

This Opinion is Not a  
Precedent of the TTAB

Hearing: September 21, 2022

Mailed: March 6, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
—

*Sazerac Brands, LLC*  
*v.*  
*Bullshine Distillery LLC*  
—

Opposition No. 91227653  
—

Kristen McCallion and Vivian Cheng of Fish & Richardson P.C.  
for Sazerac Brands, LLC.

John R. Horvack, Jr., Fatima Lahnin and Damian K. Gunningsmith  
of Carmody Torrance Sandak & Hennessey LLP  
for Bullshine Distillery LLC.

—  
Before Lykos, Adlin and English, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Bullshine Distillery LLC seeks a Principal Register registration of BULLSHINE FIREBULL, in standard characters, for “alcoholic beverages except beers,” in International Class 33.<sup>1</sup> In its notice of opposition, Opposer Sazerac Brands,

<sup>1</sup> Application Serial No. 86750668, filed September 8, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce.

LLC alleges prior use<sup>2</sup> and registration of FIREBALL (standard characters)<sup>3</sup> and



<sup>4</sup> for “whiskey,” and FIREBALL (typed form) for “liqueurs,”<sup>5</sup> all on the Principal Register in International Class 33.<sup>6</sup> As grounds for opposition, Opposer alleges that use of Applicant’s mark would be likely to cause confusion with Opposer’s marks.

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<sup>2</sup> More specifically, Opposer alleges prior use “through” its parent company and predecessor-in-interest.

<sup>3</sup> Registration No. 3550110, issued December 23, 2008 (the “110 Registration”); renewed. In this registration, Opposer spelled the identified goods as “whisky.” As Opposer explains, the term’s spelling is “location dependent.” Specifically, “‘whiskey’ is the American and Irish spelling, whereas Canada and Scotland omit the letter ‘e’ and spell the word as ‘whisky.’” Opposer’s “FIREBALL whisky is made from Canadian whisky,” so Opposer “refers to its product as whisky.” 60 TTABVUE 29 (Henry Dec. I ¶ 8 & n.1).

Citations to the record are to TTABVUE, the Board’s online docketing system. Specifically, the number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

<sup>4</sup> Registration No. 3734227, issued January 5, 2010 (the “227 Registration”); renewed. This registration describes the mark as follows: “The mark consists of Fiery headed, long tailed creature spewing flames under the curved text ‘FIREBALL’.”

<sup>5</sup> Registration No. 2852432, issued June 15, 2004 (the “432 Registration”); renewed. There is no substantive difference between “standard character” marks and marks in “typed” form. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks”).

<sup>6</sup> Opposer also pled ownership of Registration No. 4564436 for FUEL YOUR FIRE (standard characters) for “distilled spirits and liqueurs, prepared alcoholic cocktails,” but the parties stipulated to Opposer’s “withdrawal” of this basis for its likelihood of confusion claim. 57 TTABVUE 2.

In its operative third amended answer and counterclaims, Applicant denies the salient allegations in the notice of opposition and asserts “affirmative defenses” which are in fact merely amplifications of its denials. Applicant also counterclaims to cancel Opposer’s pleaded ’432 and ’110 Registrations (for the FIREBALL word marks) on the ground that “fireball” is a “generic name for a [whiskey or liqueur/schnapps-based] common alcoholic drink” containing “a spicy flavoring element such as cinnamon or hot sauce.” 24 TTABVUE 27-28 (Third Amended Answer and Counterclaims ¶¶ 109-116). In addition, Applicant counterclaims for cancellation of each of Opposer’s pleaded registrations on the ground of fraud, alleging that Opposer knew that FIREBALL is generic for its identified goods but failed to disclose this to the USPTO, and filed false declarations alleging that others do not have the right to use Opposer’s pleaded marks in commerce, when in fact they do.<sup>7</sup> *Id.* at 12-26 (Third Amended Answer and Counterclaims ¶¶ 33-103). In its answer, Opposer denies the salient allegations in Applicant’s counterclaims.

### **I. The ACR Record and Evidentiary Objections**

After the Board ruled on their cross-motions for summary judgment (“Cross MSJs”), 71 TTABVUE, the parties stipulated to resolving their remaining claims and counterclaims via accelerated case resolution (“ACR”). 77 TTABVUE (“ACR Stip.”). Specifically, the parties elected to “resolve this proceeding based on the evidence and testimony submitted with the [Cross MSJs], ACR briefs, and supplementation

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<sup>7</sup> The parties stipulated to dismissal of Applicant’s abandonment counterclaim against the ’436 Registration, 57 TTABVUE 2, and the Board granted summary judgment dismissing Applicant’s abandonment counterclaim against the ’432 Registration. 71 TTABVUE 3, 18-19 and fn.10. The ’436 and ’432 Registrations both identify “liqueurs” rather than “whisky.”

thereto.” *Id.* at 2 (ACR Stip. ¶ 1). They further agreed that evidence submitted with the Cross MSJs “is authentic for purposes of admission into the evidence and deemed properly of record ...,” subject to evidentiary objections other than “lack of personal knowledge.” *Id.* at 3 (ACR Stip. ¶ 2). Each party’s expert report “is admissible trial evidence,” but subject to objections under “Federal Rules of Evidence 702, 703 and 704, competency, accuracy, relevance, unreliability, materiality, and/or weight to be afforded.” *Id.* at 6 (ACR Stip. ¶ 8). Finally, the parties agreed that “[t]he Board may resolve any genuine disputes of material fact ... that it may find to exist ....” *Id.* at 3 (ACR Stip. ¶ 3).

Thus, the record consists of: the pleadings; by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s involved application; the evidence submitted in support of the Cross MSJs; and supplementation to the Cross MSJ evidence. More specifically, Opposer introduced the following:

First Declaration of Rebecca Henry, Opposer’s parent Sazerac Company’s Senior Marketing Director of spirit brands, including the FIREBALL brand, and the exhibits thereto (“Henry Dec. I”). 60 TTABVUE 28-456.

First Declaration of Kristen McCallion, a Principal with Opposer’s law firm, and the exhibits thereto (“McCallion Dec. I”). *Id.*, at 457-726. The exhibits to this declaration include, among others:

portions of the Deposition of Kendal Sheets, Applicant’s co-owner and co-founder (and an attorney) (“Sheets Tr.”), *id.* at 461-489;

portions of the Deposition of Wayne Kramer, Applicant’s other co-owner and co-founder, and its CEO (“Kramer Tr.”), *id.* at 491-555;

portions of the Deposition of Elizabeth Kimmerle, Applicant's expert witness ("Kimmerle Tr."), *id.* at 557-618; and

expert report of Sarah Butler, Opposer's expert witness ("Butler Report"), *id.* at 641-659.

Second Declaration of Ms. Henry, and the exhibits thereto ("Henry Dec. II"). 67 TTABVUE 28-219.

Second Declaration of Ms. McCallion, and the exhibits thereto ("McCallion Dec. II"). *Id.* at 220-338. The exhibits to this declaration include, among others:

portions of the Kimmerle Tr., *id.* at 223-250;

portions of the Kramer Tr., *id.* at 252-259;

portions of the Sheets Tr., *id.* at 261-270; and

portions of the deposition of Ms. Henry ("Henry Tr."), *id.* at 272-295.

Third Declaration of Ms. Henry, and the exhibits thereto ("Henry Dec. III"). 80 TTABVUE 2-118.

Third Declaration of Ms. McCallion, and the exhibits thereto ("McCallion Dec. III"). 81 TTABVUE 2-127.

Fourth Declaration of Ms. McCallion, and the exhibits thereto ("McCallion Dec. IV"). 105 TTABVUE 2-127.

Applicant introduced:

Internet printouts, official records, files of unpleaded and uninvolved applications and registrations, correspondence, pleadings from trademark litigation involving Opposer's FIREBALL mark, Opposer's discovery responses and printed publications. 63 TTABVUE.

Ms. Kimmerle's expert report ("Kimmerle Report"). *Id.* at 36-70.

portions of the Kramer Tr. *Id.* at 397-405.

portions of the Sheets Tr. *Id.* at 407-424.

Declaration of Mr. Kramer and the exhibits thereto (“Kramer Dec.”). *Id.* at 425-689.

Declaration of Mr. Sheets and the exhibits thereto (“Sheets Dec.”). *Id.* at 690-727.

Cross-examination of Ms. Henry, and the exhibits thereto (“Henry Cross”). 92 TTABVUE 5-104.

Declaration of the Custodian of Records for NBCUniversal Media, LLC, and the exhibits thereto (“NBC Dec.”). 94 TTABVUE.

Declaration of Wendy Szymanski, Associate General Counsel for Macmillan Publishers, Inc., and the exhibits thereto (“Szymanski Dec.”). 97 TTABVUE.

Declaration of Jeanne R. Berney, Chief Operating Officer of Berney Films, LLC d/b/a Picturehouse (“Berney Dec.”). 99 TTABVUE.

Supplemental Declaration of Mr. Kramer, and the exhibits thereto (“Kramer Supp. Dec.”). 100 TTABVUE.

While acknowledging that “the Board is capable of weighing the relevance and strength or weakness of the testimony and evidence,” 83 TTABVUE 34, Opposer nevertheless objects to much of Applicant’s evidence on various grounds, with a particular focus on Applicant’s expert witness Ms. Kimmerle. *Id.* at 34-51. We address Opposer’s objections to Ms. Kimmerle’s testimony below, as part of our evaluation of her opinions, findings and qualifications.

Opposer’s objections to Mr. Kramer’s testimony and other evidence concerning how Opposer’s FIREBALL product and other “fireball” mixtures taste are mostly beside the point. As Opposer itself points out, the issue here is “the **public’s**

understanding of the word FIREBALL,” which may include whether the public perceives there to be a “fireball” taste or flavor. 83 TTABVUE 45 (emphasis added). The parties’ own perceptions, and those of their witnesses, are not our focus except to the extent they may reflect public perception.

Moreover, while Internet printouts unsupported by testimony and other hearsay evidence may not be relied upon for the truth of the matters asserted, what these materials show on their face is often directly relevant to public perception. *Harry Winston, Inc. & Harry Winston S.A. v. Bruce Winston Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014) (“such materials are frequently competent to show, on their face, matters of relevance to trademark claims (such as public perceptions), regardless of whether the statements are true or false. Accordingly, they will not be excluded outright, but considered for what they show on their face.”). *See also In re Ayoub Inc.*, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USQ2d 1458, 1467 n.30 (TTAB 2014).

As for Opposer’s other objections, most go not to the admissibility of, but instead the weight to be accorded to, some of the testimony and evidence. Suffice it to say, “we simply accord the evidence whatever probative value it deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations.” *Hunt Control Sys. Inc. v. Koninkijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011). *See also Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1200 (TTAB 2018) (“We also remind the parties that our proceedings

are tried before judges not likely to be easily confused or prejudiced. Objections to trial testimony on bases more relevant to jury trials are particularly unnecessary in this forum.”) (citing *U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006)); *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1478 (TTAB 2017) (quoting *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017)). We have kept Opposer’s objections in mind in considering and determining the probative value of Applicant’s evidence.

## **II. Relevant Facts**

The term “fireball” has been used to describe cocktails and candy, as well as their taste or flavor. It has also been used as a trademark to identify alcoholic beverages and candy. Perhaps not surprisingly, public perception and use of the term has evolved, and is largely context-dependent.

### **A. Non-trademark and Descriptive Meanings, and Early Trademark Uses of “Fireball” for Candy**

“Fireball” is consistently defined in dictionaries as a “ball of fire,” “ball of flame” or “bright meteor.” 60 TTABVUE 83-95 (Henry Dec. Ex. G).

The term took on new significance in 1954, when Ferrara Pan Candy Co. developed and began offering a spicy and sweet cinnamon candy product called the ATOMIC FIRE BALL. 60 TTABVUE 30-34, 39, 72-78, 80-82, 85. The company registered the ATOMIC FIRE BALL mark (Reg. No. 1316009), as well as variations thereof, including ATOMIC FIREBALL (Reg. No. 3631230) and CHEWY ATOMIC

FIREBALL (Reg. No. 3635241), all on the Principal Register for “candy.” 60 TTABVUE 721-26.

As recently as 2019, Apex Flavors, Inc. offered a “fireball type flavor,” with “fireball type” presumably intended to convey that the flavor is similar to that of ATOMIC FIREBALL candy or Opposer’s FIREBALL whisky/liqueur. Significantly, the flavor was “developed for use in whiskey and other spirits,” as shown below:



63 TTABVUE 691, 696-700 (Sheets Dec. ¶¶ 10-12 and Exs. 1, 2); *id.* at 199 (highlighting added). In 2019, Northwestern Extract Co. offered a “Cinnamon Fireball” flavor. *Id.* at 207, 211. *Id.* at 692, 702-09 (Sheets Dec. ¶¶ 13-15 and Exs. 3, 4).

