

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

Mailed: October 17, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Heaven Hill Distilleries, Inc.

v.

Yassinn Patrice Diallo

Opposition No. 91183753
to application Serial No. 77266196

Matthew A. Williams of Wyatt, Tarrant & Combs, LLP for
Heaven Hill Distilleries, Inc.

Yassinn Patrice Diallo *pro se*.

Before Bucher, Kuhlke and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Yassinn Patrice Diallo ("applicant") filed an intent-to-use application for the mark HYPNOTIZER, in standard character form, for the following goods, in Class 33:

Alcoholic beverage produced from a brewed malt base with natural flavors, alcoholic beverages of fruit, alcoholic fruit extracts, alcoholic malt coolers, alcoholic punch, cachaca, cognac, distilled spirits, fruit wine, gin, hard cider, natural sparkling wines, prepared alcoholic cocktail, prepared wine cocktails, rum, sparkling fruit wine, sparkling grape wine, sparkling wines, tequila, vodka, whiskey, wine coolers, wines.

Heaven Hill Distilleries, Inc. ("opposer") opposed the registration of applicants' mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Specifically, opposer alleged ownership and prior use of the registered trademark HPNOTIQ for liqueur, in Class 33,¹ and that applicant's mark, if used in connection with the goods identified in the application, so resembles opposer's mark HPNOTIQ for liqueur as to be likely to cause confusion. A liqueur is "any class of alcoholic liquors, usually strong, sweet, and highly flavored, as Chartreuse or curacao, generally served after dinner; cordial."²

Applicant, in his answer, denied the salient allegations in the notice of opposition.

Evidentiary Objections

A. Opposer's motion to strike the exhibits attached to applicant's brief on the case.

Applicant did not take any testimony or introduce any evidence during applicant's testimony period. Nevertheless,

¹ Registration No. 2642855, issued October 29, 2002; Sections 8 and 15 combined declaration accepted and acknowledged. Opposer also pleaded ownership of Registration No. 2822475 for the mark HPNOTIQ and a bottle design for liqueur, but that registration was cancelled as of October 22, 2010 for failure to file a Section 8 declaration of use.

² The Random House Dictionary of the English Language (Unabridged), p. 1120 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

applicant attached exhibits to its brief on the case.

Opposer filed a motion to strike applicant's brief.

Evidence may not be submitted with a brief, with the exception of a proper request for judicial notice. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008). Evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party. If evidentiary material not of record is attached to a brief on the case, an adverse party may object thereto by motion to strike. *See, e.g., Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to brief given no consideration); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 (TTAB 1978) (applicant's exhibits attached to its brief cannot be considered). *See also Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973).

In view of the foregoing, opposer's motion to strike is granted to the extent that the exhibits attached to applicant's brief have been given no consideration.

B. Applicant's motion to strike plaintiff's reply brief.

Applicant filed a motion to strike opposer's reply brief. Opposer filed a brief in opposition to applicant's motion. A review of applicant's motion reveals that it is primarily nothing more than an attempt to reply to opposer's reply brief. There is no provision in the rules for a reply brief, rebuttal brief, rejoinder brief, etc. by a party in the position of defendant (*i.e.*, applicant). Trademark Rule 2.128(a)(1), 37 CFR § 2.128(a)(1). *See also Levis Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.3 (TTAB 1993) (applicant's motion to strike opposer's reply brief given no consideration because it was essentially an attempt to reply to opposer's reply brief). In view thereof, applicant's motion to strike opposer's reply brief has been given no consideration except to address applicant's evidentiary objections discussed below.

Applicant lodged an objection to opposer's testimony depositions. As best we understand the bases for the objection, applicant asserts that he did not consent to the designation or appointment of the court reporter who transcribed the depositions, that the testimony depositions were improper because the witnesses had business and

employment relationships with opposer and the witnesses were questioned by opposer's counsel, and that applicant could not cross examine the witnesses. It is clear that applicant's objections are based on his unfamiliarity with the American legal system, in general, as well as specific Board practice and procedure. Applicant's objections are not well taken and are overruled.

First, applicant's objection to the authority of the court reporter is procedural in nature and applicant was required to make it at the deposition, failing which it was waived. TBMP § 707.03(a). The depositions were duly noticed but applicant did not attend the depositions either in person or by telephone. Because applicant did not attend the depositions, he could neither object to the court reporter nor cross examine the witnesses.

Second, depositions may be taken before an officer authorized to administer oaths either by federal law or by the law in the place of examination. Fed. R. Civ. P. 28 (a)(1). Donna Chupe, the court reporter, certified that she is a notary public and court reporter in Jefferson County, Kentucky, authorized to duly administer oaths. Without any contradictory evidence, the court reporter's certification is sufficient to support her authority to officiate and transcribe the deposition.

