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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Paul Jaboulet Aine,

Opposer

v.

S.P. Grossnickle, LLC,

Applicant.

Opposition No. 91197078

OPPOSER'S BRIEF

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TABLE OF CONTENTS

I. Introduction.....5

II. Opposer’s Evidence.....6

III. Applicant’s Evidence.....9

IV. Opposer’s Rights are Prior to Any Rights Applicant May Claim.....10

**V. Applicant’s Mark is Likely to Be Confused
with Opposer’s Registered Trademark10**

A. The DuPont Factors Favor Opposer.....11

1. The Marks Are Similar and Convey Nearly
Identical Commercial Impressions.....12

2. The Goods Are Identical.....13

3. The Trade Channels are Identical.....13

4. Wine Purchasers are Frequently Unsophisticated, Impulse Buyers.....15

5. The Relatively Few Similar Marks on Wine Do Not Negate the Strength of
PARALLELE 45, but Rather Are Easily Distinguished from Opposer’s
Registered Mark By Additional Verbiage, while Applicant’s Mark is Not.....17

6. Potential Confusion is Substantial.....20

7. Applicant’s Prior Knowledge of the PARALLELE 45 Mark.....20

8. Fame of Opposer’s Registered PARALLELE 45 Mark.....21

9. All Doubts Should Be Resolved In Favor of Opposer.....22

VI. Conclusion.....23

TABLE OF CASES

In re Bercut-Vandervoort & Co., 229 U.S.P.Q. 763, 765 (T.T.A.B. 1986).....16

Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002).....22

Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 U.S.P.Q.2d 1813, 1815 (Fed. Cir. 1987).....14

Carlisle Chemical Works Inc. v. Hardman & Holden, Ltd., 434 F. 2d 1403 1406-07, 169 U.S.P.Q. 110 113 (C.C.P.A.1970).....21, 23

Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp., 35 U.S.P.Q.2d 1125, 1128 (T.T.A.B. 1995).....23

CBS v. Morrow, 218 U.S.P.Q. 198, 199 (Fed. Cir. 1983).....14

Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877 23 U.S.P.Q.2d 1698 (Fed. Cir. 1992).....13

In re Chatam International, Inc., 380 F.3d 1340, 1342 (Fed. Cir. 2004).....12

Cunningham v. Laser Golf Corp., 222 F.3d 943, 945 (Fed. Cir. 2000).....12, 23

In re Denisi, 225 U.S.P.Q. 624 (T.T.A.B. 1985).....18

In re E. I. DuPont De Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973).....11

E. & J. Gallo Winery v. Consorzio Del Gallo Nero, 782 F.Supp. 457 (N.D. Cal. 1991).....15

In re Elbaum, 211 U.S.P.Q. 639, 640 (T.T.A.B. 1981).....14

Florence Mfg. Co. v. J.C. Dowd & Co., 178 F.73, 75 (2d. Cir 1910).....21, 23

Hewlett-Packard Co. v. Packard Press, Inc. 281 F.3d 1261 (Fed Cir. 2002).....11, 23

Interstate Brands Corp. v. McKee Foods Corp., 53 USPQ2d 1910 (TTAB 2000).....17

In re Jump Designs, LLC, 80 U.S.P.Q.2d 1370 , (T.T.A.B. 2006).....19

Kangol, Ltd v. KangaROOS U.S.A., Inc., 974 F.2d 161, 163 (Fed. Cir. 1992).....12

King Candy Company v. Eunice Kings Kitchen, Inc., 496 F.2d 1400 (C.C.P.A. 1974)....23

<i>In re Melville Corp.</i> , 18 U.S.P.Q.2d 1387, 1388 (T.T.A.B 1991).....	14
<i>Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772</i> , 396 F.3d 1369 (Fed. Cir. 2005).....	16, 21, 22
<i>In re Pneumatiques, Caoutchouc Mfg. et Platiques Kleber-Colombes</i> , 487 F. 2d 918 (C.C.P.A. 1973).....	22
<i>Recot Inc. v. M.C. Becton</i> , 214 F.3d 1322 (Fed. Cir. 2000).....	22
<i>In re Rexel Inc.</i> , 223 U.S.P.Q. 830 (T.T.A.B. 1984).....	18
<i>Russel v. Caesar</i> , 62 U.S.P.Q.2d 1125, 1130 (N.D. Cal. 2001).....	15
<i>Schieffelin & Co. v. Molson Companies, Ltd.</i> , 9 U.S.P.Q.2d 2069, (T.T.A.B. 1989).....	14

I. Introduction

Opposer, Paul Jaboulet Aine, (hereinafter “Opposer” or “Jaboulet”) is the owner of Registration No. 2,682,366 for the trademark PARALLELE 45 for wine. The trademark has been in continuous use in commerce since 1967.¹ The registration is legally incontestable.

