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

Proceeding	91197078
Party	Defendant S.P. Grossnickle, LLC dba Forty-Five North Vineyard and Winery
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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
Serial No. 77806650

APPLICANT'S RESPONSE TO OPPOSER'S TRIAL BRIEF

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ARGUMENTS

I. INTRODUCTION

Applicant, S.P. Grossnickle, LLC (hereinafter “Grossnickle” or “Applicant”) is seeking to register Application No. 77/806650, first used in commerce July 4, 2008, for 45 and design for wine.

Opposer, Paul Jaboulet Aine (hereinafter “PJA” or “Opposer”) is the owner of Registration No. 2,682,366, registered February 4, 2003, for the trademark PARALLELE 45 for wine.

Applicant requests that the Trademark Trial and Appeal Board dismiss this Opposition since the law and the facts clearly show that there is no likelihood of confusion between Applicant’s 45 and design mark and Opposer’s PARALLELE 45 mark. The distinctive nature of Applicant’s mark, and the presence of other wines incorporating “45” in their mark, removes all source confusion from potential purchasers.

The following facts support a finding of no likelihood of confusion:

- a) “45” is used on many other wines and alcoholic beverages;
- b) the marks are different in sound, connotation, meaning, appearance and overall commercial impression;
- c) the channels of trade are distinguishable;
- d) the respective purchasers are discerning;
- e) there has been no actual confusion between Applicant’s and Opposer’s marks.

In light of these facts, consumers are unlikely to be confused into thinking Applicant's wines are connected to Opposer.

II. EVIDENCE

A. Applicant's Evidence

In support of Applicant's position that the Opposition should be dismissed and that the 45 and design mark be allowed to register, Applicant has made the following evidence of record.

i. Applicant's Responses to Opposer's Interrogatories to Applicant

Applicant's Responses to Opposer's Interrogatories were submitted through a Notice of Reliance on September 18, 2011.

Applicant's responses to the Interrogatories establish the following uncontroverted facts:

- The vast majority, approximately 90%, of Applicant's wine is sold through Applicant's tasting room.¹ The balance of Applicant's wine is sold through two distributors, one which services Michigan, another which services Warsaw, Indiana. Applicant's Response to Interrogatory No. 5.
- Applicant is unaware of any instance of actual confusion between Applicant's mark and Opposer's mark. Applicant's Response to Interrogatory No. 14.

¹ Opposer incorrectly states that Applicant sold wine to consumers in Illinois, Ohio, Colorado, California, Washington, Missouri and Iowa. Applicant sold wine to consumers from these states; these consumers visited Applicant's tasting room in Michigan where wine was purchased.

ii. Applicant's Supplemental Responses to Opposer's Interrogatories to Applicant

- Applicant's vineyard, Forty-Five North, and Applicant's mark, 45 and design, were chosen since the 45.0 degree North latitude line passes directly through Applicant's vineyard. Applicant's Supplemental Response to Interrogatory No. 3.

iii. Application No. 77/806,650 for 45 and design

A copy of the file history for Applicant's 45 and design trademark application was made of record by Notice of Reliance on November 29, 2011.

The trademark application history shows that Applicant overcame the Examining Attorney's rejection that Applicant's mark was confusingly similar to 45 MAGIC with arguments that 45 MAGIC had been allowed in light of VIN45 and PARALLELE 45, examples of two marks for wines which preceded 45 MAGIC and the present application. The Examiner found persuasive the argument that consumers are used to discerning between various wine-related marks which include the numeral "45" without confusion.

iv. Declaration of Eric Grossnickle

The Declaration of Eric Grossnickle and attached exhibits (the "Grossnickle Declaration") was submitted by Notice of Reliance on November 29, 2011. Eric Grossnickle is the Creative Director of Applicant.

The Grossnickle Declaration sets forth the following uncontested facts:

- The 45 and design mark was chosen to indicate that Applicant's vineyard is located at 45.0 degrees North latitude. Grossnickle Declaration, ¶ 7.

