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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jose Cuervo, S.A. DE C.V.

Serial No. 77564969

Lawrence E. Abelman of Abelman, Frayne & Schwab, for Jose Cuervo, S.A. DE C.V.

Matthew J. Pappas, Trademark Examining Attorney, Law Office 107 (Leslie Bishop, Managing Attorney).

Before Bucher, Bergsman, and Ritchie, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Jose Cuervo, S.A. DE C.V. ("applicant") filed an application to register the mark shown below, for "rum; alcoholic beverages containing rum,"¹ in International Class 33:

¹ Serial No. 77564969, filed September 8, 2008, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a *bona fide* intent to use in commerce, disclaiming the exclusive right to use "RUM/RHUM" and "ANEJO" apart from the mark as shown, and stating: "The English translation of 'CASTILLO,' 'RHUM and 'ANEJO' in the mark is 'CASTLE,' 'RUM,' and 'AGED.'"



The Trademark Examining Attorney refused registration of applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the two registered marks shown below, both owned by the same entity, that when used on or in connection with applicant's goods, it is likely to cause confusion or mistake or to deceive:

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1. Cited registration #1, for "rum," in International Class 33,²

The word "Castillo" is written in a black, elegant cursive script on a white background.

2. Cited registration #2, for "rum [and anise liquor]," in International Class 33"³



² Registration No. 1013668, issued July 17, 1975, based on first use and first use in commerce on December 31, 1933. Sections 8 and 15 affidavits accepted and acknowledged. Renewed twice. The registration contains the translation statement: "'Castillo' is a Spanish word having the English meaning 'Castle.'"

³ Registration No. 0544316, issued June 26, 1951, based on first use on December 31, 1914, and first use in commerce on December 31, 1933. Sections 8 and 15 affidavits accepted and acknowledged. Renewed three times.

Upon final refusal of registration, applicant filed a timely appeal. Both applicant and the examining attorney filed briefs. For the reasons discussed herein, the Board affirms the refusal to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); see also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

For purposes of the analysis, we focus on the cited registration that is most similar, Registration No. 1013668. If we find a likelihood of confusion with this cited registration, then the examining attorney's arguments vis-à-vis the other cited registration are moot. Conversely, if we do not find a likelihood of confusion for this cited registration, then we would not find it for the other. We discuss each of the *du Pont*

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factors as to which applicant or the examining attorney submitted argument or evidence.

The Goods

The application identifies "rum; alcoholic cocktails containing rum" while the Registration No. 1013668 identifies simply "rum." Accordingly, the goods in the cited registration are encompassed within the broad scope of "rum; alcoholic cocktails containing rum" identified in the application. Hence, the goods in the cited registration are legally identical to those in the application, and we find that this *du Pont* factor strongly favors finding a likelihood of confusion.

The Channels of Trade and Classes of Purchasers

Because registrant's goods and applicant's goods as identified in the application and the cited registration are legally identical, we presume that the respective services are or will be sold in the same trade channels and to the same classes of purchasers. *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009); *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003); *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Accordingly, we find that these *du Pont* factors also weigh in favor of finding a likelihood of confusion.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee*

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En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

We note that the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The mark in Registration No. 1013663 is as follows:



Castillo

We note that this mark consists entirely of the stylized word "CASTILLO," translated as "castle."⁴

Applicant's mark is as follows:



Applicant's mark consists of both words and a design. The word "CASTILLO," is by far the largest and most prominent word in applicant's mark. It is further emphasized by the

⁴ Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine similarity of connotation in a likelihood of confusion analysis. See *Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Foendee En 1772*, supra 73 USPQ2d at 1696. The doctrine is applied when "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Id.* See also *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008).

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drawing of a large castle (or "castillo") in the mark. The other words in applicant's mark ("Rum," "Rhum," "Anejo") are descriptive and disclaimed. Descriptive or disclaimed matter is generally considered a less dominant portion of a mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). Accordingly, we find that the commercial impression of "Castillo" (or "castle") strongly dominates applicant's mark, just as it does the mark in Registration No. 1013668.

In sum, we find that, viewed in their entirety, the similarities of the marks outweigh their differences. Accordingly, we find this *du Pont* factor also favors finding a likelihood of confusion.

Third-Party Use of Shared Term

Applicant argues that under the sixth *du Pont* factor, we should consider in this case, the "number and nature of similar marks in use on similar goods." At core, the relevant question is whether so many third parties use the term shared between the mark in the application and the cited registration that consumers will look to even very nuanced points of differentiation. *See In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1564-1565 (TTAB 1996). In that case, the applicant submitted evidence that hundreds of businesses use the shared term for the goods for which applicant sought registration.

Here, applicant submitted eighteen relevant, use-based third-party registrations in International Class 33 that include

in the mark either "CASTILLO" or the translated "CASTLE."⁵ As the examining attorney pointed out, almost all of the third-party registrations were for "wine" or "wines" and none were for apparently "rum" or "alcoholic cocktails containing rum" as identified in the application. While eighteen, or even twenty-six, use-based registrations may seem like a lot to applicant, it is certainly not overwhelming evidence in applicant's favor.

Moreover, third-party registrations do not prove that "Castillo" or "Castle" are weak terms. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party (sic) registrations are still in use. Because of this doubt, third party (sic) registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as their weakness in distinguishing source.

In re Hub Distributing, Inc., 218 USPQ at 286.

⁵ Applicant submitted closer to twenty-six third-party registrations, but several were not use-based (for example they were based on international priority under Section 44 or 67 of the Trademark Act).

Finally, the third-party registrations have value to show the meaning of a term analogous to a dictionary. In this case, the third-party registrations show that CASTILLO has some significance in connection with wine because it has been adopted and registered numerous times. However, we do not find that CASTILLO is descriptive when used in connection with rum. The most that could be said is that CASTILLO has some suggestive significance in connection with alcoholic beverages. Thus, we find that the word CASTILLO is inherently distinctive when used in connection with rum.

We deem this *du Pont* factor to favor applicant.

Conclusion

In summary, we have carefully considered all of the evidence and arguments of record relevant to the *du Pont* likelihood of confusion factors. We conclude that although applicant has shown that there are third-party registrations incorporating the word "CASTILLO" or "CASTLE" in International Class 33, that evidence is overridden by the fact that applicant and registrant here have legally-identical goods moving in the same channels of trade to the same purchasers, and similar marks, both dominated by the commercial impression of "Castillo" (or "castle."). Accordingly, on the balance, we find a

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likelihood of confusion between applicant's mark and
Registration No. 1013668 as discussed herein.⁶

Decision: The refusal to register is affirmed.

⁶ We note that since we have affirmed as to Registration No. 1013668, we has not considered the refusal as to Registration No. 0544316.