Also in 2019, the “fona.com” website listed the “most daring/creative” ice cream flavors, one of which was “Fireball/Red Hot Cinnamon.” 63 TTABVUE 693, 722-27 (Sheets Dec. ¶ 22 and Ex. 9); *id.* at 339, 348, 395. In 2016 Perry’s Ice Cream’s website

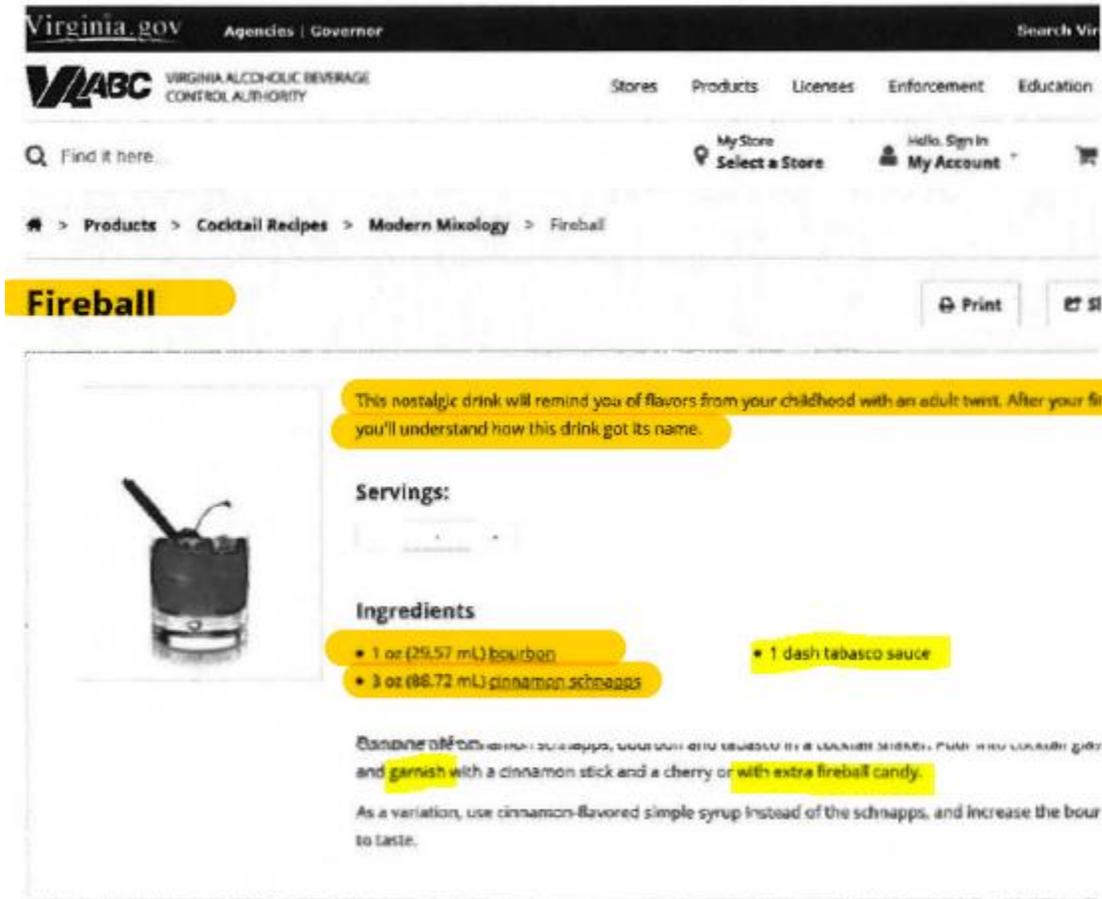
promoted the company's "Fireball" ice cream, stating "[w]e've blended hot cinnamon ice cream with cinnamon flavored swirls and sprinkled it with cinnamonette candies ...." *Id.* at 354. In 2019 Southern Snow offered a "Fireball"-flavored shaved ice concentrate. *Id.* at 363; *see also id.* at 366, 369. "Beef Jerky Outlet's Fireball Flavored Beef Jerky" was promoted online in 2019, and was claimed to have "cinnamon flavor." *Id.* at 372. In 2019 the "avalonmeatcandy.com" website offered "Fireball" flavored beef jerky, stating "cinnamon meets teriyaki and cayenne pepper **in layers much like atomic fireball candy**. Interesting and lots of fun." *Id.* at 376 (emphasis added). In 2019 the "popcorn carnival.com" website offered "Fireball" popcorn stating "one bite of our fireball popcorn and you'll know where it got its name! Chock full of spicy sweet cinnamon and crushed candy red hots, our Fireball popcorn is featured in Food Network Magazine's June 2015 issue." *Id.* at 379.<sup>8</sup> In 2018, the "carawaytea.com" website offered "Cinnamon Fireball" tea, describing it as "a hot cinnamon black tea with a slightly sweet flavor." *Id.* at 392.

At the same time ATOMIC FIREBALL was being used as a trademark for candy, and "fireball" was being used to describe the candy's flavor or similar flavors in other food and beverage products, "fireball" was also being used in a non-trademark manner in connection with alcoholic beverages, many with a sweet/spicy cinnamon flavor. For example, one undated recipe for a "Fireball" cocktail requires as ingredients bourbon, cinnamon schnapps and Tabasco sauce, and states: "This

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<sup>8</sup> Opposer introduced a 2020 printout from the same website showing that the popcorn's name was changed to "Fireball Cinnamon Whiskey." 67 TTABVUE 297 (McCallion Dec. II Ex. U).

nostalgic drink will remind you of flavors from your childhood with an adult twist. After your first sip you'll understand how this drink got its name”:



*Id.* at 235 (highlighting added). The recipe even suggests that the drink may be garnished “with extra fireball candy.” *Id.*

There are a number of additional recipes for “fireball” alcoholic cocktails or shots,<sup>9</sup> many of which include whiskey or cinnamon schnapps (or variations thereof) and Tabasco sauce, as shown below:

<sup>9</sup> Ms. Henry testified that “FIREBALL whisky is primarily drank as a shot.” 67 TTABVue 31 (Henry Dec. II ¶ 15).

**Hot Shot (also called a Fire Ball)**  
¾ oz. cinnamon schnapps  
¾ oz. Tabasco sauce  
Serve straight up in a shot glass.

**Fireball**  
Mix 1 oz. of cinnamon Schnapps with a dash of Tabasco sauce.

http://www.bardrinks.com/drinks/drink.asp?id=8261565  
13 captures  
11 Jan 2002 - 19 May 2008



**Fireball**

Qty.	Ingredients
1 oz.	Cinnamon Schnapps
-	Tabasco

**Fireball**  
1 oz. cinnamon schnapps  
dash Tabasco sauce  
Serve straight up in a shot glass.

Fireball (The Webtender) <https://www.webtender.com/db/drink/18>



**Fireball**

**Ingredients:**

- 1 oz Cinnamon schnapps
- 1 dash Tabasco sauce

**Mixing instructions:**

Pour the cinnamon schnapps in shot glass and add the dash of Tabasco Sauce. Then shoot.

**Drink Information:**  
Category: Shot  
Alcohol: Alcoholic  
Serve In: Shot glass  
Rating: 7.0 - 23 votes [vote]  
Contributor: [Thane J. Hafen](#)  
Added: 07 Apr 1997

**Options:**

- Find similar drinks
- Print drink
- Add to favourites
- Show your favourites

**Fireball**  
 Contributed by: n/a

[Printable Version](#)  
[Add to "My Handbook"](#)  
[Email This Drink](#)  
 Rate this Drink -

(No Votes)

**Drink Ingredients**

- 1 oz **Southern Comfort**
- 3 oz **Cinnamon Schnapps**
- 1 dash **Tabasco Sauce**
- 1 **Cherry(s)**

**Drink Directions**  
 Mix the schnapps, southern comfort and tabasco sauce. Pour into cocktail glass. Garnish with a cherry.

## Fireball Shot Recipe

The Fireball is a red shot made from Hot Damn cinnamon schnapps and Tabasco sauce, and served in a chilled shot glass.

**Ingredients**

- 1-1/2 oz Cinnamon Schnapps (Hot Damn)
- 1 dash Tabasco Sauce
- Glass: Shot Glass

**Directions**

- Shake cinnamon schnapps and Tabasco sauce with ice in a cocktail shaker.
- Strain into a chilled shot glass.



Rating: 4.75 (15 reviews) ★★★★★

Good: Average: Bad: Rate

© CompleteCocktails.com  
 Categories: Red Drinks, Shot Glass, Spicy Drinks

http://www.drinksecret.com/recipe/fireball-1.html

2 captures  
 27 May 2005 - 3 Oct 2005

Drink Recipes : A B C D E F G H I J K L M

**drinksecret.com**

Drink Recipes :: Cocktails :: Fireball #1 Drink Recipe

**Fireball #1 Drink Recipe**

**Drink Ingredients:**

- 1 oz. Southern Comfort
- 1 Cherry
- 3 oz. Cinnamon Schnapps
- 1 dash Tabasco Sauce

**Instruction:**  
 Mix the Schnapps, Southern Comfort, and Tabasco. Pour into cocktail glass. A cherry may be added.

**Glass Type:**



Blended & Frozen Drinks  
 Cocktails  
 Halloween Theme Drinks  
 Hot Drinks  
 Liqueurs  
 Mixed Drinks  
 Non-Alcoholic Drinks  
 Punches  
 Shots / Shooters  
 Specialty Drinks  
 X-Rated Drinks

**Information**  
 Search Drink Recipes  
 Drinking Games

**Recommended Sites**  
 Bar Supplies  
 Home Decor Products  
 Cooking Supply

Fireball #4 (Shooter) https://web.a

http://www.barnonedrinks.com:80/drinks/fireball-4-6627.html

12 captures  
 21 Jan 2008 - 8 Jul 2017

**Fireball #4**

**Fireball #4**

**Drink Type:** Shooter - F

**Ingredients**

- 1 oz. Cinnamon Schnapps - (more)
- 1/4 oz. Tabasco Sauce - (more)

**Instructions**

Shake with ice and strain into a shot glass.

http://www.barmandrinks.com:80/cocktails-drinks/fireball5-drink.html

1 capture  
9 Feb 2007

Fireball #5

**drinks**  
Bazman  
Barmandrinks.com

Cocktails

Cocktails Mixed Drink Recipes > Fireball #5 Drink

**Fireball #5 Recipe**

Home > Cocktails Drinks > Fireball #5

Browse Mixed Drink Recipes Alphabetically:

Cocktails : # A B C D E E F G H I J K L M N O P Q R S T U V W X Y Z

Popular recipes like Fireball #5 Recipe

Candy Cocktail recipe  
Strawberry Splash recipe  
Irish Tea recipe  
Peppermint Party recipe

Margarita recipe  
The Milk Way recipe  
Sourly Fizz recipe  
Valentino recipe

Cocktails Recipes. Mixed Drinks

**Fireball #5 Recipe**

Ingredients  
1.5 oz. Cinnamon Schnapps  
Top With Tabasco Sauce  
Mixing Instruction  
Shake and Strain Schnapps w/ ice into shooter glass float tobasco

Drink Category  
Cocktails

Glass Type  
Shooter



Fireball - Liqueur Shot Drink Recipe

https://web.archive.org/web/20100729100000/http://www.drinkoftheweek.com/drink\_recipes/fireball/

12 captures  
14 Sep 2010 - 11 Oct 2017

**Fireball**

The Barkeep  
Thursday, July 29, 2010

**Ingredients**

- 2 oz cinnamon schnapps
- Tabasco

**Instructions**

Pour the cinnamon schnapps into a shot glass and add a dash of Tabasco.

**Tags:** Cinnamon Schnapps, Hot sauce, Tabasco

— Brown Derby Cocktail

**Fireball**

1½ oz. cinnamon schnapps

1 dash Tabasco sauce

Pour cinnamon schnapps into a shot glass. Add Tabasco sauce.

BarDrinks Drink Page - Fireball #2

https://web.archive.org/web/20031114054432/http://www.bardrinks.com...

http://www.bardrinks.com:80/drinks/drink.asp?id=92931702

9 captures  
14 Nov 2003 - 22 May 2008

Fireball #2

Qty.	Ingredients
-	Goldschlager
-	Tabasco

Glass type: Shot

Directions: pour in shot glass and drink

Source: Remon



**Jawbreaker aka Fireball Cocktail Recipe**

Category: Shots

**Ingredients :**

- 1 oz red cinnamon schnapps
- 3 - 5 drops tabasco sauce
- 1 oz red cinnamon schnapps
- 3 - 5 drops tabasco sauce

Use a "In glass" for Jawbreaker aka Fireball drink recipe

Pour Red Cinnamon Schnapps into a shot glass then add Tabasco Sauce.  
Serve in "Shot Glass " Garnish: No

Fireball Cocktail Recipe - Barmano.com https://web.archive.org/web/20110917105212/http://www.barmano.com

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6 captures  
17 Sep 2011 - 22 Apr 2016

Go AUG SEP SEP  
◀ 17 ▶  
2010 2011 2013 About this capture

Blue Lady

Screaming Organism

Mojito

Pina Colada

Shit On Grass

Lemon Drop Martinis

Long Island Iced Tea

Swimming Pool

Laughing Buddha

most popular cocktails

**Cocktail Categories**

Apéritif

Coladas

Daquiris

Highballs



ABV: 14.53 %

Flavor: [Cinnamon](#)

Type of glass: [Shot glass](#)

Categories: [Shooters](#)

Created: 06/13/11

Last updated: 06/13/11

Read: 160 times

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**Recipe instructions for a Fireball:**

To make a Fireball Shooter, shake the liqueur and tabasco sauce with ice and strain into a chilled shooter glass.