- Applicant’s counsel performed a search for marks related to “wine” including the numeral “45” prior to filing a trademark registration, the following marks were returned (Grossnickle Declaration, ¶ 8):
 - PARALLELE 45
 - PRINCE CHARLES EDWARD’S LIQUEUR DRAMBUIE A LINK WITH THE 45
 - CACHAZA 45
 - CLUSTER M45
 - VIN45
 - ROUTE 45
 - 45 MAGIC
 - 45YGB
 - BLOCK NO. 45
 - WESTBAY EASTBAY 45 N
 - OLD NO. 45 STOUT
 - COLT 45

- The majority of Applicant’s wines are sold at Applicant’s tasting room. Grossnickle Declaration, ¶ 12.

- All wines sold by Applicant indicate the geographic origin of the wines: Michigan, American, or Leelanau Peninsula. Grossnickle Declaration, ¶ 14.

- Applicant’s wines are labeled in a way to make clear that they are produced in America; nothing on Applicant’s labels suggests or intones any connection to a French winemaker. Grossnickle Declaration, ¶¶ 14, 16, 25.

- Consumers of Applicant’s wines are discerning and seek out region-specific wines. Grossnickle Declaration, ¶ 16.

- Applicant is unaware of any instances of actual confusion between Applicant’s wines and Opposer’s wines. Grossnickle Declaration, ¶ 25.

- Though foreign winemakers do enter into partnerships with American winemakers, there is nothing about Applicant's advertising or marketing that would lead a purchaser to believe that such a partnership has been entered into here. Grossnickle Declaration, ¶ 26.

The following exhibits accompanied the Grossnickle Declaration:

- A copy of a view of Applicant's 45 and design mark.
- A copy of a search report from Applicant's trademark search.
- Applicant's 45 and design trademark application file history.
- A copy of a photograph of a wine bottle having Opposer's mark.
- Printouts from the following websites: www.domaincarneros.com, www.chandon.com, and www.opusonewinery.com.

B. Opposer's Evidence

i. Opposer's Responses to Applicant's Interrogatories

- Opposer is unaware of any communication which suggests that Applicant may be connected with Opposer's mark. Opposer's Response to Interrogatory No. 7.
- Opposer has not granted any third party any rights or licenses to use Opposer's mark in the United States. Opposer's Response to Interrogatory No. 10.

ii. Opposer's Amended Responses to Applicant's Interrogatories

- Opposer is unaware of any instance of actual confusion between Applicant's mark and Opposer's mark. Opposer's Amended Response to Interrogatory No. 8.

iii. Declaration of Martin Sinkoff

The Declaration of Martin Sinkoff and attached exhibits (the "Sinkoff Declaration") was submitted by Notice of Reliance on September 27, 2011. Martin Sinkoff oversees marketing for Opposer.

The Sinkoff Declaration sets forth the following:

- Mr. Sinkoff believes that it is likely that Opposer's and Applicant's wines will travel in the same channels of trade, but provides no evidence of Opposer's and Applicant's wines actually being sold in the same locations. Sinkoff Declaration, ¶¶ 30, 33.

The following Exhibits accompanied the Sinkoff Declaration:

- A copy of Opposer's trademark registration for PARALLELE 45.
- A copy of a photograph of a wine bottle having the PARALLELE 45 mark.
- Applicant's response to Opposer's Interrogatory No. 5.
- Copies of prints showing Applicant's use of the 45 and design mark.
- Applicant's response to Opposer's Interrogatory No. 11.
- A printout of Applicant's website, www.fortyfivenorth.com.

III. APPLICANT'S MARK IS NOT CONFUSINGLY SIMILAR TO OPPOSER'S MARK

Applicant's mark, 45 and design, reproduced at right, is distinguishable from Opposer's mark, PARALLELE 45, in sight, sound and appearance. While both marks are for wines, it is unlikely that a consumer who encounters Applicant's mark would be confused into thinking that Opposer is the source of Applicant's wine.