Applicant, S.P. Grossnickle, (hereinafter “Applicant” or “Grossnickle”) is seeking to register Application No. 77/806650 for 45 for wine. It filed an application for the mark on August 18, 2009.

Opposer requests that the Trademark Trial and Appeal Board sustain the opposition on the ground that the law and the facts unequivocally establish that registration of the 45 mark for the identical goods in connection with which Opposer is using and has registered the PARALLELE 45 trademark will lead to purchasers being confused, deceived or mistaken as to source in violation of Section 2(d).

With respect to a finding of probable confusion the facts show:

- (a) the marks are substantially similar in sound, meaning, appearance and overall commercial impression;
- (b) the goods are identical
- (c) the trade channels are identical;
- (d) the goods are subject to impulse purchase without a great deal of forethought and consideration; and
- (e) Opposer’s mark is famous, strong and well known and has been in continuous use in commerce for forty-five years.

¹ The registration claims 1978 as the dates of first use, but during the course of these proceedings, a review of Opposer’s archives revealed that the trademark PARALLELE 45 has been in use in commerce since 1967. See ¶¶ 17-18 of the Declaration of Martin Sinkoff, Director of Marketing, Fine Wines of Frederick Wildman and Sons Ltd., filed by Notice of Reliance on September 27, 2011, (the “Sinkoff Declaration”).

Given that Opposer has been using the trademark PARALLELE 45 on wine for 45 years continuously and Applicant has more recently adopted the number 45 to identify its wine, it is likely that consumers will assume a connection between sources of the goods.

II. Opposer's Evidence

In support of its position that registration of the 45 mark will result in confusion with the registered PARALLELE 45 mark, Opposer has made the following evidence of record.

1. Registration No. 2,682,366 for PARALLELE 45

A status and title copy of Opposer's Registration No. 2,682,366 for PARALLELE 45 for "wines" was made of record with the opposition, as well as being submitted by Notice of Reliance on September 19, 2011. This evidence establishes Opposer's standing in these proceedings.

2. The Declaration of Martin Sinkoff.

The Declaration of Martin J. Sinkoff and attached exhibits (the "Sinkoff Declaration")² was submitted by Notice of Reliance in the Opposition on September 27, 2011. Martin Sinkoff is the Director of Marketing of Fine Wines of Frederick Wildman and Sons Ltd. ("Wildman"). Wildman has been Opposer's exclusive U.S. importer and distributor since at least as early as 1967. Sinkoff Declaration, ¶¶ 1 and 5.

Mr. Sinkoff's Declaration set forth the following uncontested facts:

² The parties jointly agreed that testimony would be submitted via Declaration and that neither party would be taking depositions in this proceeding.

- Wildman markets and sells Jaboulet's PARALLELE 45 wine throughout the U.S. Sinkoff Declaration, ¶ 7.
- Wildman has sold and distributed PARALLELE 45 wine in the U.S. continuously since 1967. Sinkoff Declaration, ¶ 17.
- PARALLEL 45 wine is sold in retail stores specializing in wines, retail stores specializing in the sale of all alcoholic beverages, general retail stores that are licensed to sell wine, restaurants that are licensed to sell wine, as well as by wholesalers. Sinkoff Declaration, ¶8.
- Imported wines such as Jaboulet's PARALLELE 45 wine are sold in the same trade channels as domestic wines, to the same type of customer. Sinkoff Declaration, ¶ 8-9.
- It is common for wines sold at different price points to be sold alongside each other. Sinkoff Declaration, ¶ 10.
- Wildman advertises PARALLELE 45 nationwide through a variety of media including Internet marketing as well as print advertising in national magazines. Sinkoff Declaration, ¶ 11.
- The advertising and marketing strategy for PARALELLE 45 is nationwide. Sinkoff Declaration, ¶ 13.
- Wildman distributes and sells wine identified and distinguished under the trademark PARALLELE 45 throughout the fifty states, including in particular the states of Michigan, Indiana, Illinois, Ohio, Colorado, California, Washington, Missouri, and Iowa. Applicant also sells wine to consumers in these specific states. Sinkoff Declaration, ¶ 19.

