

This Opinion is Not a
Precedent of the TTAB

Mailed: July 31, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sazerac Brands, LLC
v.
Buffalo City Distillery, LLC

Cancellation No. 92079064

Cynthia Johnson Walden, Ryan C. Steinman, Ryan E. Thomas, and Nathan C. Ranns
of Fish & Richardson, P.C. for Sazerac Brands, LLC.

Norman J. Leonard, Joseph A. Schouten, and Angela P. Doughty of Ward and Smith,
P.A., for Buffalo City Distillery, LLC.

Before Pologeorgis, English and Stanley,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Respondent, Buffalo City Distillery, LLC, owns a registration on the Principal
Register for the standard-character mark BUFFALO CITY for “alcoholic beverages
except beers; distilled spirits” in International Class 33.¹

¹ Registration No. 6615641, issued on January 11, 2022. The underlying application was
filed on April 16, 2018 based on an allegation of an intent to use the mark in commerce
under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Respondent filed a Statement
of Use in connection with the application on November 16, 2021, alleging first use and first
use in commerce at least as early as November 11, 2021.


Petitioner, Sazerac Brands, LLC, has petitioned to cancel the registration alleging a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with its prior used common law mark BUFFALO TRACE and marks consisting of or incorporating buffalo designs, all for bourbon, and the following marks registered on the Principal Register:

- BUFFAL TRACE (typeset) for “bourbon” in International Class 33;²
- BUFFALO TRACE (standard characters) for “alcoholic beverages, namely, distilled spirits” in International Class 33;³

BUFFALO TRACE

- **BUFFALO TRACE** for “bourbon” in International Class 33 as well as “glassware, namely, beverage glasses and shot glasses” in International Class 21 and “clothing and headgear, namely, shirts, sweatshirts, t-shirts, jackets, caps and hats” in International Class 25;⁴



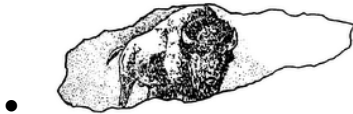
-  for “bourbon” in International Class 33 as well as “clothing and headgear, namely, shirts, sweatshirts, t-shirts, jackets, caps and hats” in International Class 25;⁵

² Registration No. 2294792 (the “792 Registration”), issued on November 23, 1999; twice renewed. A mark in typeset is the legal equivalent of a standard character mark. *In re Vittera, Inc.*, 671 F.3d 1358, 1363, n.2 (Fed. Cir. 2012).

³ Registration No. 4859200, issued on November 24, 2015; Section 8 & 15 declaration accepted and acknowledged.

⁴ Registration No. 2622735, issued on September 24, 2002; twice renewed. The registration does not include a description of the mark.

⁵ Registration No. 2601650, issued on July 30, 2002; twice renewed. The registration does not include a description of the mark.



- for “bourbon” in International Class 33;⁶



- for “paper products, namely, paper napkins” in International Class 16 and “clothing and headgear, namely, shirts, sweatshirts, t-shirts, jackets, caps and hats” in International Class 25;⁷ and
- BUFFALO TRACE DISTILLERY WHITE DOG (standard characters, “DISTILLERY WHITE DOG” disclaimed) for “whiskey” in International Class 33.⁸

In its answer, Respondent admits that “Petitioner and its affiliates market and sell different types and brands of alcoholic beverages and distilled spirits,” such as vodkas, whiskeys, tequilas, liqueurs, and other spirits;⁹ that it “was aware of one or more of the Cited Marks” when it filed its application for the BUFFALO CITY mark;¹⁰ and that it received an October 16, 2018 cease and desist letter from Petitioner’s counsel.¹¹ Respondent otherwise denies the salient allegations in the petition for cancellation.¹²

⁶ Registration No. 2476423, issued on August 7, 2001; twice renewed. The registration does not include a description of the mark.

⁷ Registration No. 2516318, issued on December 11, 2001; twice renewed. The registration does not include a description of the mark.

⁸ Registration No. 3835562, issued on August 17, 2010; renewed.

⁹ Petition, 1 TTABVUE 8, ¶ 3; Answer, 4 TTABVUE 3, ¶ 3.

¹⁰ Petition, 1 TTABVUE 11, ¶ 13; Answer, 4 TTABVUE 5, ¶ 13.

¹¹ Petition, 1 TTABVUE 11, ¶ 14; Answer, 4 TTABVUE 5, ¶ 14.

¹² 4 TTABVUE. Respondent also asserts a few purported “affirmative defenses.” *Id.* at 7, ¶¶ 26-29. The first affirmative defense, failure to state a claim, is not a true affirmative defense and will be given no consideration because it relates to an assertion of the insufficiency of the pleading rather than a statement of a defense to the merits of a claim. *Tequila Cuadra S. de RL de CV v. Manufacturera de Botas Cuadra, S.A. de C.V.*, Opp. No.

The case is fully briefed.¹³ To prevail on its Trademark Act Section 2(d) claim, Petitioner must prove by a preponderance of the evidence its entitlement to a statutory cause of action, priority and likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 951 (Fed. Cir. 2000). We find Petitioner has met its burden; we grant the petition for cancellation.

I. Record

The record includes the pleadings, the submissions of the parties during their respective trial periods, and, by rule, Respondent's registration file. *See* Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1). Although we do not list the contents of the record, we have reviewed and considered it in its entirety. *See Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021) ("We have held 'on multiple occasions that failure to explicitly discuss every issue or every piece of evidence does not alone establish that the tribunal did not consider it.'" (quoting *Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017))); *In re Miracle Tuesday LLC*, 695 F.3d 1339, 1348 (Fed. Cir. 2012) ("[T]he mere fact that the Board did not

91282327, 2025 WL 1431504, at *1 n.3 (TTAB 2025). The second and third affirmative defenses are mere amplifications of Respondent's denial that there is a likelihood of confusion, and we treat them as such. *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, Opp. No. 91263919, 2022 WL 16646840, at *1 n.5 (TTAB 2022). Respondent has waived its fourth affirmative defense alleging "waiver, estoppel, laches and/or acquiescence" because it did not pursue these defenses in its brief. *Tequila Cuadra*, 2025 WL 1431504, at *1 n.3.

¹³ Petitioner's Brief, 92 TTABVUE (confidential); 100 TTABVUE (public); Respondent's Brief, 94 TTABVUE (public), 95 TTABVUE (confidential); Rebuttal Brief, 97 TTABVUE (confidential), 98 TTABVUE (public). Petitioner refiled the public version of its brief at 100 TTABVUE because the original version at 93 TTABVUE inadvertently contained confidential material. *See* 96 TTABVUE and 99 TTABVUE. Thus, Petitioner's public brief has a later docket entry number than later-filed briefs.

recite all of the evidence it considered does not mean the evidence was not, in fact, reviewed.” (citing *Plant Genetic Sys., N.V. v. Dekalb Genetics Corp.*, 315 F.3d 1335, 1343 (Fed. Cir. 2003))).

II. Petitioner’s Objection to Respondent’s Expert Testimony

Respondent introduced the expert report and declaration of Mark Keegan¹⁴ in an effort to rebut the *Squirt*-style lineup likelihood of confusion survey conducted by Petitioner’s expert, Sarah Butler, Managing Director at NERA Economic Consulting (“NERA”).¹⁵ Petitioner objects to and seeks to exclude Keegan’s testimony and expert report on the grounds that: (1) Keegan is “not qualified to opine” on the survey because of the “speculative narrative and legal conclusions” in his testimony; and (2) Keegan’s “opinion that Ms. Butler set up a ‘best fit’ exercise is unreliable because it fails to account for a generally well accepted survey technique employed for measuring the likelihood of confusion between two marks.”¹⁶

Petitioner’s objections are overruled. Based on the record before us, we find that Mr. Keegan is qualified as an expert to opine on the Butler survey. As to his opinions and conclusions, we are capable of determining whether they are speculative or unreliable.

¹⁴ Keegan Decl. and Expert Rebuttal, 44 TTABVUE.

¹⁵ Butler Decl. and Expert Report, 42 TTABVUE.

¹⁶ Appendix to Petitioner’s Brief, 100 TTABVUE 58.

III. Background

Buffalo Trace Distillery is the “oldest continuously operating distillery in America ... making bourbon whiskey for more than 200 years.”¹⁷ It is designated as a National Historic Landmark, and is “the most award-winning distillery in the world, garnering more than 1,000 awards for its wide range of premium whiskeys” sold under a number of different brands.¹⁸ It was not until 1999, however, that the distillery was “rechristened” Buffalo Trace.¹⁹ Since then, Petitioner has sold its flagship BUFFALO TRACE bourbon, winning more than one hundred “different awards and accolades since 2009.”²⁰

Respondent more recently entered the distilled spirits market as a way to utilize “some agricultural land in Eastern North Carolina,” owned by Respondent’s manager, Clifford “Buddy” Byrum.²¹ Mr. Byrum’s property is near the Outer Banks, “a string of barrier islands off the coast of North Carolina.”²² Because the Outer

¹⁷ Declaration of Andrew Duncan, Global Brand Director, American Whiskey, at Sazerac Company, Inc., the parent corporation of Petitioner (“Duncan Decl.”), 31 TTABVUE 4, ¶ 11.

¹⁸ *Id.* at 4-5, ¶ 11.

¹⁹ Duncan Decl., 31 TTABVUE 67 (Page from Petitioner’s website including statement that the distillery was “rechristened as the Buffalo Trace Distillery” in 1999). Respondent treats this statement on Petitioner’s website as true. Respondent’s Brief, 94 TTABVUE 21, n.7 (“Petitioner only adopted the name BUFFALO TRACE in 1999 after it bought the distillery from someone else in 1992.”). We thus deem that portion of Petitioner’s internet evidence as stipulated into the record for the truth of the matter stated. *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, Opp. No. 91221553, 2018 WL 1326374, at *4 (TTAB 2018) (“[T]o the extent that a party has accepted as fact any portion of this Internet evidence submitted by the adverse party, we deem such portions of the submitted Internet evidence stipulated into the record for the truth of any matters asserted therein.”).

²⁰ Duncan Decl., 31 TTABVUE 15, ¶ 23.

²¹ Declaration of Clifford “Buddy” C. Byrum Jr. (“Byrum Decl.”), 45 TTABVUE 4, ¶ 12.

²² *Id.* at 4, ¶ 15.

Banks “receives millions of visitors” annually, and many of these visitors return year after year, Respondent decided to establish its distillery in Point Harbor, North Carolina, “located along a highway that is a primary gateway into the Outer Banks.”²³ Mr. Byrum “wanted [Respondent’s] branding to be tied to the history and culture of the Outer Banks region.”²⁴ Eventually, Mr. Byrum decided to brand his distillery and distilled spirits under the BUFFALO CITY mark, “a ghost town ... that once existed in the Outer Banks region and was at one time called ‘the Moonshine Capital of North Carolina.’”²⁵

IV. Entitlement

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128 n.4 (2014)). A party in the position of plaintiff may petition to cancel a registration when the cause of action is within the zone of interests protected by the statute, and the plaintiff has a reasonable belief in damage that is proximately caused by the continued registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1305-06 (Fed. Cir. 2020).

Petitioner introduced with its petition for cancellation printouts from the Office’s TSDR database showing that it owns the pleaded registrations, which remain valid

²³ *Id.* at 5, ¶¶ 17, 19.

²⁴ *Id.* at ¶ 20.

²⁵ *Id.* at 6, ¶ 22.

and subsisting.²⁶ Moreover, for “this Proceeding only, [Respondent] does not dispute Petitioner may maintain its statutory cause of action based on its pleaded registrations.”²⁷ Petitioner thus has entitlement to pursue its likelihood of confusion claim. *Cunningham v. Laser Golf*, 222 F.3d at 945-46 (pleaded registrations “suffice to establish ... direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest); *Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 WL 2188890, at *9 (TTAB 2022) (pleaded registrations demonstrated entitlement to bring Section 2(d) claim).

V. Priority

“In a cancellation proceeding such as this one where both parties own registrations, priority is in issue.” *Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 WL 6072822, at *7 (TTAB 2021) (citations and quotation marks omitted). Petitioner must prove that it has a proprietary interest in its pleaded marks obtained before any date of priority on which Respondent may rely. *Id.* To do so, Petitioner may rely on the filing dates of the applications underlying its pleaded registrations. *See, e.g., Calypso Tech. Inc. v. Calypso Cap. Mgmt. LP*, Can. No. 92049489, 2011 WL 4090446, at *7 (TTAB 2011) (petitioner’s priority established based on filing date of application underlying its pleaded registration); *Christian Broad. Network Inc. v. ABS-CBN Int’l*, Can. No. 92044366, 2007 WL 2253483, at *5 (TTAB 2007) (where both petitioner and respondent are owners of registrations,

²⁶ 1 TTABVUE 14-100.

²⁷ Respondent’s Brief, 94 TTABVUE 18, n.6.

petitioner must prove priority of use and may rely on filing date of its application for registration to do so).

Respondent's application filing date is later than each of Petitioner's filing dates and the record shows that Respondent did not use its mark before Petitioner filed its applications.²⁸ Moreover, for "this Proceeding only, [Respondent] does not dispute ... that Petitioner's Marks have priority with respect to the goods in its pleaded registrations."²⁹

Petitioner thus has priority in each of its registered marks for the identified goods.

VI. Likelihood of Confusion

Section 2(d) prohibits registration of a mark that "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 [or respondent], to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d).

To determine whether Petitioner has proven confusion is likely, we evaluate evidence bearing on the several factors listed in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont*"). *See, e.g., Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020). The first two listed factors are the similarities and/or dissimilarities between the parties' marks and

²⁸ 1 TTABVUE 14-100.

²⁹ Respondent's Brief, 94 TTABVUE 18, n.6.

goods/services. *DuPont*, 476 F.2d at 1361. These are key factors in any case under Section 2(d). *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *In re Max Cap. Grp. Ltd.*, Ser. No. 77186166, 2010 WL 22358, at *1 (TTAB 2010) (“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services.”) (citations omitted).

“No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010); *see also In re Charger Ventures LLC*, 64 F.4th 1375, 1381 (Fed. Cir. 2023) (citation omitted) (“The weight given each factor depends on the circumstances of each case.”); *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022) (“Not all of the ... factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case.”) (cleaned up; citation omitted).

In assessing Petitioner’s likelihood of confusion claim, we focus on the Petitioner’s typeset registered mark BUFFALO TRACE for “bourbon” (subject to the “’792 Registration”). If we find confusion likely between Respondent’s mark and the mark subject to the ’792 Registration, we need not consider the likelihood of confusion between Respondent’s mark and Petitioner’s other pleaded marks, including its common law marks.

A. Similarities and Dissimilarities between the Goods, Trade Channels and Consumers and Purchasing Conditions³⁰

Under the second, third and fourth *DuPont* factors, we consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” “[t]he similarity or dissimilarity of established, likely-to-continue trade channels,” and “[t]he conditions under which and buyers to whom sales are made, i. e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361. We must base our comparisons under these *DuPont* factors on the goods identified in the parties’ registrations. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323-25 (Fed. Cir. 2014) (consumer sophistication must be based on identified goods and services not on current use); *Sabhnani*, 2021 WL 6072822, at *8 (“[A]s with the relatedness of the goods, the similarity or dissimilarity of the channels of trade must be determined based on the identifications of goods in the parties’ registrations[.]”).

Respondent’s identification of goods, namely, “alcoholic beverages except beers; distilled spirits” is broad enough to encompass “bourbon” identified in Petitioner’s ’792 Registration. *Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 WL 417620, at *7 (TTAB 2023) (“If an application or registration describes goods or services broadly, and there is no limitation as to their nature, it is presumed that the ‘registration encompasses all goods or services of the type described.’”). The goods are thus legally identical, in part.

