuervo La Rojena, S.A. de C.V.

Before Seeherman, Walters and Bergsman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Chatam International Incorporated ("Chatam") and 750
ML, LLC ("750 ML") have filed their opposition to the
application of Tequila Cuervo La Rojena, S.A. de C.V.
("TCR") to register the standard character mark JOSE for

¹ The original opposer, Chatam International Incorporated, assigned its
registration to 750 ML, LLC on April 16, 2007. Under the Board's order

"non-alcoholic mixes to be used with tequila," in International Class 32, and "tequila," in International Class 33.²

As grounds for opposition, opposers assert that applicant's mark, when applied to applicant's goods, so resembles opposers' previously used and registered mark JOSE CORTEZ for "tequila"³ as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Applicant, in its answer, denied the salient allegations of the claim. In further support of its denial of the claim, applicant asserted affirmatively that it is the owner of numerous registrations for the mark JOSE CUERVO, including registration no. 711630, registered 1961, for "tequila"; that its tequilas sold under the JOSE CUERVO mark are the top-selling tequilas in the United States; and that applicant's JOSE CUERVO mark is famous.

The Record

The record consists of the pleadings; the file of the involved application; and a certified status and title copy of opposer's registration no. 860664, made of record by opposers' notice of reliance. Applicant made of record, by

of March 17, 2008, the assignee was joined as a party to this proceeding.

² Application Serial No. 78585998, filed March 12, 2005, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

³ Registration No. 860664, issued November 19, 1968, in International Class 33. [Renewed, Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

its notice of reliance, copies of its existing registrations; copies of third-party registrations; excerpts from the U.S. Census Bureau website; opposers' responses to specified interrogatories of applicant; and excerpts from printed publications. Both parties filed briefs on the case.

Factual Findings

Opposer 750 ML is the owner of registration no. 860664 for the mark JOSE CORTEZ for "tequila." Opposer Chatam is the prior owner of this registration. Opposers use the mark JOSE CORTEZ on containers for the goods and shipping cases for goods shipped to the United States, depicting the two words JOSE and CORTEZ in the same size and style of lettering. Opposers have not conducted advertising for JOSE CORTEZ tequila in the United States and do not have information as to whether distributors or retailers have conducted advertising for JOSE CORTEZ tequila.

Applicant owns eighteen active registrations for the mark JOSE CUERVO in standard character format, in various design formats, and with additional words such as TRADICIONAL, ESPECIAL, GOLD, CLASICO, CITRICO, or TROPINA. The original mark, JOSE CUERVO in standard character format, was registered in 1961; and the additional registrations range in date from 1986 to 2006. Two periodical publications in the record discuss tequila and refer to

applicant's JOSE CUERVO as a "leading" or "top" brand (*Beverage Dynamics and Impact*) and both list it as the number 1 brand of tequila.⁴

Applicant made of record the following three active third-party registrations:

- Registration no. 2834295 for JOSE MARTI and design, for rum and rum liqueur;
- Registration no. 3233032 for DON JOSE LOPEZ PORTILLO for tequila; and
- Registration no. 2608680 for JOSE MART for rum liqueurs.

The record also includes the following active third-party registrations, each of which is owned by a different third party:

- JOSE JOSE and JOSE PADILLA for compact discs and other entertainment services;
- JOSE'S and JOSE BRAVO for coffee;
- SALSA DE JOSE for taco sauce and GOURMET JOSE and JOSE GOLDSTEIN for salsa;
- JOSEPH, JOSEPH MULLER, JOSEPH SWAN VINEYARDS and design, and JOSEPH DROUHIN for wines; and

⁴ These publications establish that the statements about applicant's brand of tequila were made in the respective publications, but we do not assess the truth of these statements. We also note that a book publication, *Classic Spirits of the World A Comprehensive Guide*, is referenced in the notice of reliance but is not in the record.

- JACK, JACK DAVIS, JACK RILEY: THE ORIGINAL MAN FROM SNOWY RIVER; and PLUMPJACK, all owned by different parties, for whiskey and/or distilled spirits.

According to the U.S. Census of 1990, JOSE is the 28th most common first name in the United States, appearing as a name for .613% of the U.S. population.

Analysis

Because opposers have properly made the pleaded registration of record, we find that opposers have established standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because the pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and goods covered by said registration. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d

1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Both the application and opposers' registration contain the identical goods: tequila. Additionally, it is clear from the nature of the goods that applicant's "non-alcoholic mixes to be used with tequila" are closely related to tequila, as applicant admits in its brief (p. 3). Thus, we conclude that the goods of the parties are either identical or closely related.

Further, both opposers' and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We must presume that the goods of applicant and opposers are sold in all of the normal channels of trade to all of the usual purchasers for goods and services of the type identified. See *Canadian*

Imperial Bank v. Wells Fargo, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that the channels of trade and class of purchasers of the parties' tequila are the same. Because applicant's mixes to be used with tequila are non-alcoholic, these mixes may be sold through broader trade channels than tequila, an alcoholic beverage whose sale is controlled. However, the trade channels are likely to be overlapping, with the tequila mixes sold in the same stores as tequila; and the class of purchasers is identical.

