

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

E.&J. Gallo Winery

v.

Christopher M. Malek

Opposition No. 91199089
to Application No. 85056231
filed June 7, 2010

Steven M. Weinberg, Holmes Weinberg PC, for opposer.

Jean S. Perwin, Law Offices of Jean S. Perwin, for applicant.

**Before Cataldo, Mermelstein, and Ritchie, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Christopher M. Malek filed an application for registration
of the mark JOTS (in standard characters) for

alcoholic beverages, namely, flavored gelatin shot
consisting of gelatin mixed with distilled spirits and
wine - wine and distilled spirits not combined in
single shot

in International Class 33, based on the allegation of a *bona
fide* intent to use the mark in commerce. See Trademark Act
§ 1(b).

E.&J. Gallo Winery opposes registration, alleging that
there would be a likelihood of confusion arising from

applicant's use of the applied-for mark in view of opposer's registration and prior use of the mark TOTT'S (in standard characters) for "sparkling wine."¹ See Trademark Act § 2(d). Applicant generally denied the salient allegations of the notice of opposition.²

I. Accelerated Case Resolution

The parties filed and fully briefed cross-motions for summary judgment. When informed by the Board interlocutory attorney that both motions were likely to be denied because they appeared to involve genuine issues of material fact, the parties stipulated to final consideration of the opposition on the merits using the evidence and argument submitted in connection with their cross-motions in lieu of formal trial and briefing. Thus, although the evidence and argument of record were submitted in support of motions for summary judgment, we

¹ Registration No. 1557141, based on use of the mark in commerce, issued September 19, 1989. Post-registration filings pursuant to §§ 8, 9, and 15, accepted, granted, and acknowledged.

² Rather than admitting or denying the specific allegations set out in the notice of opposition, applicant's answer consists of a series of arguments why the opposition should be denied. An answer is not a platform for argument, but rather a means to find out whether the matters alleged by the plaintiff are in dispute, thus defining the boundaries of the proceeding for purposes of discovery and trial.

Thus, a proper answer should simply admit or deny the allegations set out in each numbered paragraph of the notice of opposition (adding explanation only if necessary), and set out any affirmative defenses or counterclaims asserted. Fed. R. Civ. P. 8(b)-(d). Applicant's answer does not appear to meet this standard. Nonetheless, although an allegation which is not denied is considered admitted, Fed. R. Civ. P. 8(b)(6), opposer appears to have construed applicant's answer as a general denial, and we will do the same.

consider the record on the merits, resolving any issues of fact or law necessary to reach a final decision.

II. Record

The record consists of the pleadings, and pursuant to Trademark Rule 2.122(b)(1), the file of the opposed application. In addition, the parties submitted the following evidence:

A. Opposer's Evidence

The declaration of Julia Kropp, a Senior Marketing Manager for opposer. Attached to Ms. Kropp's declaration were three exhibits:

1. **Exhibit A:** Copy of Registration No. 1557141 for TOTT'S for "sparkling wine," issued to opposer September 19, 1989.
2. **Exhibit B:** Picture of two wine bottles bearing TOTT'S label.
3. **Exhibit C:** Eight brief reviews (or extracts from reviews) of opposer's TOTT'S-branded wine.

The declaration of Steven M. Weinberg, opposer's counsel of record. Attached to Mr. Weinberg's declaration were six exhibits:

1. **Exhibit A:** A copy of the TARR page for opposer's TOTT'S registration, showing the current status of the registration and opposer's ownership of it.
2. **Exhibit B:** A copy of opposer's April 4, 1995, post-registration filings under Trademark Act §§ 8 & 15.
3. **Exhibit C:** Opposer's First Set of Requests for Admission and applicant's responses.
4. **Exhibit D:** Opposer's First Set of Interrogatories and applicant's responses.

5. **Exhibit E:** Opposer's First Set of Requests for the Production of Documents, and applicant's responses, including Exhibit 1A ("JOTS Executive Summary") and 1B ("Business Information for 2011 Launch Pad Elevator Pitch Finalists.").
6. **Exhibit F:** A copy of the TARR page for the subject application.