³⁰ Respondent does not address the second, third or fourth *DuPont* factors.

Moreover, because the '792 Registration and Respondent's registration do not include any restrictions on trade channels or consumers, we must presume that the parties' legally-identical goods are sold through the same channels of trade to the same consumers. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) ("With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and 'presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods."); *Stone Lion*, 746 F.3d at 1323 (Board correctly presumed that the trade channels and consumers were the same with respect to the parties' legally identical services).

In addition, in response to requests for admission, Respondent admitted that the "alcoholic beverages identified in the BUFFALO CITY Registration": (1) "travel in the same or similar channels of trade as the alcoholic beverages identified in Petitioner's registrations"; (2) "are marketed to similar classes of purchasers as the alcoholic beverages identified in Petitioner's Registrations"; and (3) "are or will be sold or offered for sale in the same retail stores."³¹

Turning to purchasing conditions, purchaser sophistication and care in making a purchase may tend to minimize likelihood of confusion while impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1376 (Fed. Cir. 2005).

³¹ Petitioner's Notice of Reliance ("NOR") on Discovery Materials, 38 TTABVUE 131-32 (admitting Requests for Admission Nos. 17-19).

We must base our decision on the least sophisticated purchasers of the parties' products. *Stone Lion*, 746 F.3d at 1325. Petitioner argues that given this principle, "the Board must presume that the parties' goods are accessible to impulse purchasers."³²

Neither Respondent's registration nor Petitioner's '792 Registration includes any price restrictions. Thus, we must consider that the parties' goods are sold at all price points for such goods. *Sock It To Me, Inc. v. Fan*, Opp. No. 91230554, 2020 WL 3027605, *10 (TTAB 2020) (where there are no limitations in the identification, goods encompass "all goods of the type identified, without limitation as to their nature or price"). The record shows that the parties' goods are a type that may be sold at relatively low prices. A 750 ml bottle of Petitioner's BUFFALO TRACE bourbon whiskey "is typically sold to the end-consumer at a retail price ranging from approximately \$24.99 to \$39.99."³³ Similarly, Respondent sells or intends to sell 750 ml bottles of its BUFFALO CITY whiskey and vodka for between \$27.95 to \$59.60.³⁴ The lower end of these price ranges in particular are relatively inexpensive. We thus find that the least sophisticated purchasers of the goods identified in Respondent's registration and Petitioner's '792 Registration are ordinary consumers purchasing on impulse.

³² Petitioner's Brief, 100 TTABVUE 38 (internal citations omitted).

³³ Duncan Decl., 31 TTABVUE 20, ¶ 34.

³⁴ Petitioner's NOR on Discovery Materials, 38 TTABVUE 113, 119 (Respondent's Second Supplemental Response to Interrogatory No. 14, verified July 18, 2023).

B. Strength of Petitioner's BUFFALO TRACE Mark

Next, we assess the strength of Petitioner's BUFFALO TRACE mark because it affects the scope of protection to which Petitioner's mark is entitled. *Made in Nature v. Pharmavite*, 2022 WL 2188890, at *12. We consider Petitioner's evidence and arguments concerning the commercial strength of Petitioner's BUFFALO TRACE mark under the fifth *DuPont* factor, and we consider Respondent's evidence and arguments concerning the commercial weakness, as well as the conceptual strength or weakness, of Petitioner's mark under the sixth factor. *See, e.g., Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (There are "two prongs of analysis for a mark's strength under the sixth [*DuPont*] factor: conceptual strength and commercial strength."); *Made in Nature v. Pharmavite*, 2022 WL 2188890, at *11 (quoting *DuPont*, 476 F.2d at 1361).

1. Fifth *DuPont* factor

Commercial strength under the fifth *DuPont* factor may be proven through direct evidence, such as consumer polls, as well as indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the mark; and the general reputation of the goods. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002); *Made in Nature v. Pharmavite*, 2022 WL 2188890, at *16; *Weider Pubs., LLC v. D & D Beauty Care Co.*, Opp. No. 91199352, 2014 WL

343269, at *6 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

a. The Parties' Arguments and Evidence

Petitioner argues under the fifth *DuPont* factor that its BUFFALO TRACE mark has “substantial commercial and marketplace strength.”³⁵ In support, Petitioner asserts that Respondent’s “principal acknowledges the well-known nature of Petitioner’s Marks”³⁶ and cites indirect evidence of commercial strength, namely, Petitioner’s sales, advertising, unsolicited media attention, and awards. Respondent challenges the probative value of this latter evidence and cites “the only direct evidence in the record,” namely, Petitioner’s consumer brand studies, to support its contention that Petitioner’s mark BUFFALO TRACE is not commercially strong.³⁷

• **Byrum’s Admission**

We address first the admission of Mr. Byrum, Respondent’s Manager. During the process of choosing a mark for Respondent’s distilled spirits, Mr. Byrum acknowledged that “there is a well known [sic] quality large Kentucky distiller ... Buffalo Trace[.]”³⁸ The fact that Respondent’s own manager admits that BUFFALO

³⁵ Petitioner’s Brief, 100 TTABVUE 41. Petitioner made clear it “does not argue that its BUFFALO Marks are famous.” Petitioner’s Rebuttal Brief, 98 TTABVUE 17 (emphasis omitted).

³⁶ Petitioner’s Rebuttal Brief, 98 TTABVUE 5; *see also* Petitioner’s Brief, 100 TTABVUE 19.

³⁷ Respondent’s Brief, 94 TTABVE 26-27.

³⁸ Petitioner’s NOR on Discovery Materials, 38 TTABVUE 125, Request for Admission No. 1 (admitting that document bearing Bates number BCD_0000002 is a true and authentic copy of a genuine original e-mail from Buddy Byrum to David Jones dated November 10, 2017); *see id.* at 288 (copy of referenced email); *see also* Petitioner’s NOR on Discovery

TRACE is a well-known distiller is persuasive evidence of the mark's commercial strength for bourbon.

- **Advertising Expenditures**

Andrew Duncan, Petitioner's Global Brand Director, testified that Petitioner has "invested a great deal of financial resources" to promote the BUFFALO TRACE brand in the United States.³⁹ Petitioner's U.S. advertising expenditures were filed under seal so we do not refer to specifics but, in general, Petitioner's raw advertising expenditures between 2019 to 2023 are substantial.⁴⁰

Respondent criticizes the probative value of Petitioner's advertising expenditures on grounds that Petitioner has "provide[d] precisely zero context for that raw dollar figure";⁴¹ and based on highly confidential "brand health" reports⁴² that Petitioner commissioned from a third party.⁴³

Contrary to Respondent's argument, there is some context for Petitioner's raw advertising expenditures, namely, one of the referenced "brand health" reports and

Materials, 37 TTABVUE 290 (confidential) (email from Byrum referring to "trademark disputes with a **major brand** over the use of the word BUFFALO") (emphasis added); *id.* at 228 (Byrum testifying for Respondent under Fed. R. Evid. 30(b)(6) that the "major brand" referenced was BUFFALO TRACE). Even though this evidence was filed under seal, it is publicly known that Respondent and Petitioner are involved in the instant proceeding. Trademark Rule 2.116(g).

³⁹ Duncan Decl., 31 TTABVUE 16, ¶ 26.

⁴⁰ Duncan Decl., 28 TTABVUE 16, ¶ 26 (confidential).

⁴¹ Respondent's Brief, 94 TTABVUE 30.

⁴² Duncan Rebuttal Decl., 83 TTABVUE 4, ¶ 12 (confidential).

⁴³ Respondent's Brief, 95 TTABVUE 30 (confidential).

Mr. Duncan's testimony regarding the same.⁴⁴ Because the evidence is confidential, we do not address it specifically, but we find it supports that Petitioner's advertising expenditures have been significant in the field of bourbon and whiskey. Moreover, we find Petitioner's promotional expenditures for its BUFFALO TRACE brand significant on their face.

- **Online Promotion**

As to its methods of advertising, Petitioner has promoted the BUFFALO TRACE brand on its website at <buffalotrace.com> "for approximately 25 years."⁴⁵ The website "showcases BUFFALO TRACE whiskey," describes how the bourbon is made, and "highlights" the brand's "recent awards."⁴⁶ The record, however, does not reflect how many unique visitors Petitioner has to the website annually.

With respect to social media promotion, Mr. Duncan testified that Petitioner has the following "BUFFALO TRACE dedicated social media pages":⁴⁷

- Facebook page since March 2009 with over 441,000 followers;
- Twitter (now X) page since May 2011 with over 92,300 followers;
- Instagram page since November 2012 with over 300,000 followers, placing this account in the top five percent of Instagram users in North America; and
- YouTube channel since April 2009 with over 17,000 subscribers, and nearly 4,500,000 views.

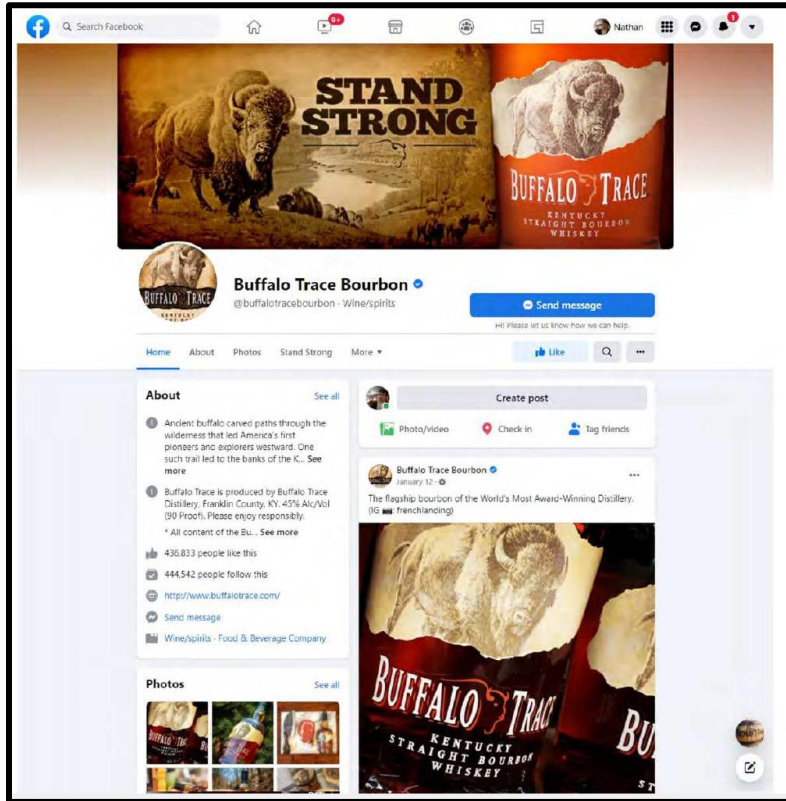
⁴⁴ Duncan Rebuttal Decl., 83 TTABVUE 4-5, ¶ 12 (confidential); *see also* Rule 30(b)(6) deposition of Petitioner, 51 TTABVUE 70-73 (explaining limitations of information in report with respect to marketing spend) (confidential).

⁴⁵ Duncan Decl., 31 TTABVUE 7, ¶ 16.

⁴⁶ *Id.* at 7-8, ¶ 16.

⁴⁷ *Id.* at 12, ¶ 22; Duncan Rebuttal Decl., 84 TTABVUE 5, ¶ 13.

A screenshot from Petitioner’s BUFFALO TRACE-dedicated Facebook page, shown below, prominently features Petitioner’s BUFFALO TRACE mark.⁴⁸



There are a couple of limitations on Petitioner’s evidence. The record does not reflect how frequently Petitioner posts content to its social media accounts. Nor do we know the percentage of social media followers inside the United States as opposed to ex-U.S. *Cf. Ifit Inc v. ERB Indus., Inc.*, Opp. No. 91264855, 2024 WL 3355220, at *4 (TTAB 2024) (“Federal Circuit decisions on trademark fame and strength focus on United States rather than foreign use.”). Nevertheless, the number of BUFFALO TRACE bourbon social media followers and visitors is significant enough for us to

⁴⁸ Duncan Decl., 31 TTABVUIE 13, ¶ 22; 33 TTABVUE 43.

infer meaningful U.S. consumer exposure to Petitioner’s BUFFALO TRACE social media outlets regardless of the frequency of Petitioner’s posts. In addition, the BUFFALO TRACE brand has a stronger INSTAGRAM following than “notable bourbon brands such as Maker’s Mark (220,000 followers), Jim Beam (167,000 followers), Woodford Reserve (149,000 followers), Bulleit (173,000 followers), Knob Creek (79,300 followers), Four Roses (173,000 followers), Basil Hayden (62,200 followers), Elijah Craig (102,000 followers), Eagle Rare (99,000 followers), and Weller (71,7000 followers).”⁴⁹

- **Experiential Marketing and Promotional Goods**

Petitioner also takes “an experiential approach” to marketing its BUFFALO TRACE whiskey, engaging end-users directly “at bars, restaurants, retail stores and social events.”⁵⁰ For example, each year, Petitioner hosts “over 60 consumer tastings related to the BUFFALO TRACE brand” through which it teaches consumers about BUFFALO TRACE whiskey and shares the brand’s story.⁵¹ Petitioner also sells and distributes promotional goods, including at its direct-to-consumer events.⁵² Such

⁴⁹ Duncan Rebuttal Decl., 84 TTABVUE 5, ¶ 13. Respondent argues that “the follower and subscriber numbers for [Petitioner’s BUFFALO TRACE] goods and services compare unfavorably to marks found to be famous for likelihood of confusion purposes.” Respondent’s Brief, 94 TTABVUE 32. But “Petitioner does not argue that its BUFFALO Marks are famous.” Petitioner’s Rebuttal Brief, 98 TTABVUE 17 (emphasis omitted). Rather, it asserts that its mark has “substantial commercial and marketplace strength.” Petitioner’s Brief, 100 TTABVUE 41.

⁵⁰ Duncan Decl., 31 TTABVUE 9, ¶ 18.

⁵¹ *Id.*

⁵² *Id.* at 10, ¶ 19.

goods include hoodies and decanters.⁵³ In 2023, Petitioner “distributed over 41,000 pieces distributed of BUFFALO TRACE branded merchandise.”⁵⁴ Absent from the record, however, is information regarding how many years Petitioner has been engaged in such “experiential” marketing and selling/distributing promotional items, how many consumers attend tastings or other BUFFALO TRACE events and the geographic scope of such promotions.

Next, Petitioner “works with its national and regional on premise accounts” to promote its BUFFALO TRACE bourbon through “product features, drink specials, specialty drinks, and branded menus.”⁵⁵ Petitioner also “fosters relationships with bartenders and other industry members” who can directly promote the BUFFALO TRACE brand to consumers, and promotes its “BUFFALO TRACE bourbon whiskey in e-mail newsletters sent to members of the trade interested in recent news about Sazerac’s various brands.”⁵⁶ Again, however, some pertinent information is lacking. We do not know how often Petitioner promotes and provides BUFFALO TRACE drink specials and the like, how many consumers encounter such promotions, how many bartenders are part of Petitioner’s network, how often and to how many industry insiders Petitioner sends its newsletter or for how long Petitioner has been engaged in such activities.

⁵³ *Id.* at 11, ¶ 19.

⁵⁴ *Id.* at 10, ¶ 19.

⁵⁵ *Id.* at 11, ¶ 20.

⁵⁶ *Id.* at 11-12, ¶ 21.