Examples are provided below of one Applicant's wine bottles having the 45 and design mark (on left) and one of Opposer's wine bottles having the PARALLELE 45 mark (on right).



A. The Du Pont Factors Favor Applicant

The legal standard for analyzing likelihood of confusion is set out in *In re E. I. DuPont De Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). *Du Pont* provides a list of factors to weigh when determining whether two marks are confusingly similar. The factors relevant here are analyzed in detail below, and on balance weigh in favor of a finding of no confusion between Applicant's and Opposer's marks.

i. Applicant's mark is dissimilar to Opposer's mark as to appearance, sound, connotation and commercial impression

Applicant's mark, 45 and design, provides a completely different commercial impression than Opposer's PARALLELE 45 mark. When comparing marks, marks must be considered in their entireties. Similarly, likelihood of confusion should not be based on a dissected portion of a mark. *In re Nat'l Data Corp.*, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985). ("The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.") Instead, the focus is on the recollection of the average purchaser, who generally retains a general, rather than specific, impression of the mark. *See Sealed Air Corp. v. Scott Paper Co.*, 119 U.S.P.Q. 106 (TTAB 1975).

Opposer argues that "45" is the dominant portion of Opposer's mark since numbers are rare in the name of wines. Opposer provides no evidence to support this proposition. Opposer then goes on to explain why Applicant's use of "45" is confusing while other uses of "45" are not confusing as used on wine. Opposer cannot have it both ways. The record clearly shows that

“45” is present on other wines, and as such consumers are accustomed to distinguishing between wines which incorporate “45.” This also shows that where “45” is present, consumers will look to the portion of the mark which differs, and as such PARALLELE is the dominant portion of Opposer’s mark.

The appearance of the marks is completely different. Opposer’s mark, PARALLELE 45, consists of two words having a combined 11 characters, with “45” being diminutive in comparison to “PARALLELE.” When viewing Opposer’s mark, the average purchaser will consider PARALLELE as the dominant portion both due to its length, and because it comes first. Applicant’s mark consists of the numeral “45” with a stylized partial circle extending from the tail of the “5” and having a triangle at the top of the circle. The partial circle and triangle evoke the idea of a compass in the mind of the consumer, and tie-in with the name of Applicant’s winery, Forty-Five North. As such, Applicant’s mark is not confusing in appearance as compared to Opposer’s mark.

Similarly, Applicant’s mark has a distinguishable sound, as compared to Opposer’s mark. When spoken, Opposer’s mark is pronounced “parallel forty five” while Applicant’s mark would be pronounced “forty five.” Opposer’s mark contains six syllables as compared to Applicant’s three syllables. The first term in a mark is often given the most weight. For Example, it was held that VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines, were not likely to cause confusion. *In re White Rock Distilleries, Inc.* 92 U.S.P.Q.2d 1282 (TTAB 2009). (“As to sound, because the literal portion of the registered mark begins with the term TERZA, this mark sounds somewhat different from applicant’s mark.”) Here, PARALLELE is the dominant portion of Opposer’s mark, and when spoken, gives a distinct impression which is not confusing as compared to Applicant’s mark.

Consumers will encounter the relevant marks in the context of the wine bottles they are placed on, which wine bottles will help form the connotation of the marks. Marks should be considered “as they appear in the marketplace.” *Abercrombie & Fitch Co. v. Moose Creek, Inc.*, 486 F.3d 629, 636 (9th Cir. 2007) (reasoning that the marks should be considered as embroidered on apparel). When forming a connotation of Opposer’s product, a consumer would notice the name of the wine, PARALLELE 45, and would note the French spelling of “parallel.” A consumer would also notice the distinctively French name of the vintner, Paul Jaboulet Aine (which is generally included prominently on the wine bottle in at least three locations), as well as the French regional designations “Côtes du Rhône” and “TAIN L’HERMITAGE – FRANCE.” In total, the overtly French nature of the markings on the bottle will highlight and add emphasis to the French word PARALLELE as the dominant portion of the mark. A consumer would clearly associate this wine with a French company. Applicant’s wine bottle, gives a completely different commercial impression. The dominant feature of Applicant’s bottle is the 45 and design mark, and all markings indicate the type of wine and the American origin. While Applicant’s bottle may include a French name for a wine, such as Pinot Gris, wine consumers are accustomed to associating such designations to wines from any number of countries.

