

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 26, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sutter Home Winery, Inc.

v.

Roar Spirits, LLC

Opposition No. 91281737

J. Scott Gerien and Joy L. Durand of Dickenson, Peatman & Fogarty,
for Sutter Home Winery, Inc.

Paulo A. de Almeida, Robert Rivas, and Benjamin Mandel of Wolf, Rifkin, Shapiro,
Schulman & Rabkin, LLP, for Roar Spirits, LLC.

Before Goodman, Thurmon and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Roar Spirits, LLC, applied to register the standard-character mark
BREAK OUT THE BANDIDO on the Principal Register for various goods including
“distilled blue agave liquor” in International Class 33.¹

¹ Application Serial No. 90680986 (“the Application”) was filed on April 29, 2021 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. The Application also identifies goods in four other classes that are not at issue in this proceeding.

Opposer, Sutter Home Winery, Inc., opposes registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).² In its notice of opposition, Opposer pleads prior common law rights in the mark BANDIT for wine, and ownership of a standard-character registration for that mark for use in connection with "alcoholic beverages except beers" in International Class 33.³

Applicant admits in its answer that "Opposer is the owner of U.S. Trademark Registration No. 3,974,340 issued on June 7, 2011 for the mark BANDIT for alcoholic beverages except beer[s] in International Class 33," but denies the remaining salient allegations in the notice of opposition.⁴

The case is briefed and ready for decision.⁵ For the reasons discussed below, we **dismiss** the opposition.

² The original opposer was Rebel Wine Co., LLC ("Rebel Wine"). However, during trial, Rebel Wine's BANDIT mark was assigned to Sutter Home Winery, Inc. The Board subsequently granted Rebel Wine's motion to substitute Sutter Home Winery as the opposer in this proceeding. *See* 40 TTABVUE.

Citations in this opinion to the briefs and other materials in the case file refer to TTABVUE, the Board's online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

³ Registration No. 3974340 ("Opposer's Registration"), issued June 7, 2011; renewed.

⁴ 5 TTABVUE 3-6. Applicant also asserted various affirmative defenses in its Answer but did not pursue them further, so they are waived. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014) ("As applicant did not pursue the affirmative defenses of failure to state a claim and unclean hands, either in its brief or by motion, those defenses are waived."). *See also TPI Holdings, Inc. v. TrailerTrader.com LLC*, 126 USPQ2d 1409, 1413 n.28 (TTAB 2018); ("Respondent also asserted 'estoppel, acquiescence and waiver,' but does not argue any of these in its brief. They are therefore waived.").

⁵ We note that between Opposer's main brief and its reply brief, Opposer cites to nonprecedential Board decisions approximately two dozen times without identifying them as such, in violation of the Board's requirement that "[a]ny nonprecedential cases must be clearly identified as nonprecedential." TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03(a)(2) (June 2024).

I. Preliminary Issue

Twenty-one days after Opposer filed its reply brief in this proceeding, Applicant filed a document titled “Applicant’s Motion to Strike Evidentiary Objections Raised for the First Time and Improper Opinion Testimony,” wherein Applicant moves to strike purported (1) “untimely evidentiary objections raised for the first time on reply” and (2) “improper opinion testimony from Opposer’s counsel, who is not an expert witness.”⁶ Applicant summarizes its argument as follows:

First, pages 1-8 of the brief are essentially relevance objections to Applicant’s third-party use evidence, which weakens Opposer’s BANDIT mark. Likewise, pages 12-21 are a critique of the survey of Applicant’s expert witness, Dr. AnnaBelle Sartore, in which she found no likelihood of confusion between Applicant’s mark BREAK OUT THE BANDIDO for tequila⁷ and Opposer’s mark BANDIT for boxed wines. 32 TTABVUE. Opposer argues the survey is “not probative” and therefore irrelevant. This is essentially an attempt to file untimely evidentiary objections for the first time on reply. An objection that is first raised in a reply brief is untimely and will not be considered because it effectively forecloses the adverse party from responding to the objection. TBMP § 707.01, 801.02(c). Had Opposer objected earlier in the proceeding,

⁶ 46 TTABVUE 2.

⁷ Opposer and Applicant both refer to Applicant’s “distilled blue agave liquor” as “tequila.” See e.g., 41 TTABVUE 19-20; 43 TTABVUE 9. We take judicial notice of the fact that “tequila” is “a Mexican liquor made chiefly from the fermented sap of the blue agave that has been subjected to two separate distillations.” <http://www.merriam-webster.com/dictionary/tequila> (accessed June 24, 2025). *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (The Board may take judicial notice of dictionary definitions). The term has also previously been registered as a certification mark. See e.g., *Consejo Regulador del Tequila, A.C. v. Michalopoulos*, 2020 TTAB LEXIS 296, at *2-4 (TTAB 2020) (nonprecedential). We also take judicial notice of the Alcohol and Tobacco Tax and Trade Bureau’s statement that since February 1, 1974, the official United States standard of identity for Tequila has recognized Tequila as a distinctive product of Mexico.” <https://www.ttb.gov/public-information/industry-circulars/archives/2006/06-03> (accessed June 25, 2025). See *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (taking judicial notice of U.S. government online publications). There being no issue here as to whether Applicant’s distilled blue agave liquor is in fact made in Mexico or whether Applicant is entitled to use the term, we will also use both terms in response to the parties’ arguments.

Applicant could have cured any perceived deficiencies in the evidence. As such, the objections are untimely and should not be considered.

Second, pages 12-21 consist of counsel's opinions on perceived methodological "flaws" in the Sartore survey. Counsel is essentially testifying about matters upon which he has no expert qualifications. These opinions - asserted under the guise of attorney argument - are improper and should not be allowed, especially when raised for the first time on reply. Thus, the improper portions of the reply brief (pages 1-8 and 12-21) should be stricken and given no consideration at final hearing.⁸

Upon review of the motion, we agree with Opposer that Applicant's motion, while couched as a motion to strike, is nothing more than an attempt to respond to the arguments presented in Opposer in its reply brief, which amounts to an impermissible sur-reply brief.⁹ *See Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1701 (TTAB 2008) ("Parties may not couch a surreply as a new motion in order to avoid the prohibition on surreplies."); *Fortunoff Silver Sales, Inc.*, 225 USPQ 863, 863 n.3 (TTAB 2008) ("There is no provision in our rules for the filing of a rejoinder. Consequently, the period for briefing of arguments terminated with the filing of opposer's reply brief."). *See also* TBMP § 539 (June 2024) ("The Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof."). We give it no consideration.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the Application. In addition:

⁸ *Id.* at 2-3 (emphasis omitted).

⁹ 48 TTABVUE 2-3.

Opposer, during its testimony period, submitted a notice of reliance on (1) printouts from the USPTO's Trademark Status & Document Retrieval (TSDR) database showing the current status and title of its pleaded registration;¹⁰ (2) Internet evidence consisting of third-party websites that offer both parties' goods under the same mark, and other websites that Opposer contends show the relatedness of distilled blue agave liquor and wine;¹¹ and (3) TSDR database printouts of several third-party registrations and applications for marks that identify distilled blue agave liquor as well as other alcoholic beverages.¹² Opposer also submitted the testimony declaration of its President and Chief Executive Officer, Robert Torkelson, with exhibits,¹³ and the testimony declaration of one of Opposer's attorneys, Joy Durand, with exhibits.¹⁴

Applicant, during its testimony period, submitted a notice of reliance on TSDR printouts of printouts of third-party registrations for marks Applicant purports are similar to Opposer's BANDIT mark;¹⁵ Internet printouts showing third-party use of marks Applicant purports are similar to Opposer's BANDIT mark and used in connection with both parties' goods;¹⁶ and a transcript of the discovery deposition of

¹⁰ 19 TTABVUE 13-24 (Exhibit A).

¹¹ *Id.* at 25-68 (Exhibits B-N), 83-140, (Exhibits P-EE), 151-162 (Exhibits GG-JJ).

¹² *Id.* at 69-82 (Exhibits O), 140-50 (Exhibits EE-FF).

¹³ 21 TTABVUE (public); 22 TTABVUE (confidential) ("Torkelson Test. Decl.").

¹⁴ 20 TTABVUE.

¹⁵ 30 TTABVUE 12-26 (Exhibits 1-2).

¹⁶ *Id.* at 27-150 (Exhibits 3-29).

Robert Torkelson.¹⁷ Applicant also submitted the testimony declaration of its Chief Financial Officer, Eric Lanz, with exhibits,¹⁸ and the testimony declaration of its expert, Dr. Annabelle Sartore, with an exhibit consisting of the results of a likelihood of confusion survey she conducted on behalf of Applicant.¹⁹

Opposer, during its rebuttal testimony period, submitted a notice of reliance on the discovery transcript of Dr. Sartore, with exhibits;²⁰ an English translation of Spanish wording from the Collins Dictionary;²¹ a copy of a third-party application for a Certificate/Exemption of Label/Bottle Approval;²² and Internet printouts from several third-party websites.²³ Opposer also submitted the rebuttal testimony declaration of Ms. Durand, with exhibits,²⁴ and the rebuttal testimony declaration of Mr. Torkelson, with exhibits.²⁵

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter

¹⁷ *Id.* at 151-202 (“Torkelson Disc. Dep.”) (Exhibit 30).

¹⁸ 31 TTABVUE (“Lanz Test. Decl.”).

¹⁹ 32 TTABVUE (“Sartore Test. Decl.” and Survey Results).

²⁰ 36 TTABVUE 6-153 (“Sartore Disc. Dep.”) (Exhibit A). Pursuant to Trademark Rule 2.120(k), 37 C.F.R. § 2.120(k), and TBMP § 704.09, and in lieu of the oral cross-examination by deposition of Dr. Sartore during Opposer’s rebuttal testimony period, the Board approved the parties’ stipulation that the entire transcript of Dr. Sartore’s discovery deposition could be introduced by Opposer during its rebuttal period and would be treated as trial testimony that could be relied on by both parties. *See* 33-34 TTABVUE.

²¹ *Id.* at 154-55 (Exhibit B).

²² *Id.* at 156-59 (Exhibit C).

²³ *Id.* at 160-76 (Exhibits D-G).

²⁴ 37 TTABVUE (“Durand Rebuttal Test. Decl.”).

²⁵ 39 TTABVUE (public) (“Torkelson Rebuttal Test. Decl.”).

partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark when such opposition is within the zone of interests protected by the statute, Trademark Act Section 13, 15 U.S.C. § 1063, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark*, 572 U.S. at 129, 132); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020).

Opposer’s entitlement to oppose registration of Applicant’s mark on the ground of likelihood of confusion is established by its pleaded registration, which is of record and supports a colorable claim for likelihood of confusion. *See, e.g., Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (reasonable belief in damage may be established by “assert[ing] a likelihood of confusion which is not wholly without merit”); *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *13-14 (TTAB 2022) (valid and subsisting pleaded registration establishes opposer’s direct commercial interest in the proceeding and its belief in damage) (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)).