- **Awards**

With respect to the referenced awards, Petitioner’s BUFFALO TRACE bourbon has earned more than 100 awards and accolades since 2009, e.g. 2023 Silver New York World Wine & Spirits Competition and 2023 Gold San Francisco World Spirits Competition.⁵⁷ And “[r]ecently, Buffalo Trace was named ‘Distiller of the Year’ by Whiskey Magazine.”⁵⁸ Petitioner “promotes these awards as well as other BUFFALO TRACE brand-related news in press releases that are often reprinted in third-party publications and websites.”⁵⁹ But just as we do not know the number of visitors to Petitioner’s website, the record does not reflect the circulation of or consumer exposure to such press releases or the referenced Whiskey Magazine. We further keep in mind that some of these awards appear to be from industry competitions conducted outside the United States, e.g. 2023 Gold Singapore World Spirits Competition. We are concerned with the commercial strength of the BUFFALO TRACE mark in the United States.

- **Traditional Advertising**

Lastly, with respect to more traditional media, Petitioner has promoted its BUFFALO TRACE brand through television, print and billboards.⁶⁰ Mr. Duncan testified that Petitioner has placed “print and digital advertisements for its

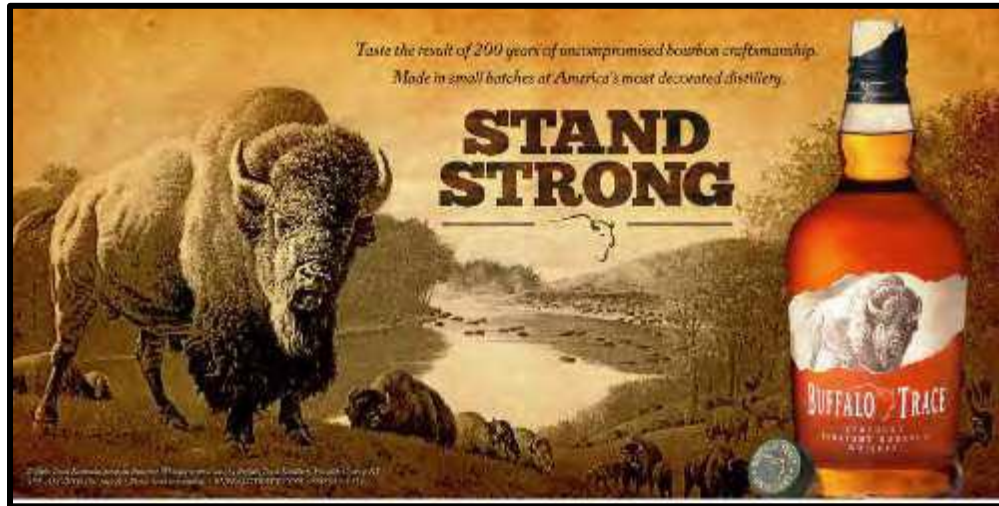
⁵⁷ *Id.* at 15, ¶ 23.

⁵⁸ *Id.* at 5, ¶ 11.

⁵⁹ *Id.* at 16, ¶ 25.

⁶⁰ *Id.* at 9, ¶ 18.

BUFFALO TRACE bourbon whiskey in trade publications over the years.”⁶¹ An example is below:⁶²



The record, however, does not contain many details about such advertising. For example, we do not know the yearly number of such advertisements or the scope of consumer exposure to such advertising, including geographic reach. *Cf. Ifit v. Erb Indus.*, 2024 WL 3355220, at *6 (finding evidence of unsolicited media attention “overstated” because, among other things, record lacked information regarding how many U.S. consumers had been exposed to the articles).

- **Unsolicited and Third-Party Media Attention**

Turning to unsolicited and third-party media attention, Mr. Duncan testified that unsolicited “[a]rticles about BUFFALO TRACE bourbon whiskey have appeared in a wide range of publications and websites from nationwide news publications and magazines such as *Forbes*, *Whisky Magazine*, and *TheStreet*, to local/regional news

⁶¹ *Id.* at 8, ¶ 17.

⁶² *Id.*

outlets such as The Lane Report and Lexington Herald” as well as websites.⁶³ Mr. Duncan further testified that third-party media coverage for the BUFFALO TRACE brand reached an exceptionally significant number of global impressions “in just the last year alone.”⁶⁴

Petitioner did not break out the number of impressions attributable to U.S. consumers but many of the articles appear to have been published in the U.S.,⁶⁵ and therefore we can infer that the number of media impressions in the U.S. is significant and supports that there has been some U.S. consumer exposure to these articles.

Respondent criticizes the articles on the ground that some of them are duplicates and “a significant percentage of these pieces only mentions BUFFALO TRACE in passing, or along with many other third-party products.”⁶⁶ Contrary to Respondent’s assertion, publication of the same story by multiple different media outlets supports Petitioner’s assertion of commercial strength because it increases potential media impressions. Moreover, while there are some articles that appear to mention the BUFFALO TRACE brand in passing, several articles tout BUFFALO TRACE as a “go-to,” “best” or recommended bourbon.⁶⁷ This is significant because consumer

⁶³ *Id.* at 18-19, ¶ 29.

⁶⁴ Duncan Decl., 28 TTABVUE 19-20, ¶ 32 (confidential).

⁶⁵ *Id.* at 512-41 (Exhibit 16) (confidential).

⁶⁶ Respondent’s Brief, 94 TTABVUE 31; 95 TTABVUE 31 (confidential).

⁶⁷ *See, e.g.*, 28 TTABVUE 515 (confidential) (ranking BUFFALO TRACE bourbon in an article titled *12 Best Bourbons and other Whiskeys to Use in Your Whiskey Sour*); *id.* at 521 (listing BUFFALO TRACE bourbon in an article titled *We’ve Assembled Your Go-To List of the Most Sought-After U.S. Whiskey Brands*). Petitioner filed the report including excerpts of these articles under seal but the article excerpts themselves were published and thus are public matter. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) (“The Board may treat as not

perception of Petitioner's BUFFALO TRACE bourbon may be shaped by such articles recommending the product.

In addition, BUFFALO TRACE bourbon has received unsolicited attention on social media. As of February 2024, "there [were] nearly 350,000 [social media] posts that 'tag' the BUFFALO TRACE brand."⁶⁸ And three third-party videos on YouTube reviewing BUFFALO TRACE bourbon garnered over 223,000, 377,000 and 562,000 views, respectively.⁶⁹ This evidence further reflects consumer exposure to BUFFALO TRACE bourbon.

- **Sales**

Petitioner introduced data showing U.S. sales of its BUFFALO TRACE bourbon for 2019 through 2023 to "on premise' accounts, such as restaurants, bars, hotels, and other establishments where individual alcoholic drinks are sold and consumed, as well as 'off premise' accounts, such as liquor stores, grocery stores, online retailers, and other retail outlets."⁷⁰ Petitioner's U.S. sales figures are impressive on their face⁷¹ and show that Petitioner's sales revenue attributable to BUFFALO TRACE bourbon "has been steadily increasing over time."⁷² Further, Mr. Duncan

confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.").

⁶⁸ Duncan Decl., 31 TTABVUE 17, ¶ 28.

⁶⁹ *Id.* at 19, ¶¶ 30-31.

⁷⁰ Duncan Decl., 31 TTABVUE 20, ¶¶ 33, 35, 36; 28 TTABVUE 20-21, ¶¶ 33, 35, 36 (confidential).

⁷¹ 28 TTABVUE 20-21, ¶ 35 (confidential). Because this evidence was filed under seal we discuss it generally.

⁷² Duncan Decl., 31 TTABVUE 20, ¶ 35.

testified that “BUFFALO TRACE bourbon whiskey is now among the top-selling bourbons in the United States[.]”⁷³ This un rebutted testimony provides some context for Petitioner’s sales figures.

- **Petitioner’s Brand Health Studies**

Respondent argues that the “only direct evidence” of commercial strength under the fifth *DuPont* factor, is four highly confidential brand health reports that Petitioner commissioned from a third party, and these reports demonstrate that Petitioner’s BUFFALO TRACE mark is “commercially weak.”⁷⁴ Due to the highly confidential nature of this evidence, we are quite restrained in our discussion of it. Suffice it to say, we have considered all of the evidence relevant to Respondent’s argument. When we consider the brand reports as a whole, taking into account the context of the reports, the nature of the studies, and the various takeaways, as well as Mr. Duncan’s explanatory testimony regarding the same, we find that Respondent’s argument based on this evidence is overstated. This evidence does not support a finding that Petitioner’s BUFFALO TRACE brand is commercially weak in the bourbon and whiskey market, which includes 700+ brands.⁷⁵

⁷³ Duncan Rebuttal Decl., 84 TTABVUE 3, ¶ 8; *see also id.* at 4, ¶ 12 (testifying that there are more than 700 bourbon and whiskey brands in the United States).

⁷⁴ Respondent’s Brief, 94 TTABVUE 27; 95 TTABVUE 27 (confidential).

⁷⁵ Mr. Duncan’s testimony regarding the number of brands in the bourbon and whiskey market was filed under seal, but this information is not confidential and Petitioner publicly filed a report to corroborate this information. 84 TTABVUE 68.

b. Summary of Findings under the Fifth *DuPont* Factor

Despite some gaps in the evidentiary record, we find that Petitioner's considerable advertising expenditures and sales revenue, its advertising through a number of different media, as well as experiential marketing, and the unsolicited and third-party coverage of the BUFFALO TRACE brand, taken as a whole, support that Petitioner's BUFFALO TRACE mark is well-known among consumers for bourbon. Petitioner's brand studies do not meaningfully undermine this finding. And the admission of Respondent's manager that BUFFALO TRACE is a "a well known [sic] quality large Kentucky distiller"⁷⁶ corroborates this finding.

We thus conclude that Petitioner's BUFFALO TRACE mark for bourbon falls toward the "stronger" end of the commercial strength spectrum.⁷⁷ *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017) (In the context of a likelihood of confusion analysis, the commercial strength of a mark is not a binary factor. Rather, it "varies along a spectrum from very strong to very weak.") (quoting *Palm Bay*, 396 F.3d at 1374-75).

⁷⁶ Petitioner's NOR on Discovery Materials, 38 TTABVue 125, Request for Admission No. 1 (admitting that document bearing Bates number BCD_0000002 is a true and authentic copy of a genuine original e-mail from Buddy Byrum to David Jones dated November 10, 2017); *see id.* at 288 (copy of referenced email). *See also* Petitioner's NOR on Discovery Materials, 37 TTABVue 290 (confidential) (email from Byrum referring to "trademark disputes with a **major brand** over the use of the word BUFFALO") (emphasis added); *id.* at 228 ((Byrum testifying for Respondent under Fed. R. Evid. 30(b)(6) that the "major brand" referenced was BUFFALO TRACE). Even though this evidence was filed under seal, it is publicly known that Respondent and Petitioner are involved in the instant proceeding. Trademark Rule 2.116(g).

⁷⁷ Again, Petitioner did not argue that the BUFFALO TRACE mark is famous and we make no such finding.

2. Sixth *DuPont* Factor

a. Commercial Strength under the Sixth Factor

While the fifth *DuPont* factor enables a plaintiff to prove that its mark is entitled to an expanded scope of protection by adducing evidence of “the fame of the prior mark (sales, advertising, length of use),” the sixth *DuPont* factor allows the defendant to prove that there is a contracted scope of protection by adducing evidence of “the number and nature of similar marks in use on similar goods.” *Made in Nature v. Pharmavite*, 2022 WL 2188890, at *11 (quoting *DuPont*, 476 F.2d at 1361).

“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, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324 (Fed. Cir. 2018) (quoting *Palm Bay Imps.*, 396 F.3d at 1374). Evidence that a considerable number of third parties use similar marks for similar goods and services is “powerful on its face” without specifics regarding the extent of such use. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.2d 1363, 1374 (Fed. Cir. 2015) (“Given the volume of evidence in the record [showing ubiquitous third-party use of paw designs], consumers are conditioned to look for differences between paw designs and additional indicia of origin to determine the source of a given product.”); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015). To this end, Respondent argues

that “there are a multitude of third party marks containing the word BUFFALO, its equivalent BISON, and/or a bison design in use for alcoholic beverages.”⁷⁸

- **Third-Party Marks: Bourbon and other Distilled Spirits**

The record shows the following third-party marks and one trade name for bourbon and other distilled spirits.



⁷⁸ Respondent’s Brief, 94 TTABVUE 33 (internal parenthetical omitted).

⁷⁹ Respondent’s NOR on Internet Materials No. 1, 58 TTABVUE 26; *see also id.* at 12-25; 27-48.

⁸⁰ Respondent’s NOR on Internet Materials No. 1, 58 TTABVUE 51 (red arrow added by the Board).



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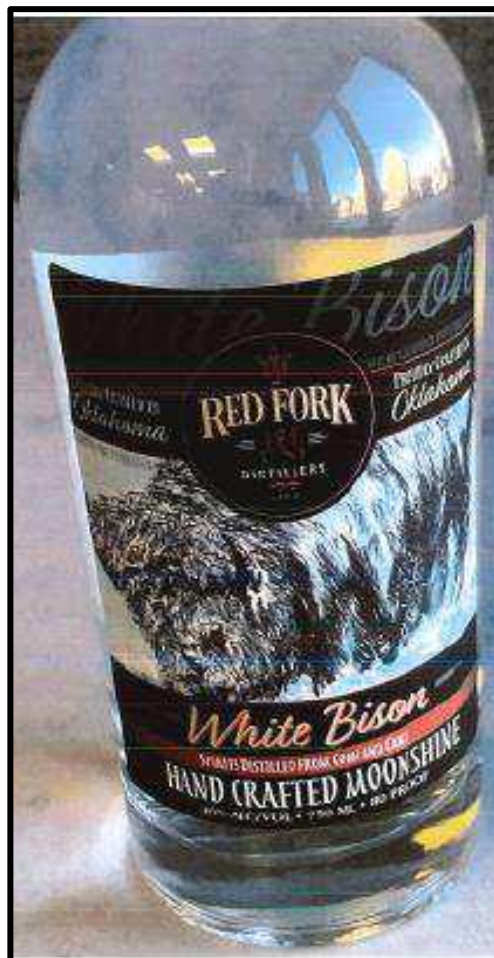
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⁸¹ Exhibit 16 to Byrum Decl., 48 TTABVUE 8 (photo of FLYING BUFFALO bourbon); Byrum Decl., 45 TTABVUE 20, ¶ 59 (testifying that he purchased FLYING BUFFALO bourbon “in January 2024 at Griffin Claw Brewing Co. (‘Griffin Claw’) in Michigan”); Exhibit 17 to Byrum Decl., 49 TTABVUE 45 (confidential receipt of Byrum’s purchase); *see also* 45 TTABVUE 21, ¶ 62 (photos of products for sale “inside the Griffin Claw brewery/distillery store” at 48 TTABVUE 26-29).

⁸² Respondent’s NOR on Internet Materials No. 1, 58 TTABVUE 91. West River Whiskey Co. also promotes whiskey and other products in connection with bison imagery that is prominently displayed on its website and Facebook page. *Id.* at 85-97 and 59 TTABVUE 4-6.



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⁸³ Byrum Decl., 45 TTABVUE 20-21 ¶¶ 59-61 (Mr. Byrum personally purchased this product from the Roger Wilco website) and Exhibit 16 to Byrum Decl., 48 TTABVUE 9, 15; Exhibit 17 to Byrum Decl., 49 TTABVUE 46 (confidential, receipt of purchase); Respondent's NOR on Internet Materials No. 1, pt. 2, 59 TTABVUE 22-23.

⁸⁴ Affidavit of R. Blaine Nice, 48 TTABVUE 31, ¶ 4 (testifying that he purchased a bottle of Red Fork White Bison moonshine at the Spirit Shop in Norman, Oklahoma); *id.* at 32-33 (Exhibit A to Nice Affidavit).