**Ingredients:**

1 shot (2.95 cl/1 oz) [Liqueur, cinnamon](#)

3 splash (1.11 cl/0.38 oz) [tabasco sauce](#)

BarDrinks Drink Page - Fireball #7 https://web.archive.org/web/2004102002203/http://www.bardrinks.com

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7 captures  
20 Oct 2004 - 10 May 2006

Go SEP OCT DEC  
◀ 20 ▶  
2003 2004 2006 About this capture

**Fireball #7**

Qty.	Ingredients
1 oz.	Jack Daniel's
.5 oz.	Cinnamon Schnapps
1 sprinkle	Tabasco

Glass type: Shot

Directions: Pour Jack in a shot glass, add schnapps, then two drops of Tabasco.

Source: Shawn J.

# DRINK MONKEY

[Home](#) | [Random Drink](#) | [Print](#)

**FIREBALL 5**

<b>Ingredients:</b> Tabasco® Sauce Schnapps (Cinnamon)	<b>Amount:</b> Top With 1.5 oz.	<b>Current Rating:</b> 0 stars of 5 [] votes
--	---------------------------------------	--

**Description:**  
Shake and Strain Schnapps w/ ice into shooter glass float tabasco

**Tell The Monkey What You Think:**

Vote:  
 ★★★★★  
 ★★★★☆  
 ★★★☆☆  
 ★★☆☆☆  
 ★☆☆☆☆  
 ☆☆☆☆☆

One of these recipes is called “Atomic Fireball #2 Recipe,” and another is called “Southern Comfort Fireball”:

http://drinknation.com/drink/atomic-fireball-2

13 captures  
14 Feb 2016 - 11 Sep 2017

SEARCH DRINKS  
Advanced search No votes yet!

BROWSE DRINKS  
**Atomic Fireball #2 Drink Recipe**

By:  
Name Ingredient  
Theme Class  
Collection Multi-browse!

Ingredients

- 1 1/2 oz. Goldschl ager
- 3 1/2 oz. 7-up
- 1/4 oz. Grenadine
- 6 cubes Ice
- 10 drops Tabasco Sauce

Glass to Use  
Highball

Drink Colour: Multi-coloured (layered)

Mixing Instructions  
Shake ingredients in a cocktail shaker with ice. Strain into glass.

Nutrition Information  
Serving size  
Calories  
from alcohol  
% Daily Value  
Total Fat  
Saturated Fat  
Trans Fat  
Total Carbs.  
Fiber  
Sugars  
Cholesterol  
Sodium

TABASCO

**SOUTHERN COMFORT FIREBALL**

Ground Wet Seed Yields: 1 serving

**INGREDIENTS**

Ingredients Weight Measure  
TABASCO® brand Ground Wet Seed --- 1/4 tsp. (0.5% use)

**PREPARATION**  
Mix together Southern Comfort®, schnapps and TABASCO® Ground Wet Seed.  
Pour into cocktail glass.  
Garnish with black cherry.

63 TTABVUE 438, 441, 462, 471, 481, 492, 496, 498, 500, 517, 524, 528, 536, 538, 540, 550, 555, 557, 643, 667, 674, 680 (highlighting added). A number of these recipes were published earlier than 2008. *Id.*

There is also a recipe for a “Fireball Mead” containing cinnamon oil:

**Fireball Mead**  
Recipe by Chuck Boyce

**Ingredients**  
for 5 U.S. gallons (19 liters)

18.0 lb (8.16 kg) lightly flavored honey such as clover  
2 tsp (10 mL) Fermox yeast nutrient  
2 tsp (10 mL) yeast energizer (optional)  
Lalvin 71B-1122 Narbonne Dry Wine Yeast (2 packs)

**Ingredients added after primary fermentation**  
0.5 oz (15 mL) cinnamon oil or more to taste  
5 tsp (25 mL) potassium sorbate

**Original Target Gravity:** 1.135  
**Final Target Gravity:** Keep it sweet—at least 1.030, as high as 1.060!

**Notes:** For higher gravity, give it at least a year to blend.  
Thanks to the Boston Beer Company for donating the honey used for this mead!

**Directions**  
Activate yeast in warm water. Pasteurize honey and water at 150° F (65.5° C) for 30 minutes. Cool and transfer to carboy. Add enough water to make 5.5 gallons. Add yeast and remaining ingredients. Add 0.5 tsp or more of cinnamon oil to the secondary or at bottling, adjusting for your own taste. Once fermentation has ceased and the final target gravity is reached add 5 tsp (25 mL) of potassium sorbate to stabilize the mead and to stop fermentation from restarting. Once mead has cleared, bottle.

63 TTABVUE 189 (highlighting added). And Listermann Brewing Company offered “Chuck’s Fireball Mead” which was described as “mead with cinnamon and cinnamon candy added.” 63 TTABVUE 692, 711-714 (Sheets Dec. ¶ 17 and Ex. 5).

“Fireball” recipes are not always consistent, however. Some do not include whiskey, and others may not even have a spicy/sweet cinnamon flavor, as shown below:

<p><b>Fireball Shooter</b></p> <p>This drink is a hot one – you might need the next drink to put the fire out.</p> <p><b>¾ ounce cinnamon schnapps</b> <b>¾ ounce Bacardi 151-proof rum</b></p> <p>Pour both ingredients into a mixing glass two-thirds full of ice cubes. Stir well. Strain into a chilled Pony glass.</p>	<p><b>Fireball Shooter recipe</b></p> <p><i>Description</i> A delicious recipe for Fireball Shooter, with cinnamon schnapps, Bacardi® 151 rum and Tabasco® sauce.</p> <p><i>Ingredients</i> 1 shot cinnamon schnapps <b>1 shot Bacardi® 151 rum</b> 2 dashes Tabasco® sauce</p> <p><i>Instructions</i> Mix the schnapps, rum and tabasco in a shooter glass. Stir briefly.</p> <p><i>Serving</i> Shot Glass</p>
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<p><b>Fireball Shooter</b></p> <p><b>1 shot cinnamon schnapps</b> <b>1 shot Bacardi® 151 rum</b> <b>2 dashes Tabasco® sauce</b></p>	<p>Fireball Shooter (The Webtender)</p> <p><b>THE WEBTENDER</b> An On-Line Bartender</p> <p><b>TWO MEDIUM \$6.99 EACH</b> <b>2-TOPPING PIZZAS</b></p> <p>PROMO CODE <b>2MD699</b> ORDER NOW</p> <p><b>FireBall Shooter</b></p> <p><b>Ingredients:</b></p> <ul style="list-style-type: none"><li>• 1 shot Cinnamon schnapps</li><li>• 1 shot Bacardi 151 proof rum (Red Label)</li><li>• 2 dashes Tabasco sauce (McIlhenny's)</li></ul> <p><b>Mixing instructions:</b> Mix the Schnapps, Rum and Tabasco in a Shooter Glass. Stir briefly.</p> <p><b>Creator/contributor's comments:</b> Drink the shooter and chase it with a beer. Tastes like a fireball candy.</p> <p><b>Drink Information:</b> Category: Shot Alcohol: Alcoholic Serve in: Shot glass Rating: 7.3 - 9 votes [vot] Contributor: Eric Nerfeld Added: 29 Jul 1997</p> <p><b>Options:</b></p> <ul style="list-style-type: none"><li>• Find similar drinks</li><li>• Email drink</li><li>• Print drink</li><li>• Add to favourites</li><li>• Show your favourites</li></ul>
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**Fireball # 1**

Home > Drinks - Fireball #1

**Fireball # 1**

Drink Type: **Cocktail**

**Ingredients**

1 1/2 oz.  
**Brandy** (more Brandy drinks)  
 1 1/2 oz.  
**Sambuca** (more Sambuca drinks)

**Instructions**

Build in a lowball glass.

**Top Rated Coffee**

Enter Code: "HEYBOXED"

**Fireball # 2**

Home > Drinks - Fireball #2

**Fireball # 2**

Drink Type: **Cocktail**

**Ingredients**

1 1/2 oz.  
**Kahlua** (more Kahlua drinks)  
 1 1/2 oz. **Ouzo** (more Ouzo drinks)

**Instructions**

Build in a lowball glass.

**Fireball # 5**

Home > Drinks - Fireball #5

**Fireball # 5**

Drink Type: **Shooter**

**Ingredients**

1/3 oz. **Jose Cuervo** (more Jose Cuervo drinks)  
 1/3 oz. **Rumple Minze** (more Rumple Minze drinks)  
 1/3 oz. **Cranberry Juice** (more Cranberry Juice drinks)

**Instructions**

Shake with ice and strain into a shot glass.

Cocktails Mixed Drink Recipes > **Fireball #6 Drink**

**Fireball #6 Recipe**

Home > Cocktails Drinks > Fireball #6

Browse Mixed Drink Recipes Alphabetically:

Cocktails : # **A B C D E F G H I J K L M N O P Q R S T U V W X Y Z**

Popular recipes like **Fireball #6** Recipe

French Desquart recipe  
 French 75 recipe  
 Steak Banana recipe  
 Big Bird recipe

Joe Punch recipe  
 Negroni recipe  
 What Cocktail recipe  
 Jersey Gentlemen recipe

**Cocktails Recipes. Mixed Drinks**

**Fireball #6 Recipe**

Drink Category: Cocktails  
 Glass Type: Shooter

**Ingredients**

1 oz. **Kahlua**  
 1 oz. **Ouzo**

**Mixing Instruction**

Mix all ingredients in a shotglass.

http://www.barnonedrinks.com:80/drinks/f/fireball-1

5 captures  
 18 Feb 2008 - 6 Sep 2015

**Fireball #1**

**Fireball #1**

Drink Type: **Cocktail - F**

**Ingredients**

1 1/2 oz. **Brandy** (more)  
 1 1/2 oz. **Sambuca** (more)

**Instructions**

Build in a lowball glass.

**Fireball #3**

**Ingredients:**

- 1 part **Sambuca**
- 1 part **Tequila**
- 5-10 drops **Tabasco Sauce**

Shots & Shooters

Printable version

**Peppermint Fireball recipe**

Scale ingredients to 1 servings Go

**INGREDIENTS**

1/2 oz Appleton Estate® 151 proof Jamaican rum  
 1/2 oz Smirnoff® vodka  
 1/2 oz Scotch whisky  
 1 drop peppermint extract

**DIRECTIONS**

Mix the rum, vodka and whiskey together in a cocktail shaker. Add the peppermint extract/essence to taste. Strain into a 2-oz shot glass, and serve.

Serve in:  
 Shot Glass

**FIREBALL 2**

Fill glass with ice.  
 1/2 oz Vodka  
 1/2 oz Cinnamon Schnapps  
 1/2 oz Cherry Brandy  
 4-5 drops Tabasco Sauce  
 Stir.  
 Strain into shot glass.

**Fireball**  
**Cocktail Recipe**

Categories: Shaken and Cocktail  
Glass: Fireball

Recipe name  
*Fireball*  
Glass: Cocktail Glass

Ingredients :



- 1 oz peach liqueur
- 3 oz beer liqueur
- 1 dash tabasco sauce
- 1 cherry

Use a "In glass" for Fireball drink recipe

Mix the schnapps, southern comfort and tabasco sauce. Pour into cocktail glass. Garnish with a cherry.  
Serve in "Cocktail Glass" Garnish: No

Shots & Shooters

**Peach Fireball recipe**

I don't know if I made this up or not, my buddy came up to me and said he wanted something sweet with a kick and this popped into my head.

Scale ingredients to 1 servings Go

- 1/2 shot peach schnapps
- 1/2 shot Bacardi® 151 rum

Pour the peach first, pour the Bacardi second, light it on fire, now last and this is the important part BLOW THE FIRE OUT!! Consume and enjoy.

63 TTABVUE 443, 478, 511, 563 (some highlighting in originals, some added); 67 TTABVUE 299-304 (some highlighting in originals, some added); 100 TTABVUE 47.

