

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

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Frederick Wildman & Sons, Limited

v.

Frederick William Scherrer

Opposition No. 91191369
to Serial No. 77633440

Paulette R. Carey of Buchman Law Firm, LLP for Frederick
Wildman & Sons, Limited.

Frederick W. Scherrer, *pro se*.

Before Walters, Bucher and Zervas, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Frederick William Scherrer seeks registration on the
Principal Register of the mark **Frederick William** (*in standard
character format*) for goods identified as follows:

aperitif wines; aperitifs with a wine base;
cooking wine; fruit wine; sparkling fruit
wine; grape wine; sparkling grape wine;
honey wine; kits for making wine; sparkling
wines; natural sparkling wines; port wines;
prepared wine cocktails; red wines;
strawberry wine; sweet wines; table wines;
tonic sweet grape wine containing extracts
from ginseng and conchona bark (ninjin-
kinatetsu wine); white wine; wine coolers;

wine punches; wines; fortified wines;
liqueurs in International Class 33.¹

Registration has been opposed by Frederick Wildman & Sons, Limited. As its grounds for opposition, opposer asserts that applicant's mark when used in connection with his goods so resembles opposer's previously used and registered mark as shown below:



registered for "wines" also in International Class 33² as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act.

By his answer, applicant admits that opposer is the owner of Registration No. 0984638 for the mark "Frederick

¹ Application Serial No. 77633440 was filed on December 15, 2008, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

² Registration No. 0984638 issued to Frederick Wildman & Sons, Limited on May 21, 1974; second renewal. No claim is made to the exclusive right to use the term "Ltd." apart from the mark as shown.

WILDMAN & Sons, Ltd. and design" for use on wines, that this registration is valid and subsisting, that applicant filed the subject Intent-to-Use application for the mark **Frederick William** for, *inter alia*, wines, and that opposer has a priority in its mark that predates any priority that might be claimed by applicant. Otherwise, applicant denies the salient allegations as to the likelihood of confusion.

Accelerated Case Resolution (ACR) / The Record

During the discovery conference on October 5, 2009, the parties agreed to utilize the ACR process. During the conference, applicant clarified that he concedes opposer's priority and accepts the fact that both parties sell wines, but denies the existence of a likelihood of confusion on the basis of the alleged dissimilarities of the involved marks and the nature of their respective positions in the industry. By operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the record in this case consists of the pleadings and the file of the involved application.

The parties agreed that any materials that could typically be submitted by notice of reliance could merely be submitted as attachments to their ACR briefs. Further, they agreed that documents and things produced in response to requests for production, or reprints of pages retrieved

from the Internet, could be submitted as exhibits without the need for accompanying testimony. See *Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007). Consistent with this understanding, opposer has submitted a copy of its Registration No. 0984638; Opposer's First Requests for Admissions and Applicant's responses thereto, and the affidavit of Richard Cacciato and exhibits thereto. Applicant has submitted two of opposer's press releases and a copy of a screen-print of one of opposer's web pages.

Finally, the parties agreed that the record and arguments created by utilization of the ACR process would be the entire record and that the Board may resolve any genuine issues of material fact that would be necessary to the Board's resolution of the case on its merits.

Hence, in this decision, the burden of proof remains with opposer and requires opposer to show by a preponderance of the evidence that the opposition should be sustained. We applaud the parties for choosing accelerated case resolution as this appears to be an ideal set of facts for the selection of this streamlined process.

Standing/Priority

Based on the record, opposer is the owner of Registration No. 0984638 for the mark "Frederick WILDMAN & Sons, Ltd. and design" for use on wines and this registration is valid and in full force and effect, and opposer has continuously used this mark in connection with wines from at least as early as 1973. Hence, opposer has standing to oppose and applicant has admitted that opposer has priority.

LIKELIHOOD OF CONFUSION

We turn then to the issue of likelihood of confusion. Our determination of likelihood of confusion must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to consider the goods, channels of trade, classes of purchasers and conditions of sale. Although the parties' goods are overlapping (i.e., both include wines), applicant argues that opposer is known for the *importation and distribution* of wine having the brand names of others, while applicant is a *producer and blender*

of wines that will be produced and marketed under the **Frederick William** brand.