Opposer’s argument hangs on the proposition that “45” is the dominant portion of Opposer’s mark. When considering the appearance, sound and connotation in total, as described above, Applicant asserts that PARALLELE is the dominant portion of Opposer’s mark, and that a consumer is more likely to remember PARALLELE than 45 when seeking out Opposer’s product. *See Kangol, Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161 (Fed. Cir. 1992).

Opposer argues that “45” is the dominant portion of the mark by noting that on occasion Opposer refers to his wine as “P45.” Opposer provides no evidence of a first date of use of P45,

or of any acquired distinctiveness in this common law mark. Opposer has not asserted a registration for P45, and as such all references to P45 by Opposer should be disregarded. Opposer has the burden of showing that any common law marks have acquired distinctiveness before they will be considered in an Opposition proceeding. *Bass Pro Trademarks LLC v. Sportsman's Warehouse, Inc.*, 89 U.S.P.Q.2d 1844, 1854 (TTAB 2009) (“Because petitioner has failed to demonstrate that, through its use, SPORTSMAN’S WAREHOUSE has acquired distinctiveness as a trademark prior to the filing date of respondent’s underlying application, and therefore has failed to prove priority through its common law rights in the mark SPORTSMAN’S WAREHOUSE.”). As such, the proper comparison is to PARALLELE 45, to which there is no confusion to Applicant’s 45 and design mark.

ii. *Relationship of Applicant’s and Opposer’s goods and services*

Applicant and Opposer both sell wine. Opposer is a French wine producer. Applicant is an American wine producer. Opposer offered evidence in the Sinkoff Declaration of the common practice of foreign vineyards forming joint ventures with American vineyards to sell wine in the U.S. Applicant does not dispute that such joint ventures exist. Instead, Applicant has submitted evidence which suggests that consumers are unlikely to believe that Applicant’s wine is part of a joint venture with Opposer. Grossnickle Declaration, ¶ 26.

For each of the joint ventures cited by Opposer – Domaine Carneros, Domaine Chandon and Opus One – the bottles of wine and accompanying websites make clear the foreign entity which is involved with the production of the wine. See Exhibit 1. Indeed, it is difficult to imagine why a winemaker would seek to enter such a collaborative arrangement if not associate the joint venture label with the good will established by the foreign entity.

In the present case, nothing on Applicant's wine suggests any connection to Opposer. On the contrary, everything about Applicant's packaging and marketing highlights the distinctive Northern Michigan regional origin of Applicant's wine. Further, Opposer has provided no evidence of consumers believing there is a connection between Applicant's and Opposer's wineries. Also, Opposer has provided no evidence showing that consumers associate the many other wines which include "45" with Opposer. Instead, Opposer has only laid bare the naked assertion that since other wineries have formed joint ventures, consumers would assume one has been formed here. The evidence simply does not support this assertion. There is no connection between Applicant's wine and Opposer, and Opposer has provided no credible evidence to suggest a consumer would believe there is.

iii. *Relationship of Applicant's and Opposer's likely-to-continue trade channels*

The vast majority of Applicant's wine is sold from Applicant's tasting room on the Leelanau Peninsula in the heart of Michigan's wine country. A fractional amount, roughly 10%, of Applicant's wine is sold through distributors in Michigan and in Warsaw, Indiana. Applicant's Response to Interrogatory No. 5. Applicant's wine is marketed as a niche product from Michigan's wine country. Indeed, Applicant's consumers are discerning and seek out Michigan-area wines. Grossnickle Declaration, ¶ 16. Opposer's wine is marketed as a French wine. As such, while Applicant and Opposer are selling the same base product, they are selling from two ends of the wine spectrum, and it is unlikely that consumers will be confused between the two, just as it is unlikely that a car buyer would be confused into thinking that a Ford is built by Renault.