Third, applicant's objection that the witnesses must be disqualified because they have business and employment relationships with opposer and were questioned by counsel does not make any sense and is illogical. Federal Rule of Evidence 601 and 602 provide that "every person is competent to be a witness" to testify about matter for which the witness has personal knowledge. The reference to disqualification in Fed. R. Civ. P. 28(c) refers to the court reporter, not the witnesses or a party's counsel.³

The Record

By rule, the record includes applicants' application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b). In addition, opposer introduced the evidence identified below.

1. Notice of reliance on opposer's pleaded registration.⁴
2. Testimony deposition of Norman Drew, Vice President of Keller Crescent Advertising, with attached exhibits.
3. Testimony deposition of Justin Ames, opposer's Senior Brand Manager, with attached exhibits.

³ Fed. R. Civ. P. 28(c) provides that a "deposition must not be taken before a party who is any party's relative, employee or attorney."

⁴ Opposer also claimed ownership of registered marks for HPNOTIQ for candles and glassware and clothing.

As indicated above, applicant did not take any testimony or introduce any evidence.

Standing

Because opposer has properly made its pleaded registration of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the marks and the products covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

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 the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The fame of opposer's marks.

This *du Pont* factor requires us to consider the fame of opposer's mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or

services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Citing the Liquor Handbook (2009) from The Beverage Information Group, Messrs. Ames and Wesley testified that HPNOTIQ is one of the top selling liqueurs in the United States.⁵ Mr. Wesley specifically identified the Liquor Handbook as "the source that everyone in the industry uses to rely on market rankings and volumes of products" and that it "is the Bible for the liquor category."⁶ Accordingly, the witnesses testified that HPNOTIQ is the fourth ranked imported liqueur in the U.S. by volume and the seventh ranked liqueur overall by volume. It is ranked higher than Grand Marnier, Di Saronno, and Cointreau among others.

Opposer extensively advertises HPNOTIQ in national magazines (e.g., *Rolling Stone*, *Cosmopolitan*, *Vibe*, *Wine Enthusiast*, *Wine Spectator*, *Vanity Fair* and *InStyle*) and

⁵ Ames Dep., p. 37 and Exhibit 13; Wesley Dep., p. 20 and Exhibit 13.

⁶ Wesley Dep., p. 21.

regional magazines (e.g., *Ocean Drive* (Miami), *Hollywood Life*, *Atlanta Peach*).⁷ Based on magazine industry practice, opposer estimates that on an annual basis the *Cosmopolitan* advertising generates approximately 78 million impressions, *InStyle* generates approximately 37 million impressions, and a regional magazine such as *Ocean Drive* generates approximately 2 million impressions.⁸ Impressions are the public exposure (number of advertisements in a magazine x circulation x readers per copy).⁹

In addition, opposer has advertised on radio and television, online and on social media websites, through contests and sweepstakes, product placement, and signage on and off premises, including point of sale displays.¹⁰ Since 2004, opposer has spent approximately \$90 million dollars advertising HPNOTIQ liqueur.

In 2003 and 2004, HPNOTIQ won the "Adams Growth Brand" award for being a fast growing brand.¹¹ HPNOTIQ won the 2004 "Impact Hot Brand" award as a significant new product and in 2006 as an established brand.¹²

While opposer has achieved commercial success and a high degree of renown, the evidence of record is not sufficient

⁷ Wesley Dep., p. 22 and Exhibit 14.

⁸ Wesley Dep., pp. pp. 24-27 and Exhibit 15; Ames Dep., pp. 41-43 and Exhibit 15.

⁹ Wesley Dep., p. 26, Ames Dep., p. 42.

¹⁰ Wesley Dep., pp. 27-30; Ames Dep. pp. 43-45.

¹¹ Ames Dep., pp. 61-62.

¹² Ames Dep., p. 61.

to establish that opposer's HPNOTIQ mark is famous for purposes of likelihood of confusion. Nevertheless, in view of opposer's extensive sales and advertising expenditures, as well as the unsolicited media attention it has received, we find that opposer's mark has a high degree of public recognition and renown. Indeed, when coupled with the arbitrary nature of the mark, HYNOTIQ is entitled to a broad scope of protection or exclusivity of use.

B. The similarity or dissimilarity and nature of the products described in the application and registrations, the likely-to-continue trade channels and classes of consumers.