IV. Priority and Likelihood of Confusion

Section 2(d) of the Trademark Act provides that a mark must be refused

registration if it:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive

15 U.S.C. § 1052(d), *quoted in In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023) (emphasis added). Establishing priority is thus a necessary element of any claim under Section 2(d).

A. Priority

“Because Opposer relies on its asserted [BANDIT] registration that ha[s] been made of record, and Applicant has not challenged the[] registration[] by way of any cancellation counterclaim(s), Opposer’s priority ... is not at issue with respect to the goods identified” therein, *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at * (TTAB 2021) (citing *King Candy Co. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).²⁶

B. Likelihood of confusion

To determine whether there is a likelihood of confusion between marks under Section 2(d), we analyze the evidence and arguments under the factors set forth in *In re E. I. duPont deNemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (the “*DuPont* factors”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S.

²⁶ Opposer need not rely its alleged prior common law use to establish priority. *See Nkanginieme v. Appleton*, 2023 USPQ2d 277, at *4 (TTAB 2023) (Board did not need to consider common law priority because it found it sufficient to rely on the pleaded registration in analyzing likelihood of confusion).

138, 113 USPQ2d 2045, 2049 (2015). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018).

“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (internal punctuation omitted). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at *14 (Fed. Cir. 2023) (“It is well established that, in opposition proceedings, the burden of proof rests on the opposer.”).

1. Similarity or Dissimilarity of the Goods, Trade Channels and Classes of Consumers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration ...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567.

Applicant’s “distilled blue agave liquor,” referred to by both parties as “tequila,” is encompassed by the more broadly identified “alcoholic beverages except beers” in Opposer’s Registration. The goods are thus legally identical in part. *See, e.g., Conopco, Inc. v. Transom Symphony OpCo, LLC*, 2022 USPQ2d 504, at *7 (TTAB 2022)

(quoting *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.’”).

In addition, under the third *DuPont* factor, because the goods in the Application and Opposer’s Registration are legally identical in part and there are no limitations on trade channels or consumers, we must presume that the trade channels and classes of consumers for those legally in part goods also overlap. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *In re Viterro, 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).

Applicant notes that “Opposer relies on the breadth of the goods identification in its registration and the presumption that the goods are sold to the same kinds of consumers in the same channels of trade,” but maintains “there are real life, appreciable differences between tequila and boxed wine that should be considered, including their relative alcohol content, manner of production, taste, appearance, and packaging – all of which are still relevant to show that confusion is unlikely.”²⁷ Applicant also contends, without evidence, that “[t]equila] and boxed wine are also sold in different types of stores and to different kinds of consumers.”²⁸

We cannot ignore the applicable legal presumptions as Applicant invites to do. As

²⁷ *Id.* at 26-27.

²⁸ *Id.* at 27.

Opposer correctly points out:

It is well-settled that a comparison of goods in a likelihood of confusion analysis must be determined on the basis of the goods as they are identified in the parties' respective registrations. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“[T]he question of registrability of an applicant’s mark must be decided on the basis of the identification of goods ... set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”)).²⁹

The second and third *DuPont* factors weigh strongly in favor of a finding of likelihood of confusion.

2. Strength of Opposer’s BANDIT mark

We next consider the strength or weakness of Opposer’s BANDIT mark because that determination affects the scope of protection to be accorded the mark in our likelihood of confusion analysis. The fifth *DuPont* factor enables an opposer to prove that its pleaded mark is entitled to an expanded scope of protection by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use),” and the sixth *DuPont* factor allows an applicant to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 117 USPQ at 567.

“In determining the strength of a mark, we consider both [its] inherent strength, based on the nature of the mark itself, and if there is probative evidence in the record, its commercial strength or fame, based on marketplace recognition of the mark.”

²⁹ 41 TTABVUE 17 (Opposer’s Brief).

Keystone Consol. Indus., Inc. v. Franklin Investment Corp., 2024 USPQ2d 1425, at *12 (TTAB 2024) (citing *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”). “In a likelihood of confusion analysis, the fame or strength of a mark is not a binary factor, but rather varies along a spectrum from very strong to very weak. ... Where on that spectrum a mark falls impacts its scope of protection.” *Bureau Nat’l. Interprofessionnel DU Cognac v. Cologne & Cognac Entm’t.*, 110 F.4th 1356, 2024 USPQ2d 1421, at *11 (citing *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017)).

Opposer contends that its BANDIT mark is “conceptually strong with moderate commercial strength” and therefore is “entitled to broad protection on the spectrum of very strong to very weak.”³⁰ Applicant, on the other hand, contends that “BANDIT should be deemed both commercially and conceptually weak, and therefore entitled to narrow scope of protection.”³¹

a. Conceptual Strength

Conceptually, Opposer argues:

The term “BANDIT” is defined [by the MERRIAM-WEBSTER DICTIONARY] as “an outlaw who lives by plunder especially ... a member of a band of marauders.” 20 TTABVUE 3, Durand Decl. ¶5, Exh. 4. “[H]aving no suggestive or descriptive connotation as applied to ... [alcoholic beverages except beers,” Opposer’s BANDIT mark] must be considered a strong arbitrary mark for purposes of [Trademark Act] Section 2(d),” *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 765-766 (TTAB 1986).

³⁰ *Id.* at 21 (capitalization altered), 24 (internal quotation omitted).

³¹ 43 TTABVUE 21 (Applicant’s Brief).

An “arbitrary designation [is] deserving of a broad scope of protection against the registration of any mark used for the same or related goods that may tend to diminish its commercial value and consumer acceptance.” *Jules Berman & Assoc., Inc. v. Consol. Distilled Prods., Inc.*, 202 USPQ 67, 70 (TTAB 1979).³²

Applicant counters that:

BANDIT is conceptually weak because it suggests the consumer will feel like a “bandit” – perhaps getting a “steal” of a deal when they purchase this low-priced wine in a box. *See In re Omniome*, 2020 USPQ2d 3222, at *3 (TTAB 2019) (citing *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017)) (“a mark is suggestive if it ‘requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods’”); ... Suggestive marks are considered weak and therefore entitled to a narrow scope of protection. *In re Hunke and Jochheim*, 185 USPQ 188, 189 (TTAB 1975) (“[I]t is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark.”)³³

Opposer’s mark is registered on the Principal Register without a showing of acquired distinctiveness and is therefore presumed to be inherently distinctive under Section 7(b) of the Trademark Act. *See also New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). In addition, based on the meaning of BANDIT, we agree with Opposer that it is arbitrary with respect to alcoholic beverages.³⁴ We are unpersuaded by Applicant’s unsupported speculation that the mark is suggestive, much less highly suggestive,³⁵ because “it suggests the consumer will feel like a

³² 41 TTABVUE 22 (Opposer’s Brief).

³³ 43 TTABVUE 20-21 (Applicant’s Brief).

³⁴ 41 TTABVUE 22 (Opposer’s Brief).

³⁵ In arguing that “[s]uggestive marks are considered weak,” Applicant cites to case law regarding highly suggestive marks,” thus conflating the two concepts. While the scope of protection afforded to “highly suggestive” marks is “necessarily narrow,” *see Juice*

‘bandit’ – perhaps getting a deal when they purchase this low-priced wine in a box.”³⁶ This is attorney argument, which is no substitute for evidence.³⁷ *Cai*, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”)).

Applicant also made of record two third-party registrations for purportedly similar standard-character marks, including Registration No. 1803376 for BANDOLERO for “wines and spirits; namely, tequila” and Registration No. 6162478 for FORAJIDO for “alcoholic beverages, namely, distilled spirits.”³⁸ Their respective registration certificates indicate that each of these marks may be translated into English as “bandit.” But such statements are not evidence that those translations are correct. *Cf. Kellogg Co. v. Pack’Em Enters.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (“In this regard, applicant is advised that statements in an application are not evidence in behalf of an applicant, but rather must be proved.”).

Third-party registrations may be relevant, in the manner of dictionary definitions, “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation*, 115 USPQ2d at 1675. *See also Jack*

Generation, Inc. v. GS Enters. LLC, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015), a suggestive mark is inherently distinctive and entitled to a normal scope of protection. *See In re Great Lakes Canning*, 227 USPQ 483, 485 (TTAB 1985) (“[T]he fact that a mark may be somewhat suggestive does not mean that it is a ‘weak’ mark entitled to a limited scope of protection.”).

³⁶ 43 TTABVUE 20 (Applicant’s Brief).

³⁷ 41 TTABVUE 14 (Opposer’s Reply Brief).

³⁸ 30 TTABVUE 12-26 (Applicant’s Notice of Reliance, Exhibits 1-2).

Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). However, Applicant has not provided any evidence to support a finding that consumers would stop and translate those marks from their respective foreign languages, and that we should therefore apply the doctrine of foreign equivalents in our analysis.³⁹ Even if it had, the existence of two-third party registrations hardly amounts to strong evidence that the mark BANDIT is conceptually weak for alcoholic beverages.

We agree with Opposer that its BANDIT mark is conceptually strong.

b. Commercial Strength

Commercial or marketplace strength under the fifth *DuPont* factor is “the extent to which the relevant public recognizes a mark as denoting a single source.” *New Era Cap*, 2020 USPQ2d 10596, at *30, citing *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). “[T]he proper legal standard for evaluating the [commercial strength or] fame of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public.” *Palm Bay Imps.*, 73 USPQ2d at 1695. In this case, the relevant class of consumers include prospective purchasers of alcoholic beverages except beers.

“Commercial strength may be measured indirectly ‘by [1] the volume of sales and advertising expenditures in connection with the goods sold under the mark[], for example, and other factors such as [2] length of time of use of the mark; [3]

³⁹ “Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine...similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En* 772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

widespread critical assessments; [4] notice by independent sources of the products identified by the mark[]; and [5] the general reputation of the products and services.” *Monster v. Lo*, 2023 USPQ2d 87, at *22 (quoting *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); see also *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength). Successful trademark enforcement efforts may also be pertinent to the strength of a mark. *Burns Philp Food, Inc. v. Modern Prods. Inc.*, 24 USPQ2d 1157, 1158 n.2 (TTAB 1992) (policing efforts go to the strength of the mark). “But, the mere fact that lawsuits were filed is not reasonably probative of the fame inquiry, which is focused on whether the mark has achieved ‘extensive public recognition and renown,’ not on enforcement efforts. *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1724 (Fed. Cir. 2012)).

As noted above, Opposer argues that its BANDIT mark has “moderate commercial strength.” To show this, Opposer provides evidence regarding the length of time it has used the mark, the volume of sales and advertising expenditures under the mark, and its enforcement efforts in policing its rights in the BANDIT mark against other similar marks for alcoholic beverages.

