

This Opinion is not a  
Precedent of the TTAB

Mailed: May 23, 2022

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*In re Kenzo Ltd.*

Serial No. 79272212

Jerry E. Nagae and Makiko Coffland of Christensen O'Connor Johnson Kindness PLLC, for Kenzo Ltd.


Mary Rummery, Trademark Examining Attorney, Law Office 105,  
(Jennifer Williston, Managing Attorney).

Before Cataldo, Wolfson and Goodman,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Kenzo Ltd., filed an application to register on the Principal Register

**ren**

the mark  identifying "Wine" in International Class 33.<sup>1</sup>

<sup>1</sup> Application Serial No. 79272212 was filed on September 26, 2019 seeking an extension of protection under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f), of International Reg. No. 1498792, issued on September 26, 2019. Applicant submitted the following color, translation and transliteration statements: Color is not claimed as a feature of the mark; The

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of



likelihood of confusion with the cited registered mark **REN** identifying “Vodka” in International Class 33.<sup>2</sup>

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board.<sup>3</sup> We affirm the refusal to register.

### **I. Likelihood of Confusion**

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*,

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English translation of “REN” in the mark is “LOTUS”; The non-Latin characters in the mark transliterate to “REN” and this means “LOTUS” in English.

<sup>2</sup> Registration No. 6036032 issued on the Principal Register on April 1, 2020. The registration includes the following color statement and description of the mark: Color is not claimed as a feature of the mark; The mark consists of a circle with a decorative border containing an image of a phoenix with the letters “REN” in upper case lettering below the circle. The registration does not include a translation statement.

<sup>3</sup> All citations to documents contained in the Trademark Status & Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. See, e.g., *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. See, e.g., *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, \*2 n.1 (TTAB 2020).

575 U.S. \_\_\_, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *see also In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

We have considered each *DuPont* factor that is relevant, and have treated other factors as neutral. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”).

Two key considerations are the similarities between the marks and the relatedness of the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

**A. The Goods and Channels of Trade**

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004).

In support of the refusal of registration, the Examining Attorney introduced into the record<sup>4</sup> printouts from the following third-party websites showing use of the same marks and trade names to identify various types of wines and vodka:

- Six Mile Creek (Chardonnay Reserve and Vodka);
- Koenig Distillery and Vineyards (Huckleberry Flavored Vodka and 2019 Chardonnay);
- Falls Church Distillers (Frozen Falls Vodka and Apple Cherry Brandy);
- Seven Jars (Seven Jars Vodka and Seven Jars Cabernet Sauvignon);
- Flag Hill (Sparkling White Wine and General John Stark Vodka);
- Fiore Winery (Racetrack Red [wine] and Blue Crab Vodka);

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<sup>4</sup> August 27, 2020 Office Action at 25-38; April 24, 2021 final Office Action at 16-57.

- Charbay Winery & Distillery (Cabernet Sauvignon and Clear Vodka);
- Almendra Winery & Distillery (Monkey Faced Brandy and Monkey Face Vodka); and
- Davis Valley Winery & Distillery (Virginia Breeze Red [wine] and Virginia Frost Vodka).

This evidence establishes at least these third parties offer both Applicant's goods, wine, and the goods identified in the cited registration, vodka, under the same house marks or trademarks.

The Examining Attorney also introduced into the record<sup>5</sup> copies of approximately twenty use-based, third-party registrations for marks identifying, *inter alia*, wine and vodka. The following examples are illustrative:<sup>6</sup>

Reg. No. 1064997 for the mark ASTOR;

Reg. No. 1729721 for the mark JOHNSON'S; and

Reg. No. 2791187 for the mark CHARBAY.

As a general proposition, although use-based, third-party registrations alone are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have some probative value to the extent they serve to suggest that the goods are of a kind that emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). In this case, the totality of the website and

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<sup>5</sup> April 24, 2021 final Office Action at 21-64.

<sup>6</sup> All three marks appear in typed or standard characters.

third-party registration evidence demonstrates that consumers would readily expect wine and vodka are likely to emanate from the same sources.

