

This Opinion is not a
Precedent of the TTAB

Oral Hearing: March 8, 2018

Mailed: June 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Dead Bird Brewing, LLC
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Serial No. 87140389

Serial No. 87140417
—

Erik M. Pelton of Erik M. Pelton & Associates PLLC,
for Dead Bird Brewing, LLC.

Amy E. Thomas, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.
—

Before Taylor, Wellington and Wolfson, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Dead Bird Brewing, LLC (Applicant) seeks registration on the Principal Register
of the marks DEAD BIRD BREWING COMPANY (in standard characters, “Brewing

Company” disclaimed) and



both for “beer” in International Class 32.¹

¹ Applications Serial Nos. 87140389 for the bird design mark (Application ‘389) and 87140417 for the word mark (Application ‘417) were filed on August 16, 2016. Both applications were filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s allegation of December 1, 2015 as a date of first use anywhere and in commerce.

The Trademark Examining Attorney has refused registration of both marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's marks, as used in connection with beer, so resemble the registered standard character mark, DEADBIRD, for "wine," as to be likely to cause confusion.²

I. Procedural Background

The two applications for the marks were prosecuted separately and, with respect to each application, Applicant concurrently filed an appeal and a request for reconsideration after the Examining Attorney made the refusals final.³ The requests for reconsideration were denied by the Examining Attorney.⁴

In addition, Applicant filed with the Board a request to consolidate the two appeal proceedings and a request to remand one application for the purpose of introducing additional evidence "to ensure that the evidentiary record in each application is the same on appeal."⁵ Both requests were granted by the Board; the proceedings have been consolidated and Applicant's additional evidence is of record.⁶ The record is the same for each appeal.

² Registration No. 5054429 issued on October 4, 2016.

³ Application '417: 1 TTABVUE (appeal) and 4 TTABVUE (Request for Reconsideration). Application '389: 1 TTABVUE (appeal) and 5 TTABVUE (Request for Reconsideration).

⁴ Application '417: 7 TTABVUE (Request for Reconsideration Denied). Application '389: 7 TTABVUE (Request for Reconsideration Denied).

⁵ Application '417: 6 TTABVUE (Motion to Consolidate) and 5 TTABVUE (Motion for Remand). Application '389: 4 TTABVUE (Motion to Consolidate). Unless otherwise specified, all citations in the decision are to the TTABVUE docket in Application '389.

⁶ 4 TTABVUE.

The consolidated appeals have been briefed. An oral hearing was held on March 8, 2018.

II. Likelihood of Confusion

Our determination under Section 2(d) 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. *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.”).

1. Similarity of the Marks

We first consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). “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.” *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs. Inc. v. Triumph*

Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)) (internal quotation marks omitted). We address Applicant's marks individually in making our comparison with the cited, registered mark.

a. DEAD BIRD BREWING COMPANY versus DEADBIRD


With respect to Applicant's mark DEAD BIRD BREWING COMPANY, we find DEAD BIRD to be the dominant and source-identifying element. In the context of beer, the disclaimed, generic wording BREWING COMPANY has little, if any, value for purposes of distinguishing Applicant's mark. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under *DuPont*. As a generic term, ALE simply delineates a class of goods."). In addition, the significance of the wording DEAD BIRD as the dominant element of Applicant's mark is further reinforced by its location as the first part of the mark. *See Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"); *see also Palm Bay Imps.*, 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label).

When comparing the source-identifying element of Applicant's mark, DEAD BIRD, with the cited mark DEADBIRD, we find them virtually identical; the space (or lack thereof) between the easily recognized words "dead" and "bird" does not

distinguish them from each other. *See In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010) (difference between ACTIVECARE and ACTIVE CARE has no trademark significance).

In terms of meaning, because consumers are likely to view and understand both marks as the combination of the two words “dead bird,” the commercial impressions created by the marks will be the same. There is no evidence that the term “dead bird” has any significance in connection with beer or wine. Consumers will thus understand the term as merely connoting just that, a dead bird, and being arbitrarily employed in each mark in the context of the involved goods.