With regard to length of time, Opposer’s CEO, Robert Torkelson, testified that Opposer’s predecessors-in-interest used the mark BANDIT in connection with “alcoholic beverage products and the offering of alcoholic beverage products for sale

throughout the United States since as early as August 24, 2004.”⁴⁰ But the wording “alcoholic beverages” includes beer and Opposer’s Registration excludes beer. He also testified that the mark “has been used on and in association with wine, wine-based hard seltzers and wine cocktails,”⁴¹ but we have no evidence as to the specific dates or extent of that use until July 1, 2019. Mr. Torkelson also testified that “BANDIT alcoholic beverage products are sold in all normal trade channels in “forty-nine (49) states and the District of Columbia by ninety-seven distributors,” but we do not know the time period or extent of use in any particular state or sales outlet. For these reasons, the probative value of the foregoing evidence is limited.

Regarding sales, Mr. Torkelson testified that from July 1, 2019 through June 30, 2023, Opposer’s predecessor in interest (Rebel Wine) sold what appears to be a significant number of 9-liter cases of BANDIT-branded wine, wine-based hard seltzer and wine cocktails that resulted in ostensibly significant sales.⁴² Regarding advertising, he testified that Opposer spent a certain amount on advertising during the same period.⁴³ But Opposer did not provide any context for any of these figures, such as Opposer’s market share or sales and advertising figures for comparable types of goods provided by their parties, which limits their probative value. *See Keystone Consol. Indus.*, 2024 USPQ2d 1425, at *49, citing *Bose Corp.*, 63 USPQ2d at 1309

⁴⁰ 21 TTABVUE 3 (Torkelson Test. Decl., ¶ 3).

⁴¹ *Id.* (¶ 7).

⁴² 22 TTABVUE 3 (Torkelson Test. Decl., ¶ 9) (confidential). The exact numbers of 9-liter cases sold and the amount of revenues are designated confidential by Opposer.

⁴³ *Id.* at 3-4 (¶ 10). The specific advertising amounts are also designated confidential.

(“Raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today’s world may be misleading.”). *See also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, at *58 (TTAB 2016) (“The probative value of [Applicant’s evidence of the number of doses of its pharmaceuticals sold] is diminished by the fact that the amount is just a raw number in the vast pharmaceutical industry, providing no context showing Applicant’s market share and whether the stated amount of doses sold is significant in the industry.”); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007) (sales figures for 14 years, standing alone and without any context in the trade, found insufficient). “The raw number[s], although perhaps showing the relative success of applicant’s product, does not necessarily evidence consumers’ recognition of the proposed mark as a source indicator.” *Mini Melts*, 118 USPQ2d at 1481-82.

Regarding enforcement, Mr. Torkelson testified that Rebel Wines (Opposer’s predecessor-in-interest) “has successfully enforced its trademark rights in the BANDIT mark against similar marks for alcoholic beverage products including sending cease and desist letters and obtaining undertakings to cease use, filing Opposition and Cancellation proceedings with the Trademark Trial and Appeal Board, and filing complaints in federal court.”⁴⁴ Specifically:

Since 2017, Rebel has sent out over forty cease and desist letters, filed eight opposition proceedings, in addition to the present proceeding, and one cancellation proceeding to protect its rights in the BANDIT mark. Such actions have resulted in third parties agreeing to cease use of confusingly similar marks, or otherwise complying with Rebel’s demands, as well as the abandonment of a trademark registration and

⁴⁴ *Id.* at 4 (¶ 13).

applications.⁴⁵

However, out of the eight previous inter partes proceedings mentioned by Mr. Torkelson, only two of them—Opposition No. 91268314 against the mark EL BANDIDO YANKEE, and Cancellation No. 92063917 against the mark MASKED BANDIT—were decided on the merits.⁴⁶ And with respect to the former, though Opposer was successful in preventing the registration of EL BANDIDO YANKEE, Applicant’s CEO testified (and Opposer did not deny) that the mark is still in use for tequila in the marketplace.⁴⁷

The remaining six inter partes proceedings, as well as one infringement action filed in the United States District Court for the Northern District of California, were all resolved well before a decision on the merits, either by the defending party’s default, or voluntary withdrawal or abandonment of its application (or agreement to a consent judgment).⁴⁸ We therefore cannot conclude that those proceedings are “probative of the [fame] of the mark[s] as opposed to the [defending parties’] desire to avoid litigation.” *See In re Dimarzio, Inc.*, 2021 USPQ2d 1191, at *17 n.24 (TTAB 2021) (citing *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7, *17 n.2 (CCPA 1977)). The same is true with respect to the cease and desist letters discussed in Mr. Torkelson’s testimony. *See, e.g., Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, at *20 (TTAB 2019) (“[W]e find that competitors likely acquiesced to Freud’s

⁴⁵ *Id.*

⁴⁶ *Id.* at 11-60 (Exhibit 1), 86-111 (Exhibit 8).

⁴⁷ 31 TTABVUE 3 (Lanz Test. Decl., ¶¶ 3, 10).

⁴⁸ 21 TTABVUE 61-85, 128-145 (Torkelson Test. Decl., Exhibits 2-7, 17-18).

assertion of its exclusive right to use the color red on saw blades to avoid litigation.”); *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *5 (TTAB 2019) (applicant’s evidence “only shows” that “competitors ceased use of that term, but does not shed light on its competitors’ motivation for stopping their respective uses.”).

Applicant contends that “Opposer’s enforcement efforts appear futile in a crowded field of at least 27 other BANDIT-formative marks for alcoholic beverages,”⁴⁹ which brings us to “[t]he number and nature of similar marks in use on similar goods” under the sixth *DuPont* factor. *DuPont*, 177 USPQ at 567. “The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of ... similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks Int’l*, 128 USPQ2d at 1693 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693).

Applicant provided Internet evidence of the following 27 third-party uses:

The Bandito Mexican lager (beer); Blue Bandito Mexican lager (beer); Bandito (wine); El Bandito (wine); Bandido (wine); Neato Bandito (beer); Cosmic Bandido (mead); Bandito’s Blood (wine); Bandito (wine); Bandito (tequila); Il Bandito (wine); Harpoon Bandito! (beer); Bandido de Amores (tequila); Bandolero (tequila); Goofy Bandit Espressotini (liqueur); Blackberry Bandit (wine); The Bandit (hard cider); Bandit Pale Ale (beer); Barrel Bandit (whiskey); The Barrel Bandit (wine); The Bandit (wine); Apple Bandit (hard cider); Bandit Queen (beer); Time Bandit (vodka); Bandit’s (rum); Bandits (moonshine); and Forajido (mezcal).⁵⁰

Not all of these third-party uses are relevant to our analysis. As Opposer observes, six of the third-party marks are for use in connection with beer, which is excluded

⁴⁹ 43 TTABVue 20 (Applicant’s Brief) (bold, italics, and underlining omitted).

⁵⁰ *Id.* at 29-150 (Exhibits 4-29).

from the identification in Opposer's Registration ("alcoholic beverages except beers").⁵¹ Because the goods legally identical and neither Opposer's Registration nor the Application identifies beer, the relevant scope of goods used in determining whether Opposer's mark has been weakened in the marketplace should be no broader than alcoholic beverages not including beer. That evidence has no probative value in proving that BANDIT is commercially weak in connection with alcoholic beverages that are not beer.⁵² See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991) (discounting third-party use and registration evidence as "not only unpersuasive but essentially meaningless," where "[n]one of the third party marks and uses of ACE made of record are nearly as closely related to the activities of the parties as the virtually identical uses of the parties are to each other."); *Key Chems., Inc. v. Kelite Chems. Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) ("... great majority of those registered marks are for goods unrelated to those in issue, and [have] little weight in the circumstances present here"). Moreover, there is no evidence of record demonstrating that beer and other alcoholic beverages are related.

Opposer additionally points out that a further nine of the third-party uses mentioned above pertain to goods that are not available in the United States,

⁵¹ *Id.* at 27-34 (Exhibit 3-4), 50-57 (Exhibit 8), 78-81 (Exhibit 14), 104-07 (Exhibit 20), 128-33 (Exhibit 25).

⁵² We thus need not discuss other purported defects in this evidence raised by Opposer, i.e., no showing of availability for Harpoon Bandito! or Bandit Queen beers, 44 TTABVue 9 (Opposer's Reply Brief), or limited availability of The Bandito, Blue Bandito, and Neato Bandito beers, *id.* at 10.

including El Bandito, Il Bandito, The Barrel Bandit, and The Bandit wines that are advertised on vivino.com.⁵³ Rather than an “add to cart” function that available wines on the website appear to have,⁵⁴ the pages for these wines only allow consumers to add the wines to their “Wishlist” (or “cellar” for premium members). There is no showing that the wines are currently available in the United States, when they were last available, if at all, or to what extent. There are numerous ratings for these wines and their different vintages referenced on the respective webpages, but we cannot tell if the ratings are from U.S. customers.

As Opposer further observes, Applicant’s evidence fails to show that Bandito wine, The Bandit hard cider, Apple Bandit hard cider, Bandit’s rum, Bandits Moonshine, or Forajido mezcal, are or have been available in the U.S.⁵⁵

⁵³ 30 TTABVUE 37-47 (Applicant’s Notice of Reliance, Exhibit 6), 69-77 (Exhibit 13), 113-25 (Exhibit 22-23).

⁵⁴ 37 TTABVUE 3 (Durand Test. Decl. ¶¶ 2-3).

⁵⁵ 30 TTABVUE 63-66, 90-103, 126-27, 140-50 (Applicant’s Notice of Reliance, Exhibits 11, 19, 24, 27-29). The producer of Bandito wine in Exhibit 11 is an Italian winery, Tenuta Di Tramonte, and its website shows only that one can order the wine from that site for delivery to Lucca, Italy. 37 TTABVUE 4-5 (Durand Rebuttal Test. Decl., ¶ 8, Exhibit 7). The producer of Bandits hard cider in Exhibit 19, Cambium Cider Co., is located in Vernon, British Columbia, Canada, 37 TTABVUE 3-4 (Durand Rebuttal Test. Decl., ¶ 4, Exhibit 3), and the comments shown on the webpage submitted by Applicant do not mention U.S. availability. Nor do the reviews, which fall under the heading “Global Recent Activity.” The webpage submitted to show use of Apple Bandits hard in Exhibit 24, wine-searcher.com, only lists retailers in the Netherlands. The website submitted to show use of Bandit’s rum in Exhibit 27 also does not show availability, indicating “no prices currently available.” And the website Moosejaw.com submitted to show use of Bandits moonshine in Exhibit 28 is a Canadian liquor store with no indication of sales to the U.S. The webpage from mezcalorama.com submitted to show use of Forajido mezcal in Exhibit 29 is in Spanish and provides no indication of sales to the U.S. We therefore need not address Opposer’s further argument that Forajido is not relevant because it is a Spanish word.