- The trademark PARALLELE 45 has achieved renown and name recognition. Sinkoff Declaration, ¶ 21.
- PARALLELE 45 is consistently recognized as a best value and best buy by *Wine Spectator* and *Wine & Spirit* magazines. Sinkoff Declaration, ¶ 22.
- PARALLELE 45 is sometimes referred to as P45 in advertising, on invoices, shipment documents, and other materials. Sinkoff Declaration, ¶ 23.
- Because PARALLELE 45 wine is sometimes referred to as P45, it is particularly likely to be confused in the marketplace with Applicant's 45 wine. *Id.*

The following exhibits accompanied the Sinkoff Declaration:

- A status and title copy of Opposer's Registration No. 2,682,366 for PARALLELE 45.
- A copy of a photograph the first PARALLELE 45 wine product sold in the U.S.
- Applicant's response to Opposer's Interrogatory No. 5.
- Copies of examples of Applicant's use of its 45 and Design mark.
- Applicant's response to Opposer's Interrogatory No. 11.
- A copy of the home page from Applicant's website at www.fortyfivenorth.com.

3. Evidence of Third Party Commercial Partnerships between French and U.S. Wine Producers

Opposer submitted evidence of French wine producers who have entered into partnerships with wine producers in the U.S. to sell new brands under common marks in the U.S. This evidence was submitted under Notice of Reliance on September 22, 2011, to demonstrate that French and American wines may emanate from a common source, thereby creating a likelihood of confusion between the parties' marks.

4. Applicant's Responses to Opposer's Interrogatories

Opposer submitted the totality of Applicant's Responses to Opposer's Interrogatories through two Notices of Reliance on September 19, 2011, one submitting Applicant's initial responses and another submitting Applicant's supplementary responses.

Applicant's Interrogatory responses establish the following uncontroverted facts:

- Applicant had actual knowledge of Opposer's mark at least as early as August 12, 2009 prior to filing its application for 45 and Design on August 18, 2009. Applicant's Response to Interrogatory No. 11.
- Applicant's wine sold under the 45 and Design mark is sold to consumers in Michigan, Indiana, Illinois, Ohio, Colorado, California, Washington, Missouri, and Iowa. Applicant's Response to Interrogatory No. 5.

III. Applicant's Evidence

The only evidence that Applicant has proffered is the Declaration of Eric Grossnickle and attached exhibits (the "Grossnickle Declaration"), submitted by Notice of Reliance on November 29, 2011. Eric Grossnickle is Creative Director of Applicant. The Declaration states in relevant part that:

- Applicant has been selling wine under the 45 and Design mark since July 4, 2008. Grossnickle Declaration, ¶¶ 5 and 24.
- Applicant conducted a trademark search prior to filing for 45 and Design that included Opposer's PARALLELE 45 mark. Grossnickle Declaration, ¶ 8.

- Applicant sells wine under the 45 and Design mark on the Internet.

Grossnickle Declaration, ¶ 12.

The following exhibits accompanied the Grossnickle Declaration:

- A graphic representation of Applicants 45 and Design mark.
- The search report from Applicant's trademark search prior to filing its application.
- Applicant's file history on the application.
- A copy of a photo of one of Opposer's wine products.
- Copies of the websites at www.domaincarneros.com, www.chandon.com, and www.opusonewinery.com.

IV. Opposer's Rights are Prior to Any Rights Applicant May Claim

The uncontroverted facts of record establish that Opposer has used its PARALLELE 45 mark commercially in the U.S. since at least as early as 1967. Sinkoff Declaration, ¶ 17. Additionally, as the owner of an incontestable U.S. registration claiming a date of first use in 1978, Opposer enjoys a presumption of exclusive rights dating back approximately 34 years. Applicant on the other hand only claims use of its 45 mark in the U.S. since July 4, 2008, a mere four years ago.

Under these facts of record, Opposer has prior use of its mark and is therefore the senior user.