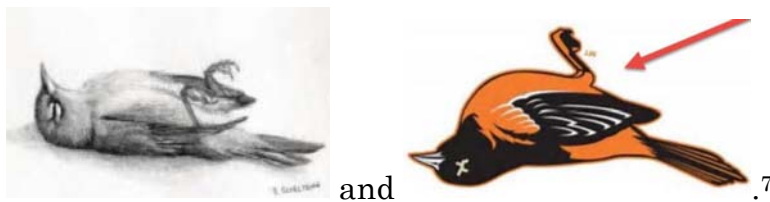
In sum, these marks, despite any differences between them, when viewed as a whole are extremely similar. Indeed, for consumers already familiar with Registrant’s mark in connection with wine, they may believe (incorrectly, of course) that the added term BREWING COMPANY is simply being used in connection with a variant mark to designate Registrant’s attempt at brewing beer, a concept that would be plausible in the minds of the relevant consumers, as discussed *infra*.

b.  versus DEADBIRD

As to Applicant’s design mark, we immediately find it to be the pictorial equivalent to the wording “dead bird.” The doctrine of legal equivalents is based on a recognition that a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers. *See TRADEMARK MANUAL OF EXAMINING PROCEDURE* (“TMEP”) Section 1207.01(c)(i) (Oct. 2017) and authorities cited

therein. Under this doctrine, a design mark has often been found to be confusingly similar to a word mark consisting of the design's literal equivalent. *See, e.g., In re Rolf Nilsson AB*, 230 USPQ 141, 142-43 (TTAB 1986) (holding applicant's lion's head design with a stylized letter "L" mark for shoes, and registrant's word mark, LION, for shoes, likely to cause confusion) (citing *In re Serac, Inc.* 218 USPQ 340, 341 (TTAB 1983) ("[I]t is well settled . . . that a picture and the word that describes that picture are given the same significance in determining the question of likelihood of confusion.")).

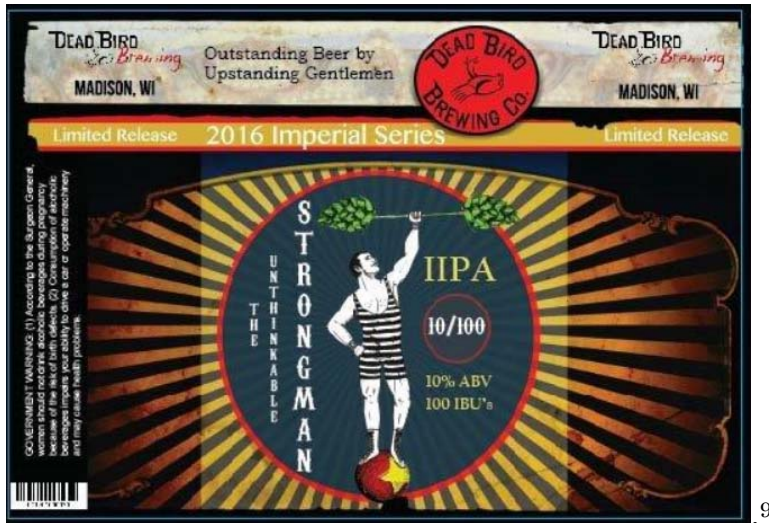
Here, Applicant's mark does not consist of a highly stylized or abstract pictorial representation, but will readily evoke a "dead bird." The Examining Attorney has presented evidence showing that utilizing the image of a bird on its back, with crosses for eyes and feet lifted stiffly up in the air is certainly not novel, and an internet search engine retrieved several images similar to Applicant's design in response to a search for "dead bird drawing," including:



Indeed, the mark is described in Application '389 as an "upside down dead bird."⁸ Applicant also uses its design mark in conjunction with its word mark and evidently intends to evoke the "dead bird" connotation:

⁷ 7 TTABVUE 7, 10.

⁸ In its entirety, Application '389 describes the mark as: The mark consists of Upside down dead bird with an "x" for an eye, two feet, a wing, and five lines making up the tail feathers.