B. Applicant's Evidence

The declaration of applicant Christopher Malek. Attached to Mr. Malek's declaration were the following exhibits:

1. **Exhibits 1(a)-(c):** Applicant's intended packaging for its goods, showing the JOTS mark.
2. **Exhibit 2:** A page downloaded from collegepartyguru.com (downloaded February 8, 2012). Applicant states that this is "a targeted advertising site aimed at students."
3. **Exhibits 3-4:** Recordings of two advertisements for opposer's branded products.
4. **Exhibit 5(a):** A page downloaded from <http://www.winebookclub.org/10-famous-brands-of-champagne...> (complete URL not provided) (downloaded Feb. 6, 2012). Published on this page is a list of "10 famous brands of champagne."
5. **Exhibit 5(b):** Several pages downloaded from <http://www.foodandwine.com/articles/10-top-affordable-champ...> (complete URL not provided) (downloaded Feb. 6, 2012). This website publishes a list of "10 Top Affordable Champagnes."
6. **Exhibit 6:** Search results from Google.com (first page only) of a search for "Tott's Champagne." (Date not provided.) A result page from a search on the website marketviewliquor.com (Feb. 9, 2012). Applicant points out that this evidence "show[s] Tott's Brut champagne in a green bottle with a red and black label. . . ."
7. **Exhibit 7:** TESS record of Registration No. 3713691 for OTT'S (stylized) for "restaurant and pub services."

8. **Exhibit 8:** Pages from *beverageresources.com* (Feb. 17, 2012), including a definition of "Other Than Standard Wine."

As noted above, this case is before us upon a stipulation to use the Board's ACR procedures. We therefore consider the parties' declarations as if they were testimony and we consider the declaration exhibits as if they had been identified and made of record during testimony or submitted under a notice of reliance, as appropriate.

III. Standing & Priority

Opposer made of record a copy of its trademark registration taken from the USPTO's TESS database, establishing that the registration is subsisting and owned by opposer. As a result, priority is not an issue. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Opposer also alleged and proved its use of TOTT'S on "sparkling wine," e.g., Kropp Dec. ¶¶ 4, 6-11, and applicant admits opposer's priority in this respect. App. Resp. and Cross-Motion at 2.

Likewise, opposer's registration and use of TOTT'S in connection with sparkling wine establish its standing, i.e., that it has a real interest in the outcome of this proceeding and a reasonable basis for its belief that it would be damaged by issuance of a registration of the mark to applicant. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir.

1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

IV. Likelihood of Confusion

A. Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis 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, 567 (CCPA 1973); *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

B. Analysis

1. The Similarity or Dissimilarity of the Marks in their Entireties

In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "[T]he 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." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008).

Applicant argues at some length that in comparing the marks, we must consider opposer's mark as it is actually used, and applicant's mark in the way applicant currently intends to use it. Applicant is incorrect. The marks in both the subject application and in opposer's registration are in "standard character" form, *i.e.*, "without claim to any particular font style, size, or color." Trademark Rule 2.52(a). The marks at issue are thus for the words TOTT'S and JOTS, and in determining registrability, we must consider them to encompass any stylization in which they might appear. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253,

1258-59 (Fed. Cir. 2011); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"). Accordingly, we do not consider either applicant's or opposer's mark³ to be limited to any stylization or trade dress.⁴

Applicant's mark is JOTS, while opposer's mark is TOTT'S. Both marks sound similar in that they are both single-syllable words ending with an "-ots" sound, and thus rhyme. See *Kimberly-Clark*, 227 USPQ at 542. Aurally, the marks differ only in the sound of the initial consonant.

The marks are also similar in appearance, both being short (4- or 5-letter) terms with similar structure in that applicant's mark ends in -OTS, while opposer's mark ends in -OTT'S, and could appear in any stylization, including one which is similar or identical to the other. While opposer's mark

³ Opposer relies in this proceeding on both its registrations and its prior use of the TOTT'S mark. While opposer's use-based (*i.e.*, common-law) rights are limited to the ways in which opposer actually uses its mark, we find it largely unnecessary to consider opposer's common-law rights.