V. Applicant's Mark is Likely to Be Confused with Opposer's Registered Trademark

Applicant's 45 and Design mark is similar in sight, sound and appearance to Opposer's registered PARALLELE 45 trademark. Both marks contain the identical

dominant element 45 (Applicant's mark consists exclusively of this element), and the marks are used for identical goods, namely wine.

Under the prevailing legal standard for likelihood of confusion set in *In re E. I. DuPont De Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973), several crucial factors strongly support a finding in Opposer's favor, and few to none weigh against Opposer. Furthermore, any questions of doubt with respect to likelihood of confusion are to be resolved in favor of the senior user. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265 (Fed. Cir. 2002) ("This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks."). Under these circumstances, the opposition should be sustained.

Opposer's analysis of the relevant *DuPont* Factors is as follows:

A. The *DuPont* Factors Favor Opposer

Applicant's mark 45 is "likely to cause confusion" with respect to Opposer's Mark PARALLELE 45 under Section 2(d) of the Trademark Act. The touchstone test for Section 2(d) before the Board derives from the non-exclusive "*DuPont* Factors." *See, e.g., In re E. I. duPont De Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). These *DuPont* Factors include, *inter alia*, the similarity of the marks, the similarity of goods, the similarity of channels of trade, and the fame of Opposer's Mark. *Id.* Of primary importance among these factors are the similarity of the marks and the similarity of the goods.

1. The Marks Are Similar and Convey Nearly Identical Commercial Impressions

Applicant's 45 mark is similar to Opposer's registered PARALLELE 45 mark in sight, sound and commercial impression, because both marks contain the same dominant element, the figure 45.



Applicant's mark, in fact, consists *only* of a stylized 45:

It is proper when evaluating the similarity of conflicting marks to give each term in the marks more or less weight, depending on its effect on the overall commercial impression. *In re Chatam International, Inc.*, 380 F.3d 1340, 1342 (Fed. Cir. 2004); *see also Kangol, Ltd v. Kangaroo U.S.A., Inc.*, 974 F.2d 161, 163 (Fed. Cir. 1992) (“a particular feature of a mark may be more obvious or dominant, and therefore when determining likelihood of confusion, greater weight ought to be given to the force and effect of such a feature.”)

Though Opposer's PARALLELE 45 mark also includes the word PARALLELE, it is the 45 element that dominates the mark. Wine labels routinely display word marks and sundry other verbal indicators of origin, but a numerical figure, other than a vintage year, is a rare find on a wine label. It is thus far more distinctive than any words that may appear on the product. In this context, the 45 element in Opposer's mark has a greater effect on the commercial impression of the mark for wine purchasers than the verbal element does.

Additionally, Opposer's PARALLELE 45 wine is sometimes referred to in marketing, advertising, invoices, and shipment documents merely as "P45". Sinkoff Declaration, ¶ 23. This shorthand nomenclature within the industry and also in advertising to consumers only increases the likelihood of confusion between the parties' marks, since the 45 element in Opposer's mark takes on even more significance, and the verbal element less when Opposer's wine is referred to as "P45". *Id.*

The 45 element is the *only* element in Applicant's mark. 45 is thus dominant in both marks, and identical in both marks. And given the rarity of numbers as source identifiers in the wine industry, it is the shared 45 element of the parties' marks that dominates the commercial impression to purchasers of the parties' goods - goods which are identical. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877 23 U.S.P.Q.2d 1698 (Fed. Cir. 1992) (a high degree of similarity in goods lowers the level of similarity of the marks required to find confusion). The marks thus convey nearly identical commercial impressions, such that the *DuPont* factor of mark similarity weighs heavily in Opposer's favor.

2. *The Goods Are Identical.*

Opposer's registration and Applicant's application claim exactly the same goods, namely wine. The goods are thus identical, establishing that the factor of similarity of the goods also militates in Opposer's favor.

3. *The Trade Channels are Identical*

Opposer and Applicant sell wine throughout the U.S. under their respective marks. They do so in the same geographic regions, notably in the fifty states including in Michigan, Indiana, Illinois, Ohio, Colorado, California, Washington, Missouri, and Iowa.