In sum, although Applicant's mark, because it is a design or logo, cannot be said to be similar to Registrant's word mark in terms of sound or appearance, the overall commercial impressions engendered by the respective marks, namely that of dead birds, are the same. It is also important to bear in mind that consumers who are familiar with or have been exposed to Applicant's mark are very likely to use the words "the dead bird design (or mark or logo)" when describing the mark to others, and are very likely to use the words "dead bird beer" when requesting or ordering Applicant's beer. *See In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) ("Beer is often ordered by name, in a bar or restaurant, or from a menu, where only the name of the beer will be used ...").

Under the aforementioned circumstances, we find that the similarity between the marks is very strong. The fact that Applicant's mark is a design, without any literal

⁹ Specimen filed with application on August 16, 2016.

element, does not remove or negate this similarity with the registered mark, DEADBIRD.

Accordingly, the *du Pont* factor involving the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

2. Similarity of the Goods, Their Trade Channels and Consumers

We now consider the *du Pont* factors addressing the similarity of the goods, the channels of trade in which they may be encountered and the purchasers to whom they are marketed. Here, the goods are Applicant's beer and Registrant's wine – as such, the goods share the common characteristic of an everyday alcoholic beverage often consumed with meals. That said, we have long held that “[t]here is no per se rule that holds that all alcoholic beverages are related.” *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009). Even though beer and wine have been found related in other cases, we must decide the outcome of this proceeding based on its own facts and evidence.

The Examining Attorney argues that, aside from both being alcoholic beverages, beer and wine are “highly related” because they are the type of goods that may be sold by the same entity under the same mark, are marketed in the same trade channels, and are offered to the same classes of consumers.¹⁰ In support, the Examining Attorney cites the previous Board decisions finding beer and wine to be sufficiently related for purposes of finding a likelihood of confusion, but also relies on the following types of evidence of record:

¹⁰ 13 TTABVUE 4-9.

- Copies of 24 use-based registrations owned by third parties for a mark that covers both beer and wine;¹¹
- Printouts from websites showing beer and wine featured in festivals, e.g., “Portland Spring Beer and Wine Fest”¹² and Lighthouse Beer Wine website printout advertising a “beer & wine” festival;¹³
- Printouts from various websites showing beer and wine made (and offered) by a single entity under the same mark -- Schram Vineyards (a winery and brewery), Wagner Valley Brewing Co. and Wagner Vineyards, Arcadian Moon Winery and Brewery, and Von Jakob Winery and Brewery;¹⁴ and
- Printouts from websites advertising retail establishments, such as restaurants and stores, that specifically feature beer and wine.¹⁵

Applicant “readily acknowledges that the Board has frequently in the past found beer and wine to be related goods for purposes of [a likelihood of confusion decision],” but counters that it has created a record in this appeal that “demonstrates that beer and wine are not treated as related goods by the USPTO, by Applicants, or by business operators in the field.”¹⁶ Applicant primarily relies on evidence it submitted to show that the same, or very similar, mark is used or registered by one entity for

¹¹ Attached to Office Action issued on November 30, 2016, TSDR pp. 4-67. The Examining Attorney asserts that the 24 registrations are “representative ... of over 70 registered marks found from the [Office trademark search database].” 13 TTABVUE 8. We cannot consider the asserted additional registrations or acknowledge their existence, let alone that they represent what the Examining Attorney states they do, without copies thereof submitted properly into the record. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section 1208.02 (June 2017) (treatment of evidence and third-party registrations).

¹² Attached to Office Action issued on November 30, 2016, TSDR p. 104.

¹³ Attached to Office Action issued on April 26, 2017, TSDR p. 12.

¹⁴ Attached to Office Action issued on November 30, 2016, TSDR pp. 69-112; additional examples attached to Office Action issued on April 26, 2017 at TSDR pp. 12-59.

¹⁵ Attached to Office Action issued on November 30, 2016, TSDR pp. 69-112; and attached to Office Action issued on April 26, 2017 at TSDR pp. 12-59.