Opposer argues that the third-party use of Bandolero for tequila,⁵⁶ which corresponds to one of the two third-party registrations mentioned above, should be given no probative value because of its “distinct appearance and commercial impression” that is “markedly different from Opposer’s BANDIT mark and Applicant’s ‘BANDIDO’ mark.”⁵⁷ To the extent that Bandolero has the same meaning, we would not automatically disqualify it from consideration because it is in a foreign language. *See, e.g., Palm Bay Imps.*, 73 USPQ2d at 1693 (considering as similar third-party marks with either VEUVE, the French term for “widow,” and VIUDA, the Spanish term for “widow”). However, Applicant did not provide a translation of “bandolero,” which is different in appearance, sound and commercial impression from BANDIT apart from having the same first four letters, so we do not consider the terms similar.

Opposer also argues that Applicant’s evidence regarding Bandito tequila⁵⁸ is not probative because it appears to be “a printout from a retailer mistakenly using the term BANDITO on its website in connection with the sale of a Tequila that does not feature the term BANDITO anywhere on its labels.”⁵⁹ We agree that the term BANDITO is not shown on the image of the product on the website printout Applicant provided, and while consumers may have still been exposed to the wording in the text of the page, the evidence has less probative value.

⁵⁶ 30 TTABVUE 84-85 (Applicant’s Notice of Reliance, Exhibit 16).

⁵⁷ 44 TTABVUE 7-8, 12 (Opposer’s Reply Brief).

⁵⁸ 30 TTABVUE 67-68 (Opposer’s Notice of Reliance, Exhibit 12).

⁵⁹ 44 TTABVUE 9 (Opposer’s Reply Brief).

Regarding the mark Bandido de Amores for tequila,⁶⁰ Opposer provided evidence that it opposed the owner's corresponding application to register the mark and obtained a default judgment,⁶¹ but like with Applicant's El Bandido Yankee mark for tequila that Opposer successfully opposed previously but did not result in nonuse of that tequila, the fact that the Bandido de Amores tequila did not register does not mean it is not now in use for tequila. Nevertheless, we do not consider this mark relevant because, apart from containing the arguably foreign word "Bandido," it also includes the words "de Amores" for which there is no translation of record.

Regarding the marks Bandido, Bandito's Blood, and Blackberry Bandit,⁶² all for wine, Opposer points out that the respective owners have agreed to cease use of their allegedly infringing marks in response to its demands.⁶³ This contention is supported by evidence as to the marks Bandito's Blood and Blackberry Bandit, thus limiting the probative value of that evidence, but not as to the Bandito mark for wine.⁶⁴

Regarding the mark Time Bandit for vodka,⁶⁵ Opposer argues that Applicant's evidence has no probative value because the webpage provided shows that the product is currently "Sold out."⁶⁶ However, we do not automatically infer generally unavailability, as that status could also indicate popularity.

⁶⁰ 30 TTABVUE 82-83 (Applicant's Notice of Reliance, Exhibit 15).

⁶¹ 21 TTABVUE 5-6 (Torkelson Test. Decl., ¶ 17).

⁶² 30 TTABVUE 48-49 (Exhibit 7), 61-62 (Exhibit 10), 88-89 (Exhibit 18).

⁶³ 44 TTABVUE 9-10 (Opposer's Reply Brief).

⁶⁴ 22 TTABVUE (Torkelson Test. Decl., ¶¶ 22, 24, Exhibits 12, 14) (confidential).

⁶⁵ 30 TTABVUE 134-39 (Applicant's Notice of Reliance, Exhibit 26).

⁶⁶ 44 TTABVUE 9, 13 (Opposer's Reply Brief).

Regarding the marks Bandido for sherry wine and Cosmic Bandito for mead, Opposer asserts that it sent demand letters to their respective owners and that its enforcement efforts against those marks “remain pending.”⁶⁷ But we do not know the outcome of those proceedings and cannot assume that the results will favor Opposer.

Finally, Opposer notes that the marks Goofy Bandit for coffee liqueur and Barrel Bandit for whiskey have “limited availability.”⁶⁸ With respect to Goofy Bandit Espressotini, Opposer asserts that the evidence “shows that the product is available at one retail location in Brooklyn, New York and only available for ‘[l]ocal delivery.’”⁶⁹ While the website only listed one distributor, Opposer’s contention is somewhat misleading because the webpage also notes that the product may be shipped if that option box is checked on the page. With respect to Barrel Bandit, Opposer asserts that because the Certificate of Label Approval for this product “was issued to Jersey Artisan Distilling and the product is not offered for sale on the Jersey Artisan Distilling website, [this] suggest[s] that consumers have not been exposed to the mark beyond the single retail location in New Jersey.”⁷⁰ We disagree that the evidence shows this, and the internet printouts “on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein.” *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011).

⁶⁷ 44 TTABVUE 10 (Opposer’s Reply Brief).

⁶⁸ 30 TTABVUE 86-87 (Exhibit 17), 108-112 (Exhibit 21).

⁶⁹ 44 TTABVUE 10-11 (Opposer’s Reply Brief).

⁷⁰ *Id.* at 11.

Notwithstanding the above critiques of Applicant's third-party use evidence, we agree with Opposer's larger point that "[b]ecause Applicant introduced its third-party use evidence ... without accompanying testimony concerning, for example, how many U.S. consumers have been exposed to these alleged third-party uses of 'BANDIT' marks, the value of such evidence is limited."⁷¹ See *Palm Bay Imps.*, 73 USPQ2d at 1693 ("As this court has previously recognized where the record includes no evidence about the extent of [third-party] uses the probative value of this evidence is thus minimal.") (internal quotation omitted); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1123 (TTAB 2007) ("Thus, we are unable to conclude that consumers have become conditioned to recognize that several other entities use the mark DEVONSHIRE for products that may be used in the bathroom.").

Ultimately, we are left with the following seven potentially relevant third-party uses – Bandito wine, Bandido wine, Cosmic Bandido mead, Bandito's Blood wine, Bandido de Amores tequila, Goofy Bandit Espressotini liqueur, Barrel Bandit whiskey, and Time Bandit vodka – with no accompanying evidence regarding the extent of their use.⁷² These several Bandit-esque uses, coupled with the two third-party registrations as discussed above, fail to demonstrate a consistent pattern of use of the term 'BANDIT' in a manner that would prove that term "has a normally understood and well recognized descriptive or suggestive meaning," *Juice Generation*,

⁷¹ *Id.* at 8.

⁷² Opposer has not argued that any of the Bandido- or Bandito-formative marks are not relevant due to a difference in meaning or connotation, perhaps owing to its position that its mark BANDIT and the word BANDIDO in Applicant's mark "look the same, sound the same, and have identical meanings," 41 TTABVue 30-31 (Opposer's Brief), as discussed *infra*.

110 USPQ2d at 1675, and thus “fall[] short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present in [*Juice Generation* and *Jack Wolfskin*].” *i.am.symbolic*, 123 USPQ2d at 1751. *Cf. Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016) (weakness found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark).

Overall, the record establishes that Opposer’s BANDIT mark has achieved slight commercial strength, but not enough to increase the scope of protection the mark is entitled as an inherently distinctive mark. But it is also not diminished by Applicant’s evidence of third-party use of similar marks on similar goods.

c. Conclusion on Strength

Given our finding that Opposer’s BANDIT mark is conceptually strong and has slight commercial strength for alcoholic beverages except beers. We place it slightly higher on the strength spectrum, but given the limited evidence and the equivocal nature of much of that evidence, we do not place much weight on the two strength factors.

3. Similarity or Dissimilarity of the Marks

We now consider the first *DuPont* factor, which involves an analysis of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “[T]he ‘similarity

or dissimilarity of the marks in their entireties’ is a predominant inquiry.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *DuPont*, 476 F.2d at 1361).

The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks omitted)).

The marks must also be considered “in light of the fallibility of memory” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quotation omitted). The focus is on the recollection of the average purchaser—here, the average purchaser of alcoholic beverages except beers—who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991)), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992).

“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.” *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981). “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the

ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 224 USPQ at 751.

a. Appearance

Opposer argues that the marks are similar in appearance because BANDIT is the only term in its mark, and the dominant element in Applicant’s BREAK OUT THE BANDIDO mark is “the BANDIDO brand name,” which “is virtually identical in appearance” to BANDIT because “both share the identical letter string ‘BANDI,’ differing only by the final letters, ‘T’ and ‘DO’.”⁷³ According to Opposer, “the terms ‘BREAK OUT THE’ in Applicant’s mark do little to distinguish the marks.”⁷⁴

Applicant disagrees, asserting that the marks are “completely dissimilar in appearance” because “Applicant’s Mark begins with “BREAK OUT THE” which is not present anywhere in Opposer’s mark”; “[t]he spellings of the marks are entirely dissimilar”; and “consumers will focus on the first and dominant words BREAK OUT THE, which significantly change the marks in appearance.”⁷⁵

We are not persuaded by either party’s characterization of the purported dominant element(s) in Applicant’s mark. Instead, we find the slogan BREAK OUT THE BANDIDO to be unitary in nature and one that conveys a single commercial impression that is distinct from the constituent words “BREAK,” “OUT,” “THE,” and

⁷³ 41 TTABVUE 27 (Opposer’s Brief).

⁷⁴ *Id.* at 27-28.

⁷⁵ 43 TTABVUE 24 (Applicant’s Brief) (emphasis omitted).

“BANDIT.”⁷⁶ *See Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (“A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.”).

Opposer’s attempt to establish a dominant element of Applicant’s BREAK OUT THE BANDIDO mark as “BANDIDO” through extrinsic evidence, namely, pages from Applicant’s website and several posts on X.com that show the slogan has been used to promote Applicant’s El Bandido Yankee tequila, and that Applicant has used the wording “Bandido” in various other phrases, is unavailing.⁷⁷ While “[m]ore dominant features [of a mark] will, of course, weigh heavier in the overall impression of a mark[.]” *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990), as Applicant correctly points out, “the analysis is based on the marks **as depicted in the respective application and registration**, without regard to

⁷⁶ Both parties refer to Applicant’s mark as a slogan. *See, e.g.*, 41 TTABVUE 25-27 (Opposer’s Brief); 43 TTABVUE 9-11 (Applicant’s Brief). “Slogans, by their attention-getting nature, are treated as unitary matter” *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1213.05.

⁷⁷ *Id.* For example, Applicant’s posts on X include a cocktail using Applicant’s tequila called “Lucky Bandido!”; a post that refers to an image of three versions of Applicant’s tequila as “3 Bandidos – on a mission to bring criminally smooth taste to your glass”; a post that bids salutes, “Cheers Bandidos!”; and a post that refers to its El Bandido Yankee tequila as BOLD BAD ASS BANDIDO and the hashtag #BandidoAttitude. 20 TTABVUE 33-37 (Exhibit 6). Although Opposer argues, based on these examples, that “it is likely that Applicant will be successful in conditioning consumers to recognize ‘BANDIDO’ as Applicant’s brand name and the dominant element of the BREAK OUT THE BANDIT slogan[.]” 41 TTABVUE 27 (Opposer’s Brief), that is speculation, not evidence.

whether the marks will appear with other marks or other elements when used.”⁷⁸ See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993) (applicant’s arguments that its mark would appear with applicant’s house mark not considered); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“[W]e do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application. We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information.”).