Sinkoff Declaration ¶19; Applicant's Response to Opposer's Interrogatory No. 5. Mr. Sinkoff, a wine distributor by trade, has testified based on his 32 years of experience in the U.S. wine market that Applicant's and Opposer's goods are likely to travel in the same trade and distribution channels, be sold in the same retail and wholesale outlets, and be purchased by the same ultimate customers. Sinkoff Declaration ¶¶ 30 and 33. Applicant has not refuted these facts in evidence. Rather, Applicant has pointed to the predominant geographic areas of its customers, areas in which Opposer also sells. Applicant has also noted that it sells its wines on the Internet, which, of course, has no geographic bounds. Applicant's wine is thus available for sale nationwide, just as Opposer's wine is. Thus the evidence unequivocally shows that Applicant and Opposer sell goods through identical trade channels throughout the U.S. to essentially the same wine consumers nationwide.

Furthermore, where there are no explicit restrictions as to trade channels and classes of consumers, it is presumed that the goods and services move in all normal trade channels and to all normal classes of purchasers. *See Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 U.S.P.Q.2d 1813, 1815 (Fed. Cir. 1987); *In re Elbaum*, 211 U.S.P.Q. 639, 640 (T.T.A.B. 1981). Because the goods of the parties are identified in the Registration and the Application respectively with no limitation on how they are to be sold, the channels of trade for each should be deemed to be similar or identical. *See, e.g., Schieffelin & Co. v. Molson Companies, Ltd.*, 9 U.S.P.Q.2d 2069, 2073 (T.T.A.B. 1989)(Discussing the traditional view that, in the absence of limitations on channels of trade in the goods and services identifications, all normal channels of trade are to be presumed); *see, also, In re Melville Corp.*, 18 U.S.P.Q.2d 1387, 1388 (T.T.A.B 1991);

CBS v. Morrow, 218 U.S.P.Q. 198, 199 (Fed. Cir. 1983)(stating it is proper to construe an Applicant's description of goods in the manner most favorable to Opposer (internal citations omitted)).

Given the identical nature of goods in question, and absence of limitations on channels of trade, Opposer's goods sold under PARALLELE 45 should be deemed to move through commerce in the *identical* channels of trade as the Applicant's goods sold under the 45 and Design mark, thus increasing the likelihood of confusion. For these reasons, this *DuPont* factor favors Opposer.

4. *Wine Purchasers are Frequently Unsophisticated, Impulse Buyers*

Courts have frequently found that purchasers of wine are not sophisticated such that they will not be confused when similar marks are used to indicate the source of wine produced by different winemakers. *See E. & J. Gallo Winery v. Consorzio Del Gallo Nero*, 782 F.Supp. 457, 464-465 (N.D. Cal. 1991) (The American wine-buying public is not "sophisticated" and does not devote a great deal of care in choosing a brand. This lack of consumer sophistication "significantly enhances the likelihood of confusion between . . . [wine] products."). As such, wine has been deemed an "impulse" product, effectively compelling the consumer's reliance "on faith in the maker". *Id.* ; *see also Russel v. Caesar*, 62 U.S.P.Q.2d 1125, 1130 (N.D. Cal. 2001) (purchasers of \$15/bottle wine are unsophisticated: this enhances the likelihood of confusion between similar marks).

The Board itself has noted that likely confusion in the purchase of wine is measured not only by the purchase of "expensive wines sold to careful, discriminating wine connoisseurs through fine wine and spirits stores but also less expensive wines sold

to ordinary consumers through liquor stores, grocery stores, supermarkets, drug stores and the like”. *In re Bercut-Vandervoort & Co.*, 229 U.S.P.Q. 763, 765 (T.T.A.B. 1986). With regard to the price of wines, the evidence of record shows that it is common for wines sold at different price points, both high and low, to be sold alongside each other. Sinkoff Declaration ¶ 10. Thus wine cannot be characterized as an expensive good that engenders great attention and scrutiny from its purchasers. Rather, it is most commonly bought with little sophistication. “[I]t is the average ordinary adult wine consumer who must be looked at in determining likelihood of source confusion” with regard to wine. *In re Bercut-Vandervoort & Co.*, 229 U.S.P.Q. at 765.

The Federal Circuit has agreed with this assessment, finding in a case concerning champagne and sparkling wine, that “general consumers, not just connoisseurs, occasionally purchase champagne or sparkling wine on celebratory occasions, with little care or prior knowledge.” *Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1376 (Fed. Cir. 2005).

Because the common purchaser of wine is unsophisticated and frequently buys on impulse, without attention or scrutiny, this *Dupont* factor favors Opposer and a finding of likelihood of confusion between the marks.

