

**This Opinion is Not a
Precedent of the TTAB**

Mailed: February 24, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JWB Wine LLC

Serial No. 86163390

Leela Madan of Madan Law PLLC,
for JWB Wine LLC.

Ellen Awrich, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

Before Bergsman, Wolfson and Hightower,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

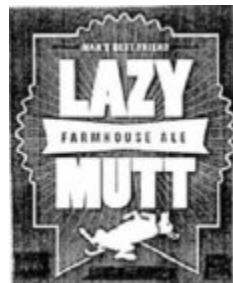
JWB Wine LLC (“Applicant”) seeks registration on the Principal Register of the mark MUTT (in standard characters) for “Beers,” in International Class 32.¹

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 that Applicant’s mark so resembles the two registered marks listed below, both registered

¹ Application Serial No. 86163390 was filed on January 12, 2014, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act of 1946, 15 U.S.C. § 1051(b).

on June 14, 2011 for beer and both owned by the same entity, as to be likely to cause confusion:

1. Registration No. 3976478 for the mark LAZY MUTT (in standard characters); and
2. Registration No. 3976477 for the mark LAZY MUTT FARMHOUSE ALE MAN'S BEST FRIEND and design, shown below:



Registrant disclaimed the exclusive right to use the phrase "Farmhouse Ale."

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Preliminary Issues

A. Whether the evidence attached to Applicant's brief was timely filed?

When Applicant filed its brief, it attached evidence that had not been previously filed. The Trademark Examining Attorney, in her brief, objected to the evidence attached to the brief on the ground that it was not timely filed.²

Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), reads as follows:

² 9 TTABVUE 5.

The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.

Applicant argues that “while ‘[t]he TTAB will not consider evidence for the first time with a reply brief; [it] may consider evidence submitted for the first time in the main brief,’” citing a decision that was not designated as precedential, *In Re Julie White*, Serial No. 78175476 (TTAB 2004), and TBMP § 1207.03 (2d ed., rev. 2004).³

The evidence submitted by the applicant for the first time with its brief in the *Julie White* appeal were copies of two third-party applications printed from the USPTO database. Section 1207.03 of the TBMP discusses when evidence filed after an appeal is filed may be considered.

Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence, *see* TBMP § 1207.02, may be considered by the Board, despite its untimeliness, if the nonoffering party(1) does not object to the new evidence, and (2) discusses the new evidence or otherwise affirmatively treats it as being of record. [Note 1.] In such a situation, the Board may consider evidence submitted by the nonoffering party to rebut the untimely evidence. [Note 2.]

* * *

If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise the applicant that a listing is insufficient to make such

³ 12 TTABVUE 4.

registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to the admissibility of the list.

TBMP § 1207.03 (2015). In *Julie White*, without any explanation, the Board held that it would consider copies of the two applications submitted for the first time with applicant's brief because their submission fell within the circumstances covered by TBMP Section 1207.03. We surmise that the applications were on a list of registrations and applications submitted earlier and that the Examining Attorney did not lodge an objection to the copies of the applications.

The evidence submitted by Applicant in this appeal does not fall within the exception identified in the TBMP because the Examining Attorney objected to the evidence and the evidence was not derived from a list of registrations previously submitted. In view of the foregoing, the objection to the evidence attached to Applicant's brief is sustained. We will give such evidence no consideration with the exception of the dictionary definition of the word "Mutt."⁴

B. Our focus will be on Registration No. 3976478 for the mark LAZY MUTT (in standard characters).

Because the design element and additional wording in the mark LAZY MUTT FARMHOUSE ALE MAN'S BEST FRIEND and design (Registration No. 3976477) contain additional points of difference with Applicant's mark, we confine our analysis

⁴ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

to the issue of likelihood of confusion between Applicant's mark and Registration No. 3976478 for the mark LAZY MUTT (in standard characters). That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with the mark LAZY MUTT FARMHOUSE ALE MAN'S BEST FRIEND and design, while if there is no likelihood of confusion between Applicant's mark and LAZY MUTT (in standard characters), then there would be no likelihood of confusion with the mark with the mark LAZY MUTT FARMHOUSE ALE MAN'S BEST FRIEND and design. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

II. Applicable Law

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of 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 Co., 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 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.”).

A. The similarity or dissimilarity and nature of the goods.

The goods are identical.

Applicant argues that although Applicant's beers and Registrant's beer are both beer, "there are distinct differences within the range of beers categorized as ales."⁵ This argument is unavailing because we must consider the goods as they are described in the application and registration. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("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."). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods."). We also do not read limitations into the identification of goods. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration."). Therefore, we must presume that Registrant's beer includes all types of beers, including Applicant's beer.

B. The similarity or dissimilarity of established, likely-to-continue channels of trade.

⁵ 9 TTABVUE 18.

Because the goods described in the application and the cited registration are identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

C. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, “two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound *or* visual appearance *or* connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int'l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff'd mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola 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.”)).

