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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re E. & J. Gallo Winery

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Serial No. 77458162

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D. Peter Harvey and Matthew A. Stratton of Harvey Siskind  
for E. & J. Gallo Winery.

Dayna J. Browne, Senior Trademark Examining Attorney, Law  
Office 104 (Michael Baird, Managing Attorney).

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Before Quinn, Holtzman and Bergsman, Administrative  
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

E. & J. Gallo Winery filed, on April 25, 2008, an  
intent-to-use application to register the mark BEAR  
REPUBLIC (standard character form) for "wines."

The senior examining attorney refused registration  
under Section 2(d), 15 U.S.C. §1052(d), on the ground that  
applicant's mark, when used in connection with applicant's  
goods, so resembles the previously registered mark shown  
below



for "brewed malt-based alcoholic beverages in the nature of beer and ale"<sup>1</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

The examining attorney maintains that the marks are similar in that both share the same words "BEAR REPUBLIC"; these words, appearing first in registrant's mark and at the top of registrant's label, comprise the portion most likely to be remembered by purchasers. In response to applicant's contention that the words "Bear Republic" are weak, the examining attorney introduced a printout of the results of a TESS search showing the absence of any third-party registrations of the same or similar mark. "BEAR REPUBLIC" in registrant's mark is likely to be viewed as a house mark, and the remainder of the mark as a separate additional mark for the specific product. According to the

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<sup>1</sup> Registration No. 2923042, issued February 1, 2005. The word "Ale" is disclaimed. The registration includes the following statement: "The mark consists of a star next to the words "Bear Republic" on a ribbon-like banner and a stylized rocket between the words 'Red' and 'Rocket.'"

examining attorney, it is common in the beer industry for brewers to use a house mark at the top of their marks, and then have an additional product mark below. In support of this proposition, the examining attorney submitted Internet evidence retrieved from the websites of registrant and third-party brewers. As to the goods, the examining attorney contends that they are related, relying on several third-party registrations showing that the same entity has registered the same mark for both beer and wine. In addition, there is Internet evidence showing two wineries also producing beer.

Applicant contends that the words "BEAR REPUBLIC" do not comprise the dominant portion of registrant's mark due to the small size of the words relative to the other portions of the mark. Rather, applicant asserts, the dominant portion comprises "RED ROCKET ALE," given its size in the mark and the representation of a rocket. According to applicant, "[h]ad the Registrant intended 'Bear Republic' to be the dominant portion of the mark, it would have put those words in the center of the mark, in much larger print, and included a drawing of a bear." (Brief, p. 3). In sum, applicant argues that the marks, when considered in their entirety, are "dramatically" different in appearance, given the presence in registrant's

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mark of "a prominent drawing of a rocket in take-off, handwritten script, three different text sizes, a drawing of a star, a banner, and a box enclosing the primary elements of the mark." (Brief, p. 6). Applicant also points to differences in sound, meaning and commercial impression. Applicant submitted Internet evidence bearing on the presence of a golden bear and the words "California Republic" on the California state flag. In this connection, applicant argues that the words "Bear Republic" are diminished in distinctiveness because they are suggestive of the state of California. As to the goods, applicant's only remark is that they are "not identical." (Brief, p. 7).

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to the second *du Pont* factor and compare beer and ale with wines. It is not necessary that the respective goods be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. The issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

Applicant's and registrant's goods obviously are similar to the extent that wine, beer and ale are alcoholic beverages. Wine and beer/ale are specifically different products which would not be confused for each other, but that is not the test, as noted above.

Further, the examining attorney submitted eleven third-party use-based registrations that include in their identification of goods both wine and beer (and/or ale). Although such registrations are not evidence that the marks

shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). Also of record are excerpts of two third-party websites showing that these two wineries also produce beer. We find that the evidence of record weighs in favor of finding a likelihood of confusion under the second *du Pont* factor.

Insofar as the trade channels and classes of purchasers are concerned, we note that there are no trade channel limitations in either applicant's or registrant's identification of goods. Accordingly, we must presume that the goods, as identified, are marketed in all normal trade channels for such goods and to all normal classes of purchasers for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). It is common knowledge that wine and beer are routinely sold in the same trade channels (e.g., liquor stores, convenience stores, and the like) to the same purchasers, including ordinary ones; applicant does not argue to the contrary. *See Schieffelin & Co. v. Molson*

*Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) ["[a] typical consumer of alcoholic beverages may drink more than one type of beverage and may shop for different alcoholic beverages in the same liquor store. Moreover, a person may serve more than one kind of alcoholic beverage before or during a meal or at a party."] Further, wine and beer may be the subject of an impulse purchase made by an ordinary consumer without a great degree of sophistication. These factors weigh in favor of a finding of likelihood of confusion.

In making our findings above on the *du Pont* factors relating to the goods, we have kept in mind that when similar evidence has been made of record, numerous cases have found that different alcoholic beverages are related products which are sold in the same trade channels to the same classes of purchasers, including to ordinary consumers, and that confusion is likely to result if the goods were to be sold under similar marks. See, e.g., *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) [beer and tequila]; and *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Indeed, when the proper evidence has been made of record, the Board's precedential authority specifically

holds beer and wine are related products. See *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719 (TTAB 1992).

With respect to the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

With respect to registrant's mark, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("There is nothing



improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.").

Where both words and a design comprise the mark (as in registrant's mark), then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Thus, although we have taken into account the design features of the cited mark, we find that the dominant portion is the literal portion of the mark.

Even assuming that the term "RED ROCKET ALE" is the dominant portion of the registered mark, as applicant argues, we find that the marks are similar because they share the words "BEAR REPUBLIC." See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 9 USPQ2d at 1692 ["To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a 'prominent

feature' as the first word in the mark and the first word to appear on the label."]; *Hewlett-Packard Company v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ["the dominant portion of Packard Press's mark [PACKARD TECHNOLOGIES] is identical to a prominent portion of HP'S HEWLETT PACKARD marks"]; and *Presto Products, Inc. v. Nice Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ["it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"]. Although the words "Bear Republic" may suggest the state of California, the TESS summary indicates the absence of any third-party registrations of the same or similar mark for any goods (or services), let alone for alcoholic beverages. Thus, contrary to applicant's contention, we do not view these words as "weak."

As shown by the excerpts from registrant's (Bear Republic Brewing Company, Inc.) website, "Bear Republic" appears to be registrant's house mark that is used on a variety of its products. The examining attorney's evidence reveals that other brewers use their house mark or trade name at the top of a label or mark, followed by an additional product mark below, as is the case with registrant's mark. This would appear to be a common

practice in the industry, and serves to buttress the notion that the "BEAR REPUBLIC" portion of registrant's mark cannot be ignored when comparing the marks.

In sum, the marks share the identical literal portion, "BEAR REPUBLIC." Thus, we find that the marks are similar in appearance, sound, meaning and overall commercial impression. This factor weighs in favor of finding a likelihood of confusion. While registrant's mark includes other words and design features, this first portion of registrant's mark is identical to the entirety of applicant's mark, and thus may lead consumers to mistakenly believe that applicant's BEAR REPUBLIC wine is an expansion of the BEAR REPUBLIC product line and somehow is associated or affiliated with the source of the product sold under the mark BEAR REPUBLIC RICARDO'S RED ROCKET ALE and design.

Lastly, to the extent that any of applicant's points raises a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrants. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision:** The refusal to register is affirmed.