⁸⁵ Respondent's NOR on Internet Materials No. 1, pt. 2, 59 TTABVUE 9-19 (record shows the product offered through Total Wine & More and numerous other third-party retailers identified on wine-searcher, and Bottle Bargains). In addition, the mark BISON RIDGE (standard characters) is subject to use-based Principal Register Reg. No. 4345407 for "alcoholic beverages except beers or wine." 57 TTABVUE 59-61.

⁸⁶ Byrum Declaration, 45 TTABVUE 20, ¶¶ 59-60; *Id.* at 48 TTABVUE 10 (Exhibit 16, photo); *Id.* at 49 TTABVUE 50-51 (Exhibit 17, receipt of purchase (confidential)); Respondent's NOR on Internet Materials No. 1, pt. 2, 59 TTABVUE 46-80 (record shows the product offered through Total Wine & More, Astor Wines & Spirits, Caskers, and promoted on Drizly.com, Eater.com, and Food & Wine magazine).

This entity appears to own the following Principal Register registrations, among others,



featuring bison designs or imagery Register:

and

both



for “vodka,” subject to use-based Reg. Nos. 3396813 and 3757655. 57 TTABVUE 32-34, 38-40; *see also id.* at 20-31, 35-37, 41-43.

⁸⁷ Byrum Decl., 45 TTABVUE 20-21, ¶¶ 59-61 and 48 TTABVUE 11 (Exhibit 16); *See also* Byrum Decl., 49 TTABVUE 47-49 (confidential Exhibit 17, receipt of purchase); Respondent’s NOR on Internet Materials No. 1, pt. 2, 59 TTABVUE 113- (record shows the product offered through The Liquor Barn, Remedy Liquor, Euro Liquors, and promoted on DrinkHacker.com).



The mark on the bottle, **STUMBRAS** VODKA, is subject to Principal Register Reg. No. 6430644 for “alcoholic beverages, except beers, namely, vodka,” issued under Section 66 of the Trademark Act, 15 U.S.C. 1141f(a). 57 TTABVUE 48-51.

⁸⁸ Respondent’s NOR on Internet Materials No. 1, pt. 2, 59 TTABVUE 86 (promoted as “a rare distillate with the flavor of a grass unique to the woods of Poland that is eaten by the Country’s endangered bison population”); *see also id.* at 86-107 (record shows the product offered through Bourbon Central, Virginia ABC stores, Wine Anthology, Total Wine & More, Binny’s Beverage Depot, and promoted on SpiritReview.com).

The bottle trade dress is subject to Principal Register Reg. No. 3776577 for alcoholic beverages, namely, vodka. 57 TTABVUE 52-54.

- **Third-Party Marks: Bourbon-Barrel Aged Beers**

The record shows the following three bourbon-barrel aged beers bearing BUFFALO-formative marks:



FLYING BUFFALO beer appears to be produced by the same entity that produces FLYING BUFFALO bourbon.

- **Third-Party Marks: Other Alcoholic Beverage Marks**

The record includes the following additional third-party BUFFALO-formative marks:⁹² (1) approximately 34 such marks in use for beer, not including the three

⁸⁹ Respondent's NOR on Internet Materials No. 2, 61 TTABVUE 27-28.

⁹⁰ *Id.* at 34-35.

⁹¹ *Id.* at 7-8.

⁹² We have excluded from this list those products for which Petitioner's rebuttal witness Nathan Ranns testified he was not able to find "current availability" through internet searches. Ranns Decl., 89 TTABVUE.

marks above for beer aged in bourbon barrels; (2) approximately 23 such marks in use for both breweries and beers; and (3) approximately 13 such marks in use for wines. In addition, there are two beers, four breweries/beers, and one wine, each identified with the image of a bison.⁹³ Respondent introduced ample evidence demonstrating that beer, breweries and wine are related to distilled spirits, including bourbon.⁹⁴ The third-party marks for beer, breweries and wine are thus relevant under the sixth *DuPont* factor. *In re C.H. Hanson Co.*, Ser. No. 77983232, 2015 WL 6121759, at *5-6 (TTAB 2015) (evidence that goods were a type that emanated from the same source under a single mark and third-party use-based registrations supported finding goods related). These marks are thus relevant to our consideration of commercial strength under the sixth *DuPont* factor.

- **Analysis of the Third-Party Marks**

Petitioner argues that the third-party uses are “stunted by the lack of testimony or evidence concerning marketplace use and its extent.”⁹⁵ Generally, “the probative

⁹³ In addition, we have considered the few third-party marks in the record in use for hard cider.

We find the third-party marks consisting of or incorporating the word BISON and/or bison imagery relevant because the words “buffalo” and “bison” are interchangeable. *See* Respondent’s NOR on Internet Materials No. 5, 72 TTABVUE 64 (Merriam-Webster Dictionary defining “buffalo” as “BISON *especially*: a large North American bison”).

⁹⁴ Specifically, Respondent introduced: (1) approximately nine third-party use-based registrations for beer and distilled spirits and approximately ten third-party use-based registrations for beer, wine and distilled spirits; (2) approximately 50 third-party beers identified or promoted as aged in bourbon barrels, including ten promoted as aged in BUFFALO TRACE bourbon barrels; (3) one wine brewed in bourbon barrels; and (4) approximately 15 combined breweries and distilleries, two combined breweries, distilleries and wineries, and three combined winery and distilleries.

⁹⁵ Petitioner’s Brief, 100 TTABVUE 45.

value of third-party trademarks depends entirely upon their usage,” and thus, “where the ‘record includes no evidence about the **extent of [third-party] uses ... [t]he probative value of this evidence is ... minimal.’” *Palm Bay*, 396 F.3d at 1373–74 (emphasis in original changed from italics to bold) (quoting *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001)). There is, however, a limited exception for numerous third-party uses that would be deemed powerful on their face without contextual evidence. *Juice Generation*, 794 F.3d at 1339; *see also Jack Wolfskin*, 797 F.3d at 1373-74. We find that exception applies in this case to a certain extent.**

The evidence of BUFFALO-formative marks for alcoholic beverages is extensive and powerful on its face. It demonstrates that the word BUFFALO is commercially weak for beer and breweries, in particular, which goods are related to bourbon. But for the subset of distilled spirits, there are many fewer third-party marks incorporating the word BUFFALO (or BISON) and equivalent designs, and even fewer for bourbon, the specific product identified by Petitioner’s BUFFALO TRACE mark. Thus, even though the term BUFFALO is commercially weak for related goods, we consider Petitioner’s argument that the record “confirms the exclusivity of Petitioner’s rights in its BUFFALO [TRACE] Mark[] in the distilled spirits space.”⁹⁶

When we look only at distilled spirits, including bourbon, the number of third-party marks is not powerful on their face. We thus consider the extent and nature of the third-party uses for these specific goods.

⁹⁶ Petitioner’s Brief, 100 TTABVUE 44.

With respect to the mark BUFFALO CHIP and the trade name BUFFALO DISTILLING CO., Petitioner points out that the Internet screenshots showing these uses were accessed and printed approximately 10-11 months before Respondent introduced them at trial. We agree with Petitioner that these printouts are somewhat stale lessening their probative value. *Cf. Tao Licensing LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 2017 WL 6336243, at *15 (TTAB 2017) (probative value of third-party use evidence diminished because it was dated two to three years before it was introduced). Further, in the intervening 10-11 months, Petitioner successfully opposed registration of the BUFFALO CHIP mark for distilled spirits and other alcoholic beverages.⁹⁷ *Id.* (evidence of third-party use less probative because Petitioner successfully challenged several marks referenced in the third-party webpages). While the Board decision in that case has no bearing on use of the BUFFALO CHIP mark, the decision finding likelihood of confusion between Petitioner's BUFFALO TRACE mark and the mark BUFFALO CHIP, coupled with the somewhat stale Internet evidence of use, raises the question of whether BUFFALO CHIP bourbon and whiskey is currently on the market.

We further observe that Buffalo Distilling Co. bourbon bottle identifies the business as located in Buffalo, New York, suggesting the reason for its name.⁹⁸

⁹⁷ Duncan Decl., 31 TTABVUE 22, ¶ 40a; *see also* Exhibit 15 to Duncan Decl., 36 TTABVUE 81-153 (Board decision sustaining opposition under Section 2(d) of the Trademark Act); Petitioner's Rebuttal NOR on USPTO Records, 85 TTABVUE 6 (showing application for BUFFALO CHIP mark abandoned after inter partes proceeding).

⁹⁸ Respondent's NOR on Internet Materials No. 1, 58 TTABVUE 51-64. The BUFFALO DISTILLING CO. trade name is displayed in a much smaller font than the product mark ONE FOOT COCK, but the trade name is displayed more prominently on what appears to

Turning to FLYING BUFFALO bourbon, Mr. Byrum testified that he visited “Griffin Claw’s locations in Birmingham, Michigan and Rochester Hills, Michigan.” We do not know whether FLYING BUFFALO bourbon and beer is sold other than from Griffin Claw’s two establishments in Michigan.⁹⁹

Respondent did not purchase the WEST RIVER WHISKEY bourbon, and the website for the product promotes the business as a “small ... artisan family farm distiller” in Deadwood, South Dakota.¹⁰⁰ Mr. Byrum did purchase the BISON rye product from the Roger Wilco website, but there is no evidence that this product is available through any other retailer. A representative for Respondent also purchased WHITE BISON moonshine from the Spirit Shop in Norman, Oklahoma.¹⁰¹ The product is also listed as available on the Spirit Shop’s online store and the online store of Tulsa Hills Wine Cellar, also identified as in Oklahoma.¹⁰² In addition, the Red Fork Distillery website promotes that the distillery’s products are

be the distillery’s website at <buffalodistillingcompany.com/spirits> and Facebook and page, promoting bourbon along with products such as brandy, rye whiskey and vodka.

⁹⁹ Mr. Byrum testified that based on his “observations as the owner of a similar business, Griffin Claw’s operation is quite extensive and they appear to sell a high volume of bourbon.” 45 TTABVUE 21, ¶ 62. This testimony is speculative. Similarly, Petitioner’s argument that FLYING BUFFALO products are “only available for purchase at two physical locations in Michigan,” 100 TTABVUE 48, is unsupported by the record because the internet printout Petitioner introduced to support this assertion (91 TTABVUE 7) is hearsay. 91 TTABVUE 7. *WeaponX*, 2018 WL 1326374, at *4 (internet printouts hearsay and only admissible for what they show on their face, not the truth of their contents). Even if we were to consider the internet evidence for the truth of what is stated, it does not establish that FLYING BUFFALO bourbon is sold only in two locations.

¹⁰⁰ Respondent’s NOR on Internet Materials No. 1, 58 TTABVUE 91.

¹⁰¹ Affidavit of R. Blaine Nice, 48 TTABVUE 31, ¶ 4.

¹⁰² Respondent’s NOR on Internet Materials No. 1, pt. 2, 59 TTABVUE 36, 40.

available at “local retailer[s], restaurant[s] or pub[s]” all identified as in Oklahoma.¹⁰³

The BISON RIDGE Canadian whiskey and the ZUBRÓWKA, STUMBRAS and BAK’S vodka appear to be more widely available, each listed for sale on a number of third-party websites.¹⁰⁴ In addition, the BISON RIDGE mark is registered on the Principal Register while each of the identified vodkas have registrations for marks incorporating the design of a bison/buffalo.¹⁰⁵ But the record reflects that “bison” has a descriptive connotation for the vodkas that each contain or have the flavor of “bison grass.”¹⁰⁶

Finally, we cannot ascertain from the record the extent of use of the three BUFFALO-formative marks for bourbon barrel-aged beers.

We find that the market is saturated with BUFFALO-formative marks for beer and breweries – goods that are related to bourbon; however, Petitioner has carved out a space of relative exclusive use of the term BUFFALO for bourbon specifically. Thus, the BUFFALO term in Petitioner’s mark BUFFALO TRACE retains some commercial strength for bourbon.

¹⁰³ 91 TTABVUE 9-13.

¹⁰⁴ See notes 85-89 above.

¹⁰⁵ See notes 86-89 above.

¹⁰⁶ Petitioner’s Rebuttal NOR on Internet Materials No. 1, 91 TTABVUE 15 (Bison grass “is an aromatic herb native to northern Eurasia and North America. .. It is used ... in the production of distilled beverages....”).

This conclusion is underscored by Petitioner's enforcement efforts.¹⁰⁷ *Burns Philp Food Inc. v. Modern Prods. Inc.*, Opp. No. 91077433, 1992 WL 259302, at *1 n.2 (TTAB 1992) (policing efforts go to the strength of the mark). To the extent there are some third-party uses of similar marks for bourbon and distilled spirits, as discussed above the record does not support that such use is extensive. A trademark owner need not police inconsequential or transient uses of its mark. *Cf. McDonald's Corp. v. McKinley*, Opp. No. 91074168, 1989 WL 274414, at *5 (TTAB 1998) (McDonald's failure to object to some other "MC" formative marks did not weaken its mark).

b. Conceptual Strength under the Sixth Factor

Turning to the issue of conceptual strength, Petitioner's BUFFALO TRACE mark for bourbon is registered on the Principal Register, without a claim of acquired distinctiveness, and thus, the mark is presumed to be inherently distinctive for bourbon. Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, Opp. No. 91118587, 2006 WL 2460188, at *21 (TTAB 2006) (a "mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods") (citations omitted). Nonetheless, we may consider Respondent's arguments that the mark is conceptually weak. *In re Fat Boys Water Sports LLC*, Ser. No. 86490930, 2016 WL 3915986, at *8-9 (TTAB 2016).

¹⁰⁷ Duncan Decl., 31 TTABVUE 22, 24, ¶¶ 40, 42; 28 TTABVUE 21-22, 24, ¶¶ 38-39, 41; 29 TTABVUE 543-590 (confidential); 30 TTABVUE; Duncan Rebuttal Decl., 83 TTABVUE 5-10, ¶¶ 15-24 (confidential).

Respondent argues that the BUFFALO TRACE mark is “highly suggestive of the region where [Petitioner’s] goods originate and, therefore, relatively weak conceptually.”¹⁰⁸ To this end, Respondent contends that the Buffalo Trace “path and its name are well-known, as there are numerous websites, articles, and books on the subject[,] ... a historical marker for the path at Petitioner’s own distillery,” and “other businesses in Petitioner’s region” that have adopted “the name ‘Buffalo Trace.’”¹⁰⁹

Respondent did not introduce any dictionary definitions or encyclopedia entries for “Buffalo Trace,” which “can be strong evidence of the commonly understood meaning of a term.” *Tea Bd. of India*, 2006 WL 2460188, at *22 (“Dictionaries can be strong evidence of the commonly understood meaning of a term.”). Rather, Respondent introduced six third-party websites¹¹⁰ and three paperback books available on Amazon.com¹¹¹ addressing the Buffalo Trace as well as webpages showing a golf course, campground and bike trail named Buffalo Trace.¹¹² We cannot ascertain from the record whether bourbon consumers are familiar with these websites, books and places. *In re Newbridge Cutlery*, 776 F.3d 854, 861 (Fed. Cir. 2015) (must consider the geographic significance of a mark from the standpoint

¹⁰⁸ Respondent’s Brief, 94 TTABVUE 33.

¹⁰⁹ *Id.*

¹¹⁰ Respondent’s NOR on Internet Materials No. 5, 72 TTABVUE 17-38 (USDA Forest Service website, Indiana state government Historical Bureau website, Historical Marker Database website, The Herald-Times website, the Orange Bean website, and Indiana’s Historic Pathways website).