In addition to judicial findings that wine purchasers are not particularly sophisticated but rather, are impulse buyers, Opposer submits that in the wine market, even sophisticated buyers may be confused by Opposer’s and Applicant’s marks. This is because foreign, and particularly, French wine producers occasionally enter into partnerships with American producers. Thus even wine consumers who may know of Applicant and Opposer as distinct entities could mistakenly believe that Applicant and

Opposer have entered into such a partnership because of the similarity of their marks, since many winemakers in France and the U.S. have done so.

Opposer has submitted evidence of three such transatlantic partnerships resulting in wines sold in America under the marks of both American and French producers. These wines, DOMANIE CARNEROS BY TATTINGER, OPUS ONE, a joint venture between the American winemaker Robert Mondavi and French Bordeaux producer de Rothschild, and DOMAINE CHANDON, located in California, but associated with French champagne producer Moet et Chandon, establish that such partnerships exist and may cause consumers to believe that an American wine such as Applicant's could be associated with a French producer such as Opposer.³

5. *The Relatively Few Similar Marks on Wine Do Not Negate the Strength of PARALLELE 45, but Rather Are Easily Distinguished from Opposer's Registered Mark By Additional Verbiage, while Applicant's Mark is Not*

With the Grossnickle Declaration, Applicant submitted the results of a trademark search it conducted shortly before it filed its application. Grossnickle Declaration, ¶ 8, Exhibit 2. The search report revealed a total of 7 trademarks registered or applied for in the United States, Canada, and Mexico, incorporating the number 45 as an element with other terms or characters, and expressly claiming wine in the goods identifications.

³ Statements in the Grossnickle Declaration on this issue miss the point. Grossnickle states that “[n]othing in our advertising, labels, or other promotion would lead a consumer to assume any connection between our winery and a French winemaker”. Grossnickle Declaration, ¶26. But it is the common 45 element, not any other verbiage on Applicant's wine labels, that is likely to suggest a connection between the parties to consumers. Furthermore, with respect to opposition proceedings, likelihood of confusion is based on the marks in the record, not the product packaging or other trade dress. *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914-15 (TTAB 2000) (When neither the applied-for mark nor a cited registered mark includes a house mark, “determination of likelihood of confusion must be based on the specific marks at issue.”) Thus it is no matter that Applicant's labels “proudly proclaim” the U.S. origin of their wine – so do the labels of U.S. produced wine under the Franco-American partnerships cited herein, and still there is an association between two distinct producers. Grossnickle Declaration, ¶26. Nothing prevents consumers from assuming the same of Applicant and Opposer.

Opposer's PARALLELE 45 mark as registered in both the U.S. and Canada was among these marks. The only other registered marks in the search also incorporating the 45 element and including wine among the claimed goods were:

- PRINCE CHARLES EDWARD'S LIQUEUR DRAMBUIE A LINK
WITH THE 45
- 45 MAGIC
- BLOCK NO. 45
- WESTBAY EASTBAY 45N

The other marks in Applicant's search report did not specifically claim wine as a product to be sold under the mark and/or were pending intent to use applications.

Opposer notes that unlike Applicant's mark, each of these marks includes other terms or characters along with the 45 element, sometimes before the 45 element, sometimes after it, and in one case, both before and after it. These added elements serve to distinguish each of these marks from Opposer's PARALLELE 45 mark and thus significantly make confusion between them and Opposer's mark unlikely. They do not show that Applicant's mark and Opposer's mark are unlikely to be confused, nor do they negate the strength of PARALLELE 45. To the contrary, they show why Applicant's mark is uniquely likely to be confused with Opposer's mark, since these other marks all contain other terms or characters in addition to 45. *See In re Rexel Inc.*, 223 U.S.P.Q. 830 (T.T.A.B. 1984) (finding GOLIATH confusingly similar to LITTLE GOLIATH for related goods); *see also In re Denisi*, 225 U.S.P.Q. 624 (T.T.A.B. 1985) (finding PERRY'S PIZZA confusingly similar to PERRY's for identical services).