Furthermore, Opposer points out that many shot and cocktail recipes call for its FIREBALL whisky, specifically and by name, i.e. by Opposer's FIREBALL mark. 67 TTABVUE 31, 64, 71, 85, 108, 117 (Henry Dec. II ¶ 15 and Exs. AL-1, AN). However, most of those recipes name the shot or cocktail itself something other than "Fireball."  
*Id.*

**B. Opposer’s Predecessor Develops FIREBALL Cinnamon Flavored Whisky in Canada and Opposer Begins Offering the Product in the United States**

In the 1980s, Joseph E. Seagram & Sons, Inc. offered in Canada a line of DR. MCGILLICUDDY’S schnapps and “whisky shooters.” One of the line’s two whisky shooters was “cinnamon flavored” and known as “DR. MCGILLICUDDY’S FIREBALL”:

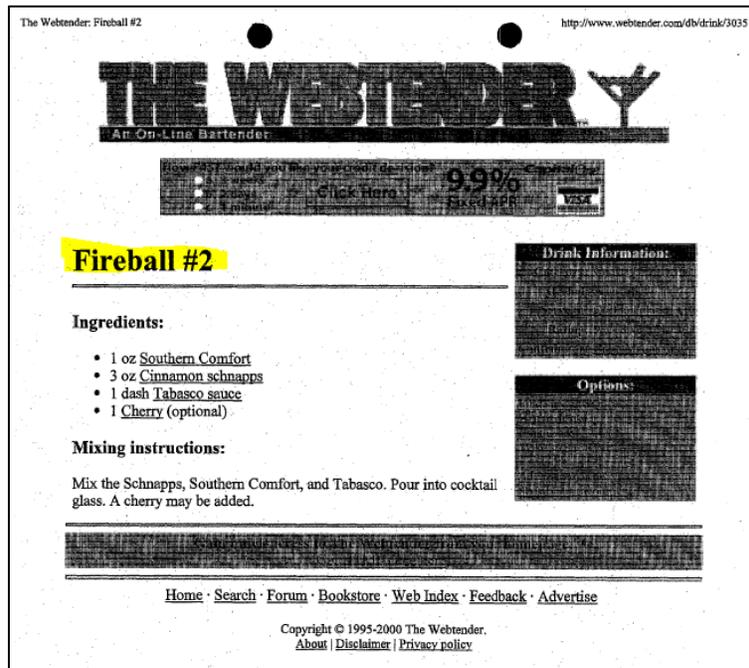


60 TTABVUE 29 (Henry Dec. I ¶ 8). “Around 1999, [Opposer] acquired Seagram’s worldwide rights to the DR. MCGILLICUDDY’S brand, including the DR. MCGILLICUDDY’S FIREBALL ... flavored whisky shooters, and their trademarks, artwork/label designs, and formulas,” and began selling DR. MCGILLICUDDY’S FIREBALL cinnamon- flavored whisky in the United States. *Id.* at 30 (Henry Dec. I ¶¶ 9-10).

**C. At That Time (Over 20 Years Ago), Opposer Effectively Conceded that FIREBALL is Not Inherently Distinctive for Whiskey or Whiskey-Based Liqueurs**

In 2000, Opposer filed application Serial No. 75941554 to register DR. MCGILLICUDDY’S FIREBALL for “whiskey-based liqueurs.” The USPTO issued an

Office Action requiring a disclaimer of “FIREBALL” as “merely descriptive because a ‘fireball’ is a whiskey based alcoholic drink.” The evidentiary basis for the requirement was this recipe for a “Fireball #2” cocktail:



63 TTABVUE 103-07 (highlighting added). As shown, the recipe calls for Southern Comfort, cinnamon schnapps and Tabasco sauce. Without challenging the requirement, Opposer entered the disclaimer. *Id.* at 110-11.<sup>10</sup>

The following year, Marie Brizard Wines & Spirits, U.S.A. sent Opposer a cease and desist letter claiming prior use of FIREBALL for “liqueurs” and challenging Opposer’s use of DR. MCGILLICUDDY’S FIREBALL. *Id.* at 113. Opposer responded by filing a declaratory judgment action in federal court seeking a declaration that its use of DR. MCGILLICUDDY’S FIREBALL was not infringing. *Id.* at 115-122. More

<sup>10</sup> Opposer later sought to have the resulting registration “corrected,” by deleting the disclaimer, but the USPTO refused the request. 60 TTABVUE 64-69.

specifically, Opposer pled that “Brizard is not entitled to trademark protection in the descriptive name FIREBALL.” *Id.* at 120.

Marie Brizard then counterclaimed for infringement, in response to which Opposer went even further, asserting, as its Second Affirmative Defense, that “[t]he **FIREBALL name is the generic term for a type of cinnamon flavored alcoholic beverage and thus is not protectable as a trademark under Federal or State law.**” *Id.* at 128 (emphasis added); *see also id.* at 133 (Opposer’s Response to Request for Admission (“RFA”) 28). While the details are designated “Confidential,” the declaratory judgment/infringement action apparently settled, because, as Opposer describes it, “[i]n 2002, [Opposer] purchased [Marie Brizard’s] rights in the FIREBALL trademark, including its application for FIREBALL with ‘liqueurs’ that [Marie Brizard] had filed based on a date of first use in commerce of September 1988, which the USPTO issued to [Opposer] as” the ’432 Registration. 83 TTABVUE 7; 59 TTABVUE 32 (Henry Dec. I ¶ 19); 62 TTABVUE 187-90.

Around the same time Opposer was effectively conceding in its trademark application and asserting in litigation that FIREBALL is not inherently distinctive, it was using FIREBALL as a mark for its cinnamon whisky product, and using “cinnamon whisky” to identify the product’s category, as shown in the following 2001 press release:



The image is a screenshot of a webpage from the Sazerac Company. At the top left is the Sazerac logo, which includes a crest with a figure and the text "SINCE 1850 SAZERAC NEW ORLEANS". To the right of the logo is the text "COMPANY NEWS". Below the logo and title is a dark vertical sidebar with white text listing "HISTORY", "PRODUCTS", "NEWS", "JOBS", and "PEYCHAUD'S BITTERS". The "NEWS" item is highlighted with a grey background. The main content area has a white background with a black horizontal bar at the top. The headline reads "Fireball - The Newest Taste Sensation and Member of the Dr. McGillicuddy's Family". The text below the headline is a press release dated February 2, 2001, from New Orleans, LA. It states that the Sazerac Company will introduce Fireball, a cinnamon whisky, as the newest member of the Dr. McGillicuddy's family. It mentions that Fireball is currently the fastest growing brand in Canada and that its unique flavors are driving the market. A quote from Rebecca Green, Dr. McGillicuddy's Brand Manager, describes Fireball as unique and smooth. The text also notes that Fireball's "Original Formula" is faithful to the original creation of A.P. McGillicuddy and is imported from Canada by the Sazerac Company, Inc. The press release is available in various sizes including liters, 750 ml, and 750 ml. At the bottom left of the page is a URL: "ps://web.archive.org/web/20011023192600/http://sazerac.com/news4.html[1/2/2020 11:20:31 AM]". At the bottom right is the text "BD-009247".

63 TTABVUE 92 (highlighting added). On the other hand, in the same press release, Opposer states that “Mentholmint Schnapps, Vanilla Schnapps and Fireball” are “members of the Dr. McGillicuddy’s family,” which could be perceived as equating “Fireball” with the apparently non-distinctive terms “Mentholmint Schnapps” and “Vanilla Schnapps.” Cf. 67 TTABVUE 282 (McCallion Dec. II Ex. T) (Henry Tr. 121) (“Menthol mint and vanilla are flavors.”).

Suffice it to say that, based on the record in its entirety, during the early 2000s Opposer did not consistently treat or use “fireball” as a mark.

**D. Opposer Quite Successfully Rebrands FIREBALL Cinnamon-Flavored Whisky**

“Around 2005, [Opposer] explored transitioning the brand from DR. MCGILLICUDDY’S FIREBALL to just FIREBALL.” *Id.* at 32 (Henry Dec. I ¶ 20). In 2007, Opposer updated the product’s packaging, as shown below:



*Id.* at 33 (Henry Dec. I ¶ 21). As reflected in the depictions above, “[t]he imagery of a flaming ball of fire also carried over to the newly designed FIREBALL product label as a reference to the fact that the word ‘fireball’ means, literally, a ball of fire.” *Id.* at 33 (Henry Dec. I ¶ 22).

Although Opposer enjoyed only modest success in its first several years of offering DR. MCGILLICUDDY’S FIREBALL cinnamon-flavored whisky in the United States, 59 TTABVUE 31 (Henry Dec. I ¶ 13), after the rebranding, FIREBALL cinnamon whisky’s popularity skyrocketed in the United States. In fact, in 2012 Opposer’s FIREBALL whisky was rated the “#1 shooter in growth according to Nielsen.” 60 TTABVUE 37 (Henry Dec. I ¶ 38). “In 2014, FIREBALL whisky became the #1 shot by volume in the U.S,” *id.*, although FIREBALL whisky’s share “of the entire United

States market for shots” was perhaps not as significant as might have been expected given its ranking. 59 TTABVUE 38 (Henry Dec. I ¶ 38). How these “ratings” were formulated is unexplained.

In any event, Opposer’s FIREBALL whisky has become even more successful in recent years. In fact, “[a]s of October 2019, FIREBALL whisky was ranked the #1 selling whisky nationwide, as it had also been in 2017 and 2018, after holding the #2 position in 2015 and 2016.” 60 TTABVUE 38 and 59 TTABVUE 188-89 (Henry Dec. I ¶ 38 and Ex. O). Again, the method behind these “rankings” and the evidence supporting them are unexplained.

The product has received substantial unsolicited media attention. *Id.* at 38, 150-254 (Henry Dec. I ¶ 39 and Exs. Q-1 and Q-2); 67 TTABVUE 30-31, 63-152 (Henry Dec. II ¶¶ 12-14 and Exs. AL-1, AL-2 and AM). For example, a 2016 BUSINESS INSIDER article about FIREBALL whisky is titled “This liquor brand grew sales from \$1.9 million to \$160 million in under 5 years — and it’s now more popular than Grey Goose or Jim Beam.” 60 TTABVUE 39, 241-42 (Henry Dec. I ¶ 40 and Ex. Q-2). Opposer estimates that the product’s unsolicited media attention has “reached” a large number of people, but how it arrived at this estimate is unexplained, and it is unclear whether the estimate is limited to the United States. 59 TTABVUE 50-51 (Henry Dec. I ¶ 70).

Opposer’s gross sales from 2011-2019 are significant. 59 TTABVUE 52 (Henry Dec. I ¶ 71). Its marketing expenses from 2011-2019 are as well. *Id.* at 45-46 (Henry Dec. I ¶ 61). However, Opposer has not provided context for its sales and advertising

figures which would allow us to compare them to those of Opposer's competitors.<sup>11</sup> Nonetheless, Applicant agrees that Opposer's FIREBALL brand has been successful because it "sold a lot." 60 TTABVUE 501-02 (Kramer Tr. 127-28).

Opposer attributes its marketing success, in part, to its "brand ambassador program." 60 TTABVUE 40 (Henry Dec. I ¶ 45). Opposer's brand ambassadors "are charged with identifying, establishing, and cultivating super fans, influencers, and brand advocates throughout their respective markets. [Opposer's] FIREBALL ambassadors visit places where FIREBALL whisky is sold and engage consumers in fun drinking activities and other events at which FIREBALL whisky is highlighted." *Id.* (Henry Dec. I ¶¶ 45-46). *See also id.* at 159 ("The company would offer free shots of Fireball to the entire bar. The bar would then take the shot as a group, which left an impression on customers."). Opposer also provides "branded novelty items," signs and other promotional materials to bars:



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<sup>11</sup> The "Nielsen Answers" rankings Opposer provided, 59 TTABVUE 188-89, are unauthenticated hearsay, unexplained and insufficient to allow us to draw firm conclusions about whiskey "spirit share distribution," even if that term was adequately explained.

*Id.* at 41 (Henry Dec. I ¶ 47). Opposer’s “Official Bartender Loyalty Program” has apparently been successful because in 2015 and 2016 FIREBALL won a “Most Recommended Brand Award” in the “Overall Spirit” and “Shot/Shooter” categories. 59 TTABVUE 42 (Henry Dec. I ¶ 49); 60 TTABVUE 146-49 (Henry Dec. I Ex. P).

Opposer’s celebrity endorsers include Chris Pratt, Ed Sheeran, Miranda Lambert, and the bands Florida Georgia Line (whose song “Round Here” mentions FIREBALL) and Kings of Leon. Opposer’s “Fireball Whisky” Facebook page has almost one million followers, and was estimated to have “reached” many more than that. *Id.* at 43, 151-52 (Henry Dec. I ¶¶ 53-54 and Ex. Q-1); 80 TTABVUE 16 (Henry Dec. III ¶ 18). “What is Fireball?” was the correct “answer” (in the form of a question) to this clue on the television show Jeopardy: “I carry a flask full of this cinnamon whisky that ‘Tastes Like Heaven’ & ‘Burns Like Hell.’” 80 TTABVUE 12 (Henry Dec. III ¶ 18).

**E. Opposer Challenges Third-Party Uses of FIREBALL for Alcoholic Beverages, and Sometimes Other Products**

Opposer has successfully challenged third-party applications to register FIREBALL for beer and spirits. 67 TTABVUE 29, 35-37 (Henry Dec. II ¶ 7 and Exs. AE and AF). It also prevailed in a UDRP case, resulting in the transfer of the domain name “fireballcannabis.com” to Opposer. *Id.* at 29, 39-42 (Henry Dec. II ¶ 8 and Exs. AG).

Opposer recently enforced its rights against several of the third-party users of FIREBALL cited by Applicant in this case, but apparently did not do so until Applicant relied on these third-party uses in support of its Cross-MSJ. *Id.* at 29-30, 46-61 (Henry Dec. II ¶ 10 and Exs. AI, AJ and AK) (revealing successful enforcement

against Beef Jerky Outlet, Northwestern Extract and Apex Flavors). Opposer also successfully enforced its rights in its FIREBALL mark against Jack Daniel's, which used FIREBALL in connection with its competing cinnamon whiskey product. 79 TTABVUE 18, 161-67 (Henry Dec. III ¶ 31 and Ex. BH); *see also id.* at 126-59; 80 TTABVUE 17-18, 114-16 (Henry Dec. III ¶¶ 29-30 and Exs. BF and BG).