For this reason, we are not persuaded by Applicant's arguments regarding the distinctions between wine and vodka, namely, that they are dissimilar "in terms of ingredients, method of manufacturing, taste, and alcoholic content."<sup>7</sup> Clearly, there are distinctions between these alcoholic beverages. However, to support a finding of likelihood of confusion, it is not necessary that the goods be identical or even competitive. It is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009). The evidence of record clearly establishes that wine and vodka, despite their differences as alcoholic beverages, may emanate from common sources.

Applicant relies upon our determination in *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009) in support of its contention. However, in *White Rock*, this tribunal not only found insufficient support in the record for the examining attorney's argument that energy vodka infused with caffeine was related to sparkling fruit wine, sparkling grape wine, sparkling wine and wines, but also found that the applied-for

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<sup>7</sup> 4 TTABVUE 11-12 (Applicant's brief).

mark VOLTA was more dissimilar from, than similar to, the registered mark



. *Id.* at 1285. In the case before us, the Examining Attorney’s evidence of record supports a finding that vodka and wine may emanate from common sources, under the same house marks or trademarks, and as discussed more fully below, we find the marks more similar in their entirety than dissimilar.

With regard to the third *DuPont* factor, the similarity of the trade channels in which the goods are encountered, we must base our likelihood of confusion determination on the basis of the goods as they are identified in the application and registration at issue. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). *See also Octocom*, 16 USPQ2d at 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed”).

In other words, we may not limit or restrict Applicant’s broadly identified wine or the similarly unrestricted vodka listed in the cited registration by price point, availability or quality, but rather must consider both wine and vodka to include

modestly priced beverages as well as more expensive, high-end varieties, available at all typical vendors. We thus are not persuaded by Applicant's arguments that

the relevant classes of consumers, such as persons at legal drinking age, do not face the respective goods in a same manner due to further restrictions to the sales of spirits and hard liquor as opposed to the sales of wines. Many states within the United States pose a restriction to the sales of hard liquor, such as limited locations and hours or dates to purchase. For all of these reasons, the goods are distinctive to each other, and consumers are not likely to presume these marks emanate from the same source and confusion is not likely to occur.<sup>8</sup>

Applicant's contentions rely upon restrictions not present in either identification of goods. Evidence of record demonstrates that both Applicant's goods and Registrant's goods may be encountered by the same classes of consumers under the same marks in at least one common trade channel, i.e., websites of wine and vodka producers and sellers. Although Applicant's contention that many states within the United States restrict the sale of hard liquor to "limited locations, hours or dates to purchase," nothing in the record suggests that any such restrictions apply to website advertising. In addition, the identifications of goods in the cited registration and involved application do not recite any limitations as to the channels of trade in which the goods are or will be offered. In the absence of trade channel limitations on the goods offered under the applied-for and registered marks, we must presume that these goods are offered in all customary trade channels. *See Citigroup v. Capital City Bank Grp.*, 98 USPQ2d at 1261; *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

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<sup>8</sup> 4 TTABVUE 13.



We find that the *DuPont* factors of the relatedness of the goods, channels of trade and classes of consumers weigh in favor of likelihood of confusion.

### B. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of

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Applicant's 蓮 mark and the registered REN mark in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”).

“The proper test 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.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted); see also *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In*

*re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988), *aff'd mem.*, 864 F.2d 149 (Fed. Cir. 1988).

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Applicant's 蓮 mark adopts the wording of the registered mark in its entirety, adding a non-Latin character that transliterates to "REN." We thus find that the non-Latin wording in Applicant's mark reinforces and refers back to the term "REN." Applicant states that "REN" translates to "lotus" in English. Nothing in the record suggests that "REN" has a different significance in Applicant's mark as applied to wine than in the registered mark as applied to vodka. Similarly, to the extent consumers will recognize that the term "REN" translates to "lotus" in either mark, "lotus" appears to have the same connotation or meaning in both. Thus, the term "REN" common to the marks is identical in meaning and sound and similar in appearance.