For example, the record shows that opposer imports and distributes branded wines having, for example, a **Trapiche Manos Malbec** label, or a **Hecht & Bannier** label. Then each of these bottles is given opposer's "Oval of quality" (opposer's claimed mark) before retail distribution. By contrast, applicant's wine label will brand the wine for example, as "**Frederick William** 2008 Cabernet Sauvignon," or "**Frederick William** 2008 Santa Clara Valley Merlot."

Despite this alleged difference, the respective identifications of goods include the legally equivalent term, "wines." Accordingly, we reject applicant's allegations of a meaningful distinction based upon a party's respective positioning in the trade channels, e.g., importer/distributor vs. blender/producer. For purposes of the Lanham Act and opposition procedures, this is a marketplace distinction without a legal difference.

As to the renown of opposer's mark, this is a mark that has been used for decades, opposer established an annual advertising budget exceeding two million dollars, sales of opposer's products bearing the registered trademark exceed one million cases a year, and applicant

was familiar with opposer's trade name prior to filing his opposed application. Hence, this is an arbitrary mark with a substantial history in the United States. However, opposer has not provided information as to how its annual advertising budget and sales volumes compare with that of other popular wine labels, as to how successful the advertising has been in terms of petitioner's household penetration or market share nationwide, and whether it has achieved the kind of strong brand awareness and national recognition that would entitle it to be considered a famous mark. In view thereof, the strength of opposer's mark does not reach the level of playing "a 'dominant' role in the process of balancing the *du Pont* factors." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). See also *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000).

The parties seem to agree that the most important single factor - and perhaps the determinative issue - in contention is over the similarities or dissimilarities of the marks. Hence, with respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot*

Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). 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 their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

Opposer makes the argument that the design portion of its registered mark is of little significance in analyzing the similarity of the respective marks, and that the word portions of the respective marks are nearly identical.

By contrast, applicant contends that its **Frederick William** mark is very different from registrant's design mark, naming distinctions such as the following:

- The **WILDMAN** portion of the graphic is dominant and emphasized in opposer's composite, while the word "Frederick" and the words "and Sons, Ltd." take a subordinate position due to the size and font of the typeface and the overall design of the mark.
- Opposer's CEO states that "[t]he familiar Wildman oval found on every bottle sold is recognized around the world as a symbol of quality assurance."
- The syllables "Wild-" and "Will-" are quite different.

- Opposer's national newsletter on its website is called "Wildman Juice."
- The common name "Frederick" is in both marks, but this similarity is outweighed by the strong dissimilarities of the marks considered in their entireties, and especially given the difference between an importer and distributor versus a producer and blender.

As to appearance, we find that applicant has correctly highlighted the dissimilarities of his mark from opposer's "Wildman oval":



Frederick William

While both will be sounded out by first enunciating the rather common name "Frederick," the terms "Wildman" and "William" have very different sounds, connotations and commercial impressions. "Wildman" in this context appears to be a surname (i.e., preceded by a given name and followed by the phrase "and Sons"). By contrast, the name "William," when used with the name "Frederick," sounds like the joining of two given names, as indeed, appears to be the case for applicant. In fact, we find these two marks

are so different that the *du Pont* factor of the dissimilarities of the marks outweighs the other relevant *du Pont* factors discussed above. In view thereof, we conclude that there is no likelihood of confusion between applicant's mark **Frederick William** and opposer's mark "Frederick WILDMAN and Sons, Ltd. and design." See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ["We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive"]. See also, *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567 ["[E]ach [of the thirteen elements] may from case to case play a dominant role"].

In view of the above, opposer has not proven by a preponderance of the evidence its claim of likelihood of confusion under Section 2(d) of the Trademark Act between applicant's standard character mark **Frederick William** and opposer's mark "Frederick WILDMAN and Sons, Ltd. and design."

Decision: The opposition is dismissed, and applicant should be issued a Notice of Allowance in due course.