Opposer has not prevented all third-party uses of "fireball," however. For example, in 2014, in the midst of FIREBALL Cinnamon Whisky's explosive growth, the theatrical film "The Guest" included descriptive or generic use of FIREBALL for an alcoholic drink. Specifically, in the film a waiter asks the main character for his order, and the main character responds "You know how to make a fireball?" The waiter answers "cinnamon schnapps and Tabasco sauce," to which the main character responds "that's my drink of choice. Let me get one of those." 96 TTABVUE.

**F. Opposer Admits, Sometimes Begrudgingly, that FIREBALL Whisky Tastes Like ATOMIC FIREBALL Candy**

Ms. Henry concedes not just that "[p]eople often compare the flavor of FIREBALL whisky to [ATOMIC FIREBALL] candy as well as to BIG RED chewing gum and RED HOTS candy, which have a sharp cinnamon taste," 60 TTABVUE 55 (Henry Dec. I ¶ 84), but also that "[t]he cinnamon flavor of Fireball whisky and the Fireball candy cinnamon flavor, they're the same flavoring." 67 TTABVUE 293 (Henry Tr. 165). Moreover, when the founder of Ferrara Pan Candy Co. died, Opposer posted on its "Fireball Whisky" Facebook page that it had a "heavy heart" and that FIREBALL whisky is "based on" the ATOMIC FIREBALL, as shown below:



63 TTABVUE 214 (highlighting added); *see also id.* at 216, 223, 225 (essentially identical and substantively similar tweets).

Opposer's statements are consistent with perceptions reported in the media and product listings:

Fireball, which is described as tasting like cinnamon gum  
.... 60 TTABVUE 159

Consumers say Fireball, a heavily sweetened spirit with a spicy cinnamon kick, 'tastes like Big Red in liquid form.' *Id.* at 165.

It tastes like a syrupy incarnation of Wrigley's Big Red gum. It's sweet, with a spicy burn. *Id.* at 171.

The drink, which tastes exactly like the Atomic Fireball candy .... *Id.* at 174.

... it used social media to spread the word about the flavored whiskey, which tastes like the liquefied Big Red gum. *Id.* at 175.

The primary ingredient is Canadian whiskey and the pop, which resembles the flavor of a product made by the Ferra [sic] Candy Company “Atomic Fireball” candy, comes from the added cinnamon flavor. *Id.* at 178.

It tasted exactly like atomic fireball cinnamon candy – those little red-hot balls with the hard-to-open plastic wrappers ... Fireball Whisky is just pure liquid cinnamon burn, and it’s pure fun. 63 TTABVUE 241.

The younger kids, it reminds them of the Atomic hot balls candy .... *Id.* at 244.

You barely taste the alcohol, it tastes like (Atomic Fireball) candy .... *Id.* at 248.

The current darlings of the trashy-liquor category are Fireball Cinnamon Whiskey, which tastes just like Atomic Fireball candy with a million times the sugar .... *Id.* at 252.

It’s the cinnamon flavored, Atomic Fireball candy like, syrupy-sweet liquor that “Tastes like Heaven. Burns like Hell.” And, its sales are just that – on fire. *Id.* at 256.

Its foundation is Canadian whisky, and the taste otherwise resembles the candy with a similar name, Ferrara Candy Company’s “Atomic Fireball” candy. *Id.* at 260.

Fireball Cinnamon Whisky, which tastes remarkably similar to the molar-dulling Ferrara jawbreakers of our youth .... *Id.* at 264.

It tastes like the Atomic Fireball candy kids dared each other to suck on the longest. *Id.* at 267.

Like Atomic Fireball candy, for which this spicy hot spirit is named, Fireball Cinnamon Liqueur is a treat to be savored. *Id.* at 272.

... the taste otherwise resembles, no, **is identical, to the atomic fireball jawbreaker candy** you had as a kid. Remember the “hot balls” you would put in your mouth and see how long you could keep them in there? Well, turned out that hot ball was intense cinnamon and someone decided to make a whiskey the tastes exactly like one of those balls, but in liquid form. *Id.* at 280 (emphasis added).

With the childhood flavor of the atomic fireball candy, this gives Fireball Cinnamon Whisky a smooth and delicious finish. *Id.* at 292.

... the taste otherwise resembles the candy with a similar name, Ferrara Candy Company’s “Atomic Fireball” candy. *Id.* at 298.

“When I was a kid, the most popular dare on the playground was who could suck on a fireball jawbreaker the longest ... That childhood cinnamon flavor is what Fireball Whiskey is all about. 67 TTABVUE 155 (Henry Dec. II Ex. AN).

The Wikipedia entry for “Fireball Cinnamon Whisky” states “the taste otherwise resembles the candy with a similar name, Ferrara Candy Company’s ‘Atomic Fireball’ candy.” 60 TTABVUE 227.

Opposer’s website is consistent with these assessments. It states: “If you haven’t tried it yet, just imagine what it feels like to stand face-to-face with a fire-breathing dragon who just ate a whisky barrel filled with spicy cinnamon.” *Id.* at 339. Opposer’s website is reported to have also stated, alternatively, that “if you haven’t tried it yet, just imagine what it’s like to get a Chuck Norris roundhouse kick to the face if his legs were on fire and tasted like cinnamon.” 67 TTABVUE 83 (Henry Dec. II Ex. AL-

1). Opposer markets FIREBALL whisky under the slogan/tagline “Tastes Like Heaven, Burns Like Hell”:



60 TTABVUE 40 (Henry Dec. I ¶ 42).

### III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \* 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Here, Opposer’s pleaded registrations, 60 TTABVUE 34, 96-102 (Henry Dec. I ¶ 24 and Ex. H), establish that it is entitled to oppose registration of Applicant’s mark on the ground of likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943,

55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes “standing”). Applicant’s entitlement to assert its counterclaims is inherent, as it is the defendant in the opposition. *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007); *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1502 (TTAB 2005) (“Applicant, by virtue of its position as defendant in the opposition, has standing to seek cancellation of the pleaded registration.”). In any event, the parties stipulated to each other’s entitlement to bring a statutory cause of action. 77 TTABVUE 6-7 (ACR Stip. ¶ 11).

#### **IV. Applicant’s Counterclaims**

We address Applicant’s counterclaims first, because if successful they would impact our analysis of Opposer’s likelihood of confusion claim.

##### **A. Genericness Counterclaims**

“Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold. They are by definition incapable of indicating a particular source of the goods or services,” and may not be registered. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2011) (citations omitted). *See also USPTO v Booking.com B.V.*, 140 S. Ct. 2298, 2020 USPQ2d 10729, at \*2 (2020) (“A generic name—the name of a class of products or services—is ineligible for federal trademark registration.”); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045-46 (Fed. Cir. 2018).

“The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of

goods or services in question.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). Thus, “[t]he primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.” 15 U.S.C. § 1064(3). *See also In re Am. Fertility Soc’y.*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991).

We must make a two-step inquiry to determine whether FIREBALL is generic: First, what is the genus (category or class) of goods at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods? *Marvin Ginn*, 228 USPQ at 530.

Applicant/Counterclaimant “bears the burden of proving that the term is generic ... by a preponderance of the evidence.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018). In deciding whether Applicant has met this burden, “we examine the evidence up through the time of trial,” *Alcatraz Media Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1763 (TTAB 2013), *aff’d mem.*, 565 F.App’x 900 (Fed. Cir. 2014), including the evidence “at the time each registration is sought,” here 2001 for the ’432 Registration and 2008 for the ’110 Registration. *In re Consumer Protection Firm PLLC*, 2021 USPQ2d 238 at \*22 (TTAB 2021).

Applicant posits two closely related theories that FIREBALL is generic, as follows:

First, the evidence shows that the relevant public primarily uses and understands the term to refer to a “subcategory” or “part” of the claimed genus of goods. Specifically, “Fireball” was the name of a subcategory of alcoholic drinks containing whiskey and liqueurs that sought to replicate the taste of Fireball candy.

Second, the evidence also shows that the relevant public primarily uses and understands the term to refer to a “key aspect” of the goods at issue—namely, the flavor. Because flavor is a key product characteristic, it is only used to differentiate products—not sources of products.

101 TTABVUE 17. Before addressing these theories, we must identify the genus and the relevant public.

### **B. The Genus**

Despite some arguing about it, the parties agree that the genus is “whisky” (the goods identified in the ’110 Registration) and “liqueurs” (the goods identified in the ’432 Registration). 107 TTABVUE 3, 15, 22-23; 101 TTABVUE 21-22. We agree with them. In fact, Opposer’s FIREBALL whisky is both a “whisky” and a “liqueur.” 60 TTABVUE 34-37 (Henry Dec. I ¶¶ 25-36); 59 TTABVUE 35 (Henry Dec. I ¶ 32). It is settled that “a proper genericness inquiry focuses on the description of [goods] set forth in the certificate of registration.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1636 (Fed. Cir. 2016) (quoting *Magic Wand*, 19 USPQ2d at 1552).

### **C. The Relevant Public**

The “relevant public” consists of consumers of whisky and liqueurs. *See Magic Wand*, 19 USPQ2d at 1553-54. Thus, as explained below, Opposer’s expert’s focus on

certain consumers of shots/shooters specifically was misplaced. The identifications of goods, and more to the point the parties' agreed-upon genus, is not so limited. In fact, the genus encompasses, by way of example: (1) those who occasionally sip a desert liqueur in a fancy restaurant; (2) connoisseur collectors of rare, aged bourbons and ryes; and (3) college-aged partiers who "do shots" while closing down bars on Friday and Saturday nights, among other relevant consumers.

**D. Do Whisky or Liqueur Consumers Primarily Use or Understand FIREBALL to Refer to Whisky or Liqueurs, or a Key Aspect Thereof?**

Applicant does not allege that relevant consumers use or understand FIREBALL to refer to "whisky" or "liqueurs" generally. Rather, both of Applicant's proffered theories of genericness are more specific – the first theory is that FIREBALL is generic for a "subcategory" or "part" of the genus (alcoholic drinks containing whiskey and liqueurs that attempt "to replicate the taste of Fireball candy"), and the second theory is that FIREBALL is generic for a "key aspect" of the genus (the "fireball" flavor). 101 TTABVUE 17. *See Royal Crown*, 127 USPQ2d at 1041 (term is generic if it refers to a "key aspect" or part of a genus); *In re Cordua Rests.*, 118 USPQ2d at 1638. *See also In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1438 (TTAB 2005) ("the class or category of services described in the application still clearly includes that of providing information regarding sports and betting"). We thus focus here on whether consumers use or understand FIREBALL to refer to a "subcategory," "part" or "key aspect" of the genus, specifically whisky or liqueur with a spicy/sweet cinnamon or ATOMIC FIREBALL-type flavor. 101 TTABVUE 17.

Evidence of the relevant public's understanding of FIREBALL may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). “[E]vidence of competitors’ use of particular words as the name of their goods or services is, of course, persuasive evidence that those words would be perceived by purchasers as a generic designation for the goods and services.” *Cont’l Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999). Similarly, “examples of ... commentators using the term to refer to a category of [goods] is persuasive evidence that the term would be perceived by the relevant public ... as a generic designation of those [goods].” *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1069 (TTAB 2018). *See also Northland*, 227 USPQ at 963 (relying on publications’ uses of the term to find BUNDT generic for a type of ring cake mix); *In re Noon Hour Food Prods. Inc.*, 88 USPQ2d 1172 (TTAB 2008) (relying on publications’ uses of the term to find BOND-OST generic for a type of cheese).

Here, the evidence of genericness, especially the evidence from around the time registration was sought, is significant. The contrary evidence that FIREBALL is perceived as a mark for Opposer’s cinnamon-flavored whisky is also significant.

**1. Opposer’s Concessions in 2000 and 2001 that FIREBALL is Not Inherently Distinctive**

We start with Opposer’s concessions that FIREBALL is not inherently distinctive. Opposer disclaimed FIREBALL in its application Serial No. 75941554, thus conceding that the term was merely descriptive of “whiskey-based liqueurs.” *Alcatraz*

*Media*, 107 USPQ2d at 1762 (TTAB 2013); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.* 89 USPQ2d 1844, 1851 (TTAB 2008). The concession that FIREBALL is merely descriptive is not a concession that the term is generic or unregistrable, however.<sup>12</sup> See *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015).

The situation is different with respect to Opposer's litigation position in the Marie Brizard case. There, Opposer's second affirmative defense to Marie Brizard's infringement counterclaim was unequivocal: "[t]he FIREBALL name is the generic term for a type of cinnamon flavored alcoholic beverage and thus is not protectable as a trademark under Federal or State law." 63 TTABVUE 128 (emphasis added). This assertion directly and obviously supports Applicant's genericness counterclaim.

On the other hand, we recognize that Opposer asserted that FIREBALL is generic over 21 years ago, about a decade before FIREBALL cinnamon-flavored whisky's popularity started its meteoric rise. Today, the record shows that as a result of FIREBALL whisky's success over the past decade, the term "fireball" is used and understood differently by the relevant public than it was in 2001, and is now much more likely to be perceived as a source identifier for Opposer's cinnamon-flavored whisky.