Applicant argues: "the wording 'ren' in lowercase letters does not create a similar impression with the wording '**REN**' in bold uppercase letters. Unlike some alphabets where letters in uppercase and lowercase look exactly same, such as 'C' and 'c,' and 'K' and k,' and 'O' and 'o,' each letter of the wording 'ren' in Applicant's mark appears completely different from each letter of the wording '**REN**' in Registrant's mark."<sup>9</sup> We

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<sup>9</sup> 4 TTABVue 9 (emphasis supplied by Applicant).

agree with Applicant that the renditions of the term “REN” in both marks differ to the extent that one is in upper case and the other in lower case letters. Nonetheless, both include the same three letters, namely, “REN” which are similar in appearance and identical in sound and meaning.

Applicant further argues that the differences in the marks, namely, the non-Latin character for “REN” in Applicant’s mark and the phoenix design in the registered mark, create significant differences in the marks’ meaning and appearance.<sup>10</sup> However, as discussed above, the Chinese or Japanese character in Applicant’s mark transliterates to “REN,” and thus reinforces the wording therein. Further, although



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the registered **REN** mark includes the design of a phoenix inside a circle, it is settled that where, as here, a mark is comprised of both a word and a design, the word is normally accorded greater weight, in part because consumers are likely to remember and use the word to request the goods. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (“if one of the marks 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 or services” and “because applicant’s mark shares

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<sup>10</sup> 4 TTABVUE 9-11.

with registrant's mark that element responsible for creating its overall commercial impression, the marks are confusingly similar"). There is nothing in the record to suggest that consumers will utilize the design portion of Applicant's or Registrant's mark to request the goods rather than the more conventional wording, "REN."

Further, it is not clear on this record to what extent consumers of wine and vodka will recognize the design in the registered mark as denoting a phoenix, as opposed to a different zoological or mythological creature. The average consumer will not be aware of the description of the registered mark and will rely upon its unaided appearance.

Where, as here, the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding some differences. *See, e.g., Stone Lion*, 110 USPQ2d at 1161 (affirming TTAB's finding that applicant's mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties' marks); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (finding that, even though applicant's mark PACKARD TECHNOLOGIES, with "TECHNOLOGIES" disclaimed, does not incorporate every feature of opposer's HEWLETT PACKARD marks, a similar overall commercial impression is created).

We recognize the differences between the marks. Nonetheless, viewing the marks as a whole, we find purchasers may reasonably assume, due to presence of the term "REN" in both marks that Applicant's goods offered under its mark emanate from the

same source as the related goods in the cited registration. As a result, consumers encountering these marks could mistakenly believe the two are a variation of each other used to identify wine and vodka, but nonetheless emanating from a common source.

For these reasons, we find that the marks are more similar than dissimilar. The first *DuPont* factor thus also weighs in favor of finding a likelihood of confusion.

### **C. Conditions of Purchase**

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. In its brief, Applicant argues that “Average alcohol consumers are able to distinguish specific alcohol products from a variety of different types and brands of alcoholic beverages.”<sup>11</sup>

However, as discussed, both Applicant’s wine and the vodka identified in the cited registration must be presumed to include both expensive and inexpensive varieties, available in any common channels of trade. There is nothing in the nature of these alcoholic beverages, without any limitation as to their type, price point or intended consumers, to suggest their purchasers are particularly sophisticated or careful. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1739 (TTAB 2018). In fact, the standard of care is that of the least sophisticated potential purchaser. *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1163 *cited in In re FCA US LLC*, 126 USPQ2d 1214, 1222

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<sup>11</sup> 4 TTABVUE 13.

(TTAB 2018) (“Board precedent requires our decision to be based on the least sophisticated potential purchasers.”). In the absence of evidence relating to the degree of care purchasers exercise, the similarity of the marks and relatedness of the goods outweigh Applicant’s assertion that purchasers are sophisticated or careful in their purchases. *See HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff’d*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods).

All in all, we have insufficient bases to find that ordinary consumers would exercise more than an ordinary degree of care. The fourth *DuPont* factor is neutral.

#### **D. Conclusion**

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant’s arguments relating thereto, including those arguments and evidence not specifically addressed herein, we conclude that consumers familiar with Registrant’s goods offered under its mark would be likely to believe, upon encountering Applicant’s mark, that the goods originated with or are associated with or sponsored by the same entity.

**Decision:** The refusal to register Applicant’s mark is affirmed under Section 2(d) of the Trademark Act.