Opposer acknowledges the axiom that “a mark should not be dissected and considered piecemeal,” quoting *Franklin Mint. Corp.*, 212 USPQ at 234.⁷⁹ But Opposer appears to have done exactly that in removing “DO” from the last word in Applicant’s unitary mark, then disregarding the remainder of the mark for comparison. The marks BANDIT and BREAK OUT THE BANDIDO are very different in appearance.

b. Sound

Just as we disagree that BANDIDO is the dominant element in Applicant’s mark, we also disagree with Opposer’s contention that the marks are “highly similar in sound” due to that alleged dominance.⁸⁰ Consequently, we further disagree with Opposer that the “additional syllable ‘O’ sound at the end of [BANDIDO] hardly

⁷⁸ 43 TTABVUE 23 (Applicant’s Brief) (emphasis in original; italics and underlining omitted).

⁷⁹ *Id.* at 25.

⁸⁰ 41 TTABVUE 28 (Opposer’s Brief) (initial caps in original).

serves as a point of distinction so as to eliminate aural similarity.”⁸¹ The marks BANDIT and BREAK OUT THE BANDIDO sound very different.

Opposer argues that “it is reasonable to assume that consumers will shorten Applicant’s BREAK OUT THE BANDIDO mark to BANDIDO when verbally requesting Applicant’s product.”⁸² While we keep in mind “the penchant of consumers to shorten marks,” *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016), this tendency seems lessened here we have found that Applicant’s BREAK OUT THE BANDIDO mark is unitary. When consumers shorten a mark, they typically keep the essence of the mark intact. For example, in *Bay State Brewing*, which was cited by Opposer, the Board found that because the word “BLONDE” in the applicant’s mark TIME TRAVELER BLONDE for beer was shown by the evidence to be descriptive of a type of beer, its addition “d[id] very little or nothing to distinguish” it from the registrant’s mark, TIME TRAVELER. *Id.* See also Judge Rich’s concurring opinion in *In re Abcor Dev. Corp.*, 200 USPQ 215, 218 (CCPA 1978), where, in the context of a finding of descriptiveness of mark GASBADGE which he noted was a shortening of the actual name of the article at issue, “Gas Monitoring Badge,” he discusses provides other potential examples such as “automobile to auto, telephone to phone, necktie to tie, gasoline service station to gas station.” Here, “break out the” makes no sense on its own and has a different meaning than the full mark, as does “bandido.”

⁸¹ *Id.*

⁸² *Id.* at 29.

c. Connotation and Commercial Impression

Opposer, through the testimony of one of its lawyers, Joy Durand, provided a definition from the MERRIAM-WEBSTER DICTIONARY that defines “bandit” as “an outlaw who lives by plunder *especially*: a member of a band of marauders ...: robber.”⁸³ Ms. Durand also testified that she “conducted an Internet search using the Collins translator, collinsdictionary.com, to translate the Spanish term ‘bandido’ into English” which “returned the English translation ‘bandit’ for the Spanish term ‘bandido’ that “will be relied upon to demonstrate the similarity of the marks.”⁸⁴ But in its main trial brief, Opposer drops the contention (but does not argue against the fact) that “bandido” is a Spanish word, and instead asserts “bandido” is an English word defined as “an outlaw especially of Mexican extraction or origin.”⁸⁵ Thereafter, when Applicant argues in its brief that the marks have different commercial impressions because BREAK OUT THE BANDIDO is “in mixed English and Spanish words,”⁸⁶ Opposer retorts that the mark “is entirely in English, as the term BANDIDO is an English word.”⁸⁷ Thus, the position of Opposer is that BANDIDO is

⁸³ 20 TTABVUE 3 (Durand Test. Decl. ¶ 5).

⁸⁴ It appears Ms. Durand inadvertently omitted the translation that was purportedly attached as Exhibit 2 from the attachments to her declaration, so we have taken judicial notice of it: <https://www.collinsdictionary.com/translator> (accessed June 3, 2024). *See In re Weiss*, 123 USPQ2d 1205 n.10 & n.11 (Board took judicial notice translations of German letter and word from the LANGENSCHIEDT ONLINE GERMAN DICTIONARY).

⁸⁵ “Providing only a website address or hyperlink to Internet materials is insufficient to make such evidence of record.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *32 n.67 (TTAB 2021). However, for completeness, we elect to take judicial notice of it: <https://www.merriam-webster.com/dictionary/bandido> (accessed June 3, 2025).

⁸⁶ 43 TTABVUE 26 (Applicant’s Brief).

⁸⁷ 44 TTABVUE 16 (Opposer’s Reply Brief).

an English word because it is found in one particular dictionary, namely the MERRIAM-WEBSTER DICTIONARY.

We are not persuaded. Authoritative linguistic sources establish that dictionaries are descriptive, not prescriptive, and a word's inclusion in a single dictionary does not mean the word is a part of the English language. As explained in the *ENCYCLOPEDIA BRITANNICA*, "Dictionaries are primarily descriptive, recording how words are actually employed in speech and writing The inclusion of a word in a dictionary reflects its use in a language community, often requiring evidence of sustained and widespread usage, but dictionaries do not serve as official arbiters of a language's vocabulary."⁸⁸ The *OXFORD COMPANION TO THE ENGLISH LANGUAGE* (Tom McArthur ed., 1992) points out that "Dictionaries document the lexicon of a language as it is used, not as it ought to be Loanwords ... achieve full integration when they are used consistently across varied contexts by native speakers."

Opposer's reliance on MERRIAM-WEBSTER's entry for "bandido" as the basis for considering it an English word is undermined by its absence from other major English dictionaries, such as the *AMERICAN HERITAGE DICTIONARY*,⁸⁹ the *CAMBRIDGE ADVANCED LEARNER'S DICTIONARY*,⁹⁰ the *CAMBRIDGE ESSENTIAL AMERICAN ENGLISH DICTIONARY*,⁹¹ *WEBSTER'S REVISED UNABRIDGED DICTIONARY*, 1913 ED.,⁹² *WEBSTER'S*

⁸⁸ <https://www.britannica.com/topic/dictionary> (accessed June 5, 2025).

⁸⁹ <https://www.ahdictionary.com/word/search.html?q=bandido> (accessed June 3, 2025).

⁹⁰ https://dictionary.cambridge.org/spellcheck/english/?q=bandido#google_vignette (accessed June 3, 2025).

⁹¹ <https://dictionary.cambridge.org/us/spellcheck/english/?q=bandido> (accessed June 3, 2025).

⁹² <https://www.webster-dictionary.org/definition/bandido> (accessed June 3, 2025).

1828 DICTIONARY,⁹³ and the LONGMAN DICTIONARY OF CONTEMPORARY ENGLISH.⁹⁴ This limited presence indicates that “bandido” lacks the widespread acceptance required to be a standard English word. In addition, the MERRIAM-WEBSTER entry relied upon by Opposer has the notation “**Southwest**” (emphasis in original) immediately before the definition,⁹⁵ which specifies the term is primarily used in the southwestern United States and therefore reflects regional usage rather than universal assimilation into English as spoken in the United States. According to MERRIAM-WEBSTER, a regional label is used “to signal that a word or a sense of a word is not part of the standard vocabulary of English.”⁹⁶ Here, the notation suggests a connection to the region’s vernacular, influenced by Mexican culture. In contrast, the word “bandit” is listed in all of the aforementioned dictionaries⁹⁷ and thus appears fully assimilated into English.⁹⁸ We are not convinced that BANDIDO is an English

⁹³ <https://webstersdictionary1828.com/Dictionary/bandido> (accessed June 3, 2025).

⁹⁴ <https://webstersdictionary1828.com/Dictionary/bandido> (accessed June 3, 2025).

⁹⁵ <https://www.merriam-webster.com/dictionary/bandido> (accessed June 3, 2025).

⁹⁶ <https://www.merriam-webster.com/help/explanatory-notes/dict-usage> (accessed June 5, 2025).

⁹⁷ <https://www.ahdictionary.com/word/search.html?q=bandit> (accessed June 3, 2025).

<https://dictionary.cambridge.org/dictionary/english/bandit> (accessed June 3, 2025).

<https://dictionary.cambridge.org/us/dictionary/english/bandit> (accessed June 3, 2025).

<https://www.webster-dictionary.org/definition/bandit> (accessed June 3, 2025).

<https://webstersdictionary1828.com/Dictionary/bandit> (accessed June 3, 2025).

<https://www.ldoceonline.com/dictionary/bandit> (accessed June 3, 2025).

⁹⁸ Legal precedents also support the general concept that a dictionary definition may have limited probative value under the particular circumstances of a case. For example, in *Nix v. Hedden*, 149 U.S. 304 (1883), which determined whether tomatoes should be classified as a fruit or vegetable for tariff purposes, the plaintiff cited dictionary definitions to argue that they were fruits, botanically. However, the Supreme Court relied on “ordinary meaning” in commerce, using dictionaries as aids, not as conclusive evidence. *Id.* at 307. And in *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981), which concerned whether the word “Braunschweiger” is generic for sausage, the U.S. Court of Customs and

word that has worked its way into the American lexicon.

Based on the foregoing, we do not agree with Opposer that “Opposer’s BANDIT mark and Applicant’s BREAK OUT THE BANDIDO mark are highly similar in connotation and commercial impression.”⁹⁹ Opposer’s mark is a single term identifying “an outlaw who lives by plunder,” a “robber.” In contrast, Applicant’s mark is a mixed English and foreign word phrase.

We need not rely on our finding that the Applicant’s mark is comprised of mixed English and foreign wording. Even if it is known that “bandido” is a synonym of “bandit,” there are still differences in connotation because “bandido” is defined (in MERRIAM-WEBSTER’S) as “an outlaw of Mexican extraction or origin” (consistent with Applicant’s offering of tequila, a Mexican liquor), whereas Opposer’s mark refers generally to an outlaw or robber. Furthermore, and to extent consumers understand the meaning of the word “bandido” as Opposer contends, we again point out that Applicant’s mark is BREAK OUT THE BANDIDO, not BANDIDO. Furthermore, we find some merit to Applicant’s argument that BREAK OUT THE BANDIDO connotes “breaking a prisoner out of jail,”¹⁰⁰ which calls to mind breaking an imprisoned Mexican outlaw out of jail.

Patent Appeals noted that “Dictionary definitions are, of course, relevant as reflecting the ‘common understanding’ of words, but they are not controlling where other evidence, such as consumer perception or usage in the trade, indicates a different meaning.” *Id.* at 46.