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<sup>12</sup> As explained throughout this opinion, Opposer has introduced a great deal of evidence that could support a claim that FIREBALL has acquired distinctiveness for Opposer's goods.

In fact, FIREBALL is now one of the country's most popular whiskies, and has been widely reported on in the media, especially during the early-mid 2010s, when its sales and public recognition started growing so significantly. As a result, the relevant public's encounters with the term "fireball" are much more likely now than they would have been in the early 2000s to be in connection with Opposer's cinnamon whisky product as opposed to, for example, a cocktail/shooter recipe or ATOMIC FIREBALL candy. Furthermore, five months before asserting its affirmative defense of genericness, Opposer issued a press release which made trademark use of FIREBALL, calling its specific product "FIREBALL" and the product's category "cinnamon whisky." 63 TTABVUE 92.

Finally, while Opposer's 2001 assertion that FIREBALL is generic is certainly "illuminative of shade and tone in the total picture confronting" us, at the same time, we recognize that "[u]nder no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of making his own ultimate conclusion on the entire record." *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978); *cf. Quaker Oats Co. v. St. Joe Processing Co.*, 232 F.2d 653, 109 USPQ 390, 391 (CCPA 1956) (a witness's opinion "obviously is not binding upon either the tribunals of the Patent Office or the courts"); *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1746 n.8 (TTAB 1987) (witness testimony "on questions pertaining to ultimate issues of trademark law" entitled to less weight). Thus, Opposer's affirmative defense of genericness in the Marie Brizard litigation is

not conclusive on the question, but it certainly weighs in favor of finding that “fireball” was generic for whisky and liqueurs, at least in 2001.

**2. The Impact of Ferrara Pan’s Use of FIRE BALL Marks for Candy, and Third-Party Use “Fireball” to Identify a Flavor**

The record reveals that when “fireball” is used in connection with Opposer’s cinnamon whisky, it has two meanings. First, as Ms. Henry explains, “fireball” means “a ball of fire.” 60 TTABVUE 33 (Henry Dec. I ¶ 22). Indeed, a ball of fire has been depicted on the packaging for FIREBALL cinnamon whisky since before Opposer acquired the product from Seagram. *Id.*

Second, while Ms. Henry was less forthcoming about it, the term “fireball” is perceived by many as referring to the “cinnamon flavor” of Opposer’s FIREBALL cinnamon whisky. Ms. Henry admits that FIREBALL cinnamon whisky has “the same flavoring” as Ferrara Pan’s ATOMIC FIREBALL candy. 67 TTABVUE 293 (Henry Tr. 165); 63 TTABVUE 214, 216, 223, 225. Moreover, there are a number of media reports to the same effect, providing ample evidence that at least a portion of the relevant public perceives “fireball” as the flavor of Opposer’s FIREBALL cinnamon whisky. *Id.* at 55 (Henry Dec. I ¶ 84); *id.* at 159, 165, 171, 174, 175, 178, 227; 63 TTABVUE 241, 244, 248, 252, 256, 260, 264, 267, 272, 280, 292, 298; 67 TTABVUE 155 (Henry Dec. II Ex. AN).

As we point out above, a term may be generic if it refers to a subpart or “key aspect” of the genus. *See Royal Crown*, 127 USPQ2d at 1041 (term is generic if it refers to a “key aspect” or part of a genus); *In re Cordua Rests.*, 118 USPQ2d at 1638 (“churrascos,” a type of grilled meat, is generic for restaurant services). Obviously,

flavor is a “key aspect” of many foods and beverages, and thus a flavor name may be generic for food or beverage products. *In re Pepcom Indus., Inc.*, 192 USPQ 400 (TTAB 1976) (affirming refusal to register JIN.SENG on the Supplemental Register for soft drinks, because it is the phonetic equivalent of “ginseng,” which “is the generic name of an herb that might be an ingredient in applicant’s goods”); *In re Demos*, 172 USPQ 408, 409 (TTAB 1971) (“CHAMPAGNE’ is deemed unregistrable to applicant irrespective of the amount of purported secondary meaning evidence submitted” because it “merely names the principal ingredient of [applicant’s] salad dressing). *See also A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3d Cir. 1986) (CHOCOLATE FUDGE found generic for diet soda, because “the term ‘chocolate fudge’ denotes a particular full and rich chocolate flavor, that distinguishes Canfield’s product from plain chocolate sodas” and “it appears difficult if not impossible for a competing producer to convey to the public that its product shares this functional flavor characteristic without using the words ‘chocolate fudge’”); *Parasol Flavors, LLC v. SnoWizard, Inc.*, 94 USPQ2d 1635 (E.D. La. 2010) (shaved ice flavor names found generic).

However, in this case the record is not consistent as to whether “fireball” refers to the “sweet/spicy cinnamon” flavor of Opposer’s FIREBALL whisky/liqueur. While there are many articles stating and other evidence that Opposer’s whisky/liqueur has the same flavor as ATOMIC FIREBALL candy, this evidence is “mixed” with contrary evidence. Indeed, while “fireball” typically signifies spiciness, it only sometimes refers

to cinnamon flavoring, especially when used in connection with alcoholic beverages, as discussed immediately below.

### **3. Recipes for “Fireball” Cocktails and Shots/Shooters Are Inconsistent**

Many of the “fireball” cocktail and shot/shooter recipes of record call for a whisky or whiskey-based product (often bourbon or Southern Comfort) or a cinnamon-flavored liqueur (or both) on the one hand, and Tabasco sauce on the other. 63 TTABVUE 235, 438, 441, 462, 471, 481, 492, 496, 498, 500, 517, 524, 528, 536, 538, 540, 550, 555, 557, 643, 667, 674, 680. But, even if we assume that all of these recipes create a whisky/liqueur beverage with a “sweet/spicy cinnamon” flavor,<sup>13</sup> we must balance them against the large number of “fireball” recipes that do not feature this type of flavor.

For example, neither the “Fireball Mead” recipe containing cinnamon oil nor “Chuck’s Fireball Mead” “with cinnamon and cinnamon candy added” are part of the whisky/liqueur genus, and they would have a mead flavor rather than the “sweet/spicy cinnamon” whisky or liqueur flavor for which Applicant contends that FIREBALL is generic. 63 TTABVUE 189, 692, 711-14 (Sheets Dec. ¶ 17 and Ex. 5). The rum, tequila and vodka-based recipes, and those made with other liquors, would presumably not have the whisky/liqueur flavor of Opposer’s FIREBALL cinnamon

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<sup>13</sup> It is not at all clear that recipes featuring only a whisky or Southern Comfort and Tabasco sauce would result in a beverage with a cinnamon flavor such as that found in Opposer’s FIREBALL cinnamon whisky. Thus, while “fireball” is recognized by some members of the relevant public as a flavor similar to the flavor of ATOMIC FIREBALL candy, it may very well be that precious few “fireball” cocktail/shot/shooter recipes come nearly as close to the ATOMIC FIREBALL flavor as does Opposer’s FIREBALL cinnamon whisky.

whisky, or of other “fireball” cocktails/shots/shooters that are whisky-, Southern Comfort- or liqueur-based. And most of the recipes that include brandy, Kahlua, ouzo or Sambuca do not include cinnamon or other ingredients that would be expected to create a cinnamon flavor.

In other words, while some alcoholic beverages (including Opposer’s FIREBALL cinnamon whisky) feature the “sweet/spicy cinnamon” flavor of ATOMIC FIREBALL candy, the term “fireball” does not always or even consistently refer to whisky or liqueur-based beverages having that flavor. Applicant’s expert witness Ms. Kimmerle admits as much. 60 TTABVue 606-11 (Kimmerle Tr. 124-28). In short, “fireball” alcoholic beverages do not all share the same flavors, as they are based on different liquors, liqueurs and even meads falling outside the genus, and different mixers as well. Some do not even include cinnamon or any other spicy ingredient.

#### **4. The Parties’ Expert Testimony and Reports**

Each party retained an expert witness. For the reasons set forth below, we do not find either expert’s testimony or report particularly probative.

##### **a. Opposer’s Expert Ms. Butler**

Ms. Butler is a Managing Director at NERA Economic Consulting where she is Chair of the Survey and Sampling Practice. *Id.* at 643 (Butler Report ¶ 1). She has experience with both trademark issues and “conducting and using surveys to measure consumer opinions.” *Id.* (Butler Report ¶¶ 2, 4). Opposer hired her “to evaluate the level of distinctiveness of the name FIREBALL and assess the name’s recognition by relevant consumers as an indicator of source for a single brand of alcohol.” *Id.* at 644 (Butler Report ¶¶ 6, 8).

Ms. Butler's report initially states that her evaluation was based on an online survey "of 301 consumers age 21 or older who purchase alcoholic beverages." The survey was intended "to determine whether FIREBALL is associated with one or more companies, and whether FIREBALL is viewed as a brand name associated with a single source or, rather, is seen as a common or descriptive name for a certain type of alcohol, i.e., cinnamon-flavored whiskey." *Id.* at 644-45 (Butler Report ¶¶ 8, 9). Survey respondents were divided into a Test Group that was asked questions about FIREBALL, and a Control Group that was asked questions about CINNAMON WHISKEY. *Id.* at 645 (Butler Report ¶ 9).

In the Test Group: 74.8% of respondents believed FIREBALL "is an alcoholic beverage made by one brand or company," with 59.3% of them identifying "FIREBALL" or "Sazerac" as that brand or company; 64.2% of the Test Group "indicated FIREBALL is a brand name;" and 61.6% believed "that FIREBALL is a product made by one company and is a brand name." *Id.* at 645-46 (Butler Report ¶ 9). In the Control Group, 37.3% "indicated that CINNAMON WHISKEY is a product made by one brand or company;" 16% "believed that CINNAMON WHISKEY is a brand name;" 12.7% "believed that CINNAMON WHISKEY is a product made by one company and is a brand name." *Id.* at 646 (Butler Report ¶ 9). Using "the rate in the Control Group to net out guessing or survey noise," Ms. Butler ultimately "estimated" that "a net total of 48.9 percent of consumers associate FIREBALL with products made by one company and think that FIREBALL is a brand name." *Id.*

There are a number of problems with this survey and its methodology. We focus on a few here.

First, the survey's universe of respondents is either too broad, or too narrow. It would be too broad because, as indicated above, Ms. Butler's report states initially that she surveyed "301 consumers age 21 or older who purchase alcoholic beverages." But the genus here is not "alcoholic beverages" generally; rather, it is "whisky" and "liqueurs" specifically. Thus, this universe would be overly broad.

It appears, however, that the initial statement in Ms. Butler's report about the chosen universe is inaccurate (calling the survey's credibility into question), and that the actual universe was too narrow. Specifically, later in her report, Ms. Butler indicates that "[t]he relevant population for this matter is comprised of individuals who, in the past six months, have purchased a shot of alcohol or report that in the next six months they are likely to purchase a shot of alcohol." *Id.* at 649, 651 (Butler Report ¶¶ 20, 28). This universe, like the initially (and apparently inaccurately) described universe, also ignores the genus, which is: (1) limited to "whisky" and "liqueurs" specifically rather than "alcohol" generally; and (2) unlimited as to serving size or method, rather than being limited to "shots" specifically. Because the survey's universe is limited to actual or prospective purchasers of "shots" when the genus is not, Ms. Butler focused on only a subset of relevant consumers.

Moreover, this subset of relevant consumers on which the survey actually focused is obviously more in tune with the types of alcohol sold, served, and consumed in "shots," such as Opposer's FIREBALL cinnamon whisky, one of, if not the, most

prominent alcoholic beverages typically sold in shots. This skews the survey's results, as consumers of shots (typically purchased in bars) would be more likely to be exposed to and familiar with alcoholic beverages sold in "shots" (typically in bars), and thus more likely to be familiar with Opposer's FIREBALL product than other consumers of "whisky" and "liqueurs" (the agreed-upon genus). Indeed, Opposer's marketing efforts are heavily bar- and bartender-focused. *Id.* at 40-41, 146-49, 159 (Henry Dec. I ¶¶ 45-47 and Exs. P and Q-1) (evidence of Opposer's marketing efforts involving bars, including its "Official Bartender Loyalty Program"). *See also id.* at 654 (Butler Report ¶ 38) ("I understand that **consumers who drink shots are typically under the age of 35 years old. Thus, the majority of my survey sample was comprised of respondents between 21 and 29 years of age (70.1 percent).**") (emphasis added). The problem here is that many consumers of "whisky" and "liqueurs" (the agreed-upon genus) are over 35, even if they do not imbibe as often, as much, or as late at night as the under 35 (much less 21-29) set, and even if they do not "do shots," a sales/consumption method absent from the agreed-upon genus.

Finally, Opposer's survey was not even intended to establish whether or not FIREBALL is generic. Opposer admits that instead the survey "tested brand strength and was not a *Teflon* survey." 107 TTABVUE 28 n.100. *Cf. Sheetz of Del., Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1359-66 (TTAB 2013) (analyzing genericness surveys and their attributes and probative value); *In re Country Music Ass'n, Inc.*, 100 USPQ2d 1824, 1831-33 (TTAB 2011) (same).