Opposer has provided no evidence of a single case where Applicant's and Opposer's wines are sold in the same location. It is unlikely that a consumer would encounter Applicant's

and Opposer's wines in the same trade channels, and in the rare case where they did, the distinct commercial impressions provided by each mark would prevent the consumer from having any source confusion.

iv. Opposer's mark is not famous

Opposer argues that the PARALLELE 45 brand is famous as a result of selling 600,000 bottles of wine in the United States over a 10 year period. Sinkoff Declaration, ¶¶ 17-18. Opposer provides no context for the sales of other wine producers. Applicant argues that Opposer is a small-time player in the U.S. wine market and should not be given extra protection since Opposer's mark is not famous.

In contrast, in *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369 (Fed. Cir. 2005) the court found that a wine sold in 8,000 restaurants nationwide, advertised in major publications such as *Vanity Fair*, and listed as the most ordered "sparkling wine" in *Wine and Spirits* was famous. *Id.* at 1375. Opposer clearly falls short of this standard.

By Opposer's own evidence, Opposer has only sold 600,000 bottles of wine in the U.S. over the past decade for roughly \$6 million in revenue. This averages roughly 60,000 bottles or \$600,000 per year. Sinkoff Declaration, ¶¶ 17-18. Applicant's winery is relatively new, having been established in 2008, and concedes to being a small player in the wine industry. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]²

By any measure, Opposer has not provided evidence sufficient to make a showing that Opposer's mark is famous. This factor should be weighed in favor of Applicant.

v. "45" is a component of marks commonly used on related goods

Third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991). When a mark is part of a crowded field, consumers tend to be educated to recognize distinctions, even subtle distinctions, between marks. *See Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385 (TTAB 1976); *Miss World (UK), Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 8 U.S.P.Q.2d 1237, 1241 (9th Cir. 1988). For example, the field of trademarks that include stripe designs on sports shoes is a "crowded" field. That is, widespread use by different firms of a plethora of similar stripe designs "has narrowed the breadth of protection" afforded each mark such that any one such design on sports shoes is limited to substantially that identical design. *Puma-Sportschuhfabriken Rudolf Dassler, K.G. v. Superga S.p.A.*, 210 U.S.P.Q. 316 (TTAB 1980).

Similarly, the field of "45" trademarks for "wine" is crowded.

² Confidential information regarding Applicant's revenue from wine sales redacted, this information is marked CONFIDENTIAL-ATTORNEY'S EYES ONLY.

Opposer concedes that “45” is present on other wines. The following is a non-exhaustive list of wines and other alcoholic beverages which contain “45” in their mark:³

- PARALLELE 45
- PRINCE CHARLES EDWARD’S LIQUEUR DRAMBUIE A LINK WITH THE 45
- CACHAZA 45
- CLUSTER M45
- VIN45
- ROUTE 45
- 45 MAGIC
- 45YGB
- BLOCK NO. 45
- WESTBAY EASTBAY 45 N
- OLD NO. 45 STOUT
- COLT 45

In light of these marks, consumers of wine will know to take care when purchasing wine bearing the numeral 45, and will recognize the differences between the marks, rather than focus on the similarities. This is one reason why consumers are unlikely to view “45” as the dominant portion of Opposer’s mark. Opposer proudly claims all rights in the use of “45” on wine, yet has slumbered for over 40 years while multiple winemakers have been using “45” on their brands. Opposer’s lack of action has stripped it of any distinctiveness in “45” and removed the right to claim exclusive rights in “45” on wine.