¹¹¹ Respondent’s NOR on Internet Materials No. 5, 72 TTABVUE 39-48.

¹¹² Respondent’s NOR on Internet Materials No. 5, 72 TTABVUE 50-61.

of the relevant purchasing public). Moreover, the USDA Forest Service website, describing the history of the Buffalo Trace, indicates that the trail is now obscure:

Today the trail is fading out of obscurity. The line is left off of most modern maps and on the ground, there are fewer places each year where the trace can still be followed.¹¹³

On this record, we find Respondent has failed to demonstrate that Buffalo Trace is a generally known geographic place such that Petitioner's mark is highly suggestive. *Newbridge*, 776 F.3d at 862 (“[T]he fact that [a geographic location] is mentioned on some internet websites does not show that it is a generally known location.”). The fact that visitors to Petitioner's distillery may learn the geographic significance from a historical marker at the distillery does not change this conclusion.¹¹⁴ *Newbridge*, 776 F.3d at 863 (“Neither is a place necessarily ‘generally known’ just because a purchaser is informed that the name of the mark is the name of the place.”). We thus find that Petitioner's BUFFALO TRACE mark is arbitrary. *Cf. id.* at 860 (“The rationale for allowing registration of marks that relevant consumers do not view as primarily geographic is that the consumer would consider

¹¹³ Respondent's NOR on Internet Materials No. 5, 72 TTABVUE 10. We take judicial notice of this information because it is on a U.S. government website. *See Nieves & Nieves LLC*, Ser. No. 85179263, 2015 WL 496132, at *3 (TTAB 2015) (“We take judicial notice of recent official U.S. government publications concerning Internet use in the United States: [from the government websites of www.census.gov and www.ntia.doc.gov].”).

¹¹⁴ We further note Petitioner's admission to Request for Admission No. 1, 50 TTABVUE 83, that “the name ‘Buffalo Trace’ refers to historical paths carved by migratory herds of American bison extending, in part, between Indiana and Kentucky. One such trail led to the banks of the Kentucky River where Buffalo Trace Distillery and its predecessors-in-interest have been making bourbon for more than 200 years. In tribute to the buffalo and the independent spirit of the pioneers who followed them, Petitioner selected ‘Buffalo Trace’ for its flagship brand of bourbon.” This admission does not support that bourbon consumers would know that Buffalo Trace is a geographic location.

such marks ‘arbitrary.’”); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1210.04(c) (May 2025) (“Geographic matter may be so obscure or remote that it would not be recognized as an indication of the geographic source of the goods or services. In such a case, the mark is treated as an arbitrary designation because its geographic meaning is likely to be lost on consumers.”).

We now consider Respondent’s argument that the BUFFALO portion of Petitioner’s mark is conceptually weak because “[t]he American bison is an iconic part of the culture and history of the United States” and “a multitude of alcoholic beverage companies use [and have registered] BUFFALO marks.”¹¹⁵ The number of third-party BUFFALO-marks, both used and registered based on use in commerce¹¹⁶ for beer, breweries and wine is substantial and powerful on its face, demonstrating that the term BUFFALO has significance for such goods. As discussed above, there are fewer marks in use for distilled spirits than for beer, breweries and wine, and even fewer marks for bourbon specifically. And the record includes no use-based registrations for marks incorporating the word BUFFALO for bourbon, whiskey or distilled spirits.

¹¹⁵ 94 TTABVUE 33 (emphasis omitted).

¹¹⁶ In addition to the third-party uses discussed above, Respondent introduced numerous third-party use-based registrations for BUFFALO-formative marks for alcoholic beverages. 57 TTABVUE 20-62, 88-180. A few of the registrations are for marks shown to be in use. We have not considered those registrations that issued under Sections 44 and 66 of the Trademark Act or pending applications. *Made in Nature v. Pharmavite*, 2022 WL 2188890, at *14.

One third-party registration, Reg. No. 5342230, is now cancelled. Petitioner’s Rebuttal NOR on USPTO Records, 85 TTABVUE 13-16.

We find that the word BUFFALO is conceptually weak for beer, breweries and wine, but the term has retained some conceptual strength as part of Petitioner’s BUFFALO TRACE mark for bourbon.

c. Summary of the Sixth *DuPont* Factor

We find that the word BUFFALO is commercially and conceptually weak for goods related to bourbon and this has some effect on the strength of that term in Petitioner’s BUFFALO TRACE mark for bourbon.

C. Similarity or Dissimilarity of the Marks¹¹⁷

Under the first *DuPont* factor, we consider the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 476 F.2d at 1361; *see also Stone Lion*, 746 F.3d at 1321. 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*, 901 F.3d at 1373 (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012)). The focus is on the recollection of an ordinary consumer, who normally retains a

¹¹⁷ In arguing the first *DuPont* factor, each party relies on a prior Board non-precedential decision involving Petitioner as plaintiff. Petitioner relies on *Sazerac Brands, LLC v. Buffalo Chip Campground, LLC*, Opp. No. 91272204, 2023 WL 11758752 (TTAB Nov. 29, 2023) (non-precedential) and Respondent relies on *Sazerac Brands, LLC v. Eagle Trace Brewing Co. LLC*, Opp. No. 91272260, 2024 WL 4052732, at *13 (TTAB Aug. 22, 2024) (non-precedential). The parties’ reliance on these cases is not particularly helpful. We are not bound by non-precedential decisions and we must decide this case on its own merits based on the record before us.

general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007 (CCPA 1971) (statute “requires us to consider, among other things, the fallibility of memory over a period of time, not merely whether one can distinguish the marks at a given moment”); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981) (Consumers “ordinarily must depend upon their past recollection of marks to which they were previously exposed”).

“Similarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014). We are mindful that where, as here, the goods are identical, in part, the degree of similarity necessary to find a likelihood of confusion declines. *Sunkist Growers, Inc. v. Intrastate Distribs., Inc.*, ___ F.4th ___, 2025 WL 2055711, at *2 (Fed. Cir. 2025) (quoting *Coach Servs.*, 668 F.3d at 1368)).

We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entireties. *Stone Lion*, 746 F.3d at 1321; *Franklin Mint*, 667 F.2d at 1007 (“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.”).

1. The Parties’ Arguments

In support of its position that the marks are similar, Petitioner argues that (1) the word BUFFALO is dominant in each mark because it is arbitrary for the parties’ goods and is the first word in each mark and on Respondent’s label the word

BUFFALO is “further highlight[ed] because it is stacked above the word CITY”;¹¹⁸ (2) both marks consist of two terms;¹¹⁹ (3) Respondent’s “standard character mark can be presented in any font, style, or color including those employed by Petitioner”¹²⁰ (4) the pronunciation of the identical first word is “particularly significant in [noisy] environments like bars and restaurants, where consumers typically order drinks by name without seeing the labels” and the product “may be recommended by word-of-mouth”;¹²¹ (5) consumers often refer to [Petitioner’s] BUFFALO TRACE bourbon whiskey simply as “Buffalo Whiskey” or “Buffalo Bourbon”;¹²² (6) “the meaning and history” of BUFFALO CITY as a ghost town in the Outer Banks region of North Carolina, with a history of bootlegging, is “obscure” and not familiar to consumers; similarly, the meaning of BUFFALO TRACE as “paths that led American pioneers and explorers to new frontiers” may not be known;¹²³ and (7) even if some consumers understood the meaning of the marks, there will be other consumers who are not aware of either meaning “and will thus focus on the initial first and arbitrary term BUFFALO in each mark, as consumers often are inclined to do.”¹²⁴

¹¹⁸ Petitioner’s Brief, 100 TTABVUE 30, 32.

¹¹⁹ *Id.* at 32.

¹²⁰ *Id.*

¹²¹ *Id.* at 31-32.

¹²² *Id.* at 31.

¹²³ *Id.* at 32-33.

¹²⁴ *Id.* at 33 (internal quotation marks and citation omitted).

Respondent, on the other hand, asserts that the “dissimilarities in the parties’ marks themselves are so substantial that the first *DuPont* factor, alone, is sufficient cause to dismiss this Proceeding.”¹²⁵ Respondent “does not dispute ... that the word BUFFALO and related bison imagery may dominate Petitioner’s marks,”¹²⁶ but it argues that BUFFALO is not dominant in its mark because BUFFALO CITY is a unitary mark creating a commercial impression separate from that of each word.¹²⁷ Respondent further argues that “the first word BUFFALO in [Respondent’s] Mark is used as an attributive noun to modify the second noun, CITY, such that the combination of BUFFALO and CITY conveys the idea of a geographic place (i.e., a city or town) that is real or imagined”¹²⁸ while Petitioner’s mark BUFFALO TRACE “is the well-known name for a historic 115-mile path created by herds of American bison across parts of Kentucky and Indiana and along which Petitioner’s distillery is located.”¹²⁹

2. Analysis

- **Appearance**

The parties’ marks are similar in appearance to the extent they are both comprised of two words and start with the word BUFFALO. In addition, there is no limitation on how the parties may display their marks as Respondent’s mark is in

¹²⁵ Respondent’s Brief, 94 TTAVBUE 19 (emphasis omitted).

¹²⁶ *Id.* at 21.

¹²⁷ *Id.* at 21-22.

¹²⁸ *Id.* at 21.

¹²⁹ *Id.* at 20.

standard characters and Petitioner's mark is typeset. *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 1349 (Fed. Cir. 2011) ("Standard character' or 'typed' [marks] are federal mark registrations that make no claim to any particular font style, color, or size of display and, thus, are not limited to any particular presentation."). We must consider that each party could display its mark in a font style, size or color similar to the other, including emphasis of the shared term BUFFALO, thus increasing the similarities between the marks. *In re Aquitaine Wine USA, LLC*, 2018 WL 1620989, at *5 (TTAB 2018). We acknowledge the second words in the marks, TRACE v. CITY, are quite different in appearance. But when we consider the marks in their entirety, we find the similarities in overall appearance – two word marks, starting with BUFFALO, and no restrictions on manner of display – outweigh the differences in appearance resulting from the second words in the marks.

- **Sound**

As with appearance, the parties' marks sound similar to the extent they are comprised of two words and start with the word BUFFALO, but there are differences in pronunciation because the second words in the marks are different.

Petitioner argues that the identical pronunciation of the first word in each mark "is crucial given the often noisy atmosphere" in bars and restaurants where consumers will ask for the parties' products – and Respondent's products are "likely to be marketed in the same manner as [Petitioner's] bourbon whiskey, such as at events, where the bottle labels may not be visible and the product may be

recommended by word-of-mouth.”¹³⁰ It may be that some crowded bars and restaurants are noisy such that a server may rely on hearing the first part of the parties’ marks in taking a consumers’ order, but that would not be the case in other settings in which the parties’ goods are sold, for example, liquor stores.

Further, we are not persuaded by Mr. Duncan’s testimony that “[i]t is common practice for consumers of alcoholic products to shorten the names of products” and that consumers have done just that “often refer[ring] to bourbon whiskey sold under the BUFFALO [TRACE] Mark[] simply as ‘Buffalo Whiskey’ or ‘Buffalo Bourbon.’”¹³¹ To support his testimony, Mr. Duncan attached to his declaration examples of “public third-party Instagram posts” in which third-parties have used the hashtags #buffalowhiskey and #buffalobourbon.¹³² The purpose of a hashtag is not to call for a product but rather to categorize and organize content on social media platforms.¹³³ The record simply does not support that consumers would use the hashtags or words after the hash symbol (#) to refer to Petitioner’s goods. *Cf. Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983) (evidence that “people have called” applicant’s restaurant and “hamburger and hotdog sandwiches”

¹³⁰ Petitioner’s Brief, 100 TTABVUE 31-32.


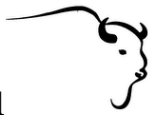
¹³¹ Duncan Decl., 31 TTABVUE 25, ¶ 46.

¹³² *Id.* at 17, 25, ¶¶ 28, 46. Some of these INSTAGRAM posts appear to be from outside the United States and some are not in English. *See, e.g.*, 34 TTABVUE 30, 32, 35. This lessens their probative value because we do not know whether U.S. consumers have been exposed to them.

¹³³ We take judicial notice of Encyclopedia Britannica’s definition of “hashtag.” <https://www.britannica.com/topic/hashtag> (last visited July 9, 2025). *In re White Jasmine LLC*, Ser. No. 77115548, 2013 WL 2951788, at *7, n.24 (TTAB 2013) (“The Board may take judicial notice of information from encyclopedias.”).

business by the name GIANT, omitting the generic word hamburger). Further, it is notable that most of the social media posts Mr. Duncan attached to his declaration include an image displaying Petitioner's full mark BUFFALO TRACE.

In addition, while Petitioner uses its registered marks consisting of an image of

a buffalo (e.g.  and ) on its products and in advertising, we do not find that the use of such marks would prompt consumers to refer to Petitioner's bourbon simply as BUFFALO. *Cf. L.C. Licensing Inc. v. Berman*, Ser. No. 78320850, 2008 WL 835278, at *3 (TTAB 2008) (“[I]t is well settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods.”). Moreover, the record does not support that Petitioner has shortened its BUFFALO TRACE word mark to BUFFALO in advertising. In fact, in some advertising, Petitioner has highlighted the second word in its mark TRACE, using the tagline TASTE OF THE TRACE to promote bourbon tastings at its distillery.¹³⁴

Thus, while consumers generally may have a penchant to shorten marks, we cannot find on this record that consumers would shorten Petitioner's mark to BUFFALO.

¹³⁴ Duncan Decl., 31 TTABVUE 42, Exhibit 2.

- **Connotation and Commercial Impression**

Respondent argues that the marks have different connotations and commercial impressions. Specifically, Respondent contends its mark will bring to mind a city or town:

The sort of city or town brought to mind naturally depends on the person encountering Registrant's Mark. For Registrant and consumers familiar with the history of Buffalo City, North Carolina, the image will be that of a rough-and-tumble mill town lost to the swamps of Eastern North Carolina [Byrum Decl. ¶ 34] or a ghost town once populated by loggers and moonshiners [*id.* ¶ 25.] For those unfamiliar with the history, the image might be of a dusty frontier town, populated by gamblers and gunslingers, like the Dodge City of the Old West. In any event, Registrant's Mark will **not** call to mind the image of an American bison, or even a geographic location where one might see a bison ... because towns and cities are populated by people, not bison.¹³⁵

Respondent has acknowledged that Buffalo City is “now an obscure and remote location[.]”¹³⁶ *Robinson v. Hot Grabba Leaf, LLC*, Can. No. 92060394, 2019 WL 1915759, at *9 (TTAB 2019) (statements in brief regarding term “grabba” considered admissions), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019). The record shows that Respondent is working to educate consumers about the history of Buffalo City as a ghost town in North Carolina that was part of the bootlegging industry. Mr. Byrum testified that “[Respondent’s] BUFFALO CITY mark and other branding evoke, and are inextricably tied to, the Prohibition history and folklore of the ghost town of Buffalo City.”¹³⁷ To this end, the

¹³⁵ Respondent's Brief, 94 TTABVUE 21-22.

¹³⁶ Petitioner's NOR on Discovery Materials, 38 TTABVUE 62 (Response to Interrogatory No. 1).