Opposer's mark HPNOTIQ is used to identify opposer's liqueur: "any class of alcoholic liquors, usually strong, sweet, and highly flavored, as Chartreuse or curacao, generally served after dinner; cordial." "Curacao" is "a cordial or liqueur flavored with the peel of the sour orange."¹³ A "cordial" is "a strong, sweetened, aromatic alcoholic liquor."¹⁴

Applicant's mark is intended to be used in connection with, *inter alia*, alcoholic beverages of fruit, cognac and distilled spirits. "Cognac" is "brandy distilled in and shipped from the legally delimited area surrounding the town of Cognac in W central France."¹⁵ "Brandy" is "a spirit

¹³ The Random House Dictionary of the English Language (Unabridged), p. 490.

¹⁴ *Id.* at 450.

¹⁵ *Id.* at 399.

distilled from wine for from the fermented juice of grapes or of apples, peaches, plums, etc."¹⁶ "Spirits" are "a strong distilled alcoholic liquor."¹⁷

By definition, the parties' products are highly related, if not legally identical. In addition, opposer's liqueur can be used as a mix with other types of alcohol.

Q. And are consumers of HpnotiQ brand liqueur likely to purchase other types of alcoholic beverages?

A. Definitely. And that is because HpnotiQ can be enjoyed by itself, but it's a very popular drink to mix with other brands, other vodkas, other spirits, and also sparkling wines.¹⁸

Accordingly, opposer's liqueur is a complementary product that can be used with applicant's vodka and sparkling wine.

Because the goods are so closely related, we may presume that the channels of trade and classes of purchasers are the same. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31

¹⁶ *Id.* at 254.

¹⁷ *Id.* at 1839.

¹⁸ Ames Dep., p. 17. See also Wesley Dep., p. 15.

USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

In any event, opposer's liqueur is sold "on-premises" in bars, restaurants, clubs, nightclubs, etc. and "off-premises" in "all varieties of retail locations that sell alcohol, from grocery stores and big box stores, to ... state stores and wine and liquor stores, mom and pop's, big chains."¹⁹ In addition, consumers of HPNOTIQ are likely to purchaser other types of alcoholic liquors.²⁰

Well, through actually participating in a variety of focus groups with - - actual Hpnnotiq consumers have told us that they don't just exclusively drink Hpnnotiq. They drink other things in other categories - - other liquor categories, and they even mix things, other liquors, with Hpnnotiq to create new cocktails.²¹

Justin Ames, opposer's Senior Brand Manager, described opposer's target market more specifically.

Q. To whom is the Hpnnotiq brand liqueur marketed?

A. Currently, it is marketed to women who are interested in a girl's night out, which means women of any race or age who are looking to spend some time - - fun, lighthearted time - - with their girlfriends.

¹⁹ Wesley Dep., p. 10. See also Ames Dep., pp. 11-12.

²⁰ Wesley Dep., pp. 14-15.

²¹ Wesley Dep., p. 15.

- Q. And in conjunction with this promotion to that specific demographic, are you also indirectly promoting to others?
- A. Yeah, indirectly promoting it to others, as well as anyone in the male sex who would be interested in buying a woman a drink.
- Q. Has this demographic changed over time?
- A. It has. When the brand first started, it was hip-hop, had a hip-hop focus.
- Q. So then, I guess, the experience with Hpnotiq has been that the focus can change over time?
- A. Oh, definitely. That's something that you have to do in the alcohol industry; you have to constantly promote your brand to new legal age drinkers, as older drinkers may move onto other products.²²

Because there are no restrictions as to channels of trade or classes of consumers in the description of goods in the application or opposer's registration, we may assume that the identified products will be sold in all of the normal channels of trade to all of the normal purchasers for such goods. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Toys R Us v. Lamps R Us*, 219 USPQ 340, 343 (TTAB 1983). In this case, the evidence demonstrates that the normal channels of trade and normal classes of consumers for

²² Ames Dep., pp. 16-17.

opposer's liqueur is very broad and, therefore, encompasses applicant's products.

In view of the foregoing, we find that goods are closely related and the channels of trade and classes of consumers are the same.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that 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 their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd*

unpublished, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods at issue are various alcoholic liqueurs, spirits, etc., we are dealing with average consumers.

We also note that where, as here, the goods are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

The marks HPNOTIQ and HYPNOTIZER, while not identical, are similar.

While there is no correct pronunciation for a trademark, HPNOTIQ is likely to be pronounced "hip not´ ik" (similar to "hypnotic") or "hip no tēk." Those pronunciations are similar to the way applicant's mark is likely to be pronounced: "hip nə tiz´ ər."