¹⁶ 9 TTABVUE 13 and 25, respectively.

beer and is also used or registered by a different entity for wine. Specifically,

Applicant submitted:

- Copies of use-based, third-party registrations showing one mark registered for beer and the same, or similar, mark registered for wine by a different entity.¹⁷ Of these, Applicant asserts that more than “60 pairs show marks that are identical, or that have only minor differentiations (such as disclaimed or descriptive wording, differences in language, tense, singular/plural status, or punctuation);”¹⁸
- Printouts from various websites showing approximately 30 examples of the advertisement of a mark for beer by one entity and another advertisement for wine under the same, or similar, mark being offered by a different entity.¹⁹
- Printouts from the website www.brewersassociation.org indicating that there are approximately 5,301 total U.S. breweries in 2016;²⁰ and
- Printout of an article from February 2016 from the “Wine Business Monthly” website www.winebusiness.com indicating that the “number of United States wineries” reached 8,702.²¹

Applicant asserts that the record it has created demonstrates the following:²²

- (A) a history of inconsistent treatment of such marks for beer versus wine marks by the USPTO over many years;
- (B) a pattern of permitting registration of dozens of marks for beer or wine when nearly identical marks are already registered for the other good;

¹⁷ Attached to Applicant’s response filed March 21, 2107, TSDR pp. 27-194.

¹⁸ 9 TTABVUE 13. We also note Applicant’s argument that the “pairs” of registrations for wine and beer represent “only a small sample of marks that coexist for beer and wine” due to the difficulty in searching the Office’s TESS database for such evidence. *Id.* at 14. However, while we appreciate that such evidence may be difficult to ascertain, we cannot extrapolate from what has been submitted that there is a significant number of additional such pairs of registrations in existence.

¹⁹ Attached to Request for Reconsideration filed on July 12, 2017, TSDR pp. 32-303.

²⁰ *Id.* at pp. 304-307.

²¹ *Id.* at pp. 308-312.

²² 9 TTABVUE 14-15.

- (C) the marketplace realities that consumers are used to seeing such marks used to indicated [sic] different sources for beer and for wine; and
- (D) the business realities that beer and wine makers repeatedly have applied for very similar marks and thus clearly do not view their products as presenting potential trademark conflicts.

Applicant's third-party use evidence is probative and demonstrates that different entities use the same or similar marks, with one using the mark on beer and the other on wine. Third-party registrations, by themselves, are not evidence that the underlying marks are in use or that consumers have been exposed to them; nevertheless, we find the "pairs of existing registrations" evidence also has some probative value in that it may reflect the views of coexisting registration owners. While acknowledging that the Office should strive for consistency, prior decisions and actions of other trademark examining attorneys in registering other marks or approving marks for registration have little evidentiary value and are not binding upon the Board. *See In re Cordua Rests. Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). In this respect, and as Applicant and the Examining Attorney have both noted, the Board's case law in this area suggests that refusals, oppositions and cancellations premised on the relatedness of beer and wine typically have resulted in a finding of a likelihood of confusion. *See, e.g., In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1265 (TTAB 2011); *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719 (TTAB 1992); *Krantz Brewing Corp. v. Henry Kelly Importing & Distrib. Co. Inc.*, 96 USPQ 219 (Exm'r in Chief 1953).

We also acknowledge the probative value and importance of the Examining Attorney's evidence, particularly that there are a significant number of examples of third-party use of a single mark by the same entity in connection with beer and wine, including several businesses that hold themselves out as a "winery and brewery," e.g.,



Likewise, the third-party registration evidence is relevant and helps corroborate that beer and wine are the type of goods which may emanate from a common source under the same mark. *See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