⁴ Applicant cites a number of infringement cases in which courts have looked to the marks and goods as actually used by the parties. There are, however, numerous differences between registrability cases before the TTAB and infringement cases tried in civil courts which make applicant's cited cases inapposite in this regard. *Cf. Jet Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1857-58 (Fed. Cir. 2000). By contrast, we compare only the mark applicant seeks to register with the mark in opposer's registration.

includes a double "T" in the place of applicant's single one, that difference is relatively minor, and does not add a different letter, sound, or meaning to the mark.

The parties agree that "[n]either mark has any particular identifiable meaning," App. Resp. & Cross-Mot. at 5; Opp. Mot. at 14, although applicant notes that opposer's mark includes an apostrophe, while its mark does not. When viewed, the difference in the ending of the marks connotes a possessive in opposer's mark (possibly implying that the goods are produced by some person or entity named "TOTT"), and a plural in applicant's mark (possibly implying that applicant's good is a "JOT,"⁵ and that the package contains more than one of them). But neither party introduced any evidence reflecting how the relevant public does or will understand the marks, and on this record both marks appear to be arbitrary as applied to the identified goods. We think that this distinction between the marks is minor, first, because it only applies to visual depictions of the mark (the plural "—S" and the possessive "—'S" sound exactly the same), second, because, like the additional "T" in opposer's "—OTT'S" ending, the distinction is visually minor, and third, because it

⁵ Applicant stated that he "decided on the mark 'Jots' because it combined the word 'shots' with a reference to jelly, jello or gelatin," Malek Dec. ¶ 3, and in a document produced by applicant and submitted by opposer, applicant states that "[t]he name JOTS is meant to evoke the commonly used term 'jello shots,'" Weinberg Dec. Exh. E ("JOTS Executive Summary"). There is no evidence indicating whether consumers are likely to recognize applicant's intended connotation.

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is not uncommon for people to confuse (and misuse) the possessive and plural forms.

It is true that the marks can clearly be distinguished when closely examined. But consumers rarely have the luxury of a side-by-side comparison, and must instead rely on sometimes vague or fallible memory. *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). "[T]he emphasis must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks." *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

As noted, the marks are similar visually and aurally, and neither has an established meaning. We find that the marks, when considered in their entirety, and in light of all relevant evidence of record, are substantially similar. While we recognize that the marks begin with a different letter, and that opposer's mark has a double "T" and an apostrophe, while applicant's does not, these differences are not so great as to overcome the marks' similarities, particularly when hastily viewed, quickly spoken, or poorly remembered. This *du Pont* factor thus favors opposer.

2. The Similarity or Dissimilarity and Nature of the Goods

The goods in the subject application are identified as alcoholic beverages, namely, flavored gelatin shot consisting of gelatin mixed with distilled spirits and wine – wine and distilled spirits not combined in single shot.

The goods identified in opposer's pleaded registration are "sparkling wine."

Opposer argues that its goods and those of applicant are "closely related," "if not legally identical," citing cases in which we or the Court of Appeals have found different types of alcoholic beverages "similar by virtue of the fact that both are "alcoholic beverages" that are marketed in many of the same channels of trade to many of the same consumers." Opp. Mot. at 10-11 (quoting *Majestic Distilling*, 65 USPQ2d at 1204). In response, applicant argues that there is no *per se* rule that all alcoholic beverages are related. App. Resp. & Cross-Mot. at 8 (citing *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009)).

As opposer correctly notes, both the Board and our reviewing court have repeatedly found a variety of different types of alcoholic beverages to be related to a significant degree for purposes of a likelihood of confusion analysis, typically noting that while such beverages may differ specifically, they share common uses, channels of trade, and

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customers. See, e.g., *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (beer and ale related to tequila); *In re Majestic Distilling*, 65 USPQ2d 1204 (malt liquor related to tequila); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1265 (TTAB 2011) (beer related to wine); *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (beer related to wine); *Somerset Distilling, Inc. v. Speymalt Whiskey Distribs. Ltd.*, 14 USPQ2d 1539, 1542 (TTAB 1989) (whiskey related to gin and vodka); *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (Cognac brandy related to malt liquor, beer and ale); *Monarch Wine Co. v. Hood River Distillers, Inc.*, 196 USPQ 855, 857 (TTAB 1977) (distilled spirits related to wine); *In re AGE Bodegas Unidas, S.A.*, 192 USPQ 326 at 326 (TTAB 1976) (wines related to whiskey); *Rosenblum v. George Willsher & Co.*, 161 USPQ 492, 492 (TTAB 1969) (Scotch whisky related to rum).