Opposer further notes that the 45 element in several of the noted marks, namely PRINCE CHARLES EDWARD'S LIQUEUR DRAMBUIE A LINK WITH THE 45 and WESTBAY EASTBAY 45N comes after extensive wording that significantly overpowers the numerical element, both visually and in significance and meaning. These marks are also heavily stylistic design marks, and in a visual sense, the image of each renders the 45 element merely incidental, not dominant, as it is in Applicant's mark.

With regards to 45 MAGIC and BLOCK NO. 45, Opposer submits, as aforementioned, that the additional verbal elements distinguish each of these marks enough from Opposer's PARALLELE 45 mark such that confusion is unlikely.

Applicant's mark, contrary to any of the other marks revealed in the search, consists solely of the 45 element. Thus the mark in its entirety is identical to the dominant component of Opposer's registered mark. Furthermore, registration of Applicant's mark would presumptively grant Applicant exclusive rights with regard to the use of 45 on wine. In addition to the likely confusion Applicant's mark would create with Opposer's mark, the grant of trademark rights to Applicant in the event or registration would diminish and damage Opposer's pre-existing trademark rights. For these reasons, Opposer has not challenged the other marks in the search report. Contrary to the Grossnickle Declaration submitted by Applicant, the existence and registration of these marks is therefore irrelevant to the issue of likelihood of confusion between Opposer and Applicant's mark.⁴

⁴ Opposer notes that statements by Grossnickle in his deposition, suggesting that there is no confusion because Opposer's uses its PARALLELE 45 mark along with the name PAUL JABOULET AINE, are not only incorrect, but in fact constitute an impermissible collateral attack on Opposer's registration. *See In re Jump Designs, LLC*, 80 U.S.P.Q.2d 1370, (T.T.A.B. 2006). Grossnickle Declaration, ¶ 21.

Thus the third party marks fail to diminish the strength of Opposer's incontestable trademark.

6. Potential Confusion is Substantial

Applicant's own trademark search across all of North America revealed only a handful of marks incorporating the 45 element in marks to be used for the sale of wine. This is not surprising since a numerical figure, other than the vintage year, is rarely found on wine labels. The 45 element in Opposer's mark is the distinctive feature that purchasers will recall. Consequently, with both Applicant and Opposer using the 45 element on wine, and with Applicant using *only* the 45 element on wine, the potential confusion between Applicant and Opposer in the marketplace is substantial.

Opposer has sold millions of dollars of its PARALLELE 45 wine. Sinkoff Declaration, ¶ 21. It has been selling wine under this mark for approximately forty-five years. Sinkoff Declaration, ¶¶ 17-18. Its significant sales and renown built up over decades of continuous use mean that confusion with Applicant's junior mark would be a substantial blow to Opposer and Opposer's goodwill built up in its mark. The potential confusion, in light of Opposer's considerable renown and goodwill, is therefore substantial and this *Dupont* factor favors Opposer.

4. Applicant's Prior Knowledge of the PARALLELE 45 Mark.

It is undisputed that Applicant knew of Opposer's PARALLELE 45 mark prior to filing its application. Applicant submitted into the record its trademark search, including records of Opposer's U.S. and Canadian registrations for the PARALLELE 45 mark, as Exhibit 2 to the Grossnickle Declaration. The search is dated August 12, 2009. Applicant's Application was filed on August 18, 2009.

Moreover, because the sales of PARALLELE 45 products were substantial during the period Applicant has been selling goods under this mark, Applicant had reason to know that Opposer's Mark had renown within the wine market. *Id.*

Generally, knowledge of use of the senior mark militates strongly against granting registration to the junior user with a similar mark. *Carlisle Chemical Works Inc. v. Hardman & Holden, Ltd.*, 434 F. 2d 1403 1406-07, 169 U.S.P.Q. 110 113 (C.C.P.A. 1970)(quoting *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F.73, 75 1910 U.S.App. Lexis 9477 (2d. Cir 1910). (“[C]ourts will look with suspicion upon one, who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish them.”) (finding confusion likely between registered ZIRCO mark and applicant COZIRC for related goods, where the junior user knew of the senior mark for eight years prior to adoption). Here, Applicant could have chosen from a universe of indicators for its mark, but it instead obviously partially emulated Opposer's PARALLELE 45 mark, in choosing the mark 45. *Id.* For these reasons, this *DuPont* Factor strongly favors Opposer.⁵

5. Fame of Opposer's Registered PARALLELE 45 Mark.

After forty-five years of continuous use in commerce, Opposer's PARALLELE 45 mark has achieved significant renown and name recognition. Sinkoff Declaration, ¶ 21. PARALLELE 45 wine has decades of significant sales and is consistently recognized in leading wine industry publications such as *Wine Spectator* and *Wine & Spirit*. *Id.*

Where it is present, fame plays a dominant role in the process of balancing the *Du Pont* factors. *See, e.g., Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison*

⁵ It should be noted that although a party may have relied on advice of counsel in selecting a mark, that is not a defense to “likelihood of confusion.”

