

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Beerworks Holdings

Serial No. 87195082

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for Beerworks Holdings.

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Before Cataldo, Greenbaum, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Beerworks Holdings (“Applicant”) seeks registration on the Principal Register of the mark FRINGE BEERWORKS in standard characters for “Taproom services

featuring craft beer brewed on premises” in International Class 43.¹ The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark FRINGE in standard characters for “bar and cocktail lounge services” in International Class 43.² After the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed. Once the Examining Attorney denied reconsideration, the appeal resumed. For the reasons set forth below, we affirm the refusal to register.

II. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Two key considerations are the similarities between the marks and the relatedness of the services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *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 [or services] and differences in the marks.”).

¹ Application Serial No. 87195082 was filed October 6, 2016 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on an alleged use of the mark in commerce.

² Registration No. 4203514 issued September 4, 2012 and has been maintained.

A. The Strength of the Cited Mark

Before we turn to the similarity of the marks, we consider Applicant's contention that the cited mark is weak, as that will affect the scope of its protection. A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis. *See Palm Bay Imps.*, 73 USPQ2d at 1694 (strong marks "enjoy wide latitude of legal protection" and are "more attractive as targets for would-be copyists"). In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."). The strength of a mark under the fifth *DuPont* factor rests on the extent to which "a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps.*, 73 USPQ2d at 1694). This factor involves assessing the mark "along a spectrum from very strong to very weak." *Id.* (internal citations omitted). Under the sixth *DuPont* factor, proof of recent consumer exposure to third-party use of similar marks in connection with similar services may show commercial weakness of a mark, so as to show that consumers generally distinguish among marks consisting of or containing FRINGE based on minor distinctions. *See Juice Generation, Inc. v. GS Enters. LLC*,

794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Third-party registrations also may be considered “powerful” evidence of conceptual weakness of a term.

Regarding conceptual strength, FRINGE in connection with bar services is arbitrary, as a “known word used in an unexpected or uncommon way.” *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173 (Fed. Cir. 2004) (defining an arbitrary mark as a “known word used in an unexpected or uncommon way” and observing that such marks are typically strong); *see also Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (arbitrary terms are conceptually strong trademarks). Applicant submitted a number of third-party registrations of marks that consist of or include FRINGE, but most involve goods and services quite different from the bar and cocktail lounge services in the cited registrations,³ and therefore have no bearing on the weakness of the mark. *See Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for goods in other classes where the proffering party “has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, ... support a finding that registrants’ marks are weak with

³ For example, Applicant submitted registrations for FRINGE BENEFITS for mascara, FRINGE FACTS for computer software, and FRINGETURF for synthetic turf, carpet, rugs and various mats. 4 TTABVUE 27-30.

respect to the goods identified in their registrations”). So, unlike the evidence in the *In re FabFitFun, Inc.* case cited by Applicant where the third-party evidence involved relevant goods, Applicant’s evidence here mostly does not. *See In re FabFitFun, Inc.*, 127 USPQ2d 1670 (TTAB 2018).

Applicant emphasizes the only two registrations that are even arguably close – FRINGE BENEFITS for wine, and FRINGE GENTLEMENS LOUNGE for adult entertainment services, namely gentlemen’s clubs featuring exotic dancing.⁴ Even with the registration for wine, Applicant has made no showing of the relatedness of the goods to the services in the cited registration. As to the FRINGE GENTLEMENS LOUNGE registration, Applicant submitted a screenshot from Registrant’s website indicating that the club was “Coming Soon! Check Back for Updates and for Our Grand Opening Gala.”⁵ In light of the small quantity of evidence, and lack of any use evidence, we do not find this sufficient to demonstrate the weakness of the cited mark. This “falls short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present in [*Juice Generation* and *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015)].” *In re i.am.symbolic*, 123 USPQ2d at 1751; *contrast Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB

⁴ 7 TTABVUE 18-19 (Applicant’s Brief); 4 TTABVUE 84, 90. Applicant also submitted evidence of a pending application for THE FRINGE COLLECTIVE for wine, which is evidence only that the application was filed on a certain date. *See WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034 n.21 (TTAB 2018). In any event, we again note that there is nothing in the record to establish the relatedness of wine to the services in the cited mark.