Nonetheless, applicant is correct in arguing that "[t]here is no *per se* rule that holds that all alcoholic beverages are related." *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (evidence insufficient to show that "energy vodka infused with caffeine" is related to "sparkling wine" (citing *G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990) (differences between beer and sparkling wine "weigh against a holding of a likelihood of confusion")); *Nat'l Distillers & Chem. Corp. v. William Grant &*

Sons, Inc., 505 F.2d 719, 184 USPQ 34, 35 (CCPA 1974) (the nature of applicant's prepared alcoholic cocktails and opposer's liqueur and French Brandy "are not such as to contribute to likelihood of confusion"))). The result in each case is a matter of evidence, not a legal presumption that certain goods are or are not always related. That the relationship must be evidenced on a case-by-case basis may be particularly important when the goods of one or both parties are somewhat out of the ordinary, such as the "prepared alcoholic cocktails" at issue in *Nat'l Distillers* or the "energy vodka infused with caffeine" that the Board considered in *White Rock*.

It seems to us that the goods in the application before us are in the latter category, that is, at least somewhat out of the ordinary. Although applicant's identification of goods is prefaced with "alcoholic beverages, namely...", it is apparent from the identification itself (as confirmed by the other evidence of record) that the goods on which applicant intends to use its mark are not beverages in the normal sense (*i.e.*, liquids), but rather single portions of flavored gelatin prepared with alcohol.⁶ The goods are thus semi-solids or gels.⁷

⁶ Opposer states that "[a]pplicant[] ... identifies the goods primarily as 'alcoholic beverages,'" citing the subject application and applicant's admission that it intends to use its mark on the goods identified in its application. Opp. Mot. at 10. However, applicant nowhere said that his goods are primarily alcoholic beverages. Instead, both the application and applicant's admission referred to the goods as fully set out above.

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Unlike a typical liquid beverage, which one would drink, applicant's goods would presumably be ingested by eating (although depending on consistency, chewing may be optional). Such goods are by their nature not likely to be used for some of the same purposes as liquid beverages, like opposer's sparkling wine. For instance, it seems unlikely that applicant's goods would be ingested to quench ones' thirst, or as a liquid sipped during a meal. On the other hand, applicant's goods inherently share at least one important characteristic with opposer's: they are both means of ingesting alcohol, and could be used by anyone seeking the pleasures of intoxication (safely, and in moderation, we hope).

Other than the parties' respective identifications, there is no evidence which indicates that the goods at issue are related in a way that would make consumers more likely to assume

Opposer is mistaken if its use of the adverb "primarily" is meant to draw a similarity between opposer's beverage (sparkling wine) and applicant's goods based *solely* on applicant's use of the term "alcoholic beverages" in the preface of its identification of goods. The identification of goods must be read in its entirety, and there is no ambiguity in this case as to the nature of the goods.

⁷ We use the term "semi-solid" here to distinguish applicant's goods from the liquid state in which most beverages appear. We take notice of the fact that prepared gelatin is a gel which – in this case – binds together water, alcohol, and flavoring in applicant's shot. Fed. R. Evid. 201.

Opposer did not raise, and we do not consider, whether it was appropriate to use the term "beverage" to describe such goods; acceptability of the identification is an issue usually resolved in *ex parte* examination. But again, there is no doubt or ambiguity as to the nature of the goods when the identification is read as a whole.

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that they come from a common source. For instance, there is no evidence that other producers of sparkling wine (or any producers of typical fermented, brewed, or distilled beverages) also produce gelatin shots, or vice versa, or even that trademark registrations have been granted listing both goods. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd* (unpublished) No. 88-1444 (Fed. Cir. Nov. 14, 1988).