⁹⁹ 41 TTABVue 30 (Opposer’s Brief) (initial caps lowered). Applicant also provides evidence of a promotional t-shirt showing the slogan over a depiction of the alleged fictional outlaw “El Bandido Yankee” behind bars, though we do not rely on it, for the same reason we do not rely on extrinsic evidence from Applicant’s website to determine the dominant element (or lack thereof) in Applicant’s mark as Opposer suggests we should.

¹⁰⁰ 43 TTABVue 25 (Applicant’s Brief).

d. Conclusion: The Marks Are Dissimilar

We find that the marks BANDIT and BREAK OUT THE BANDIDO are very different in overall appearance, sound, connotation, and commercial impression. The first *DuPont* factor weighs heavily against a finding of likelihood of confusion.

4. Purchasing Conditions

Under the fourth *DuPont* factor, we consider “the conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. We are mindful that where, as here, the goods of the parties are legally identical and without limitation as to classes of consumers, we may presume that the targeted classes of purchasers are the same, *In re Viterro Inc.*, 101 USPQ2d at 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011), and base our analysis on the least sophisticated potential purchasers. See *Double Coin Holdings v. Tru Dev.*, 2019 USPQ2d 377409 at *7 (TTAB 2019) (citing *Stone Lion*, 110 USPQ2d at 1163).

In addition to pointing out that we must focus on the least sophisticated consumer, Opposer argues that the “risk of confusion” is “exacerbated here because the parties’ goods are also ordered orally in bars or restaurants where conditions are chaotic and not much care is exercised by consumers.”¹⁰¹ “Under these circumstances,” concludes Opposer, “consumers who are unable to visually examine the marks will not notice

¹⁰¹ *Id.*

any differences in their appearance.”¹⁰² However, Opposer provides no evidence that “not much care is exercised by consumers” in bars or restaurants when ordering their drink preferences.

Applicant’s witness, Mr. Torkelson, testified that Applicant’s “tequila sold in stores is between approximately \$35 and approximately \$65 per 750 ml. bottle,” whereas, based on his review of Opposer’s wines offered for sale through online brick-and-mortar retailers, Opposer’s goods are “sold at low retail price ranges of \$7-\$10 per 1 liter box, and \$4-\$5 per 500 ml. box.”¹⁰³ “While Applicant’s evidence is relevant to show that wine can be sold at moderate prices, we do not consider [Opposer’s alcoholic beverages except beers] to be in any way *restricted* to [Opposer’s] actual products. Because it’s identification of goods is not so limited, we must consider [Opposer’s] goods to include [all alcoholic beverages except beers (including tequila)] sold at all prices normal for such goods, including both less and more expensive wines [or tequilas] than those [Opposer] sells.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n. 23 (TTAB 2018), citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (absent limitations in the application, the Board must consider “all goods of the nature and type described”).

The fourth *DuPont* factor is neutral.

5. Absence of Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent

¹⁰² *Id.*

¹⁰³ 31 TTABVue 5-6 (Torkelson Test. Decl., ¶¶ 12, 16).

of any actual confusion in light of the length of time and conditions under which there has been contemporaneous use of Opposer's and Applicant's marks. *DuPont*, 177 USPQ at 567. "[These] factors are interrelated; the absence of evidence of actual confusion, under the seventh du Pont factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth *du Pont* factor, that there has been a significant opportunity for actual confusion to have occurred." *In re Ass'n of the U.S. Army*, 85 USPQ2d 1264, 1273 (TTAB 2007) (citations omitted).

Applicant argues that "[t]here has not been a single instance of actual confusion and Opposer does not contend otherwise."¹⁰⁴ According to Applicant's explanation:

The absence of any confusion is particularly notable because the parties have aggressively promoted their respective BREAK OUT THE BANDIDO and BANDIT marks nationwide for over three (3) years without any issues. Applicant's tequila business has grown substantially – with sales nearly doubling since inception and almost 30,000 cases (with 6 bottles in each case) sold in 16 states, and revenues in the millions of dollars since 2021. Millions of consumers have been heavily exposed to both parties' marks.

The fact that there has been no confusion after years of co-existence in the marketplace – despite ample time and opportunity for such confusion to occur – is compelling. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred). ... This factor weighs in Applicant's favor, and is highly probative of an absence of a likelihood of confusion.

The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant

¹⁰⁴ 43 TTABVue 28 (Applicant's Brief) (emphasis omitted).

period of time in the same markets as those served by Opposer under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Thus, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery v. Landesman*, 82 USPQ2d at 1287 (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

Assessing the lack of any reported instances of confusion requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. *New Era Cap*, 2020 USPQ2d 10596, at *17 (citing *In re Guild Mortg.*, 2020 USPQ2d 10279, at *6 (TTAB 2020)). “Any lengthy absence of actual confusion during a period of known, rather than legally presumed, use in the same channels of trade could be telling.” *Id.*

As noted previously, while Opposer provided evidence that its predecessor-in-interest spent a particular amount on the advertising of its goods under the BANDIT mark during the period of July 1, 2019 through June 30, 2023,¹⁰⁵ Opposer did not provide context for those figures, such as its market share or sales and advertising

¹⁰⁵ See note 40 *supra*.

figures for comparable types of goods, thus limiting their probative value.

Applicant, for its part, also did not provide any evidence of its advertising expenditures. While Applicant's CEO, Eric Lanz, testified that since 2021, "[t]he BREAKOUT THE BANDIDO slogan has been used to promote the tequila on [Applicant's] website ..., in social media, and on promotional clothing such as t-shirts and hats,"¹⁰⁶ he provided no evidence of the extent of that promotion. He also emphasized that the mark "has not been used in any stores, bars, or restaurants" and that Applicant "does not use BREAK OUT THE BANDIDO directly on the tequila bottles, neckers (tags attached to the bottle neck), shelf talkers (tags attached to the shelf where the bottle is placed in stores), store displays, or any other advertising in liquor stores, bars, and restaurants."¹⁰⁷ Based on that evidence, it appears that Applicant has limited use of its mark in a manner that limits, if not prevents entirely, simultaneous market exposure to both Applicant's mark and Opposer's mark. In other words, while the parties' goods are sold in the same trade channels,¹⁰⁸ Applicant's limited use means consumers will never—at least based on the record here—encounter Applicant's BREAK OUT THE BANDIDO mark in those channels. Importantly, it is the "lengthy absence of actual confusion during a period of known, rather than legally presumed, use in the same channels of trade" that "may be telling." *New Era Cap*, 2020 USPQ2d 10596, at *50. Consequently, we are not

¹⁰⁶ 31 TTABVUE 3 (Lanz Test. Decl. ¶ 4) (emphasis omitted). Notably, such "uses" do not constitute "use in commerce" for registration purposes," but that issue is not before us.

¹⁰⁷ *Id.* at 5 (¶ 11).

¹⁰⁸ 21 TTABVUE 4 (Torkelson Test. Decl. ¶ 12);

persuaded by Applicant's contention that "[t]he absence of any confusion is particularly notable because the parties have aggressively promoted their respective [marks] nationwide for over three (3) years without any issues.

Nor are we moved by Applicant's assertion that its tequila business "has grown substantially – with sales nearly doubling since inception and almost 30,000 cases (with 6 bottles in each case) sold in 16 states, and revenues in the millions of dollars since 2021." Applicant has provided no contextual information regarding the sale of 30,000 cases of tequila over a 3-4-year period, or its revenues in the millions (which could be just two million, or many millions), and how these figures compare with those of competitors. Applicant's claim that its tequila is "sold in 16 states" and that "millions of consumers have been heavily exposed to both parties' marks" is unsupported.

Finally, three to four years is hardly a long time period for determining the impact of the lack of actual confusion in the context of this case, where the evidence shows that consumers have had limited exposure to both marks during the relevant period of time. *See Keystone Consol. Indus.*, 2024 USPQ2d 1425, at *78-79 ("Because of the more limited nature of Respondent's activities ... we find the evidence of concurrent use based on actual market conditions does not indicate a significant opportunity for confusion to occur.") *Primrose Ret. Cmty., v. Edward Rose Senior Living*, 122 USPQ2d 1030, 1039-40 (TTAB 2016) (With only three years use, "the marks have been in contemporaneous use for only a short time. ... Thus, the opportunity for actual confusion to have occurred in the marketplace is minimal.").

The absence of actual confusion in the past is not probative of the likelihood of confusion in the future for the reasons given above. The seventh *DuPont* factor is thus neutral.

6. Variety of Goods on Which Opposer's Mark is Used

Under the ninth *DuPont* factor, “the variety of goods on which a [prior] mark is or is not used,” *DuPont*, 177 USPQ2d at 567, Applicant argues that this factor “weighs against a finding of likelihood of confusion” because Opposer only uses its BANDIT marks in connection with wine and has no intention to expand into tequila.¹⁰⁹ Applicant again fails to appreciate the fact that our analysis must presume Opposer's goods to include all alcoholic beverages except beers, thus including tequila. Additionally, whether Opposer uses its mark on a variety of goods can only benefit, not hurt Opposer, and therefore would either weigh in favor of Opposer or be neutral. *See DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *44 (TTAB 2020), quoted in *Dollar Fin. Grp., Inc. v. Brittex Fin., Inc.*, 132 F.4th 1363, 2025 USPQ2d 480, at *16 (Fed. Cir. 2025) (“If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant's related good under a similar mark as an extension of the plaintiff's line.”). Moreover, in view of our finding that Opposer's goods encompass Applicant's goods, there is no need to rely on this factor which, in essence, is used to show the relatedness of the goods. *KME Ger. GmbH v. Zhejiang Hailiang Co.*, 2023 USPQ2d 1136, at *55 (TTAB 2023), *rev'd on other grounds*, No. 1:23-cv-01606, 2025 U.S. Dist. LEXIS 25637, 2025 WL 457103 (E.D. Va.

¹⁰⁹ 43 TTABVue 29 (Respondent's Brief)

Jan. 10, 2025), *appeal docketed*, No. 25-1129 (4th Cir. Feb. 12, 2025). Accordingly, this factor is neutral.

7. Applicant's Survey Evidence

Applicant submitted the testimony and report of its marketing research and consulting expert, AnnaBelle Sartore, Ph.D.,¹¹⁰ who designed and conducted a “Likelihood of Confusion Pilot Survey” of 103 participants “to address the issue of likelihood of confusion with respect to Applicant’s use of the BREAK OUT THE BANDIT mark.”¹¹¹ We consider Applicant’s survey evidence under the thirteenth *DuPont* factor, which addresses “any other established fact probative of the effect of use.”¹¹² *DuPont*, 177 USPQ 567.

