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Subject: U.S. TRADEMARK APPLICATION NO. 86333439 - DUO - 2731-051.TM - EXAMINER BRIEF

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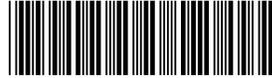
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86333439

MARK: DUO



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Uinta Brewing Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

2731-051.TM

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the trademark DUO for "beer". The trademark for which registration is sought gives rise to a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the trademark DUO for "wine" in U.S. Registration No. 2255914.

STATEMENT OF FACTS

On July 10, 2014, Uinta Brewing Company applied for registration of the trademark DUO for “beer” under Section 1(a) of the Trademark Act.

On September 10, 2014, the examining attorney refused registration of the trademark due to a likelihood of confusion with the mark DUO for “wine” in U.S. Registration No. 2255914.

The applicant filed a timely response on March 10, 2015 with arguments in favor of registration and against the substantive refusal.

On March 13, 2015, the applicant filed a Voluntary Amendment with additional evidence in support of its arguments in favor of registration and against the refusal.

On April 25, 2015, the examining attorney issued a final Office action refusing registration due to a likelihood of confusion with U.S. Registration No. 2255914.

On October 26, 2015, the applicant filed a timely Notice of Appeal and submitted a timely appeal brief on December 28, 2015.

ISSUE

The sole issue on appeal is whether under Trademark Act Section 2(d), there is a likelihood of confusion between the applicant’s proposed mark DUO for “beer” and U.S. Registration Number 2255914 for the mark DUO for “wine”.

ARGUMENTS

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of

likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. THE MARKS ARE IDENTICAL

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, the applicant's proposed mark is DUO, and the registrant's mark is DUO. Thus, the marks are not only similar, but are identical. The applicant does not disagree that the marks are identical.

Where the marks of the respective parties are identical or virtually identical, as they are here, the relationship between the relevant goods need not be as close to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re House Beer, LLC*, 114 USPQ2d 1073, 1077 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); TMEP §1207.01(a).

B. THE GOODS ARE CLOSELY RELATED

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Various alcoholic beverages have been shown to be related goods for purposes of a Trademark Act Section 2(d) analysis. *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (holding GASPAR’S ALE for beer and ale likely to be confused with JOSE GASPAR GOLD for tequila); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (holding RED BULL for tequila likely to be confused with RED BULL for malt liquor); *In re Salierbrau Franz Sailer*, 23 USPQ2d

1719 (TTAB 1992) (holding CHRISTOPHER COLUMBUS for beer likely to be confused with CRISTOBAL COLON & design for sweet wine); *Somerset Distilling, Inc. v. Speymalt Whiskey Distribs. Ltd.*, 14 USPQ2d 1539 (TTAB 1989) (holding JAS. GORDON and design for scotch whiskey likely to be confused with GORDON'S for distilled gin and vodka); *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069 (TTAB 1989) (holding BRAS D'OR for brandy likely to be confused with BRADOR for beer); *Bureau Nat'l Interprofessionnel Du Cognac v. Int'l Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (holding trademark COLAGNAC for cola flavored liqueur likely to be confused with certification mark COGNAC for brandy).

In the instant case, the applicant's goods are "beer", and the registrant's goods are "wine". The applicant's goods are related to the registrant's goods because the same commercial entities make both beer and wine, and beer and wine travel through the same channels of trade to the same class of purchasers. The Internet evidence attached to the September 10, 2014 Office action and the April 25, 2015 final Office action is comprised of websites of wineries, breweries, and commercial entities that make and offer consumers both beer and wine. This evidence shows that beer and wine are related because the same companies make and offer consumers beer and wine under the same marks, and beer and wine travel in the same channels of trade to the same class of consumers. For example:

- The evidence from www.motorcitybeer.com shows that Motor City Brewing Works makes and offers consumers beer and wine under the same mark.
- The evidence from www.thevillagevintner.com shows that Village Vintner makes and offers consumers beer and wine under the same mark.
- The evidence from www.schillingbridgewinery.com shows that Schilling Bridge makes and offers consumers beer and wine under the same mark.
- The evidence from www.kbrewery.com shows that Kuhnenn Brewing Co. makes and offers consumers beer and wine under the same mark.
- The evidence from www.wagnerbrewing.com shows that Wagner makes and offers consumers beer and wine under the same mark.