In comparing the marks, we are mindful that where, as here, the goods are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“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.*, 101 USPQ2d at 1721 (quotation omitted). See also *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 mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *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). Because the goods at issue are beer without any restrictions as to the type of beer, channels of trade or classes of consumers, the average customer must be considered an ordinary consumer of beer.

Applicant's mark is MUTT and the registered mark is LAZY MUTT. The marks are similar because they both contain the word "Mutt." The word MUTT in the registered mark LAZY MUTT is the dominant element of the registered mark because the word "Lazy" is an adjective describing the word "Mutt" (*i.e.*, what kind of mutt? A lazy mutt.). Thus, the word "Mutt" is that part of the registered mark most likely to catch the attention of the average beer drinker and be remembered by the average beer drinker.⁶

We are aware that the similarity or dissimilarity of the marks is determined based on the marks in their entireties and that the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("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."). On the other hand, 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 a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

⁶ As explained in the main text, we disagree in this case with Applicant's contention that consumers will focus on the word "Lazy" because it is first part of Applicant's mark. 9 TTABVUE 12-13.

The word “Mutt” is defined as “a mongrel dog.”⁷ The word “Lazy” is defined as “not liking to work hard or to be active” and “moving slowly.”⁸ The marks MUTT and LAZY MUTT have similar meanings and engender similar commercial impressions (e.g., a dog and/or a lazy dog). Applicant argues, on the other hand, that the marks engender different commercial impressions when applied to the taste and character of the beer products they identify.⁹ However, we may not consider the taste and character of the particular beers because, as we have previously discussed, the products as identified are identical. Our likelihood of confusion analysis is limited to the description of goods in the application and registration without the benefit of extrinsic evidence.

In similar circumstances where Registrant’s mark incorporates Applicant’s entire mark, the Board has found that the marks are similar. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women’s dresses is likely to be confused with LILLI ANN for women’s apparel including dresses); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660-61 (TTAB 2014) (applicant’s mark PRECISION is similar to registrant’s mark PRECISION DISTRIBUTION CONTROL); *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women’s clothing stores and women’s clothing likely to cause

⁷ MERRIAM-WEBSTER online dictionary at 9 TTABVUE 28.

⁸ *Id.* at 31.

⁹ 9 TTABVUE 16.

confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *United States Shoe*, the Board observed that "Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark." 229 USPQ at 709.

In view of the foregoing, we find that the marks are similar in their entireties as to appearance, sound, connotation, and commercial impression.

D. The number and nature of similar marks in use on similar goods.

Applicant argues that the word "Mutt" is commonly used to identify a broad range of goods and services, including "over 125 active applications and registrations utilizing the word 'MUTT' in each respective mark, including 89 registered marks."¹⁰ Setting aside the fact that there is no evidence of record corroborating that fact, third-party use for products that are not related to beer is of limited probative value.

None of the third party marks and uses of ACE made of record are nearly as closely related to the activities of the parties as the virtually identical uses of the parties are to each other. Thus, we agree with the Board that nothing in the record shows a narrowing of Editors' identification with A.C.E./ACE by third party marks with respect to the relevant public, namely, the film industry or even the broader entertainment industry. In sum, Cable's argument that it can use ACE because ACE is a "weak" mark, as an abstract proposition, is not only unpersuasive but essentially meaningless.

Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc., 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991). See also *Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) ("Nor is our

¹⁰ 9 TTABVUE 21.

conclusion altered by the presence in the record of about 40 third-party registrations which embody the word ‘KEY.’ The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here.”); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue).

In view of the foregoing, the number and nature of similar marks in use on similar goods is neutral.

E. The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.

Applicant argues that the purchasers of “craft beer” pride themselves on being knowledgeable, that, in some instances “it is quite common for a bottle of craft beer to be upwards of \$30,” and that they are “more likely to ensure who they are receiving these goods from and conduct extensive research on the entity providing such goods as well as the goods themselves.”¹¹

The problem with Applicant’s argument is that it is attempting to limit the description of goods to craft beers when the description of goods in both its application and the cited registration is beer without any restrictions or limitations. Under such circumstances, we cannot resort to extrinsic evidence to restrict Registrant’s beer or Applicant’s beer to determine the degree of purchaser care. *See In re Bercut-*

¹¹ 9 TTABVUE 22-25.

Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). Because there are no restrictions as to the nature of the beer in the description of goods, the beers include not only expensive, craft beer sold to careful, discriminating consumers but also less expensive beers sold to ordinary consumers through mass marketing such as grocery stores, convenience stores, *etc.* *Id.* At the lower and middle range of the price spectrum, beer may be purchased by ordinary adult consumers for a variety of reasons, such as for parties and the like.

Accordingly, we find that the highly sophisticated purchaser argument propounded by Applicant is not supported by the record and that it is the average ordinary adult consumer who must be looked at in determining likelihood of source confusion in this case.

F. Balancing the factors.

Because the marks are similar, the goods are identical, and there is a presumption that the goods move in the same channels of trade, we find that Applicant's mark MUTT for "beers" is likely to cause confusion with the Registered mark LAZY MUTT for "beer."

Decision: The refusal to register Applicant's mark MUTT is affirmed.