Though Dr. Sartore doesn’t mention the type of survey she conducted in her testimony or expert report, she agreed in her discovery deposition that the design type, at least with respect to “the critical questions,” is “typically characterized as an

¹¹⁰ Dr. Sartore lists in her curriculum vitae one prior experience giving testimony as an expert in a Canadian case, 32 TTABVUE 8-9, and in her discovery deposition she testified that she had testified in “a Lanham Act case” three or four times “30 years ago.” However, Opposer does not object to her qualifications or otherwise argue that the purported defects in the survey design are due to her lack of experience.

¹¹¹ 32 TTABVUE 1-7 (Sartore Test. Decl., ¶¶ 1-3, and Expert Report (Exhibit 1)).

¹¹² Historically, the results of a properly conducted survey has been considered akin to actual confusion. *See Blue Cross and Blue Shield Ass’n v. Harvard Comty. Health Plan Inc.*, 17 USPQ2d 1075, 1078 n.7 (TTAB 1990); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (hereafter, just “MCCARTHY ON TRADEMARKS”) § 32:54 (2d ed. 1984) (“Survey results are generally classified as evidence of actual confusion ...”). More recently, Professor McCarthy has explained that “survey evidence is circumstantial, not direct, evidence of the likelihood of confusion. Surveys do not measure the degree of actual confusion by real consumers making mistaken purchases. Rather, surveys create an experimental environment from which we can get useful data from which to make informed inferences about the likelihood that actual confusion will take place.” 6 MCCARTHY ON TRADEMARKS § 32:184 (5th ed.) We therefore discuss Applicant’s survey evidence here in a separate section, rather than under the *DuPont* factors concerning actual confusion.

Eveready survey.”¹¹³ “In a typical *Eveready* study, respondents are shown only a contextual stimulus of the allegedly infringing junior mark, and are asked the open-ended source question, ‘Who makes or puts [this] out?’, typically followed by ‘Why do you say that?’” Jerre B. Swann, *Eveready and Squirt—Cognitively Updated*, 106 Trademark Rep. 727, 733-34 (2016). These questions “can be combined with additional questions probing whether there is a likelihood of confusion as to sponsorship, affiliation or approval.” MCCARTHY ON TRADEMARKS § 32:174.¹¹⁴

In this particular survey, the “respondents” were first asked a number of qualifying questions, including whether they were within the age groups of 21-34, 35-54, or 55 or over; whether they lived in states falling within one of four areas of the country (Northeast, Midwest, South, or West); and whether they had purchased tequila within the past six months, or were likely to purchase tequila in the next six months.¹¹⁵ Those respondents whose answers did not fall within these specific

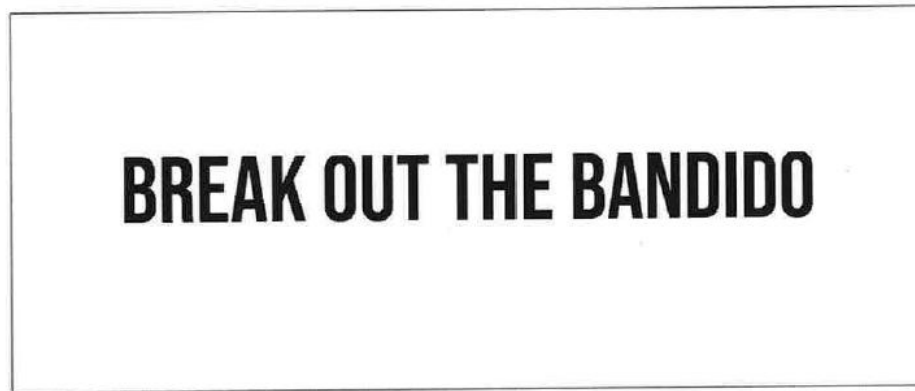
¹¹³ 36 TTABVUE 102-03 (Sartore Disc. Dep., pp. 96:24-97:5). The *Eveready* survey derives its name from the Seventh Circuit’s decision, *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 188 USPQ 623, 642-43 (7th Cir. 1976) (holding that “the district court [was] clearly erroneous in not crediting the surveys taken by [the plaintiff] Union Carbide.”).

¹¹⁴ Applicant argues that an *Eveready* survey “is the gold standard in cases like this one,” 43 TTABVUE 28 (Applicant’s Brief), whereas but as discussed *infra*, the more important issue is that the survey be tailored to the particular facts and circumstances in the case. Opposer, for its part, Opposer points out, citing the Board’s non-precedential opinion in *Sazerac Brands, LLC v. Eagle Trace Brewing Co. LLC*, 2024 TTAB LEXIS 323, at *50 (TTAB 2024), that the *Eveready* format “is generally used in cases where the senior mark is alleged to be famous or strong.” Opposer adds that Dr. Sartore herself “acknowledged that the *Eveready* survey design is more suited to famous and that well-known marks that are not as commercial strong will not perform well in an *Eveready* survey because consumers will not have such mark top of mind.” 44 TTABVUE 24 (Opposer’s Reply Brief) (citing Sartore Disc. Dep., 36 TTABVUE 111-12, pp. 105:8-112:18). Opposer’s argument that an *Eveready* survey is inappropriate because its BANDIT mark is not famous enough supports our earlier finding that the mark has attained only slight commercial strength.

¹¹⁵ 32 TTABVUE 14-16.

categories were terminated from the survey.

Qualified respondents were asked to “look at this word mark for a brand of tequila” and to “take as much time as you like looking at the word mark before continuing with the survey”:



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They were then asked the following questions, with further instructions to move on to other questions if they didn't know the answer to a particular question:¹¹⁷

- Who do you believe makes or puts out tequila that uses this word mark? Please be as specific as possible.
- Why do you say that? Again, please be as specific as possible.
- What else, if anything, is made or put out by whoever you believe makes or puts out tequila using this word mark? Please be as specific as possible.
- Why do you say that? Again, please be as specific as possible.
- Do you believe tequila using this word mark ...

_____ 1. IS being made or put out with the authorization, approval, or sponsorship of any other company or brand?

_____ 2. is NOT being made or put out with the authorization,

¹¹⁶ *Id.* at 18 (reduced in size).

¹¹⁷ *Id.* at 18-21.

approval, or sponsorship of any other company or brand?

_____ 3. don't know or have no opinion?

- Who do you believe gave authorization, approval, or sponsorship? Please be as specific as possible?
- Why do you say that? Again, please be as specific as possible.
- Do you believe that whoever makes or puts out tequila using this word mark ...

_____ 1. HAS a business affiliation or business connection with any other company or brand?

_____ 2. does NOT have a business affiliation or business connection with any other company or brand?

_____ 3. don't know or have no opinion?

- Who do you believe has a business affiliation or business connection with whoever makes or puts out tequila using this word mark? Please be as specific as possible.
- Why do you say that? Again, please be as specific as possible.

Dr. Sartore concludes in her testimony:

Based on the data collected during execution of the survey, no individual respondent expressed a belief that Opposer['s] [predecessor-in-interest] Rebel Wine Co. ("Rebel") made or put out a tequila under the BREAK OUT THE BANDIDO word mark; no individual respondent thought that the product associated with BREAK OUT THE BANDIDO was being made or put out with the authorization, approval or sponsorship of Rebel, and no individual response thought that the BREAK OUT THE BANDIDO mark had a business affiliation or business connection with Rebel."¹¹⁸

Applicant argues that Dr. Sartore's survey "conclusively shows that there is no

¹¹⁸ *Id.* at 3 (¶ 4).

likelihood of confusion” in this case.¹¹⁹

Opposer disagrees, contending that “Applicant’s expert’s opinion concerning likelihood of confusion has no probative value as the consumer confusion survey fails to test the proper issue in the case and is generally unreliable.”¹²⁰ Opposer notes it is

Applicant as “the proponent of the survey—that has the burden of establishing that it was conducted in accordance with accepted principles of survey research, including but not limited to showing that a proper universe was examined for the survey; a representative sample was drawn from the universe; the mode of questioning the respondents was correct; and the sample design, questionnaire were in accordance with generally accepted standards of procedure and statistics in the field of such surveys[.]” *Sazerac Brands, LLC v. Eagle Trace Brewing Company LLC*, No. 91272260, 2024 WL 4052732, at *24 (Aug. 22, 2024) [non-precedential] (citing MANUAL FOR COMPLEX LITIGATION, 116 (5th ed. 1981)).¹²¹

Opposer argues that “Applicant has not met this burden.”¹²² We agree.

a. The Survey is Critically Flawed, as it fails to Gauge Likelihood of Confusion in the Registration Context

“Most surveys do not measure actual confusion. Surveys only give us information about a controlled and artificial world from which we are asked to draw inferences about the real world.” 5 MCCARTHY ON TRADEMARKS § 32:163 (quoting Harvey S. Perlman, *The Restatement of the Law of Unfair Competition: A Work in Progress*, 80 TRADEMARK REP. 461 (1990)). Thus, explains Prof. McCarthy, speaking about survey methodology in general, “[t]he closer the survey context comes to marketplace

¹¹⁹ 43 TTABVUE 14 (Applicant’s Brief).

¹²⁰ 44 TTABVUE 18 (Opposer’s Reply Brief) (initial caps lowered).

¹²¹ 44 TTABVUE 19 (Opposer’s Reply Brief).

¹²² *Id.*

conditions”¹²³—that is, “the closer the survey methods mirror the situation in which the ordinary person would encounter the trademark, the greater the evidentiary weight of the survey results.” 5 MCCARTHY ON TRADEMARKS § 32:163. *See e.g., American Footwear Corp. v. General Footwear Corp.*, 204 USPQ2d 609 (2d Cir. 1979) (survey rejected for not having been conducted “under actual marketing conditions”). Applicant appears to echo that principle by emphasizing that Dr. Sartore’s survey “is representative of actual market conditions.”¹²⁴

But replicating market conditions is not always the correct standard in cases before the Board, where we are tasked with determining the likelihood of confusion in a party’s right to registration, rather than determining if confusion is likely in the infringement context. *See e.g., Miles Labs., Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986) (“In the case before us, ... the issue we have to decide concerns only the likelihood of confusion of the terms VIT-A-DAY and SUPER VIT-A-DAY with ONE A DAY, without regard to any special form of lettering or design features which may, in fact, be currently associated with either of those word marks in the marketplace. Accordingly, using the card on which the mark is displayed in block letters was the only appropriate stimulus available to the survey designer.”); *Carl Karcher Enters. Inc. v. Stars Rests. Corp.*, 35 USPQ2d 1125, * (TTAB 1995) (finding the applicant’s argument that opposer’s survey needed to include the market areas of both parties “inapposite to the case” because “[t]he issue here involves

¹²³ Initial caps lowered.

¹²⁴ 43 TTABVue 28 (Applicant’s Brief).

applicant's right to a nationwide registration, while the court cases involved infringing use.”).