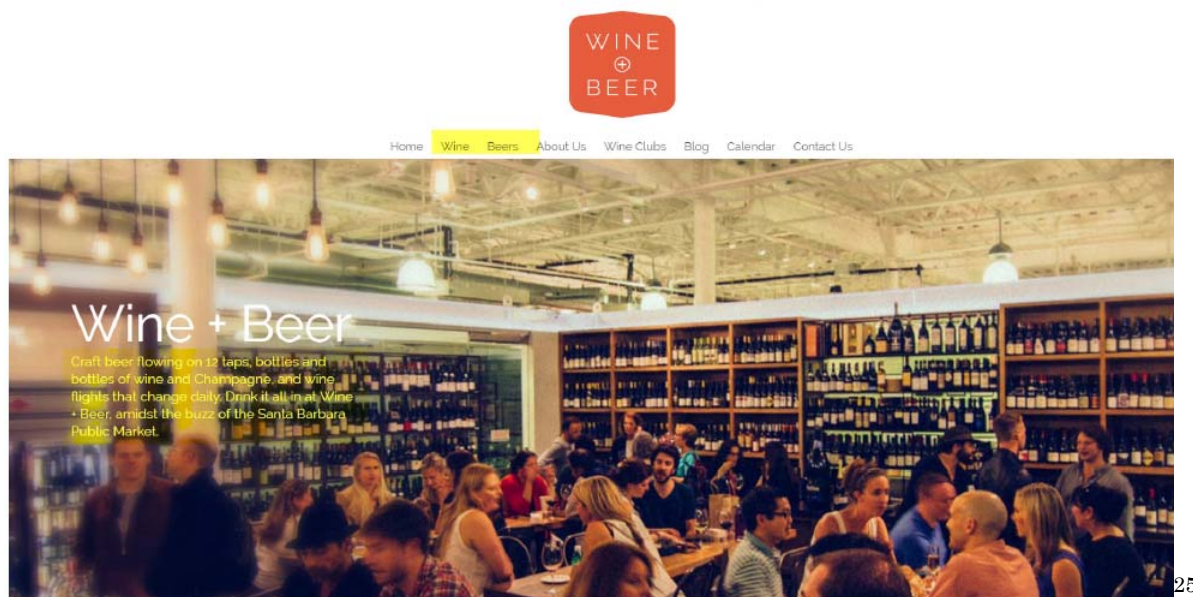
The record further demonstrates that beer and wine can be sold and advertised together, as the primary or only featured goods, through the same trade channels and will target the same consumers. This includes the following festival:

²³ Attached to Office Action issued Action issued on November 30, 2016, TSDR p. 109.



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Stores and restaurants specifically may feature beer and wine as their main offerings, for example:



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and

²⁴ *Id.*, TSDR p. 104.

²⁵ Attached to Office Action issued on April 26, 2017, TSDR p. 13.



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We have considered the entire record and, to be clear, our determination regarding the relatedness of the involved goods is not based upon who has submitted the most third-party registrations or examples of use to support their arguments. Rather, our determination is based on finding that the respective goods are “related in some manner and/or the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the respective goods] emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).


Here, we find the goods are sufficiently related such that, given the surrounding circumstances, confusion as to the source of the goods would be likely. In making this determination, we rely on the evidence that there are people offering beer and wine under a single mark and these goods are marketed together in distinct channels of

²⁶ Attached to Office Action issued Action issued on November 30, 2016, TSDR p. 91.

trade to the same consumers. Applicant's evidence of coexisting marks for beer and wine does not convince us otherwise; that is, while consumers may be aware of coexisting marks, this does not negate that they may also be aware of the same mark being used in connection with beer and wine by the same entity. As the evidence demonstrates, wine and beer are types of alcoholic beverages featured in some of the same venues and directed to the general adult drinking population.

Accordingly, we find that the *du Pont* factors relating to the similarity of the goods, the trade channels through which they travel, and the customers to whom they are offered, all favor a finding of likelihood of confusion.

Summary

Considering all the evidence of record, we find that there is a likelihood of confusion. Again, Applicant's word mark, DEAD BIRD BREWING COMPANY is extremely similar in appearance, sound, connotation and commercial impression to the registered mark, DEADBIRD. Applicant's  mark clearly evokes a dead bird and thus creates the same commercial impression as the registered mark. The evidence further shows that beer and wine will be encountered by the same consumers in common channels of trade.

Decision: The refusals to register Applicant's marks on the ground of likelihood of confusion are affirmed.