

This Opinion is not a  
Precedent of the TTAB

Mailed: December 13, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Austin Brothers' Beer Company LLC*  
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Serial No. 86545695  
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Daniel Christopherson of Lehrman Beverage Law, PLLC,  
for Austin Brothers' Beer Company LLC.

Laura Golden, Trademark Examining Attorney, Law Office 103,  
Michael Hamilton, Managing Attorney.

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Before Taylor, Adlin and Hightower,  
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Austin Brothers' Beer Company LLC ("Applicant") seeks registration on the Principal Register of the mark WOODY WHEAT (in standard characters) for "beer" in International Class 32.<sup>1</sup>

The Trademark Examining Attorney has refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on Applicant's failure to comply

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<sup>1</sup> Application Serial No. 86545695 was filed February 25, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of a *bona fide* intention to use the mark in commerce.

with an Office requirement to disclaim WHEAT because the wording is merely descriptive of Applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

The Examining Attorney also refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the goods identified in the application, so resembles two marks previously registered on the Principal Register to different owners as to be likely to cause confusion, to cause mistake, or to deceive. The cited marks are WOODY STOUT, in standard characters and with STOUT disclaimed, for "beer, ale and lager,"<sup>2</sup> and WOODY BROWN ALE, in standard characters and with BROWN ALE disclaimed, for "beer."<sup>3</sup> All goods identified in the registrations are in International Class 32.

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

#### I. Disclaimer Requirement

A requirement under Trademark Act Section 6 for a disclaimer of unregistrable matter in a mark is appropriate when that matter is merely descriptive of the goods at issue. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). Merely descriptive or generic terms are unregistrable under Trademark Act Section 2(e)(1) and therefore are subject to a disclaimer requirement if the mark is

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<sup>2</sup> Registration No. 4391478, issued August 27, 2013.

<sup>3</sup> Registration No. 4525092, issued May 6, 2014.

otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006).

The examining attorney contends that the word WHEAT in Applicant's mark is merely descriptive of its goods. Most relevant to the facts of this case, a term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of an ingredient, quality, or characteristic of the goods with which it is used. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular mark is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the possible significance that the mark is likely to have to the average purchaser encountering the goods or services in the marketplace. *See DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). In other words, the issue is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

Applicant's identified goods are "beer." In its appeal brief, Applicant states that its beer "is a wheat-style beer."<sup>4</sup> Thus, WHEAT plainly conveys information about

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<sup>4</sup> Appeal Brief at 13, 12 TTABVUE 15; *see also, e.g.*, definition of "wheat beer" as "any of various beers brewed using a mixture of wheat malt and barley malt." COLLINS ENGLISH DICTIONARY (2015) (American English), June 2, 2015 Office Action at 6-8.

Applicant's goods; in fact, Applicant indicates that "wheat" or "wheat-style" is the common descriptive name for a type of beer. Also, the Examining Attorney submitted 21 third-party, use-based registrations for beer in which WHEAT has been disclaimed, showing that the Office often finds "wheat" merely descriptive for beer.<sup>5</sup>

Thus, Applicant does not dispute that WHEAT is descriptive or generic for a style of beer encompassed within Applicant's identified goods. Rather, Applicant argues that, "even if 'WHEAT' were merely descriptive of Applicant's goods, Applicant is not required to disclaim 'WHEAT' because the word 'WHEAT' used in conjunction with the word WOODY is alliterative, and creates a distinctive sound pattern that engenders the mark as unitary."<sup>6</sup> Applicant consents to entry of a disclaimer in the alternative.<sup>7</sup> *See In re RiseSmart Inc.*, 104 USPQ2d 1931, 1932 (TTAB 2012).

In the context of a disclaimer requirement, where the combination of a registrable word and a merely descriptive word make a single distinct commercial impression, the term is unitary, obviating the need for a disclaimer. Our primary reviewing court considered the characteristics of a unitary term in *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991):

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.

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<sup>5</sup> August 18, 2015 Final Office Action at 2-53.

<sup>6</sup> Appeal Brief at 7, 12 TTABVUE 9.

<sup>7</sup> *Id.* at 7-8, 22, 12 TTABVUE 9-10, 24.

In rare cases, alliterative marks, or those with a rhyming or other sound pattern, can encourage persons encountering the mark to perceive the mark as a whole. *See, e.g., In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) (finding LIGHT N' LIVELY to be a unitary term not subject to disclaimer because the mark "as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the term 'LIGHT' per se," which is "lost in the mark as a whole").