¹³⁷ Byrum Decl., 45 TTABVUE 12, ¶ 36.

front label of each of Respondent's bottles "contains a short history of the ghost town of Buffalo City,"¹³⁸ and the back label bears "a different vintage photo of some aspect of Buffalo City or Outer Banks Prohibition-era history."¹³⁹

But trade dress may be changed at any time. *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 784 F.2d 669, 674 (Fed. Cir. 1984); *see also Sunkist Growers, ___ F.4th ___, 2025 WL 2055711*, at *2 (no substantial evidence to support the Board's finding regarding the commercial impression of applicant's mark based on a "lips image" in a marketing presentation because the "lips image" was not part of the applied-for mark); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 1147 (Fed. Cir. 1985) ("It is settled, however, that a distinction in trade dress cannot weigh against likelihood of confusion with respect to the registration of a simple word mark The reason is that such dress might well be changed at any time; only the word mark itself is to be registered.").

Further, we must consider that some consumers may purchase Respondent's product in a bar, restaurant or other environment in which they may not see Respondent's labels while some consumers who do see the labels may not pay attention to them. Thus, even if some consumers may perceive Respondent's BUFFALO CITY mark as referring to a ghost town with a history in the bootlegging industry, other consumers may not be familiar with this meaning.¹⁴⁰

¹³⁸ *Id.* at 13, ¶ 42; *see also* 48 TTABVUE 75-83 (Exhibits 13 and 14).

¹³⁹ Byrum Decl., 45 TTABVUE 15, ¶ 43; 48 TTABVUE 80-83 (Exhibit 14).

¹⁴⁰ Respondent also argues that the history of Buffalo City "has seen a recent revival." 94 TTABVUE 22. In support of this position, Respondent points to: (1) three specific

Indeed, as Respondent argues, for those latter consumers, BUFFALO CITY may conjure “the image of a dusty frontier town, populated by gamblers and gunslingers, like the Dodge City of the Old West.”¹⁴¹ *Robinson v. Hot Grabba Leaf, LLC*, 2019 WL 1915759, at *9 (statements in brief treated as “admissions”). Respondent contends that “towns and cities are populated by people, not bison,”¹⁴² but a “frontier” town or city is one on the “margin of settled or developed territory,”¹⁴³ and thus, Respondent’s BUFFALO CITY mark might very well connote a rough and tumble “frontier town” in the “Old West” where buffalo roamed.¹⁴⁴

Petitioner’s BUFFALO TRACE mark may similarly evoke a commercial impression of buffalo or bison in the American frontier. Respondent introduced

“educational exhibits at various tourist destinations in and around the Outer Banks”; (2) a 24-minute “public television” episode (date and place of airing unknown) about the history of Buffalo City available on YouTube and listed as having 7,900 views; (3) “at least one bluegrass song, by Paul Craft, that pays tribute to the history of Buffalo City, North Carolina ..., titled ‘Buffalo City,’ and available through Amazon Music; and (4) a 2017 “short horror film based on the folklore of Buffalo City” titled ‘Lost in Buffalo City,’ that purportedly “won several awards between 2017 and 2018” and is available for streaming on Amazon.com and at lost-in-buffalo-city.vhx.tv/products/lost-in-buffalo-city. Byrum Decl., 45 TTABVUE 9-12, ¶¶ 29-35.

¹⁴¹ Respondent’s Brief, 94 TTABVUE 21-22; *see also* Byrum Decl., 45 TTABVUE 11, ¶ 34 (“I believe the name ‘Buffalo City’ is, by itself, enough to call to mind images of a rough-and-tumble mill town somewhere on the frontier[.]”).

¹⁴² Respondent’s Brief, 94 TTABVUE 21-22.

¹⁴³ We take judicial notice of the dictionary definition of “frontier.” <https://www.merriam-webster.com/dictionary/frontier> (last visited July 23, 2025). *See, e.g., In re Nextgen Mgmt., LLC*, Ser. No. 88098031, 2023 WL 111145, at *4 n.5 (TTAB 2023) (“The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format or have fixed regular editions.”).

¹⁴⁴ Although not argued by Respondent, the mark BUFFALO CITY may also connote Buffalo, New York, the second largest city in the state. Encyclopedia Britannica <https://www.britannica.com/place/Buffalo-New-York> (we take judicial notice of this encyclopedia entry). Still, that specific city may also connote the buffalo animal to some consumers.

evidence that the Buffalo Trace route was created by American bison and commonly used by pioneers and settlers used to move west.¹⁴⁵ To consumers who may not be familiar with the history of the Buffalo Trace path, Petitioner's mark is still likely to connote "a path, trail, or road made by the passage of animals," specifically buffalo (or American bison), or a "a minute" or "barely detectable amount" of buffalo.¹⁴⁶

Even though the meaning of a "path" or "minute amount" is absent from Respondent's mark, and the connotation of a "city" is absent from Petitioner's mark, by Respondent's own argument and evidence, for some consumers, the parties' marks will evoke similar general commercial impressions of buffalo and the frontier. This supports that confusion is likely. *In re White Swan Ltd.*, Ser. No. 73617169, 1988 WL 252416, at *2 (TTAB 1988) ("[I]n the context of likelihood of confusion, the fact that a word mark will be understood by some individuals in a manner such that confusion with a prior mark is likely and by other individuals in a manner such that confusion is unlikely, will generally still result in a finding of likelihood of confusion, provided that the size of the group of individuals who are likely to be confused is not inconsequential.").

¹⁴⁵ Respondent's NOR on Internet Materials No. 5, 72 TTABVUE 17-61; *see also* 50 TTABVUE 83, Petitioner's admission to Request for Admission No. 1 ("Petitioner admits only that the name 'Buffalo Trace' refers to historical paths carved by migratory herds of American bison extending, in part, between Indiana and Kentucky. One such trail led to the banks of the Kentucky River where Buffalo Trace Distillery and its predecessors-in-interest have been making bourbon for more than 200 years. In tribute to the buffalo and the independent spirit of the pioneers who followed them, Petitioner selected 'Buffalo Trace' for its flagship brand of bourbon.").

¹⁴⁶ Respondent's NOR on Internet Materials No. 5, 72 TTABVUE 77 (Merriam-Webster dictionary definition of the noun "trace").

D. Actual Confusion

1. Absence of Actual Confusion

The seventh and eighth *DuPont* factors are “[t]he nature and extent of any actual confusion” and “[t]he length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 476 F.2d at 1361. Respondent argues that the seventh and eighth factors weigh against finding confusion because “Petitioner has offered **no** evidence of actual confusion in this case ... despite [Respondent] having (1) offered its products for years, (2) meeting with consumers at tasting events, and (3) selling thousands upon thousands of units.”¹⁴⁷

It is well-settled that actual confusion is “hard to prove” and not necessary to establish a likelihood of confusion. *See, e.g., Sunkist Growers*, ___ F.4th ___, 2025 WL 2055711, at *4 (“[T]he failure to prove instances of actual confusion is not dispositive against a trademark plaintiff, because actual confusion is hard to prove.”) (quoting *VersaTop Support Sys., LLC v. Ga. Expo, Inc.*, 921 F.3d 1364, 1372 (Fed. Cir. 2019)) (emphasis and internal quotation marks omitted); *In re Detroit Athletic Co.*, 903 F.3d 1297, 1309 (Fed. Cir. 2018). In addition, when we look at market conditions, as required under the eighth *DuPont* factor, *In re Guild Mortg. Co.*, Ser. No. 86709944, 2020 WL 1639916, at *8 (TTAB 2020): (1) Respondent has been using its mark for only 2.5 years;¹⁴⁸ (2) Respondent promotes its BUFFALO CITY distilled spirits on

¹⁴⁷ Respondent’s Brief, 94 TTABVUE 57 (emphasis in italics removed).

¹⁴⁸ Byrum Decl., 45 TTABVUE 30, ¶ 101.

its website at <buffalocitydistillery.com>,¹⁴⁹ and social media sites at <facebook.com/BuffaloCityDistillery> and <instagram.com/buffalocitydistillery>¹⁵⁰ but we do not know the level of consumer exposure to these websites; (3) Respondent's other advertising is primarily local to North Carolina and the neighboring Commonwealth of Virginia;¹⁵¹ (4) Respondent's advertising expenditures of record are modest;¹⁵² and (5) despite respectable sales for an emerging small business,¹⁵³ Respondent's sales are not sizeable when compared with Petitioner's sales, and have been limited to certain counties in North Carolina.¹⁵⁴

We find the record does not support that there has been a meaningful opportunity for consumer confusion to have occurred.

2. Survey

A properly conducted survey is circumstantial evidence from which we may infer whether there exists a likelihood of actual confusion. 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:184 (“[S]urvey evidence is circumstantial, not direct,

¹⁴⁹ Byrum Decl., 45 TTABVUE 12, ¶ 39 and 47 TTABVUE 42-74.

¹⁵⁰ Petitioner's NOR on Discovery Materials, 38 TTABVUE 75, 77 (Respondent's responses to Interrogatory Nos. 15 and 17).

¹⁵¹ Byrum promoted Respondent's business and BUFFALO CITY distilled spirits on a local Virginia television program on a segment promoting the Outer Banks. Byrum Decl., 45 TTABVUE 29, ¶ 98 and Exhibit 25 thereto in video format.

¹⁵² Petitioner's NOR on Discovery Materials, 38 TTABVUE 116 (Respondent's Second Supplemental Amended Answer to Interrogatory No. 23, “the total dollar amount spent on advertising goods offered under Registrant's Mark [between] November 11, 2021 [and July 18, 2023] is approximately \$3,800.00.”).

¹⁵³ Byrum Decl., 49 TTABVUE 30, ¶ 100 (confidential); Petitioner's NOR on Discovery Materials, 38 TTABVUE 114-15 (Respondent's Second Supplemental Amended Answer to Interrogatory No. 21).

¹⁵⁴ *Id.* at 30, ¶ 99.

evidence of the likelihood of confusion. ... [S]urveys 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.”).

Petitioner’s expert, Sarah Butler, conducted as “*Squirt*-style lineup” survey of 401 relevant consumers.¹⁵⁵ The survey population was “United States residents age 21 years old or older who have purchased distilled spirits (i.e., whiskey, bourbon, gin, tequila, rum, vodka, or brandy) in the past three months, or who are likely to purchase distilled spirits in the next three months” and “typically spend between \$30.00 and \$39.99, or more than \$50, on a 750 ml. bottle of distilled spirits.”¹⁵⁶

Veridata Insights (“Veridata”), “an independent data collection company,” that Mr. Butler has worked with before, administered the survey.¹⁵⁷ “Veridata complies with the standards and ethics for online survey data panels set forth by the Insights Association.”¹⁵⁸ In addition to the “standard quality control measures” Veridata “applied in this study,”¹⁵⁹ the survey was “double-blind,” meaning “that neither the staff at Veridata nor any of the respondents were aware of the survey sponsor or the ultimate intention of the survey.”¹⁶⁰

¹⁵⁵ Butler Expert Report, 42 TTABVUE 15, 18, ¶¶ 20, 27.

¹⁵⁶ *Id.* at 15, ¶ 18.

¹⁵⁷ *Id.* at 15, ¶ 19.

¹⁵⁸ *Id.*

¹⁵⁹ *Id.*

¹⁶⁰ *Id.* at 16, ¶ 22(a). Additional quality control measures are described in paragraph 16(b)-(e) of the Butler Expert Report. *Id.* at 16-17.

After answering a series of screening questions, the 401 “qualified respondents proceeded to the main questionnaire.”¹⁶¹ Two hundred and two survey respondents were randomly assigned to the Test Group and 199 respondents were randomly assigned to the Control Group.¹⁶² The Control Group was designed “[t]o account for any possible guessing or other sources of survey noise[.]”¹⁶³

Both Groups were given the same instructions, including that they would be shown brand names of distilled spirits,”¹⁶⁴ and then shown the same first survey screen as follows:

This is the first brand name: **BUFFALO TRACE**.¹⁶⁵

Survey “[r]espondents were required to view the name for at least 5 seconds before they were able to continue in the survey.”¹⁶⁶

On the next screen, respondents in both Groups were told:

Now you will be shown some brand names of other distilled spirits products.¹⁶⁷

¹⁶¹ *Id.* at 18, ¶ 27; *see also id.* at 22, ¶ 36. (respondents were “a mix of men and women, with men comprising the majority of the sample”).

¹⁶² *Id.* at 18, ¶ 28.

¹⁶³ Butler Decl., 42 TTABVUE 12, ¶ 10(a).

¹⁶⁴ Butler Expert Report, 42 TTABVUE at 18, ¶ 28.

¹⁶⁵ *Id.* at 19, ¶ 29; *id.* at 60.

¹⁶⁶ *Id.* at 19, n.26.

¹⁶⁷ *Id.* at 19, ¶ 30.

Respondents in both groups were then shown a “randomized list of brands” consisting of a “a mix of well-known and lesser-known brands, with prices similar to BUFFALO TRACE” in a “randomized order”¹⁶⁸

GREY GOOSE
MONKEY 47
GRAY WHALE
BLACK SEAL
WILD TURKEY
BASIL HAYDEN
KNOB CREEK
BRIDGE CITY VODKA
TRAVERSE CITY WHISKEY
FLOWER CITY GIN

In addition, the mark BUFFALO CITY was included in the Test Group list while the mark CATTLE CITY was included in the Control Group list.¹⁶⁹

Both groups were then asked the following series of questions:

- **First Series of Questions**¹⁷⁰

Q. Do you think any of these brands are made or put out by the same company that makes or puts out the brand you saw first?

1. Yes
2. No
3. Don’t know / no opinion

Response options 1 and 2 were rotated.¹⁷¹ Survey respondents who answered “yes” were then asked:¹⁷²

¹⁶⁸ *Id.* at 20, ¶ 31; *id.* at 60.

¹⁶⁹ *Id.* at 19, ¶ 30.

¹⁷⁰ *Id.* at 20, ¶ 32.

¹⁷¹ *Id.* at 61.

¹⁷² *Id.* at 20, ¶ 32.

Q. Which of these brands are made or put out by the same company as the brand you saw first? (***Please select all that apply.***)

Q. For each brand you selected, please describe why you think it is made or put out by the same company as the brand you saw first?

- **Second Series of Questions**¹⁷³

Q. Do you think any of these brands are associated or affiliated with the company that makes or puts out the brand you saw first?

1. Yes
2. No
3. Don't know / no opinion

Response options 1 and 2 were rotated.¹⁷⁴ Survey respondents who answered “yes” were then asked:¹⁷⁵

Q. Which of these brands are associated or affiliated with the company that makes or puts out the brand you saw first? (***Please select all that apply.***)

Q. For each brand you selected, please describe why you think it is associated or affiliated with the company that makes or puts out the brand you saw first.

- **Third Series of Questions**¹⁷⁶

Q. Do you think any of these brands received authorization or approval from the company that makes or puts out the brand you saw first?

1. Yes
2. No
3. Don't know / no opinion

¹⁷³ *Id.* at 21, ¶ 33.

¹⁷⁴ *Id.* at 61.

¹⁷⁵ *Id.* at 21, ¶ 33.

¹⁷⁶ *Id.* at 21, ¶ 34.

Response options 1 and 2 were rotated.¹⁷⁷ Survey respondents who answered “yes” were then asked:¹⁷⁸

Q. Which of these brands received authorization or approval from the company that makes or puts out the brand you saw first? (***Please select all that apply.***)

Q. For each brand you selected, please describe why you think it received authorization or approval from the company that makes or puts out the brand you saw first.

The survey was then concluded.

Based on responses across all three questions, and subtracting out the “noise” in the Control Group, Ms. Butler concluded as follows:

Overall, a net 30.5 percent of respondents are likely to be confused and believe that Buffalo City is from the same company, is affiliated or associated with, or received authorization or approval from the company making Buffalo Trace. A net 24.7 percent of respondents specifically cited the name as the reason for their confusion. The net rates of confusion calculated from this survey demonstrate a likelihood of confusion between the two brand names. ... These results indicate that a substantial number of consumers in the market for Registrant’s distilled spirits products, including whiskey, are likely to be confused.¹⁷⁹

Respondent argues that “Petitioner’s circumstantial survey evidence is fatally flawed and is entitled to no weight.”¹⁸⁰

¹⁷⁷ *Id.* at 62.