Opposer also argues that the goods are related because its goods are (sparkling) wine, while wine is listed as an ingredient of applicant's gelatin shots.⁸ Opp. Reply at 5-7. It is not entirely clear on this record whether applicant's customers will know that his gelatin shots contain wine or focus

⁸ Applicant's identification indicates that his gelatin shots are made with "distilled spirits and wine," but adds that "wine and distilled spirits [are] not combined in [a] single shot." We interpret this as meaning that the shots could be made with either wine or distilled spirits, although elsewhere applicant indicates that he might use *only* wine. See Weinberg Dec. Exh. E ("JOTS Executive Summary"). Nonetheless, applicant states in its briefs that "[i]t is ... possible that wine won't even be used in the JOTS product; that it will consist only of distilled spirits." App. Response & Mot. at 10.

Because we must base our decision on the goods applicant has identified, we conclude that his application covers gelatin shots made with either wine or distilled spirits. Having identified both sources of alcohol, applicant may not now limit his application to distilled spirits. See *Octocom Sys. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Likewise, although applicant argues that the "other than standard" wine he intends to use is simply a tasteless, odorless, source of fermented alcohol, his identification of goods is not so limited, see *id.*, and we must consider the "wine" in applicant's gelatin shots to include other kinds of wine similar to that in opposer's registration.

on that fact. We do not assume that applicant's customers will have read applicant's trademark application, and it is possible that applicant's customers will not know or care about the source of the ethanol in their gelatin shots. (Neither party has introduced any evidence on usual practices in the gelatin shot industry.) On the other hand, we note that applicant's intended packaging does bear the notation "other than standard orange wine natural flavors and certified colors." Malek Dec. Exh. 1(a)-(c). Although applicant has not yet commenced use of its mark on the identified goods and is not bound to use this packaging, we cannot ignore the strong possibility that applicant's customers would know that applicant's gelatin shots contain wine as an ingredient, and possibly even the kind of wine used.

While we cannot find that the parties' goods are "legally identical," we nonetheless find that opposer's sparkling wine and applicant's gelatin shots are related to the extent that they both contain wine, and they are both sources of alcohol for human consumption.

3. The Similarity or Dissimilarity of Established, Likely-to-Continue Trade Channels; Conditions Under Which and Buyers to Whom Sales are Made

In considering these *du Pont* factors, we consider whether the goods are likely to be encountered by the same customers, in the same channels of trade, or under conditions which may tend

to make confusion more likely than not. Neither the pleaded registration nor the subject application is explicitly limited as to channels of trade or potential customers, so we must assume that such goods are or will be marketed to all potential customers and in all channels of trade as are normal for such goods. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)).

The usual channels of trade for sparkling wine are well-known, and include wine and liquor stores, bars, restaurants, and in many jurisdictions, supermarkets and convenience stores, drug stores, and other retail outlets. Opposer in fact sells its "sparkling wine in all of the standard channels of trade for wine products...." Kropp Dec. ¶ 7.

While we recognize that sparkling wine can be sold at a variety of price points, the evidence of record shows opposer's sparkling wine on sale at the low end of the spectrum for \$6.99 per bottle. Malek Dec. Exh. 6. Moreover, sparkling wine can be sold to a wide variety of adults, although opposer states that its actual target customer is 25-45 years old.⁹

⁹ In its motion, opposer argues that its goods are sold at "from \$5.99 to \$6.50 per bottle," "to consumers between the ages of 25 and 45," Opp. Mot. at 13, citing paragraph 8 of Ms. Kropp's declaration, although the declaration does not support these facts. Nonetheless, because opposer's goods must be construed to include both cheap and expensive sparkling wine, sold to all ages normal for such goods

By contrast, we know relatively little about the usual market for gelatin shots such as those applicant intends to market, but applicant's business plan for its JOTS product states that "[t]he general marketplace is that of alcoholic beverages." Weinberg Dec. Exh. E ("JOTS Executive Summary").

Applicant adds:

Our retail target market is college students and recent graduates. Commercially we will target bars, night clubs, and restaurants. Although our product aims to be as common as a six pack of beer, the initial consumption will likely be similar to the current consumption of home made gelatin shots. Namely parties, holidays, festivals, concerts, and other special occasions.