- The evidence from www.westbendvineyards.com shows that Westbend makes and offers consumers beer and wine under the same mark.
- The evidence from www.pricklymoses.com and www.otwayestate.com shows that Otway makes and offers consumers beer and wine under the same mark.

Material obtained from the Internet is generally accepted as competent evidence. See *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1644-47 (TTAB 2015) (accepting Internet evidence to show false suggestion of a connection and that a name identified a particular living individual whose written consent to register was required); *In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1641-42 (TTAB 2011) (accepting Internet evidence to show geographic location was well-known for particular goods); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Leonhardt*, 109 USPQ2d 2091, 2098 (TTAB 2008) (accepting Internet evidence to show descriptiveness); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); TBMP §1208.03; TMEP §710.01(b).

The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. See *In re Nieves & Nieves LLC*, 113 USPQ2d at 1642 (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The Nat'l Telecomms. & Info. Admin. & Statistics Admin., *Exploring the Digital Nation: America's*

Emerging Online Experience (2013), available at

[http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation -
_americas_emerging_online_experience.pdf](http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf)). Thus, the widespread use of the Internet in the United

States suggests that Internet evidence may be probative of public perception in trademark examination.

In addition to the Internet evidence, the seventeen third party registrations attached to the September 10, 2014 Office action and the April 25, 2015 final Office action show that beer and wine are related because they may emanate from a single source under a single mark. For example, U.S. Registration No. 4588757 is for “beer” and “wines”; U.S. Registration No. 3994422 is for “beer” and “wine”; U.S. Registration No. 3962914 is for “beer” and “distilled spirits; wine”; U.S. Registration No. 3099373 is for “beer” and “wine”; U.S. Registration No. 3456841 is for “beer” and “wine”; U.S. Registration No. 4136155 is for “beer, ale, lager, porter and stout” and “wine”; and U.S. Registration No. 4380436 is for “beer” and “alcoholic beverages, namely, wine”.

These third party registrations and the evidence comprised of websites of wineries, breweries, and commercial entities attached to the September 10, 2014 Office action and the April 25, 2015 final Office action show that beer and wine are related because they emanate from a single source under a single mark and travel through the same channels of trade to the same class of purchasers.

The applicant argues that because there are relatively few registrations on the U.S. Patent and Trademark Register for both beer and wine, in comparison to the number of registrations for either beer or wine, confusion as to source is unlikely because this “suggests” that “consumers are not accustomed to encountering both beer and wine emanating from the same source” (March 10, 2015 Response to Office Action; December 28, 2015 Appeal Brief). The Internet evidence and third party registrations attached September 10, 2014 Office action and the April 25, 2015 final Office action clearly shows that consumers are accustomed to encountering beer and wine from the same source. The

evidence of record shows that the same commercial entities make and offer consumers both beer and wine, and that beer and wine are sold in the same channels of trade to the same class of purchasers.

The applicant also argues that the Trademark Act Section 2(d) refusal should be withdrawn because in some instances the Office has registered for different registrants similar marks for beer and wine. The applicant provides in support of this argument third party registrations, one of which was cancelled at the time of applicant's March 10, 2015 Response to Office Action (U.S. Registration No. 1564924). Prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); *see In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

In this case, the applicant's proposed mark is not only similar, but is identical, to the registrant's mark, and the evidence of record shows that the beer and wine are related; thus, there is a likelihood of confusion in the instant application.

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

CONCLUSION

The examining attorney, having established that the respective marks are similar and that the respective goods are closely related, respectfully submits that the applicant's mark so resembles the registered mark that it is likely, when applied to the applicant's goods, to cause confusion, or to cause mistake, or deceive. Accordingly, the examining attorney respectfully submits that registration of applicant's mark is properly refused under Trademark Act Section 2(d).

Respectfully submitted,

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