But there is no question that FIREBALL cinnamon whisky enjoys significant “brand strength.” Applicant concedes as much, testifying that FIREBALL is a strong brand because it “sold a lot.” 60 TTABVUE 501-02 (Kramer Tr. 127-28). Thus, Opposer’s survey does not have significant probative value, beyond being cumulative corroboration of the evidence that FIREBALL is commercially strong.<sup>14</sup>

**b. Applicant’s Expert Ms. Kimmerle**

Ms. Kimmerle holds “a confectionery science certificate from University of Wisconsin and a Sensory Science certificate from International Food Technologists.” 63 TTABVUE 37. She has “worked on innovation and sensory projects for both industrial and artisanal food clients for over two decades.” *Id.* She has “served as a candy expert and historian and ... served the confectionery industry as a writer and consultant.” *Id.*

However, Ms. Kimmerle was not retained to provide her expert opinion on candy or other types of food. Rather, Applicant hired her to provide her “opinions on whether or not the term ‘Fireball’ has become synonymous with the sweet, spicy cinnamon flavor of the candy Atomic Fireball Candy before it was used by [Opposer].” *Id.*

There is an obvious mismatch between Ms. Kimmerle’s confectionery and food-related qualifications and her opinions about the meaning of the term “fireball” to consumers. We therefore discount her opinions about the term “fireball,” legal aspects of this case and Applicant’s genericness counterclaim generally. *See e.g. Kohler Co. v.*

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<sup>14</sup> A generic term that enjoys de facto secondary meaning is still unregistrable. *See Frito-Lay N. Am., Inc. v. Princeton Vanguard LLC*, 124 USPQ2d 1184, 1203 (TTAB 2017) (citing *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 129 USPQ 411, 414 (CCPA 1961)).

*Honda Giken Kogyo K.K.*, 125 USPQ2d 1468 at \*13 (TTAB 2017) (holding testimony of engine expert about consumer perception inadmissible because that was not his area of expertise); *Alcatraz Media*, 107 USPQ2d at 1756-57 (travel writer and editor found to be qualified as an expert on travel writing and journalism, but unqualified to opine on consumer perception, “[n]or can Ms. Summers’ opinion serve as a substitute for the Board’s judgment on the legal claims before us”).<sup>15</sup>

The rest of Ms. Kimmerle’s testimony and report concerns ATOMIC FIREBALL candy, and the “fireball” flavor and its use in alcoholic beverages. For example, she opines that “Fireball denotes spicy, cinnamon and candy-like taste,” 63 TTABVUE 53, a fact established elsewhere in the record that Opposer does not seriously dispute. Thus, the testimony Ms. Kimmerle is qualified to provide is for the most part merely cumulative, and not particularly helpful.

#### **5. Balancing the Evidence and Reaching a Conclusion on Genericness**

When we consider the evidence from the time each registration was sought – 2001 for the ’432 Registration and 2008 for the ’110 Registration – Applicant’s counterclaim presents a close question. When we consider the evidence from the time of trial – late 2021 through mid 2022 – Opposer’s FIREBALL cinnamon whiskey had become so much more popular and well known by that time that whisky and liqueur consumers

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<sup>15</sup> During her deposition, Ms. Kimmerle was asked whether she would “categorize yourself as an expert in customer perception?” She responded “I’m asked to give my opinion on the popularity of confectionary products and names pretty often. I do not have – I did not do a specific consumer poll about this. So that’s not – that wasn’t something that I performed.” 60 TTABVUE 568-69 (Kimmerle Tr. 63-64).

did not **primarily** use or understand FIREBALL to refer to a subpart or “key aspect” of the genus, but instead to Opposer’s FIREBALL cinnamon whisky.

**a. The Time of Registration**

In 2001-2004 and 2008, relatively little time had passed since Opposer argued in federal court that FIREBALL was generic. Moreover, recipes for “fireball” cocktails/shots/shooters including whisky or cinnamon liqueur and Tabasco sauce were fairly prevalent. And there is no evidence that at that time Opposer tried to enforce any rights it had in FIREBALL against third parties; to the contrary, Opposer took the position that “fireball” was available for all to use for whisky and liqueurs. Thus, there was significant evidence of genericness at the time of registration.

However, at the time of registration, much of the evidence pointed in the opposite direction. Indeed, many of the recipes of record that were in existence at the time of registration directly contradict Applicant’s theories that FIREBALL: (1) “was the name of a subcategory of alcoholic drinks containing whiskey and liqueurs that sought to replicate the taste of Fireball candy;” and (2) refers “to a ‘key aspect’ of the goods at issue – namely the flavor.” 101 TTABVUE 17. In fact, many of the recipes do not contain whiskey, or liqueur, and would not replicate the ATOMIC FIREBALL (or FIREBALL cinnamon whisky) flavor. 63 TTABVUE 189, 443, 478, 511, 563, 692, 711-14; 67 TTABVUE 299-304; 100 TTABVUE 47.

Furthermore, the vast majority of the recipes Applicant relies upon were published in bartending or alcoholic beverage publications, or specialized websites. There is no evidence that a large number of relevant consumers were exposed to these recipes, and we would expect that relatively few relevant consumers encountered

these recipes directly (though it is unclear how many drank cocktails/shots/shooters that followed these recipes).

By contrast, the record makes clear that at the time of registration, ATOMIC FIREBALL was the trademark for a popular candy that publications assumed consumers would remember from their childhoods, and DR. MCGILLCUDDY'S FIREBALL was an at least modestly successful whisky/liqueur beverage. Thus, we can safely assume that even at the time of registration, FIREBALL was known by many relevant consumers as a trademark, whether for candy or whisky/liqueurs, rather than as a nondistinctive term for a specific flavor. In fact, the record shows more relevant consumer exposure at the time of registration to trademark use of FIREBALL than to non-trademark use of the term.

In this case, as in other cases in which the record is “mixed” or “ambiguous,” we find that Applicant has not introduced sufficient evidence of genericness at the time of registration. *See e.g. Alcatraz Media*, 107 USPQ2d at 1763. In fact, here, as in *Alcatraz Media* and *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987), much of the evidence of record shows trademark, rather than generic use of FIREBALL. *See also In re Country Music Ass'n*, 100 USPQ2d at 1829-32 (evidence, some of which was “obscure” and some of which showed potential trademark use, insufficient to show “that the relevant purchasers perceive the phrase as naming the genus of the services at issue”). There is no evidence that any of Applicant’s competitors in the whisky or liqueur fields used the

term FIREBALL at the time of registration.<sup>16</sup> *See In re Trek 2000 Int'l Ltd.*, 97 USPQ2d 1106, 1113-14 (TTAB 2010) (“where the record demonstrates both trademark and generic uses, evidence of the lack of competitor use, at a minimum, may create doubt sufficient to tip the balance in favor of registration”). We therefore find that FIREBALL was not generic at the time of registration

**b. The Time of Trial**

The evidence is even more “mixed” and “ambiguous” when we consider whether FIREBALL was generic at the time of trial. By that time, Opposer’s FIREBALL cinnamon whisky had become significantly more popular than it was at the time of registration, as reflected by sales and advertising figures and media attention. Furthermore, in the past 10-15 years, Opposer has consistently treated and used FIREBALL as a trademark, and it successfully enforced its asserted rights in FIREBALL against many of the third-party users of the term cited by Applicant in support of its counterclaims. Thus, the record does not support a finding that FIREBALL was generic for whisky or liqueurs at the time of trial.

**c. Conclusion on Genericness**

Applicant has not met its burden of proving by a preponderance of the evidence that FIREBALL was generic for whisky or liqueurs, either at the time of registration or the time of trial. Accordingly, its genericness counterclaims are denied.

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<sup>16</sup> While Marie Brizard had been using FIREBALL for liqueurs around the time of registration, Opposer acquired Marie Brizard’s FIREBALL mark in 2002 following litigation, and has used it since for whisky/liqueurs. 59 TTABVUE 32 (Henry Dec. I ¶ 19); 62 TTABVUE 187-90.

## B. Fraud Counterclaims

“Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application **with intent to deceive the USPTO.**” *Nationstar Mortgage LLC v. Ahmad*, 112 USPQ2d 1361, 1365 (TTAB 2014) (citing *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)) (emphasis added). Here, Applicant has not presented any evidence, direct, indirect or circumstantial, let alone the requisite “clear and convincing” evidence, *In re Bose*, 91 USPQ2d at 1939, that Opposer made false statements with the intent to deceive the USPTO, or that Opposer acted with reckless disregard as to the truth of its statements.

Indeed, Applicant’s theory of fraud is that “Opposer knew ‘Fireball’ was generic for whiskeys and liqueurs.” 101 TTABVUE 32. As explained above, however, the record does not support Applicant’s contention that FIREBALL is generic. Applicant’s fraud counterclaims fail for this reason alone.

Even if Applicant had established that FIREBALL is generic, it has presented no evidence that Opposer had the specific intent to deceive the USPTO, or to support its argument, 101 TTABVUE 31, that Opposer acted with reckless disregard as to the truth of its representations or omissions, while it was pursuing, or after it was issued, the ’110 or ’432 Registrations. *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001 at \*26 (TTAB 2021) (finding of reckless disregard “is the legal equivalent” of finding that defendant “had the specific intent to deceive the USPTO”); *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1090 (TTAB

2010) (“It is clear that under the holding of *Bose* that intent must be separately proved ....”).

In fact, despite Opposer’s second affirmative defense in the Marie Brizard litigation, the fact is that Opposer shortly thereafter acquired Marie Brizard’s rights in the FIREBALL mark, including the ’432 Registration, renewed that Registration and continued using the FIREBALL mark in the United States for the ensuing 20 years. Applicant’s fraud counterclaims are also denied.

## **V. Opposer’s Likelihood of Confusion Claim**

Having disposed of Applicant’s counterclaims, we now consider Opposer’s likelihood of confusion claim. Opposer’s claim is based in large part on its pleaded registrations, which have survived Applicant’s challenge.

### **A. Priority**

Because Opposer’s pleaded registrations are of record, 60 TTABVUE 34, 96-102 (Henry Dec. I ¶ 24 and Ex. H), and Applicant’s counterclaims to cancel them were unsuccessful, priority is not at issue with respect to the goods identified therein. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

### **B. Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key

considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

**1. The Goods, and Their Channels of Trade and Classes of Consumers**

The parties’ goods are legally identical because the involved application identifies “alcoholic beverages except beers,” which is broad enough to encompass Opposer’s “whisky” and “liqueurs.” *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

Moreover, because the goods are legally identical, we presume that the channels of trade and classes of purchasers for these goods also overlap. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *Am.*

*Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).<sup>17</sup>

The legal identity of the goods and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed Cir. 2010); *In re Max Capital*, 93 USPQ2d at 1248.

## **2. How Strong Is Opposer’s FIREBALL Mark?**

Before addressing the marks themselves, we consider the strength of Opposer’s mark, to ascertain the scope of protection to which it is entitled. There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength ...”).

### **a. Commercial Strength**

Turning first to commercial strength, we must determine where to place FIREBALL on the “spectrum” of marks, which ranges from “very strong to very weak.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). *See also, Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734-

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<sup>17</sup> In any event, there is ample “real world” evidence that the channels of trade and classes of consumers overlap. *See e.g.* 60 TTABVUE 541, 552 (Kramer Tr. 206, 292, ); *id.* at 665-667, 670, 683, 687-88, (Applicant’s responses to RFA Nos. 8, 9, 19, 59, 60 and Interrogatory Nos. 3, 4); 67 TTABVUE 264-67 (Sheets Tr. 37-40).

35 (Fed. Cir. 2017). The stronger the mark, the greater the scope of protection to which it is entitled. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017) (“A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis.”); *Nike, Inc. v. WNBA Enters., LLC*, 85 USPQ2d 1187, 1198 (TTAB 2007). Moreover, when fame exists, it plays a dominant role in the likelihood of confusion analysis. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame or strength “of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose*, 63 USPQ2d at 1305. Other relevant factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

Here, Applicant concedes, 60 TTABVUE 501-02 (Kramer Tr. 127-28), and we agree, that Opposer’s mark is commercially strong. In fact, while Opposer’s cinnamon whisky enjoyed only modest success in the United States when it was sold as DR. MCGILLICUDDY’S FIREBALL, not long after Opposer rebranded the product “to just FIREBALL,” 60 TTABVUE 32, it took off, becoming quite popular among at least shot/shooter drinkers. 60 TTABVUE 37-38 and 59 TTABVUE 52, 188-189 (Henry

Dec. I ¶¶ 38, 71 and Ex. O). This rapid success generated significant media attention at the time. 60 TTABVUE 38-39, 150-254 (Henry Dec. I ¶¶ 39-40 and Exs. Q-1 and Q-2); 67 TTABVUE 30-31, 63-152 (Henry Dec. II ¶¶ 12-14 and Exs. AL-1, AL-2 and AM). Opposer's aggressive and extensive marketing efforts appear to have contributed to this success and recognition. 59 TTABVUE 45-46 (Henry Dec. I ¶ 61). Opposer's survey tends to support this evidence of commercial strength to some extent.