It is well-established, however, that alliteration in and of itself does not render a mark unitary. Trademark Manual of Examining Procedure (TMPEP) § 1213.05(e) (April 2016). For example, the Board affirmed a required disclaimer of the term "LEAN" from the mark LEAN LINE in connection with low-calorie food products, finding the term not unitary: "[T]here is nothing in the record to suggest that the mere fact that both words which form the mark begin with the letter 'L' would cause purchasers to miss the merely descriptive significance of the term 'LEAN' or consider the entire mark to be a unitary expression." *In re Lean Line, Inc.*, 229 USPQ 781, 782 (TTAB 1986). Similarly, in *DuoProSS Meditech*, 103 USPQ2d at 1759, our primary reviewing court found no evidence that the alliteration in the term SNAP SIMPLY SAFER creates a commercial impression that is more than merely descriptive.

We reach the same conclusion here. The fact that the two words Applicant seeks to register both begin with W does not cause WHEAT to lose its descriptive significance for beer. WOODY WHEAT engenders the commercial impression of WOODY-brand wheat-style beer, or perhaps of wheat beer with "woody" notes, not of

a unitary term. WHEAT is merely descriptive of Applicant's goods under Trademark Act Section 2(e)(1) and therefore must be disclaimed pursuant to Section 6(a).

## II. Likelihood of Confusion

Moving to the refusal under Trademark Act Section 2(d), our determination is based on an analysis of all 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.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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 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.").

### A. Similarity of the Goods

We first consider the second *du Pont* factor, the similarity of the goods. We must look to the goods as identified in the involved application and cited registrations, not to any extrinsic evidence of actual use. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). Applicant's identified goods are "beer," while the goods identified in the two cited registrations are "beer" (WOODY BROWN ALE) and "beer, ale and lager" (WOODY STOUT). Thus, Applicant's goods are identical to some or all of the goods identified in each cited registration.

Because there are no limitations as to channels of trade or classes of purchasers in the description of goods in the application or cited registrations, we presume that Applicant's and Registrants' goods move or will move in all channels of trade normal for such goods and are available to all potential classes of ordinary consumers. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Moreover, because the goods described in the application and both cited registrations are identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

In our likelihood of confusion analysis, these findings under the second and third *du Pont* factors strongly support a finding that confusion is likely between Applicant's mark and both cited marks.

#### B. Similarity of the Marks

We next address the first *du Pont* likelihood of confusion factor, focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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 sources of the goods. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their components. *In re Nat’l 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. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data*, 224 USPQ at 751. When, as here, the marks would appear on goods that are identical, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *see also Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

Applicant's mark, like the two cited marks, consists of the term WOODY followed by the common name of a style of beer: WOODY WHEAT, WOODY STOUT, and WOODY BROWN ALE. Applicant explains:

Specifically, stout-style beers typically have a very dark, blackish color, and a strong roasty flavor. Brown ales, on the other hand, have a brown hue, and a nutty flavor. Finally, wheat ales are typically light in color and body, and have a unique spice to them that is not found in stouts or brown ales.<sup>8</sup>

In the cited marks, all wording is disclaimed except WOODY, and we have affirmed the requirement to do the same in Applicant's mark. Thus, the identical term WOODY is the only distinctive element in each of the three marks.

The fact that the shared term WOODY is the first word in Applicant's mark enhances its similarity to the cited marks. *See, e.g., Palm Bay*, 73 USPQ2d at 1692 (stating that "veuve" is a prominent part of the mark VEUVE CLICQUOT because it is the first word in the mark); *Century 21 Real Estate*, 23 USPQ2d at 1700 (stating that consumers will first notice the identical lead word on encountering the marks); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (stating that "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 additional word WHEAT does distinguish Applicant's mark somewhat from the cited marks in appearance and sound, we find that this descriptive matter has less significance in creating the mark's commercial impression

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<sup>8</sup> Appeal Brief at 13, 12 TTABVUE 15; *see also* August 13, 2015 Response to Office Action at Exhibit D, 20-21 (Merriam-Webster definition of "stout" as "a very dark, heavy beer").

and therefore is entitled to less weight in our likelihood of confusion determination. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.”) (quotation omitted).

Here, consumers are likely to view Applicant’s mark as designating a variation of one or both cited marks pointing to a common source, that is, a wheat-style beer under the WOODY brand, which also is offered in stout and brown ale-style beers. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (affirming Board decision that ML likely to be perceived as a shortened version of ML MARK LEES, and noting that “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical”).

Applicant also argues that the fact that the cited marks coexist “is itself evidence that the term WOODY is a weak indicator of source.”<sup>9</sup> We cannot agree. The application files of the two cited registrations are not of record. Accordingly, we have no evidence that would explain the rationale whereby the later registration was allowed to issue. Facts different from those before us now may have been before the involved examining attorney (such as, for example, a consent provided by the earlier registrant). Each case must be decided on its own merits, and the Office’s registration of the two cited marks does not bind the Board in deciding this appeal. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

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<sup>9</sup> Appeal Brief at 16, 12 TTABVUE 18.