In fact, there are many instances in which similar marks have been held not to be confusingly similar despite the fact that the marks themselves were quite similar. For example, in *Sunenblick v. Harrell*, 895 F. Supp. 616, 628, 638 (S.D.N.Y, 1995) *aff’d. mem.* 101 F3d 684 (2d Cir. 1996) *cert. den.* 117 S. Ct. 386 (1996) the court found no reverse confusion between jazz records and hip hop records sold under the identical mark UPTOWN RECORDS even though

³ Grossnickle Declaration, ¶8.

both marks were for musical products which were sold in the same stores. Similarly, in *Swanson v. Georgetown Collection, Inc.*, Civ. No. 94-1283, 1995 WL 72717 (N.D.N.Y. 1995) the court found that reverse confusion was unlikely between the mark FARAWAY FRIENDS for porcelain dolls and FAR AWAY FRIENDS for cloth dolls. In addition, VARGAS and VARGA GIRL were found not to be confusingly similar in *In re Hearst Corp.*, 25 U.S.P.Q.2d 1328 (Fed. Cir. 1992) even though both marks were used in connection with "calendars." ALPHA and ALPHA STEEL were also found not be confusingly similar in *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.* 616 F.2d, 440 (9th Cir. 1980) even though both marks were used in connection with steel tubing and BOND-PLUS and WONDER BOND PLUS were found not to be confusingly similar in *Indus. Adhesive Co. v. Borden, Inc.* 218 U.S.P.Q. 945 (TTAB 1975) despite the fact that both marks were used in connection with adhesives products.

As such, due to the third-party registrations of "45" on wine, consumers will look to the differences between the marks and are unlikely to be confused between Applicant's and Opposer's wine.

vi. *No actual confusion has been identified*

Applicant has been selling wine under the 45 and design mark since July 4, 2008, or nearly four years, without any evidence of confusion cited by Applicant or Opposer. Opposer's Amended Response to Interrogatory No. 8. In an absence of actual confusion, the likelihood of confusion will be diminished. *Greentree Laboratories, Inc. v. G.G. Bean, Inc.*, 718 F.Supp. 998 (D.Me.,1989) (ODOR KLEEN found not confusingly similar to ODOKLEEN, both for odor-neutralizers, after four years of concurrent use on similar goods in similar channels of trade, the court held that since no evidence of actual confusion was found, no likelihood of confusion existed). Since Applicant's wine has coexisted with Opposer's wine for nearly four years

without a single instance of actual confusion reported to either party, the likelihood of confusion going forward is minute.

IV. CONCLUSION

Applicant's 45 and design mark is not likely to be confused with Opposer's PARALLELE 45 mark. The marks are distinct in sight, sound, connotation and commercial impression, largely due to the dominant PARALLELE portion of Opposer's mark. Further, the presence of the third-party registrations for "45" on wine, and Opposer's lack of fame further mitigate any potential for confusion.

Applicant respectfully requests dismissal of the Opposition and that Applicant's mark be allowed to register.