⁵ 4 TTABVUE 92-96 (fringelounge.com).

2016) (weakness found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark).

Considering all the evidence regarding strength, we find that the cited mark is not weak, and we accord it a normal scope of protection.

B. Similarity of the Marks

We next compare FRINGE BEERWORKS to FRINGE “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

We find the marks to be highly similar because of the common wording FRINGE. The marks look and sound similar because Applicant’s mark incorporates the entirety of the cited mark, adding only BEERWORKS at the end. As the first part of Applicant’s mark, FRINGE “is most likely to be impressed upon the mind of a purchaser and remembered,” *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) and *Palm Bay Imps.*, 73 USPQ2d at 1692. Also, the remaining part of Applicant’s mark, “BEERWORKS,” consists of descriptive wording

that Applicant disclaimed, thereby diminishing its significance in the comparison of marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *Nat'l Data*, 224 USPQ at 752. We are not convinced by Applicant's argument that BEERWORKS, which it voluntarily disclaimed, is "distinctive" in the context of taproom services. Thus, while Applicants' mark, considered in its entirety, contains an additional word that adds a visual and phonetic element not found in Opposer's mark, because the dominant term in Applicants' mark is identical to Opposer's mark, we find them similar overall in appearance and sound. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[I]n articulating reasons for reaching a conclusion on the issue of confusion, 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 consideration of the marks in their entireties"); *see also Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

As to the connotation and commercial impression, we find them very similar because of the shared word. The common element FRINGE in Applicant's and Registrant's marks is the focus of the connotations and commercial impressions, rendering them highly similar. Applicant makes an unpersuasive argument that consumers would perceive the identical term FRINGE differently in its mark than in the cited mark. By improperly resorting to extrinsic evidence of actual use, Applicant alleges that the cited mark is used as a noun with the definite article "the," while Applicant's mark "is used as an adjective to describe the ensuing noun

‘BEERWORKS.’”⁶ However, “we do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application. We must compare the marks as they appear in the drawings, and not on any [actual use] that may have additional wording or information.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018); *see also In re i.am.symbolic*, 123 USPQ2d at 1749. Moreover, we do not agree that just because Applicant’s mark contains the noun BEERWORKS, that necessarily means that consumers would perceive FRINGE as an adjective describing it, because consumers would be familiar with many marks and trade names that contain two nouns in succession, particularly where the second noun names or describes the services or type of business. Rather, we find it likely that consumers would perceive the identical word FRINGE the same way in both Applicant’s mark and the cited mark.

In the context of Applicant’s taproom services, consumers would understand BEERWORKS merely to refer to the nature of Applicant’s services, contributing little to the overall meaning and commercial impression.⁷ Applicant concedes the descriptiveness of BEERWORKS, but argues that it is uncommon⁸ and therefore adds

⁶ 7 TTABVUE 11 (Applicant’s Brief).

⁷ 12 TTABVUE 4 (Applicant’s Reply Brief, stating, “companies that use the term beerworks tend to be breweries—places where craft beers are brewed and served on site”).

⁸ We reject Applicant’s request that we take judicial notice of results from the Corpus of Contemporary American English Webpage that were not included in the record, as such matter is not appropriate for judicial notice. *See* Fed. R. Evid. 201(b) (must be “capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned”); TBMP § 1208.04 (June 2019); *cf. In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (on appeal, Board will not take judicial notice of definitions from Wikipedia

more to the commercial impression. This contention lacks support in the record, and regardless of whether BEERWORKS is common or not, because it is descriptive, consumers are less likely to focus on it as an indication of source.