Id. Applicant has also stated that his "target demographic is men and women 21-30 years old, with a strong core being college students in the 21-24 year old range." Weinberg Dec. Exh. E ("Business Information") Moreover, applicant intends to market his product at a relatively-low retail price of \$9.99 per 12-pack. *Id.*

We find that applicant's goods and opposer's must be presumed to be marketed to the same potential consumers (those of drinking age), and that applicant in fact intends to market his gelatin shots to some of the same consumers as are targeted by opposers – those between 25 and 30 years old.

(essentially all people over age 21), the lack of evidentiary support is not critical.

Likewise, while goods of the type at issue could be sold at a variety of (overlapping) price points, opposer's goods are in fact inexpensive, and applicant likewise intends to sell his goods at a relatively low price. As a result, these goods may be purchased by relatively unsophisticated customers "with little care or prior knowledge," *Palm Bay*, 73 USPQ2d at 1695, and likely – when purchased in venues such as bars or restaurants – without the opportunity for the kind of close inspection which might alert such consumers to the fact that the goods do not share a common source. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898-99 (Fed. Cir. 2000) (risk of confusion is increased "[w]hen products are relatively low-priced and subject to impulse buying").

Finally, we note applicant's argument that any likelihood of confusion is "mitigated by the very different marketing by Applicant and Opposer." App. Resp. & Cross-Mot. at 12. Applicant states that his product will be advertised on the internet and through social media, while opposer's goods are not advertised at all. Applicant's argument errs by comparing what applicant currently expects to be his means of marketing with what appear to be opposer's current marketing activities. Absent explicit limitations in the application or registration at issue

(and there are none here), neither applicant nor opposer are limited to their current actual or intended marketing practices; we must analyze the issue as if the parties do (or will) advertise and sell their goods in any and all channels of trade normal for such goods. That applicant currently foresees only advertising online and through social media and that opposer does not currently engage in significant advertising is not a limitation on either party's ability to change their practices at any time.

We find that applicant's and opposer's goods are or would be marketed and sold to the same consumers and in the same channels of trade. We further find that opposer's and applicant's goods may be marketed to relatively unsophisticated consumers under circumstances which encourage impulse buying or make careful comparison of the products unlikely. These factors support a finding of likelihood of confusion.

4. The Fame of the Prior Mark

The fifth *DuPont* factor, fame of the prior mark, when present, plays a "dominant" role in the process of balancing the *DuPont* factors. See *Recot*, 54 USPQ at 1897-98; *Kenner Parker*, 963 F.2d 350, 22 USPQ2d at 1456 (Fed. Cir. 1992) (citing *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 296 (CCPA 1958)). Famous marks thus enjoy a wide latitude of legal protection. See *Kenner Parker*, 22 USPQ2d at 1456.

Packard Press Inc. v. Hewlett-Packard Co., 227 F.3d 1352, 56

USPQ2d 1351, 1356 (Fed. Cir. 2000) (citations revised).

Nonetheless, fame must be proved by the evidence of record, *id.*, and because of the extreme deference accorded to a famous mark, we have required those claiming such status "to clearly prove it." *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009).

In this case, opposer argues that its TOTT'S mark is "very well known," noting that sparkling wine has been sold under the mark since at least as early as 1987, that opposer sold over 1.2 million cases of TOTT'S wine since 2001, that "during the first two decades," it spent substantial sums advertising its product through television and in print, and that the branded goods have been mentioned by others in articles and reviews. See Opp. Mot. at 8. Applicant argues that opposer's mark is not famous,¹⁰ or if it is, that opposer has not proven it on this record. App. Resp. & Cross-Mot. at 14-15.

We cannot find on this record that opposer's mark is famous. For instance, while its sales (21 million cases since 2001) sound substantial, opposer has not introduced evidence of its market share to put those sales in context. *Bose Corp. v.*

¹⁰ Applicant introduced into evidence two web pages, titled "10 Top Affordable Champagnes," and "10 famous brands of champagne," neither of which mention opposer's brand, both as evidence that opposer's mark is not famous. We give this evidence little weight, but even if it were more fully considered, it would have no effect on our conclusion that opposer's mark is not famous, but does enjoy some renown.