Fondee en 1772, 396 F.3d 1369, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005); *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000). In this matter, the renown of Opposer's PARALLELE 45 wine and its recognition in the industry cannot be discounted, as the degree of fame is measured by the relevant market. *See, e.g., Palm Bay Imports*, 396 F.3d at 1375 (fame for confusion purposes measured with respect to the "class of customers and potential customers of a product or service and not the general public").

Opposer has sold wine continuously under the PARALLELE 45 mark since as early as 1967. Sinkoff Declaration, ¶¶ 17-18. In only the past 10 years, approximately 600,000 bottles of PARALLELE 45 wine has been sold in the U.S. for an estimated revenue during that time of approximately \$6 million. *Id.* This evidence establishes Opposer's fame, reknown and sales performance within its market. *See Bose*, 293 F.3d at 1371, 63 U.S.P.Q.2d at 1305. Thus the *DuPont* Factor of fame also favors Opposer.

3. *All Doubts Should Be Resolved In Favor of Opposer.*

Generally, any doubts about claims of "likelihood of confusion" under Section 2(d) of the Trademark Act are resolved against junior user. *See, e.g., In re Pneumatiques, Caoutchouc Mfg. et Platiques Kleber-Colombes*, 487 F. 2d 918, 919-20, 179 U.S.P.Q. 729 (C.C.P.A. 1973). Here, Opposer's PARALLELE 45 mark is legally incontestable and with its continuous use since 1967, Opposer is the undisputed senior user. Therefore, all the claims of confusion set forth in the Opposition, to the extent they still are in doubt, should be resolved in Opposer's favor.

It should be noted that Opposer has standing, because it is the record owner of a valid and subsisting prior registration. *See King Candy Company v. Eunice Kings Kitchen, Inc.*, 496 F.2d 1400, 1402-1403, 182 U.S.P.Q. 108 (C.C.P.A. 1974); *see also Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 U.S.P.Q.2d 1125, 1128 (T.T.A.B. 1995); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 U.S.P.Q. 1842 (Fed. Cir. 2000).

Knowledge of use of a senior mark militates strongly against granting registration to the junior user with a similar mark. *Carlisle Chemical Works Inc. v. Hardman & Holden, Ltd.*, 434 F. 2d 1403 1406-07, 169 U.S.P.Q. 110 113 (C.C.P.A. 1970)(quoting *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F.73, 75 1910 U.S.App. Lexis 9477 (2d. Cir 1910).

The Federal Circuit resolves all doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks. *Hewlett-Packard Co. v. Packard Press, Inc.* 281 F.3d 1261, 1265 62 U.S.P.Q.2d 1001, 1003 (Fed Cir. 2002). Here, Opposer's PARALLELE 45 mark should receive similar treatment and all doubts about confusion with Applicant's 45 mark should be resolved by finding a likelihood of confusion between the marks.

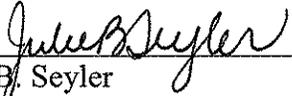
VI. Conclusion

Opposer has established strong goodwill in its PARALLELE 45 mark through its continuous use of the mark in connection with the sale of wine in the U.S. for approximately forty-five years. In addition, Opposer owns an incontestable registration for the mark that predates Applicant's registration for its similar mark. Opposer thus enjoys a presumption of rights to exclusive use of its mark on wine. Applicant's similar

mark is for identical goods that are sold in identical trade and distribution channels to an identical class of consumers. Applicant began using its mark a mere four years ago, and thus is the junior user. For these and all of the foregoing reasons, the Board should find that there is a likelihood of confusion between Applicant's and Opposer's marks, and should accordingly sustain the opposition and refuse Applicant's application.

Dated: March 13, 2012
New York, New York

Respectfully submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid this 13th day of March, 2012 upon the following:

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