Given their overall resemblance in sound, appearance, connotation and commercial impression, we find FRINGE BEERWORKS and FRINGE very similar. This factor weighs in favor of a likelihood of confusion.

C. The Services, Trade Channels, and Classes of Consumers

“[L]ikelihood of confusion can be found ‘if the respective [services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.* 101 USPQ2d at 1722 (internal citations omitted). In analyzing the second *DuPont* factor, we look to the identifications in the application and cited registration. *See Stone Lion Capital* 110 USPQ2d at 1162; *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant recites “taproom services featuring craft beer brewed on premises” while the cited registration recites “bar and cocktail lounge services.” According to a

or commercial websites that do not constitute dictionary definitions); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 n.5 (TTAB 2007) (Board would not take judicial notice of “online reference work”).

We also exclude from consideration the screenshots Applicant provides for the first time in its Brief. Pursuant to Trademark Rule 2.142(d), “[t]he record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.” 37 C.F.R. § 2.142(d). *See also In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1856-57 (TTAB 2014) (refusing to consider new evidence attached to the brief).

dictionary definition of record, “taproom” is defined as “[a] bar or barroom.”⁹ Registrant’s bar services are broadly identified, and therefore encompass all types of bar services, including those where craft beer brewed on the premises is served. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). We therefore find that Applicant’s and Registrant’s services overlap and are legally identical.

Because the services in the cited registration are legally identical to Applicant’s services, we presume that they travel through at least some of the same channels of trade to the same class of purchasers, considerations under the third *DuPont* factor. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, “the marketing channels of trade and targeted classes of consumers and donors are the same”); *see also In re Viterra*, 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).

Applicant argues that the trade channels and customers differ because of the allegedly distinct geographic locations of Applicant and Registrant, and because of the allegedly divergent actual marketplace differences between their respective bar establishments. However, “[t]he authority is legion that the question of registrability

⁹ January 16, 2017 Office Action at 6 (American Heritage Dictionary, ahdictionary.com).

of an applicant's mark must be decided on the basis of the identification of [services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's [services], the particular channels of trade or the class of purchasers to which sales of the [services] are directed." *Octocom Syst.*, 16 USPQ2d at 1787. We cannot consider alleged marketplace realities not reflected in the identification of services. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods"). In addition, Applicant's location-based arguments are unavailing because it seeks a geographically unrestricted registration, and Registrant owns a nationwide registration that gives Registrant presumptive exclusive rights to nationwide use of its mark in connection with the identified services. As stated in *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983), "it is not proper ... to limit our consideration to the likelihood of confusion in the areas presently occupied by the parties. Section 7(b) of the Trademark Act of 1946, 15 U.S.C. § 1057(b), creates a presumption that the registrant has the exclusive right to use its mark throughout the United States. Therefore, the geographical distance between the present locations of the respective businesses of the two parties has little relevance in this case."

Thus, the second and third *DuPont* factors weigh in favor of a finding of likely confusion.

D. Other Arguments

We have considered, but find unpersuasive, Applicant's arguments based on the premise that its application and the cited registration should be treated the same way as two coexisting third-party registrations of LOCAVORE (stylized and with design) for restaurant services and LOCAVORE BEER WORKS for beer. Prior registration decisions involve significantly different facts than this one, are not binding on the Board regardless, and thus do not aid our analysis here. *Medicated Prod. Co. v. Alice Jewelry Co.*, 255 F.2d 408, 118 USPQ 90, 91 (CCPA 1958) ("past decisions on confusing similarity are of little assistance in new fact situations wherein entirely different marks and products are involved"). Each case must be decided on its own merits.

As for the alleged lack of actual confusion, "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." *Majestic Distilling*, 65 USPQ2d at 1205. We also have no evidence as to whether the extent and circumstances of Applicant's and Registrant's use could even give rise to meaningful opportunities for actual confusion to occur. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). We find this factor neutral.

III. Conclusion

The overall similarity of the marks for legally identical services that move in some of the same channels of trade to the same classes of customers renders confusion likely.

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