The marks also have similar meanings and engender similar commercial impressions. Opposer's mark HPNOTIQ creates the commercial impression of "hypnotic." "Hypnotic" means "of or pertaining to hypnosis or hypnotism."²³ In this regard, opposer has advertised its mark by sponsoring parties and reporting them in advertisements entitled "HPNOTIZED in N.Y.C."²⁴ and "HPNOTIZED in L.A."²⁵ In October 2008, opposer advertised "The Halloween Hpnotist," a mixed-drink featuring HPNOTIQ.²⁶ Further emphasizing the connection with the word "hypnotic," Messrs. Ames and Wesley testified that writers and people soliciting opposer's business often misspell HPNOTIQ as H-Y-P-N-O-T-I-Q citing, *inter alia*, articles in *Hamptons* and *Wine Spectator* and business proposals from Style Network and E! Network.²⁷

Q. So, then, it's fair to say that even when there's a lot at stake, such as a business proposal or promotion of an event, it's not uncommon for others to spell Hpnotiq incorrectly, and most commonly it's spelled H-Y-P-N-O-T-I-Q?

A. That's correct.²⁸

²³ The Random House Dictionary of the English Language (Unabridged), p. 943.

²⁴ Ames Dep., Exhibit 10 (*Rolling Stone* February 2009).

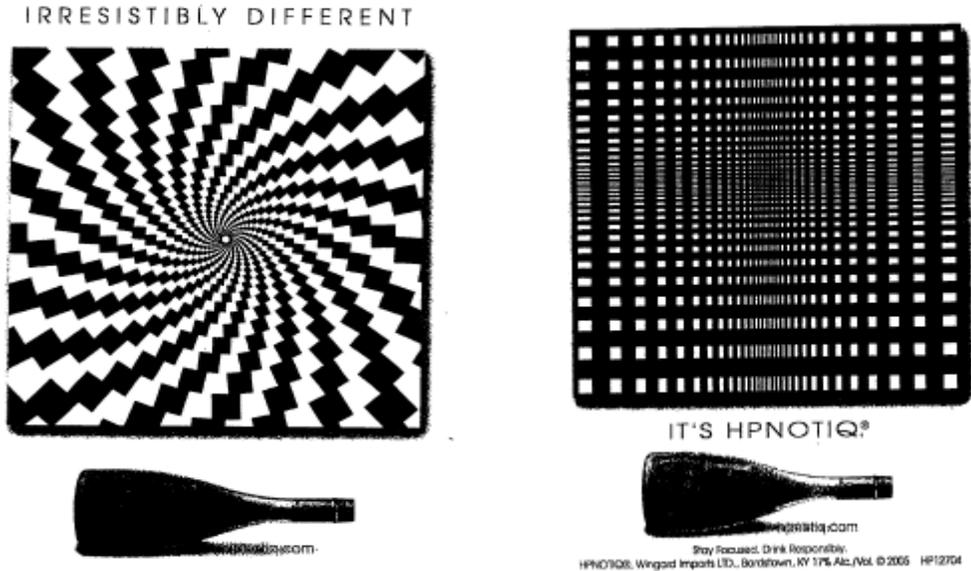
²⁵ Ames Dep., Exhibit 10 (*US Weekly* January 2007).

²⁶ Ames Dep., Exhibit 11.

²⁷ Ames Dep., pp. 47-52 and Exhibits 17-20; Wesley Dep., pp. 30-34 and Exhibits 18 and 19.

²⁸ Wesley Dep., p. 34.

Finally, opposer emphasizes the connection with hypnosis by using optical art in its advertising to create a hypnotic look and feel for the trade dress associated with opposer's mark.²⁹ The cover of the promotional recipe booklet shown below is illustrative.³⁰



Applicant's mark HYPNOTIZER means one who creates a hypnotic state.³¹ HYPNOTIZER creates the commercial impression of a hypnotist. Accordingly, the marks of both parties create a commercial impression relating to hypnotism.

In view of the foregoing, we find that the marks are similar in terms of appearance, sound, meaning and commercial impression.

²⁹ Wesley Dep., pp. 35-36.

³⁰ Wesley Dep., Exhibit 6.

³¹ The Random House Dictionary of the English Language (Unabridged), p. 943.

D. Balancing the factors.

The similarity of the marks, the close identity of the goods, and the identity of the channels of trade and classes of consumers warrant a finding that applicants' mark HYPNOTIZER for, *inter alia*, alcoholic beverages of fruit, cognac, distilled spirits, vodka and sparkling wine is likely to cause confusion with opposer's mark HPNOTIQ for liqueur.

In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

Decision: The opposition is sustained and registration to applicant is refused.