¹⁷⁸ *Id.* at 21, ¶ 34.

¹⁷⁹ *Id.* at 33, ¶¶ 48-49.

¹⁸⁰ Respondent’s Brief, 94 TTABVue 49. Respondent argues that “Courts have routinely dismissed surveys conducted by [Petitioner’s] expert, Sarah Butler.” *Id.* This argument is not persuasive. We find Ms. Butler is an expert qualified to have conducted Petitioner’s survey. Further, we must analyze the particular survey before us. *See In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1536 (Fed. Cir. 2009) (“[S]urvey 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.”).

First, Respondent challenges Ms. Butler’s use of a *Squirt*-style lineup survey.

Given that [Petitioner] characterizes its [M]ark[s] as famous, this Board should question why [its] expert chose not to follow the *Ever-Ready* survey format. .. [W]hen a mark is strong—i.e., when respondents are likely able to recall it without prompting— parties should generally use the more reliable *Eveready* format.”¹⁸¹

Second, Respondent argues that the “leading” nature of the survey questions prompted survey respondents to respond in the affirmative¹⁸² and “set[] up a ‘best fit’ exercise” testing “the respondent’s ability to select a best match between the petitioner’s mark and a listing of additional marks (including the registrant’s mark)[.]”¹⁸³ Further, Ms. Butler did not “advise respondents that it [was] possible that none of the marks presented [were] related in any manner” to the BUFFALO TRACE mark.¹⁸⁴

Third, Respondent asserts that the survey “failed to replicate the relevant marketplace” because the survey “artificially forced ... prolonged exposure” to the BUFFALO TRACE mark that was shown on the screen for at least five seconds and because only ten other brands were included in the survey array, which is “meager” given that “when consumers visit liquor stores and grocery stores they encounter literally thousands of different types of alcoholic beverages[.]”¹⁸⁵

¹⁸¹ Respondent’s Brief, 94 TTABVUE 51-52 (internal quotation marks and citation omitted).

¹⁸² Respondent’s Brief, 94 TTABVUE 52.

¹⁸³ Keegan Decl., 44 TTABVUE 16, ¶ 23.

¹⁸⁴ *Id.* at 53.

¹⁸⁵ *Id.* at 53.

Fourth, Respondent argues that the mark CATTLE CITY was not an appropriate control stimulus because “the words ‘Cattle’ and ‘Buffalo’ are neither definitionally similar (they are different species), nor syntactically so (for example, they begin with different letters).”¹⁸⁶ Respondent’s expert, Mr. Keegan, asserts that “[t]he most obvious and appropriate control stimulus – BISON CITY – was not used.”¹⁸⁷

Finally, Respondent asserts that “the survey’s universe was both under-and over-inclusive” with respect to price restrictions. Respondent questions why any purchase price restrictions were imposed on the survey population given that there are no price restrictions in either party’s registration. But even if price restrictions were appropriate, Respondent argues that it was improper for Ms. Butler to screen out potential respondents spending \$40-50 on distilled spirits because “it is entirely possible that offerings in [Respondent’s] product line will sell at retail within [that price range] depending on where they are sold” and because Respondent may expand its products to include offerings in that price range.¹⁸⁸ Thus, Respondent argues, “the Butler Study failed to capture an entire swath of potential Buffalo City customers.”¹⁸⁹

Respondent also argues that the price restrictions were “fatally overinclusive” because survey respondents could have included those purchasing spirits in a price

¹⁸⁶ Respondent’s Brief, 94 TTABVUE 53-54.

¹⁸⁷ Keegan Decl., 44 TTABVUE 4, ¶ 9.

¹⁸⁸ Respondent’s Brief, 94 TTABVUE 55.

¹⁸⁹ *Id.*

range above \$59.99, Respondent's highest priced product.¹⁹⁰ Thus, the "survey did not accurately replicate the universe of current and potential Buffalo City customers."¹⁹¹

We find it was appropriate for Ms. Butler to use a *Squirt*-style lineup survey. Contrary to Respondent's argument, Petitioner does not argue that its BUFFALO TRACE mark is famous; rather it contends, and we have found, that the mark is well known among consumers of bourbon. And just because the BUFFALO TRACE mark is well known does not mean it is likely to be recalled without prompting. As one survey commentator explained:

'Top-of-mind' refers to marks that are readily accessible in memory....
[N]ot all commercially strong marks are cognitively stored top-of-mind.

Jerre B. Swann, EVEREADY AND SQUIRT—COGNITIVELY UPDATED, 106 Trademark Rptr. 727, 733-734 (2016).

Confidential evidence in the record suggests Petitioner's BUFFALO TRACE mark may not be "top of mind." ¹⁹² A *Squirt*-format survey is appropriate where, as here, "the marks ... are less (if at all) accessible in memory, but are competitively proximate so as to be compared in the marketplace." Jerre B. Swann, A HISTORY OF THE EVOLUTION OF LIKELIHOOD OF CONFUSION METHODOLOGIES, 113 Trademark Rptr. 723, 724 (Sept.-Oct. 2023).

¹⁹⁰ *Id.*

¹⁹¹ *Id.* at 55-56.

¹⁹² Duncan Depo., 51 TTABVUE 69-70 (confidential).

We also find no fault in Ms. Butler's use of CATTLE CITY as a stimulus control. Cattle and buffalo are both bovine animals. Further it would have been inappropriate for Ms. Butler to use BISON CITY as the control stimulus because American buffalo and bison are synonymous.¹⁹³ As Ms. Butler explains, "changing [the] control name to BISON CITY would not effectively control for anything."¹⁹⁴

Further, it would have been unrealistic for Ms. Butler to use an array consisting of a thousand or even one hundred marks, even though consumers may encounter more than ten brands of spirits in a shopping trip. And we find that requiring Respondents to view Petitioner's BUFFALO TRACE mark for at least five seconds was not such an unduly long period of time as to call into question the reliability of the survey.

We also disagree that the price-restriction on the survey universe undercuts the validity or probative value of the survey. As stated, "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 AND UNFAIR COMPETITION § 32:184. Actual confusion, in turn, is assessed by considering actual marketplace conditions. *In re Guild Mort. Co.*, Ser. No. 86709944, 2020 WL 1639916, at *8 (TTAB 2020). Thus, it was appropriate for Ms. Butler to screen for consumers purchasing spirits in the price range for Respondent's BUFFALO CITY products.

¹⁹³ Respondent's NOR on Internet Materials No. 5, 72 TTABVUE 64 (Merriam-Webster Dictionary defining "buffalo" as "BISON *especially*: a large North American bison").

¹⁹⁴ Butler Rebuttal Decl., 80 TTABVUE 4, ¶ 8.

Further, while it may have been appropriate to include in the survey universe potential respondents making spirit purchases in the \$40.00 to \$49.99 price range, the exclusion of such respondents is not “fatal”; it simply decreased the population of qualified respondents. As to being overinclusive, purchasers of more expensive products generally may be more likely to exercise care in making a purchase and, thus, would be less likely to be confused. *See Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) (“[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration.”) (quoting *Astra Pharms Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983)). So while including a price cap of \$59.99 would have more accurately reflected the market for Respondent’s BUFFALO CITY goods, the failure to exclude sophisticated purchasers of more expensive products in the survey universe likely skewed in Respondent’s favor.

All that said, we are troubled by the leading question format of the survey questions, which likely created a demand effect and “best-fit” exercise.¹⁹⁵

The survey questions used were framed in the affirmative and are “a classic form of leading question” and “should not be used in surveys conducted for the purpose of being proffered as evidence in litigated matters.” Jacob Jacoby, *TRADEMARK SURVEYS, VOLUME 1, DESIGNING, IMPLEMENTING AND EVALUATING SURVEYS*, p. 667

¹⁹⁵ Butler challenges Mr. Keegan’s “best-fit” critique on the ground that “Mr. Keegan failed to conduct a survey of his own.” Butler Rebuttal Decl., 80 TTABVue 3, ¶ 5. This assertion is unpersuasive. There is no requirement that a party conduct a survey when its adversary has conducted one. Also, Petitioner as the proponent of the survey has the burden of establishing its reliability.

(2013) (Example of leading question: “Do any of these products come from the same company as the first item I showed you?”). Ms. Butler asserts that “this potential source of bias” was accounted for by asking the same questions to the Control Group and “randomizing” the order of the response options so that the ‘yes’ response option was not always presented first.”¹⁹⁶ We disagree. The positive form in which the questions were asked likely encouraged respondents to select the answer “yes.”

Mr. Keegan further opines that after seeing the mark BUFFALO TRACE respondents may have been “inclined to assess the names in the list relative to each other and select the item that is most like the first item that they saw” resulting in “false positive” responses.¹⁹⁷ To support this assertion, Mr. Keegan points out that in the Control Group, “Wild Turkey, Knob Creek, and Grey Goose,” brands with large market share, “were most often cited as being confusingly similar to the petitioner’s BUFFALO TRACE brand, with the control item (CATTLE CITY) registering a lower level of confusion.”¹⁹⁸ In addition, “the confusion measurements in the Control Cell are higher across all array brands presented as compared to the Test Cell” supporting that “in the absence of an obvious ‘best fit’ candidate, respondents were more likely to select from among the available array brands to provide a best fit to the question presented to them.”¹⁹⁹

¹⁹⁶ Butler Rebuttal Decl., 80 TTABVUE 4, ¶ 7.

¹⁹⁷ Keegan Decl., 44 TTABVUE 17-18, ¶¶ 26-27 (emphasis omitted).

¹⁹⁸ Keegan Decl., 44 TTABVUE 19-20, ¶¶ 29.

¹⁹⁹ Keegan Decl., 44 TTABVUE 20-21, ¶ 31.

We agree with this critique and with Respondent’s assertion that “false positives” were encouraged because survey respondents were not specifically informed that it was possible none of the listed brands were related to the BUFFALO TRACE mark. TRADEMARK SURVEYS, VOLUME 1, DESIGNING, IMPLEMENTING AND EVALUATING SURVEYS, p. 553 (“[E]xplicitly instructing respondents that the lineup ‘might or might not contain the culprit’ exerts a dramatic (42 percent) effect on reducing false positive identifications in the ‘culprit absent lineups, while having virtually no effect (2 percent) on accurate identification in the ‘culprit-present lineups.’”). We thus find some merit to Mr. Keegan’s conclusion that the survey “merely shows that the registrant’s BUFFALO CITY mark potentially calls to mind the petitioner’s BUFFALO TRACE mark ostensibly because both marks use the common word ‘buffalo.’”²⁰⁰ Calling to mind a mark is not the same as showing a likelihood of confusion. 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 32.9.

Because of the flaws in the survey, we give it little weight in our analysis.²⁰¹

E. Bad Faith Intent

Under the thirteenth *DuPont* factor, i.e., “any other established fact probative of the effect of use,” we consider Petitioner’s argument that Respondent adopted its mark with the intent to trade off the goodwill of its BUFFALO TRACE mark. *Quicktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021).

²⁰⁰ Keegan Decl., 44 TTABVue 21, ¶ 33.

²⁰¹ Even if we were to accord the survey no weight, we would reach the same result in this case.

In support of its argument, Petitioner points to a November 2017 email exchange between Mr. Byrum, and David Jones, Mr. Byrum’s “brother-in-law and a former minority member of Buffalo City Distillery.”²⁰² In discussing “potential branding ideas for [Respondent’s] distillery and its products,”²⁰³ Mr. Byrum sent an article to Jones about the history of Buffalo City,²⁰⁴ “a ghost town ... that once existed in the Outer Banks region and was at one time called ‘the Moonshine Capital of North Carolina.’”²⁰⁵ Jones responded suggesting “Maybe you should call it Buffalo City Spirits.”²⁰⁶ Mr. Byrum replied:

I added it to my list of potential names. It has long marketing legs for re-establishing the tradition of highest quality whiskey that fed the entire eastern seaboard during prohibition. ... Also, **there is a well known [sic] quality large Kentucky distiller ... Buffalo Trace, so wouldn’t mind some brand confusion.** There are probably relics that could be located and photos that could be used on website, in video and to decorate facility.²⁰⁷

Mr. Byron testified that the highlighted comment about potential confusion with the Buffalo Trace Distillery was “an off-the-cuff remark” made in “jest” and intended

²⁰² Byrum Decl., 45 TTABVUE 16, ¶ 46.

²⁰³ *Id.* at 16, ¶ 47.

²⁰⁴ *Id.* at 17, ¶ 49.

²⁰⁵ *Id.* at 6, ¶ 22.

²⁰⁶ Petitioner’s NOR on Discovery Materials, 38 TTABVUE 305. The parties stipulated that “each document produced in discovery in this cancellation proceeding is authentic” and “each party may introduce by notice of reliance ... documents produced by the other party.” 20 TTABVUE 2.

²⁰⁷ Petitioner’s NOR on Discovery Materials, 38 TTABVUE 288 (emphasis added).

as a “joke.”²⁰⁸ Mr. Byron further testified that he has never attempted to create brand confusion:

[A]ll of the branding decisions I have made for Registrant evidence the fact that I have never attempted to create any “brand confusion.” Instead, my branding decisions show that I have strived to link Registrant’s BUFFALO CITY mark and brand to the Prohibition-era history and distilling folklore of the ghost town of Buffalo City, or to the Outer Banks region generally. None of Registrant’s labels, websites, social media, signage, or other branding have ever depicted any images of bison, buffalo, or similar animals, or made any reference to such animals or the historical migratory path of the American bison known as the “Buffalo Trace.” Similarly, Registrant’s font choices, label layout, color schemes, and all other visual aspects of its branding are distinct from Petitioner’s branding.²⁰⁹

Images of the parties’ bourbons are set forth below:²¹⁰

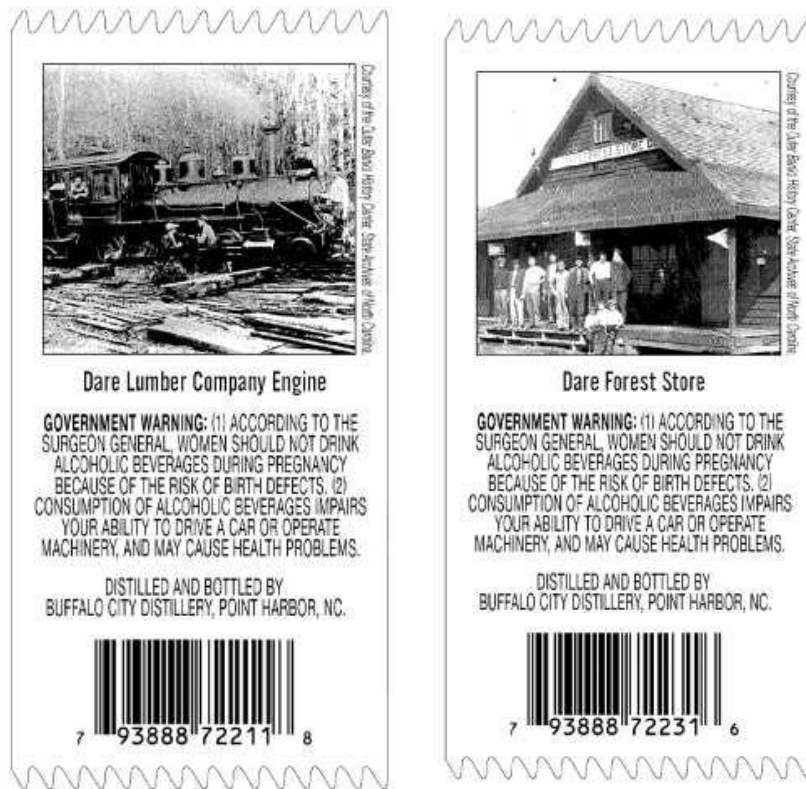


²⁰⁸ Byrum Decl., 45 TTABVue 17, ¶¶ 50-51.