For all of these reasons, we find Applicant's mark, considered in its entirety, to be similar to the cited marks, particularly as to their connotation and overall commercial impression. The first *du Pont* factor also supports a finding that confusion is likely.

### C. Third-Party Use

Finally, we address Applicant's arguments under the sixth *du Pont* factor, the number and nature of similar marks in use on similar goods. Applicant argues that many third parties have used and registered marks comprising the term WOODY in connection with beer, other alcoholic and non-alcoholic beverages, and bar and restaurant services, and that as a result, the term WOODY is relatively weak for beer and entitled to only a narrow scope of protection.

Addressing the registration evidence first, Applicant submitted one third-party registration for beer, a registration for the mark WOODY CREEK WHITE on the Supplemental Register.<sup>10</sup> This mark is distinguished from the three marks before us (WOODY WHEAT, WOODY STOUT, and WOODY BROWN ALE) by the presence of the term CREEK, lending a geographic connotation to the third-party mark not present in Applicant's mark or the cited marks. Moreover, given that the mark is used for beer, and the disclaimed term WHITE identifies the type of beer, WOODY CREEK is a unitary term in this mark.

Turning to common-law use of WOODY-formatives for beer, Applicant submitted with its request for reconsideration evidence relating to the existence and distribution

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<sup>10</sup> Registration No. 4047242, August 13, 2015 Response to Office Action at 31. The identified goods are "brewed malt-based alcoholic beverage in the nature of a beer."

of some 20 beers with names incorporating the term WOODY, including, for example, “Old Woody,” “Woody’s Perfect Porter,” “Woody’s Easy Ale,” and “Ringneck Big Woody Lager.” None of these third-party uses of record, however, has the same structure as Applicant’s mark and the cited marks, which consist only of the word WOODY plus the generic name of a beer style (i.e., WOODY WHEAT, WOODY STOUT, and WOODY BROWN ALE). Each of the names for which Applicant submitted Internet printouts indicating third-party use incorporates one or more other terms, which may assist consumers in distinguishing among them.

Applicant also submitted printouts from Untappd.com, described on Wikipedia as “a social networking service that allows its users to check into beers as they drink them, and share these check-ins and their locations with their friends,” showing more than 36,000 “check-ins” for various beers with names incorporating “Woody.”<sup>11</sup>

Even crediting all of Applicant’s evidence and accepting that the term WOODY is commonly used in association with beer, we cannot conclude that the public will look to other elements to distinguish Applicant’s mark from the two cited marks because they comprise no other source-identifying elements. As noted *supra*, each of the three marks is a standard character mark consisting only of WOODY followed by the descriptive or generic name of a beer style.

The cited registrations are presumed valid pursuant to Trademark Act Section 7(b), 15 U.S.C. § 1057(b). While strong marks are entitled to a broader scope of protection than weak ones, it has been emphasized often that even weak marks are

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<sup>11</sup> Request for Reconsideration at 22-235, 4 TTABVUE 36-249.

entitled to protection from registration by a subsequent user of a confusingly similar mark for identical goods. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (stating that likelihood of confusion “is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark”); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010). To accept Applicant’s argument would provide substantially no protection for the owners of the cited registrations under Trademark Act Section 2(d).

Based on the evidence of record, we find that the sixth *du Pont* factor weighs against a likelihood of confusion, but is not dispositive on the facts before us.

#### D. Conclusion as to Likelihood of Confusion

We have carefully considered all of the arguments and evidence of record, including any we have not specifically discussed, as they pertain to the relevant *du Pont* likelihood of confusion factors. Goods identified in the subject application and the cited registrations are identical, and we have found Applicant’s mark, considered in its entirety, to be highly similar to the cited marks.

Applicant, as the newcomer, had the obligation to select a mark which would avoid confusion, but did not do so. We find that Applicant’s mark is likely to cause confusion with the marks in cited Registration Nos. 4391478 and 4525092 when used in association with beer.

**Decision:** The refusal to register Applicant’s mark is affirmed.

However, should Applicant undertake and prevail in an appeal of the Section 2(d) refusal, this decision will be set aside if, within thirty days of the decision on appeal,

Applicant submits to the Board (in proper form) the required disclaimer of WHEAT. *See In re Country Music Ass'n Inc.*, 100 USPQ2d 1824, 1835 (TTAB 2011); Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g); Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1218 (2016). The disclaimer should be worded as follows: “No claim is made to the exclusive right to use WHEAT apart from the mark as shown.” TMEP § 1213.08(a)(i).