Respectfully submitted,

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CERTIFICATE OF SERVICE

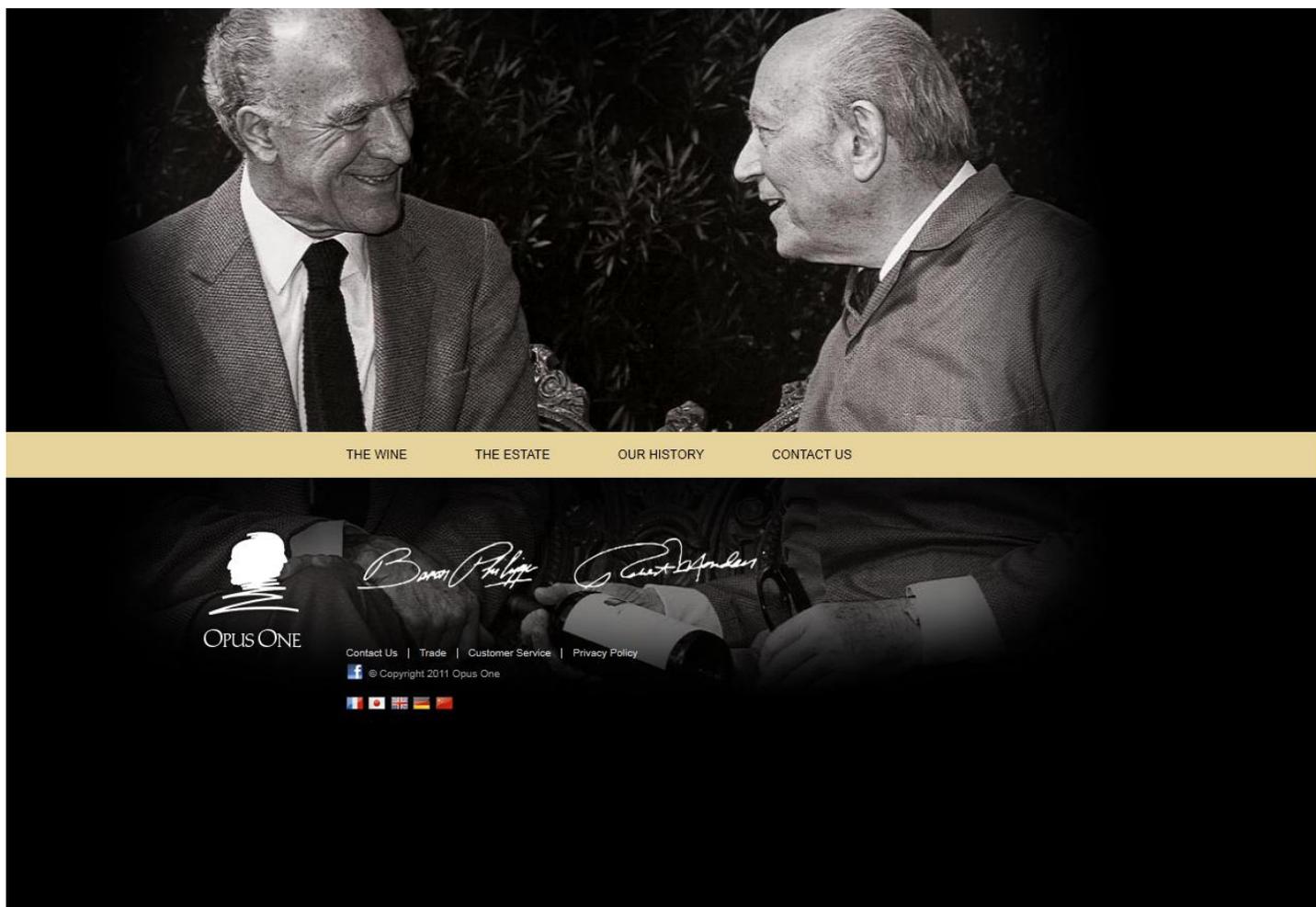
The undersigned certifies that a copy of the foregoing has been served upon the following
via United States Regular Mail on April 12, 2012:

Julie B. Seyler
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New York, New York 10017-5621

/Michelle G. Stambaugh
Michelle G. Stambaugh

APPENDIX

EXHIBIT 1



Captured at <http://www.opusonewinery.com/> on November 22, 2011

See Grossnickle Declaration, ¶ 26, Exhibit 7.



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2005 Le Réve Blanc de Blancs



95 Wine Enthusiast

Review to be included in the June 2011 WE issue
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Spectacular Views, Sparkling wine,
Pinot Noir, table service, tours.
5 miles from Napa and Sonoma.



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Premium Sparkling Wine from Napa Valley, California

Captured at <http://www.domainecarneros.com/> on November 22, 2011

See Grossnickle Declaration ¶ 26, Exhibit 7.



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See Grossnickle Declaration ¶ 26, Exhibit 7.