²⁰⁹ Byrum Decl., 45 TTABVue 18, ¶ 54.

²¹⁰ *Id.* at 18, ¶ 55.

With respect to each of Respondent’s distilled spirit bottles, the image of a train is depicted on the front label and the label around the neck of the bottle.²¹¹ The background of Respondent’s front label “is a watermark that depicts a boat pulled near the shore of a swamp under a tree.”²¹² And the side of the front label of each bottle “contains a short history of the ghost town of Buffalo City.”²¹³ The back label bears “a different vintage photo of some aspect of Buffalo City or Outer Banks Prohibition-era history,” as shown below.²¹⁴

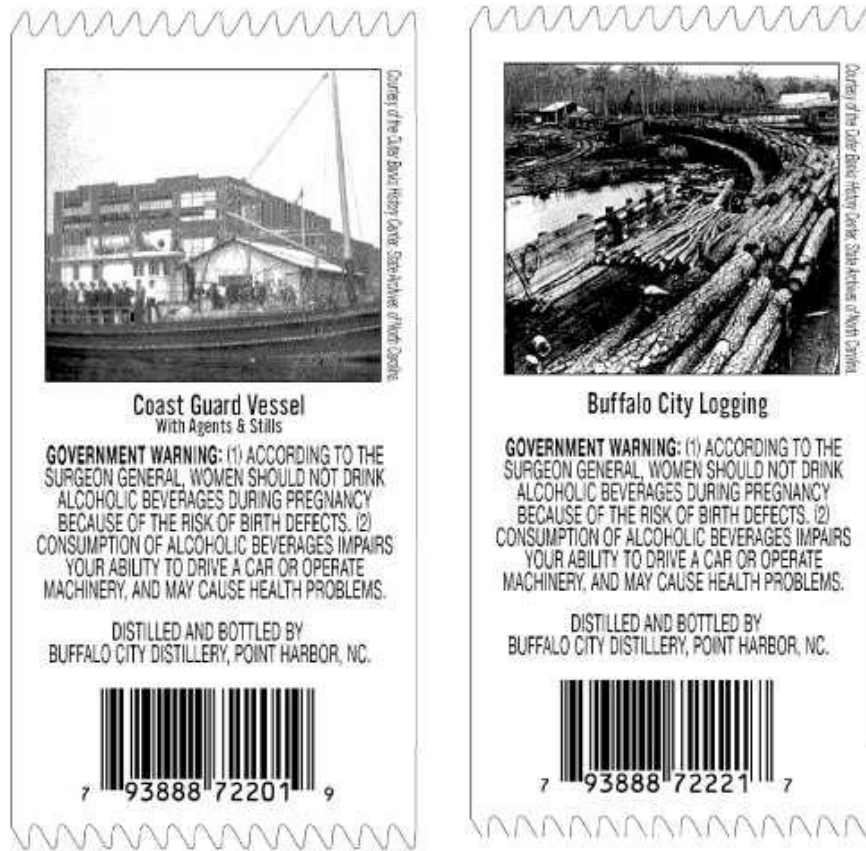


²¹¹ *Id.* at 13, ¶ 40.

²¹² *Id.*

²¹³ *Id.* at 13, ¶ 42; *see also* 48 TTABVUE 75-83 (Exhibits 13 and 14).

²¹⁴ Byrum Decl., 45 TTABVUE 15, ¶ 43; 48 TTABVUE 80-83 (Exhibit 14 to Byrum Decl.).



Mr. Byrum further testified that “[n]one of Registrant’s labels, websites, social media, signage, or other branding have ever depicted any images of bison, buffalo, or similar animals, or made any reference to such animals or the historical migratory path of the American bison known as the ‘Buffalo Trace.’”²¹⁵ To this end, in January 2020, an acquaintance of Mr. Byrum posted on Respondent’s Facebook page a photo “of a bottle (or jug) labeled ‘Buffalo City Pure Corn Whiskey’” purportedly “up for auction .. in Elizabeth City,” bearing the words “‘Distilled on the Banks of Mill Tail Creek by Honest, Hard-working Dare County Citizens,’ and the image of an American bison” and asked “wondering if you have seen anything like it, and

²¹⁵ Byrum Decl., 45 TTABVue 18, ¶ 45.

whether it is legit...?”²¹⁶ Mr. Byrum removed the post from Respondent’s Facebook page because the bottle was “inconsistent with [Respondent’s] branding” and to “honor [Respondent’s] pledge” to Petitioner that Respondent’s “branding would never include any logos or other imager depicting bison or similar animals.”²¹⁷

Establishing bad faith requires a showing of an intent to confuse. *See Quicktrip*, 984 F.3d at 1036. We accept Mr. Byrum’s un rebutted testimony that he was joking when he said he “wouldn’t mind some brand confusion” with the BUFFALO TRACE mark because this testimony is supported by Respondent’s initial brainstorming about the business,²¹⁸ verified interrogatory response,²¹⁹ trade dress (shown above), and website,²²⁰ all highlighting the story of the Buffalo City ghost town and its history of bootlegging rather than using Buffalo or Bison imagery. *Cf. Quicktrip*, 984 F.3d at 1036 (Board’s finding of no bad faith supported by substantial evidence where record showed applicant twice modified its mark in response to opposer’s concerns about customer confusion). We thus find that Respondent did not act in bad faith to cause confusion with Petitioner’s BUFFALO CITY mark.

That said, we find that Respondent did not exercise care in choosing its mark. The premise of Mr. Byrum’s joke was grounded in his stated belief that the

²¹⁶ *Id.* at 25, ¶¶ 78-79; Petitioner’s NOR on Discovery Materials, 37 TTABVUE 290-94 (confidential).

²¹⁷ Byrum Decl., 45 TTABVUE 26, ¶¶ 82.

²¹⁸ Byrum Decl., 49 TTABVUE 43 (Exhibit 2, confidential).

²¹⁹ Petitioner’s NOR on Discovery Materials, 38 TTABVUE 71-72 (verified response to First Set of Interrogatories, No. 11).

²²⁰ Byrum Decl., 47 TTABVUE 49, 51, 53, 59 (Exhibit 7).

BUFFALO TRACE mark is “well-known” and that consumer confusion between the marks was possible. Mr. Byrum, who was “primarily responsible for the selection, adoption and approval of [the BUFFALO CITY mark]”²²¹ ignored his own concerns and knowledge of Petitioner’s history of challenging marks incorporating the word BUFFALO for “bourbon.”²²² Prior to filing the application, Respondent had a list of marks it considered adopting, none of which included the word “BUFFALO.”²²³ And a few days after filing the application, Mr. Byrum considered a list of new marks, asking friends for feedback on the proposed marks in anticipation that Respondent would not be able to use the mark BUFFALO CITY because of Petitioner’s BUFFALO TRACE mark.²²⁴ Respondent’s decision to forge ahead with the BUFFALO CITY mark in these circumstances, flies in the face of the long standing principles that there is “no excuse for even approaching the well-known mark of a competitor,” *Planter’s Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 924-25 (CCP 1962), and “the newcomer has the opportunity and obligation to avoid confusion with existing marks.” *Sunkist Growers*, ___ F.4th ___, 2025 WL 2055711,

²²¹ Petitioner’s NOR on Discovery Materials, 38 TTABVUE 62 (verified response to First Set of Interrogatories, No. 1).

²²² Petitioner’s NOR on Discovery Materials, 37 TTABVUE 288, 295-300 (confidential).

²²³ Byrum Decl., Exhibit 2, 49 TTABVUE 38-39 (confidential).

²²⁴ Petitioner’s NOR on Discovery Materials, 37 TTABVUE 295-310 (emails from Mr. Byrum to friends, including statements such as: “While my company name is Buffalo City Distillery, I will probably not be able to trademark the Buffalo City for use as my leading name”; “The name of the business is Buffalo City Distillery but due to trademarks held by Sazerac for Buffalo Trace I’m probably not able to use Buffalo City as the brand name.”; “I’m probably going to run into roadblocks using ‘Buffalo City’ as my brand name because the huge Sazerac company owns trademark rights for Buffalo Trace and they have challenged virtually all trademark applications in the alcoholic beverages space using the wor[d] Buffalo.”).

at *2 (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.2d 1262, 1265 (Fed. Cir. 2002)).

F. Other *DuPont* Factors

The parties briefly address the tenth (market interface),²²⁵ eleventh and twelfth *DuPont* factors.

Petitioner argues the tenth factor weighs in its favor because “there is no market interface between the parties.”²²⁶ Respondent counters that because there is no evidence of market interface, “the tenth factor does not apply or is neutral.”²²⁷ We agree with Respondent. In the absence of relevant evidence, the tenth factor is neutral.

Under the eleventh factor, Petitioner argues that “[t]here is no evidence that [Respondent] has the right to exclude others from using the BUFFALO CITY Mark for distilled spirits.”²²⁸ Respondent argues that the eleventh factor weighs in its favor because Respondent “has subsisting trademark rights that allow it to exclude others from use of its Mark on distilled spirits under, at least, 15 U.S.C. §§ 1114, 1125 and

²²⁵ “Market interface” under the tenth *DuPont* factor concerns whether there has been any interaction between the parties indicating a lack of confusion between the marks such as a consent agreement, contractual provisions designed to preclude confusion, an assignment, or laches or estoppel. *Cunningham v. Laser Golf*, 222 F.3d at 949 (citing *DuPont*, 476 F.2d at 1361).

²²⁶ Petitioner’s Brief, 100 TTABVUE 55.

²²⁷ Respondent’s Brief, 94 TTABVUE 57 (internal citation omitted).

²²⁸ Petitioner’s Brief, 100 TTABVUE 55.

state common law.”²²⁹ Where, as here, the parties’ goods are legally identical, in part, the eleventh factor does not apply.²³⁰ *Monster Energy v. Lo*, 2023 WL 417620, at *20.

As to the twelfth *DuPont* factor, the parties “essentially repeat arguments under the other *DuPont* factors [that] have been duly considered.”²³¹ *Heil Co. v. Tripleye GmbH*, Opp. 91277359, 2024 WL 4925901, at *37 (TTAB 2024), *appeal dismissed per stipulation*, 2025 WL 401210 (Fed. Cir. Feb. 5, 2025).

The twelfth *DuPont* factor is neutral.

G. Balancing of the *DuPont* Factors

As a final step, we must “weigh the *DuPont* factors used in [our] analysis and explain the results of that weighing.” *Charger Ventures*, 64 F.4th at 1384 (emphasis omitted).

The second and third *DuPont* factors weigh heavily in favor of finding a likelihood of confusion because the goods are legally identical, in part, and, as such, are presumed to travel in identical trade channels and offered to identical classes of consumers. The fourth *DuPont* factor also weighs in favor of a likelihood of confusion

²²⁹ Respondent’s Brief, 94 TTABVUE 57.

²³⁰ Even if it did apply, we note that “the mere assertion of common-law use does not in itself suffice to establish the extent to which [the defendant] has a right to exclude others from use of the mark.” *McDonald’s Corp. v. McSweet, LLC*, Opp. No. 91178758, 2014 WL 5282256, at *17 (TTAB 2014). Respondent’s common law rights are geographically limited as Respondent sells goods bearing the BUFFALO CITY mark only in certain counties in North Carolina. Moreover, Respondent’s advertising and sales figures, discussed above, are not sufficient to establish an appreciable level of consumer recognition as necessary for the eleventh *DuPont* factor to weigh in its favor.

²³¹ The twelfth *DuPont* factor is a separate factor; it is not a means to “supercharge” our findings on other factors. In cases where we find some factor or factors relatively more important, we simply weigh or balance them more heavily in the final step of assessing the factors to determine whether confusion is likely.

because the least sophisticated purchasers of the parties' goods are ordinary consumers purchasing on impulse. *Sock It To Me*, 2020 WL 3027605, *10-11 ("Because the buyers to whom sales are made are all general consumers, and the goods at issue are relatively low-priced and subject to impulse buying, we find that, the fourth *DuPont* factor weighs in favor of finding a likelihood of confusion.")

The marks in their entirety are similar, particularly in connotation and commercial impression, such that the first *DuPont* factor also weighs in favor of a likelihood of confusion.

As to the fifth *DuPont* factor, Petitioner has proven that its BUFFALO TRACE mark is well known, and Respondent admitted that BUFFALO TRACE is a "major brand" and "well-known distillery."²³² The fifth *DuPont* factor therefore also favors finding confusion likely.

Turning to the thirteenth *DuPont* factor, even though Respondent's conduct in adopting its mark does not rise to the level of bad faith, Respondent did not exercise care in adopting its mark. We find the fact that Respondent's manager, Mr. Byrum, admitted that the BUFFALO TRACE distillery is well known and acknowledged

²³² Petitioner's NOR on Discovery Materials, 38 TTABVUE 125, Request for Admission No. 1 (admitting that document bearing Bates number BCD_0000002 is a true and authentic copy of a genuine original e-mail from Buddy Byrum to David Jones dated November 10, 2017); *see id.* at 288 (copy of referenced email referring to Buffalo Trace as a "well known [sic] Kentucky distiller"); *see also* Petitioner's NOR on Discovery Materials, 37 TTABVUE 290 (confidential) (email from Byrum referring to "trademark disputes with a major brand over the use of the word BUFFALO"); *id.* at 228 (Byrum testifying for Respondent under Fed. R. Evid. 30(b)(6) that the "major brand" referenced was BUFFALO TRACE).

that Respondent's adoption of BUFFALO CITY for distilled spirits could cause a likelihood of confusion also weighs in favor of finding a likelihood of confusion.

The sixth *DuPont* factor weighs in Respondent's favor to the extent Respondent has demonstrated that the term BUFFALO in Petitioner's BUFFALO TRACE mark is commercially and conceptually weak for beer, breweries, and wine, goods and services that are related to bourbon. But Petitioner's BUFFALO TRACE mark is the only BUFFALO-formative mark for bourbon (or distilled spirits, which encompass bourbon) registered based on use in commerce, and Petitioner has maintained relative exclusive use of the word BUFFALO as part of its mark BUFFALO TRACE for bourbon. That is important here because the parties' goods are legally identical to the extent Respondent's registration is broad enough to encompass bourbon, and the consumers and trade channels for the parties' identical goods overlap.

The seventh, eighth, tenth, eleventh and twelfth *DuPont* factors are neutral.

Balancing the factors, we find that the first, second, third, fourth, fifth, and thirteenth *DuPont* factors outweigh the sixth *DuPont* factor, which is the only factor favoring Respondent. Ultimately, should the ordinary unsophisticated consumer with a fallible memory encounter the parties' similar marks in use on legally identical, in part, goods and in the same trade channels, there is a likelihood of confusion.²³³

²³³ To the extent we have any reasonable doubt as to whether there is a likelihood of confusion, we resolve such doubt against Respondent as the newcomer. *In re Mighty Leaf Tea*, 601 F.3d at 1346; *In re Shell Oil Co.*, 992 F.2d 1204, 1209 (Fed. Cir. 1993).

Decision: Petitioner has proven by a preponderance of the evidence its entitlement to maintain this statutory cause of action and its likelihood of confusion claim under Section 2(d) of the Trademark Act. The petition for cancellation is granted.