Turning to the marks, we note that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

While we must base our determination on a comparison of the marks in their entirety, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "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*

National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Opposers state that they do not object to applicant's mark JOSE CUERVO for tequila; rather, they object to applicant's expanding its rights by seeking to register JOSE alone. In this regard, opposers contend that applicant's evidence of prior registrations and popularity of JOSE CUERVO is irrelevant; that the evidence that JOSE is a common name increases the likelihood of confusion between JOSE and its mark, JOSE CORTEZ; and that the evidence of marks consisting of JOSE combined with other matter for alcoholic beverages or JOSE with other matter or alone for unrelated goods is inapposite, as are the registrations for marks including JOSEPH or JACK.

Regarding the marks, opposers contend that the marks are substantially similar because applicant's entire mark is contained within opposers' mark, and applicant's mark is identical to the first word in opposers' mark; and, in connection with tequila, JOSE connotes Mexico as the origin of the goods.

Applicant argues that opposers' mark is a unitary mark; and that, because JOSE is a common name, the CORTEZ portion of opposer's mark renders the two marks readily distinguishable and applicant's mark, JOSE, will in no way call to mind opposers' mark, JOSE CORTEZ. Applicant argues

further that, if its mark, JOSE, calls to mind another mark, it will be the JOSE CUERVO mark, contending that JOSE CUERVO is a well known mark in the United States.⁵ Applicant points to its evidence of third-party registrations in support of its position "that the [USPTO] has allowed multiple registrations containing the name JOSE in the field of alcoholic beverages and that the public will look to the remainder of the marks, rather than the name JOSE, to distinguish the source of the goods." (Brief, p. 8-9.) Applicant also argues that the third-party registrations point to a USPTO practice of allowing registrations for alcoholic beverages to coexist for marks containing a man's first name with a surname and that same first name alone.

Applicant's evidence in connection with its mark JOSE CUERVO for tequila is of little probative value on the issue of the registrability of the mark JOSE, which is the subject of this particular application. Even if such evidence were relevant, we find that applicant has not established, on this record, that JOSE CUERVO is a famous mark in connection with tequila. Applicant's registrations, for the mark JOSE CUERVO alone and with additional wording and designs, as well as the third-party registrations for alcoholic beverages, establish only that JOSE is a common term in marks identifying alcoholic beverages and, thus, these JOSE-

⁵ Applicant did not introduce any evidence to support its argument.

formative marks are distinguished from each other by the additional matter in the marks. For the same reasons, and because each case must be decided on its facts, we find the additional third-party registrations for JOSE-formative marks and JOSEPH and JACK-formative marks for various different goods to be of little probative value.

Applicant's mark is a common first name that both applicant and opposer have used and registered in combination with other terminology for tequila. Clearly, the surnames added to JOSE in applicant's JOSE CUERVO mark and opposers' JOSE CORTEZ distinguish these two marks. In the present case, though, we must determine whether JOSE *per se* is confusingly similar to JOSE CORTEZ. The marks are both names. The mark in the subject application is the first name JOSE alone, while opposers' mark begins with the identical first name to which a surname is added. The record contains only two entities, applicant and opposers, owning registered marks for tequila that are names beginning with JOSE: JOSE CUERVO and JOSE CORTEZ, respectively. As such, the mark JOSE is equally likely to be perceived as a shortened reference to opposers' JOSE CORTEZ tequila as it is to applicant's JOSE CUERVO tequila products. Thus, we find the marks sufficiently similar that, if used in connection with identical and closely related goods, confusion as to source is likely.

Applicant contends that the single most significant *du Pont* factor in this case is the differences between the marks, which, applicant believes, should be dispositive. Applicant cites *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (no likelihood of confusion between CRISTAL and CRYSTAL CREEK for champagne and wine, respectively) and *Long John Distillers, Ltd. v. Sazerac Company, Inc.*, 166 USPQ 30 (CCPA 1970) (FRIAR JOHN and LONG JOHN for whiskey not confusingly similar). However, applicant's case is distinguishable from these two decisions on its facts.

In *Roederer*, the Court affirmed the Board's finding that the two marks had very different connotations. The Board stated that "[w]hile the former [CRISTAL] suggested the clarity of the wine within the bottle or the glass of which the bottle itself was made, the latter [CRYSTAL CREEK] suggested 'a very clear (and hence probably remote from civilization) creek or stream.'" (*Roederer* at 1460.) In *Long John Distillers*, the marks were easily distinguished by the different second word in each mark, which gave very different connotations to the two marks. In our case there is no such distinction in connotation - both marks are names, one is a first name and the other is the same first name with a surname. Applicant's mark has no additional term, such as CUERVO, to distinguish it from opposers' mark.

When we consider the record and the relevant likelihood of confusion factors, and all of the parties' arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, JOSE, and opposer's mark, JOSE CORTEZ, their contemporaneous use on the identical and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

To the extent that any doubts might exist as to the correctness of our likelihood of confusion analysis, we resolve such doubts against applicant. *See Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783, 1787 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1849 (TTAB 2004).

Decision: The opposition is sustained.