QSC Audio Prods., 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002). Moreover, although opposer states that it spent "substantial sums" on advertising during the first two decades the mark was in use, Kropp Dec. ¶ 10, opposer has not indicted what level it views as "substantial," and in any event, opposer admits that it has not "invest[ed] heavily in the continued advertising and promotion of the brand" in recent years. *Id.* Opposer established neither the level of the previous advertising nor has it shown that the effects of such advertising have continued into more recent years, during which opposer seems to not to have advertised significantly.

Nonetheless, while we do not find opposer's mark to be famous, opposer's evidence of substantial sales and its considerable length of use is entitled to some weight in our analysis. At least for likelihood of confusion purposes, fame is not an all-or-nothing proposition. *Palm Bay*, 73 USPQ2d at 1694. The more consumers are familiar with a mark, the more they are likely to be confused by a similar mark, so any degree of renown weighs proportionately in favor of the prior registrant. Although opposer has not shown on this record the very high degree of renown typical of a truly "famous" mark, the renown it has shown, combined with the arbitrary nature of TOTTS as applied to sparkling wine, makes it somewhat more likely that applicant's marks will cause confusion. This factor

thus weighs somewhat in opposer's favor.

C. Balancing the Factors

Applicant urges that "[u]nder every factor to be considered...", there is no likelihood of confusion, App. Resp. & Cross-Mot. at 4, and argues that some factors are "insufficient alone to establish likelihood of confusion." *Id.* at 14 (fame), 14 (overlapping channels of trade). Applicant is correct that a single factor would be an insufficient basis on which to find a likelihood of confusion, but that is clearly not the issue here. Rather, the question is whether, in view of *all* of the relevant circumstances, opposer has demonstrated (by a preponderance of the evidence) that confusion is likely. The process requires appropriate balancing, rather than a simple tally of the scores on the various *du Pont* factors, which may carry different weight in a given case. *Citigroup Inc.*, 98 USPQ2d at 1261.

We have carefully considered the parties' arguments and all of the record evidence, including that which we have not specifically discussed. We conclude that opposer has carried its burden of proving a likelihood of confusion. As discussed, we find that TOTTS and JOTS are substantially similar marks, albeit not identical, that applicant's channels of trade and potential customers overlap with those of opposer, and that the goods at issue are or could be sold to unsophisticated consumers

under circumstances which do not typically involve a high degree of care. We also find that opposer has shown that its mark, while not "famous," has nonetheless been sold in substantial quantity for a number of years, and we can thus infer that it is known to consumers, increasing the likelihood of confusion.

We have fully considered applicant's argument that the goods at issue are unrelated, and we agree that the goods are clearly not identical. But we also recognize that both applicant's gelatin shots and opposer's sparkling wine are related in that they both comprise wine, and both provide a means for alcohol consumption. Thus, although the goods certainly differ to some extent, they do share a significant relationship.

Although this a closer case than many of the alcoholic beverage cases we have considered, we find that on balance, the relevant factors favor a finding of likelihood of confusion. While the goods are not identical or very closely related, they are related nonetheless, and when considered along with the similarity of the marks, overlapping customers and channels of trade, conditions of marketing and sale, and opposer's renown, we find opposer's claim of likelihood of confusion to be supported by the evidence. We are bolstered in our opinion by the maxim that to the extent we have any doubt, we must resolve that doubt in favor of opposer, the prior registrant. *See Hard*

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Rock Cafe Int'l (USA) Inc. v. Elsea, 56 USPQ2d 1504, 1514 (TTAB 2000); *W.R. Grace & Co. v. Herbert J. Meyer Indus., Inc.*, 190 USPQ 308, 311 (TTAB 1976).

VI. Conclusion

We conclude that registration of applicant's JOTS mark for the identified goods is likely to cause confusion with opposer's previously-used mark pursuant to Trademark Act § 2(d).

Decision: The opposition is SUSTAINED, and registration to applicant is refused.