Nevertheless, we cannot find on this record that FIREBALL has achieved "fame," the highest level of strength, because "[w]e have no context for opposer's advertising and sales figures," or its other evidence of strength, "such as how the figures for [products bearing Opposer's pleaded marks] compare with that for other brands of" whisky and liqueurs. *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1831 (TTAB 2012); *see also Bose*, 63 USPQ2d at 1309 ("some context in which to place raw statistics is reasonable"). We acknowledge that Opposer provided "rankings" for certain alcoholic beverages, including its FIREBALL cinnamon whisky. 59 TTABVUE 188-89. But there is no testimony from the provider of these rankings, or any way for us to determine exactly what was ranked or how, or what the provided figures and statistics represent. Furthermore, while FIREBALL's "almost 1 million followers" on Facebook, 60 TTABVUE 43 (Henry Dec. I ¶ 54), is evidence of commercial strength, that number falls short of establishing fame given the lack of "context" and comparison to other whisky and liqueur brands; brands found famous in Board proceedings often have several million followers on Facebook

and other social media (or more, sometimes many more). Finally, much of the evidence of FIREBALL's commercial strength is attributable to FIREBALL cinnamon whisky's popularity among shot drinkers specifically. The evidence shows that FIREBALL is less strong for "whisky" or "liqueurs" defined broadly (the identified goods) than it is for shots/shooters specifically (a mere subset of the identified goods).

In any event, because we have found that Opposer's FIREBALL mark is commercially strong, it is entitled to a concomitantly broad scope of protection, all else being equal. *See Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35. In other words, the mark's commercial strength standing alone weighs in favor of finding a likelihood of confusion, though we must also consider the mark's conceptual strength.

**b. Conceptual Strength**

Because we have denied Applicant's counterclaims and Opposer's mark remains registered, we must presume that FIREBALL is inherently distinctive, i.e. that it is at worst suggestive of Opposer's goods. 15 U.S.C. § 1057(b) (registration is "prima facie evidence of the validity of the registered mark"); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, "we must assume that it is at least suggestive"). While Opposer's mark is valid and inherently distinctive, the record reveals that it is not just suggestive, but highly suggestive.

In fact, Opposer twice admitted, once to the USPTO and once in federal court, that FIREBALL is **not** inherently distinctive, at all. While this was more than 20 years ago, the evidence of record postdating Opposer's admissions reveals FIREBALL to be minimally distinctive for any particular whisky and liqueur.

In fact, “fireball” is the name, or part of the name, of a number of cocktails, shots and shooters, most of which include whisky or liqueur(s) as ingredients. But “fireball” names the cocktail/shot/shooter, not a brand of whisky or liqueur. In other words, “fireball,” like “martini” and “margarita,” often directly suggests certain alcoholic mixed drinks, rather than the source of particular liquors or liqueurs with which the drinks are made. For example, in the movie “The Guest,” when asked if he knew what a “fireball” is, a waiter responded “cinnamon schnapps and Tabasco sauce.” 96 TTABVUE.

The term “fireball” has also been widely used by third parties to denote the flavor of ATOMIC FIREBALL candy in products such as popcorn, ice cream and beef jerky, as well as in liquid flavorings meant to be added to food or beverages. 63 TTABVUE 199, 207, 211, 339, 348, 354, 363, 366, 369, 372, 376, 379, 392, 395, 691-93, 696-700, 702-09, 722-27. Opposer admits that its FIREBALL cinnamon whisky and ATOMIC FIREBALL candy have “the same flavoring,” 67 TTABVUE 293 (Henry Tr. 165), and a number of media reports reveal that much of the relevant public perceives “fireball” as describing the flavor of ATOMIC FIREBALL candy, and thus Opposer’s cinnamon whisky as well.

Thus, “fireball” is highly suggestive of the taste and flavor of Opposer’s “sweet/spicy cinnamon”-flavored whisky/liqueur. This taste/flavor has long been known to many consumers who have tried ATOMIC FIREBALL candy, since before Opposer started selling DR. MCGILLICUDDY’S FIREBALL, and it is a desired cocktail/shot/shooter flavor as evidenced by the number of recipes that attempt to

mimic it. We find therefore that Opposer's pleaded FIREBALL mark's conceptual weakness essentially "cancels out" the mark's commercial strength, and that ultimately the mark is entitled to no more than a normal scope of protection.

### 3. Similarity of the Marks

We compare the marks "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay*, 73 USPQ2d at 1691. When we do so we find that they are dissimilar overall.

The marks are partially similar, however, in that the term FIREBULL in Applicant's mark looks and sounds somewhat similar to Opposer's mark FIREBALL. These similarities are easily outweighed by the differences between the marks considered in their entirety, however.

In fact, the coined term BULLSHINE comes first in Applicant's mark, and therefore consumers are more likely to focus on it than the trailing term FIREBULL. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) ("The identity of the marks' initial two words is particularly significant because consumers typically notice those words first."); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").<sup>18</sup>

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<sup>18</sup> We do not find that either term in Applicant's mark is dominant. Rather, as explained below, and as Opposer argues, Applicant's mark is likely to be perceived as a combination of the house mark or trade name BULLSHINE with the product mark FIREBULL. There is no evidence that either term is anything but arbitrary for alcoholic beverages.

Obviously, BULLSHINE FIREBULL and FIREBALL look and sound different.<sup>19</sup> Furthermore, we must balance the marks' merely partial similarity in appearance and sound against the marks' completely distinct meanings.

Opposer's mark has two meanings. First, as the dictionary evidence reveals, and Ms. Henry testified, Opposer's mark FIREBALL "means, literally, a ball of fire." 60 TTABVUE 33, 83-95 (Henry Dec. I ¶ 22 and Ex. G). The record reveals that "fireball" also has a second meaning, conveying that Opposer's whisky/liqueur has a sweet/spicy cinnamon flavor that Ms. Henry testified is the "same" flavor as ATOMIC FIREBALL candy. 67 TTABVUE 293 (Henry Tr. 165). In fact, Opposer posted on Facebook that it had a "heavy heart" when the inventor of ATOMIC FIREBALL candy passed away, stating that its FIREBALL cinnamon whisky is "based on" the candy. 63 TTABVUE 214, 216, 223, 225. By contrast, Applicant's mark "calls forth images of bovine animals." 101 TTABVUE 34; 60 TTABVUE 463 (Sheets Tr. 62) ("we want to put our product brand around this bull type of theme"); 63 TTABVUE 401 (Kramer Tr. 64). And because Applicant's mark begins and ends with the term "bull" (BULLSHINE FIREBULL), the "bull type of theme" conveyed by Applicant's mark is accentuated, but entirely absent from Opposer's mark.

Moreover, as Opposer argues, the first term in Applicant's mark – BULLSHINE – will likely be perceived as "a trade name or house mark." 83 TTABVUE 26-27. Oftentimes, as Opposer also points out, the addition of a house mark to a registered

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<sup>19</sup> While the term FIREBULL in isolation looks and sounds somewhat similar to FIREBALL, Applicant has not applied for registration of FIREBULL by itself.

mark is found insufficient to avoid confusion, and is sometimes even found to be an “aggravation, and not a justification....” *Menendez v. Holt*, 128 U.S. 514, 521 (1888). *See also In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) (affirming refusal to register CLUB PALMS MVP based on prior registration of MVP, finding consumers “likely to believe that the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services”).

There are other times, however, where adding a house mark to a registered mark is sufficient to avoid confusion. These cases typically involve “highly suggestive” shared terms. For example, in *Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313 (TTAB 2005), we found no likelihood of confusion between NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS, both for women’s clothing, because evidence established that the shared, registered term ESSENTIALS is “highly suggestive.” *See also* TMEP §1207.01(b)(iii) (July 2021) (“Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if ... the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.”).

Here, we find that the primary difference between the parties’ marks – the term BULLSHINE at the beginning of Applicant’s mark – is sufficient to avoid consumer confusion, for two main reasons. First, this case is unlike the typical situation where two marks share an identical term and one of the two marks is prefaced by a house mark. Rather, in this case there is no shared term, because FIREBALL and FIREBULL are merely similar, rather than identical, in sight and sound. Moreover,

they convey entirely distinct meanings and commercial impressions in the context of alcoholic beverages. That distinguishes this case from the house mark cases upon which Opposer relies. 83 TTABVUE 26-27.

Second, the evidence of record shows that Opposer's mark FIREBALL is analogous to ESSENTIALS, the mark in *Knight Textile*, because it is "highly suggestive" of alcoholic beverages containing whisky or liqueur on the one hand and having a spicy taste on the other. In fact, most of the "fireball" cocktail/shot/shooter recipes introduced into evidence include Tabasco sauce as an ingredient. Many of them also have a cinnamon flavor, and some mimic the flavor of ATOMIC FIREBALL candy. Many media reports equate FIREBALL cinnamon whisky's flavor to the ATOMIC FIREBALL flavor. 60 TTABVUE 159, 165, 171, 174, 175, 178; 63 TTABVUE 241, 244, 248, 252, 256, 260, 264, 267, 272, 280, 292, 298; 67 TTABVUE 155. Wikipedia does the same. 60 TTABVUE 227. For a time, Opposer took the position that "fireball" is not at all distinctive for whisky or liqueurs.

Thus, to the extent the term FIREBULL in Applicant's mark may call to mind Opposer's mark FIREBALL, the term FIREBALL is not distinctive enough for there to be a likelihood of confusion between the marks when Applicant's mark includes and begins with the distinctive term BULLSHINE. *See also Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958) (finding no likelihood of confusion between SURE-FIT and RITE-FIT, both for slip covers, because the term "fit" is "eminently suitable for use in connection with goods such as ready-made slip covers ... [u]nder these circumstances, we do not feel that appellant

is entitled to the broad protection which it seeks”); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476-78 (TTAB 2014) (finding “that the mark PERKSPOT is sufficiently different from the marks PERKS and PERKSCARD to avoid a likelihood of confusion” even though the marks were used for legally identical services); *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ 773, 779-80 (TTAB 1979) (allowing registration of NATURE’S PLUS for vitamins despite prior registration of PLUS for vitamins).

It is also significant here that Applicant’s mark is comprised of two terms that each include “bull.” Indeed, because the terms in Applicant’s mark each contain “bull,” the terms mutually reinforce each other, drawing further attention to the repeated term “bull” in Applicant’s mark and highlighting the distinctions between the term FIREBULL in Applicant’s mark and the term FIREBALL in Opposer’s mark.

In short, given the conceptual weakness of FIREBALL, and the differences between BULLSHINE FIREBULL and FIREBALL in appearance and sound, and especially in meaning and commercial impression, the marks are dissimilar when considered in their entireties. This is so even though the marks are used for identical goods, and despite the commercial strength of FIREBALL. As the Federal Circuit’s predecessor court stated in *Sure-Fit*:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The

essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

*Sure-Fit Prods.*, 117 USPQ at 297. This factor weighs heavily against a finding of likelihood of confusion.

#### **4. Purchaser Care and Sophistication**

We accept Opposer's argument that the goods are inexpensive and purchased without great care. 83 TTABVUE 30-31. The parties' alcoholic beverages may be sold in shots, which are not only small serving sizes and thus inexpensive, 60 TTABVUE 52 (Henry Dec. I ¶ 73), but the more shots a consumer can afford, the less care he or she may exercise as an evening progresses. Moreover, Applicant sells its BULLSHINE FIREBULL products in "airplane bottles," which are "probably" offered at the front counter of stores as "an impulse thing." 60 TTABVUE 549-50 (Kramer Tr. 284-85). This factor weighs in favor of finding a likelihood of confusion.

#### **5. Alleged Bad Faith**

Finally, we consider Applicant's intent in choosing its mark, and whether it reflects a bad faith attempt to trade on Opposer's goodwill. *See Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 835 F.2d 888, 7 USPQ2d 1628, 1630 (Fed. Cir. 1988) ("proof of intent to trade on another's goodwill" can provide "persuasive evidence of likelihood of confusion").

Here, we disagree with Opposer's argument that Applicant acted in bad faith. 83 TTABVUE 30-31. While Applicant was aware of Opposer's mark before choosing its own, that does not establish bad faith or an intent to deceive. *Action Temporary Services, Inc. v. Labor Force, Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1310 (Fed. Cir.

1989) (“*mere knowledge of the existence of the prior user* should not, by itself, constitute bad faith”). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another’s mark or even an intent to copy. *See Quicktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at \*4 (Fed. Cir. 2021) (internal citations omitted). This factor is neutral.<sup>20</sup>

## VI. Conclusion

Applicant’s counterclaims are denied because it has failed to prove that Opposer’s FIREBALL mark is generic, or that Opposer committed fraud in connection with any of its pleaded registrations.

As for Opposer’s likelihood of confusion claim, even though the goods are identical and subject to impulse purchase, and travel in overlapping channels of trade to the same consumers, and Opposer’s FIREBALL mark is commercially strong, confusion is unlikely. Because Opposer’s FIREBALL mark is so conceptually weak, the marks FIREBALL and BULLSHINE FIREBULL are too different in appearance and sound, and especially meaning and commercial impression, for confusion to occur. *See Kellogg Co. v. Pack’em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.”).

**Decision:** Applicant’s counterclaims are denied and the opposition is dismissed.

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<sup>20</sup> Opposer argues that additional evidence concerning Applicant’s future plans, designated as “Confidential,” further supports a finding of bad faith. 82 TTABVUE 31. We disagree. Applicant’s future contingent plans, while aggressive, would only be pursued if permitted under the Trademark Act.