Indeed, our rules and precedent require us to make a number of presumptions such as those presuming, as we do in this case, that Opposer's Registration identifying “alcoholic beverages except beers” encompasses and thus includes “distilled blue agave liquor” despite the fact that the evidence shows that to date, Opposer has only used its BANDIT mark in connection with wine products (“wine, wine-based hard seltzers and wine cocktails”)¹²⁵ and the marks themselves are not currently used in the same trade channels.¹²⁶

Here, as discussed above, Applicant's expert, Dr. Sartore, used an *Eveready*-style survey, which “does not inform survey respondents what the senior mark is [which in this case is Opposer's mark BANDIT], but assumes that they are aware of the mark from their prior experience.” 5 MCCARTHY ON TRADEMARKS § 32:174. But as Dr. Sartore explained in her discovery deposition, a respondent who hasn't been exposed to the plaintiff's mark cannot provide the plaintiff's mark as an answer in the survey or otherwise express confusion:

Q: ... But it (sic) determining the respondents, right, the respondents, unless they've had prior access or exposure or the opportunity for that, access or exposure to the plaintiff's mark, then, obviously, they won't express any confusion because it's on open-ended question, correct?

¹²⁵ 21 TTABVue 3 (Torkelson Test. Decl. ¶ 7).

¹²⁶ We thus disagree with Prof. McCarthy's statement that “[n]o separate discussion of decisions relating to survey evidence in ex parte or inter partes proceedings in the Patent and Trademark Office is needed, for the same legal criteria [as in other contexts] are applied in administrative proceedings involving the registration of marks.” 5 MCCARTHY'S ON TRADEMARKS § 32:180.

A: If the potential respondent has not been exposed when they've been queried about defendant's mark, but they have not been exposed to plaintiff's, they can't provide plaintiff's if they never been exposed to defendant's. They can't provide plaintiff's if they've never been exposed to plaintiff's. Is that what you're saying?

Q: That's what I'm saying.

A: That's probably true.

Q: And just to sort of illustrate this example, I think if we look at like the geographic split between two marks, keeping in mind, of course, when the Trademark Trial & Appeal Board -- not in an infringement survey, but let's say plaintiff only sells its product in California. Obviously, if you don't have respondents from California, then it's going to be impossible for them to express any confusion because they've never been exposed to that mark because they're not in California; is that correct?

A: Yes. But --

Q: Do you understand what I'm saying?

A: Yes. I've given some exceptions, but okay.

...

Q: So, again, I'm just trying to sort of back it up as far as -- I understand what you're saying, Dr. Sartore. But what I'm trying to get at is if respondents, despite everything you just said, if respondents have never been exposed because they haven't had the opportunity to see plaintiff's mark on plaintiff's goods, then they can't express confusion on under an *Eveready* survey format, correct?

A: Given all the qualifications, yes, that's also correct.¹²⁷

Consequently, we agree with Opposer's assessment that

the fatal flaw of Dr. Sartore's survey and experimental environment which makes it not probative of the principal issue in dispute is obvious: since BANDIT Tequila does not presently exist in the marketplace, yet is protected by the BANDIT registration, it would be impossible for the survey respondents to recall BANDIT Tequila unless they were first

¹²⁷ 36 TTABVue 104-05, 109 (Sartore Disc. Dep., 98:21-99:23, 100:8-19).

exposed to a BANDIT Tequila brand before being exposed to the BREAK OUT THE BANDIDO mark for Tequila. While such a circumstance does not reflect the actual marketplace, it does reflect the trademark registration and trademark application at issue, and likelihood of confusion in this case must be determined based on the four corners of those documents, not the marketplace.¹²⁸

“There is no question that, in order to be probative, a survey must be directed to the relevant issues in the case.” *Miles Labs., Inc. Naturally Vitamin Supplements, Inc.*, 1 USPQ2d 1445, 1459 (1986). Here, it was not, and as a result, we find that the survey is critically defective and thus lacks probative value in showing that confusion is unlikely. *Cf. In re Hotels.com, L.P.*, 87 USPQ2d 1100, **31 (TTAB 2008), *aff’d In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (Genericness survey: “[W]e find that the survey is so seriously flawed that the results cannot be given any weight.”).

b. Other Survey Issues

Opposer contends that there are other survey defects beyond those discussed above, above including the fact that Dr. Sartore’s survey was a “pilot survey” consisting of just 106 respondents.¹²⁹ A pilot survey, sometimes referred to as a pre-test, “is a small field test replicating the procedures planned for the full-scale survey.” 5 MCCARTHY ON TRADEMARKS § 32:163.50. In Dr. Sartore’s words, “[a] pilot survey, simplistically, is one that tests for somewhat less than the total number of questionnaires that you’re going to ultimately rely on in a full-scale study.”¹³⁰

¹²⁸ 44 TTABVUE 22 (Opposer’s Reply Brief).

¹²⁹ 32 TTABVUE 6 (Sartore Test. Decl., Exhibit 1).

¹³⁰ 36 TTABVUE 23 (Sartore Disc. Dep., p. 17:19-23).

Opposer argues that Dr. Sartore’s report “provides no explanation or justification” for her conclusion that “unless there is a particular alteration in the environment, it would be [her] expectation, given the above-described results [of zero confusion] that results of a full study (i.e., 200 test cell interviews and 200 control cell interviews) would not be anticipated to vary significantly from that of the pilot.”¹³¹ Opposer also points out Dr. Sartore “acknowledged that given the small number of respondents in her survey, the results would be less reliable if the survey had any imperfections” and that she was “unaware of any trademark cases where a court found a ‘pilot’ survey to be reliable.”¹³²

We agree that there may be issues related to the use of a pilot, and certainly there are issues related to a survey that has an inadequate sample size. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1830-32 (TTAB 2015) (concluding that the results of a sample of 201 respondents in a likelihood of confusion survey were “probative, although not strong, evidence that confusion is likely,” but noting that “at some point, a small sample may provide results potentially so low or so imprecise as to be of little or no value in inferring the rate of confusion among all relevant consumers.”). But sample size is not likely to change the outcome here because the central problem with Applicant’s survey is that it does not match the context in which we must decide this case and that shortcoming will not change as more persons are asked the survey questions. As Dr. Sartore explained in her

¹³¹ 44 TTABVUE 26 (quoting Sartore Test. Decl., Expert Report).

¹³² *Id.* at 26-27 (quoting Sartore Disc. Dep., 36 TTABVUE 26 (pp. 20:11-27:8), 42 (p. 36:3-9)).

deposition, she was “testing whether BREAK OUT THE BANDIDO causes confusion with BANDIT for wine,”¹³³ which is the wrong standard given the facts of this case.

Opposer also argues that the survey was defective because Applicant “failed to demonstrate that the proper universe was utilized” in the survey.¹³⁴ Opposer notes that Dr. Sartore “fails to discuss her selection of universe or sampling methodology”; “fails to evidence if there were any gender or age quotas, with the quota percentages shown as ‘XX%’ or if there were any census region population quotas reflecting the four census regions, with those percentages also shown as ‘XX%’” and provides no explanation why respondents were 46.6% male to 53.4% female quota was selected.”¹³⁵ We agree with Opposer that “the burden is on the proponent of a survey to show that the sampling of the universe conforms with recognized statistical standards,” a burden Applicant has not met in this case.

c. Conclusion about Applicant’s survey

“Survey evidence is subject to review for its probative value, based on factors including the design of the survey, the questions asked, and the experience of the surveyor.” *In re Hotels.com LP*, 91 USPQ2d at 1536 (finding a genericness survey “so seriously flawed that the results cannot be given any weight.”). Here, “[t]here are, no doubt, fundamental design and execution defects in the study, as outlined by [Dr. Sartore], which would tend to cast a heavy shadow over the reliability of the survey.

¹³³ 36 TTABVUE 111 (Sartore Disc. Dep., p. 111:6

¹³⁴ 44 TTABVUE 25 (Opposer’s Reply Brief) (initial caps lowered).

¹³⁵ *Id.* (citing the Federal Judicial Center’s MANUAL FOR COMPLEX LITIGATION, 377-389 (3rd ed. 2011)).

.... All in all, the survey does not help applicant's position.” *McDonough Power Equip., Inc. v. Weed Eater, Inc.*, 208 USPQ 676, 684-85 (TTAB 1981).

8. Extent of Potential Confusion

Under the twelfth *DuPont* factor, we consider “[t]he extent of potential confusion, i.e., whether de minimis or substantial,” *DuPont*, 177 USPQ at 567, Opposer argues that the potential for confusion is “substantial” and therefore favors a finding of likelihood of confusion.¹³⁶ First, Opposer argues that because the marks are in standard characters, “BREAK OUT THE BANDIT could be used in any manner whatsoever, including in a style similar to Opposer’s use of its BANDIT mark, or in a manner that diminishes the significance of the terms ‘BREAK OUT THE’ e.g.:

Break out the
BANDIDO [.]”¹³⁷

While theoretically possible, there is no support for the contention that Applicant is likely to break apart the mark in this way, even if it used to refer to Applicant’s own tequila brand. We further disagree with Opposer that there is a “significant risk that consumers encountering Applicant’s BREAK OUT THE BANDIDO mark in the marketplace will incorrectly assume it is a slogan, derivative or off-shoot for the BANDIT brand (or vice versa).”¹³⁸ To the contrary, we find such an assumption highly

¹³⁶ 41 TTABVUE 31 (Opposer’s Brief).

¹³⁷ *Id.*

¹³⁸ *Id.*

unlikely because we find, under critical first *DuPont* factor, that the marks are very different in overall appearance, sound, connotation and commercial impression. Accordingly, we find that the potential for confusion is *de minimis*.

The twelfth *DuPont* factor weighs against a finding of likelihood of confusion.

C. Balancing the *DuPont* factors

We have found that the second and third *DuPont* factors (relating to the similarity of the goods and their trade channels) favor a finding of likelihood of confusion, the second heavily so. And we have found that Opposer's mark is conceptually strong with slight commercial strength, and thus should be accorded a slightly higher scope of protection than ordinary marks without commercial strength.

We have also found that the first and twelfth *DuPont* factors (relating to the similarity of the marks and the extent of potential confusion) weigh against a finding of likelihood of confusion, the first heavily so.

And we have found the fourth, seventh, eighth, ninth and thirteenth factors (relating to actual confusion, the variety of goods provided under Opposer's mark, and Applicant's survey evidence) neutral.

Any of the *DuPont* factors may play a dominant role. *DuPont*, 177 USPQ at 567. In fact, in some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). This is one of those cases. Indeed, the dissimilarity of the marks in appearance, sound, connotation, and commercial impression is so great as to outweigh the other *DuPont* factors. For that reason, the first *DuPont* factor (our "predominant inquiry," *Herbko*, 64 USPQ2d

at 1380) is pivotal in our opinion that confusion is unlikely as between the mark BANDIT in the Application and the mark BREAK OUT THE BANDIDO in Opposer's Registration.

Decision: The opposition is dismissed.