

This Opinion is Not a
Precedent of the TTAB

Mailed: October 18, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sergei Orel

Serial No. 87546394

Sergei Orel of Law Office of Sergei Orel LLC,
for Sergei Orel.

Toby E. Bulloff, Trademark Examining Attorney, Law Office 119,
J. Brett Golden, Managing Attorney.

Before Mermelstein, Kuczma and Heasley,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Sergei Orel (“Applicant”) seeks registration on the Principal Register of the mark

TABOO (in standard characters) for:

Alcoholic beverages, except beer; Sparkling wines; Vodka;
Wine in International Class 33.¹

¹ Application Serial No. 87546394 was filed on July 28, 2017, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney refused registration of Applicant's mark under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), citing Registration Nos. 3896666 owned by Felix Rauter GmbH & Co. KG ("Registrant Rauter"), for the mark TABU (standard character mark) for Spirituous beverages in International Class 33², and 5267746 owned by Sutter Home Winery, Inc. ("Registrant Sutter Home") for the mark HANDSOME DEVIL TABOO (standard character mark) for Alcoholic beverages, except beer in International Class 33³, as bars to registration.

After the Examining Attorney made the refusal final, Applicant appealed to this Board. Applicant and the Examining Attorney have submitted briefs.⁴ As set forth below, the refusal to register is affirmed.

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 enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575

² Registration No. 3896666, issued December 28, 2010, based on International Registration No. 0863766 registered as of August 5, 2005; declaration of use under Section 71 of the Trademark Act accepted.

³ Registration No. 5267746, issued August 15, 2017.

⁴ Both Applicant and the Examining Attorney submitted briefs that do not appear to be in accordance with the spacing requirements. Trademark Rule 2.126(b)(1) states that "[a] paper submission, including exhibits and depositions, must meet the following requirements: (1) A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet." 37 CFR 2.126(b)(1). Despite the foregoing, we exercise our discretion to consider Applicant's and the Examining Attorney's briefs as it appears that they fall within the applicable page limits had they been appropriately double-spaced. *See In re University of Miami*, 123 USPQ2d 1075, 1077 n.2 (TTAB 2017). We caution them that in the future, such filings may not be accepted.

U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.*, 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 goods and services. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *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.”). Additionally, we consider the similarity of the trade channels, purchasers of the goods, and the strength of Applicant’s mark.

We have considered all of the evidence as it pertains to the relevant *DuPont* factors, as well as Applicant’s arguments (including any evidence and arguments not specifically discussed in this opinion). *DuPont*, 177 USPQ at 567-68; *see also Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (not all of the *DuPont* factors are relevant to every case, only factors of significance to the particular mark need be considered). The other factors we treat as neutral.

A. Similarity of the Marks

It is well settled that marks are compared in their entireties for similarities in appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *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 focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) ((citing *Spoons Rests., Inc., v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013))).

Applicant's applied-for mark TABOO is identical to Registrant Rauter's mark TABU in sound, meaning and commercial impression as confirmed by dictionary definitions of "tabu" which defines "tabu" as a "[v]ariant of taboo."⁵ A finding of similarity is usually not avoided by use of a variant spelling. *Contour Chair-Lounge Co. v. Englander Co.*, 324 F.2d 186, 139 USPQ 285, 288 (CCPA 1963) ("Contur' [is] but a slight misspelling of 'Contour,' with identical pronunciation and meaning.").

Turning to Registrant Sutter Home's mark HANDSOME DEVIL TABOO, Applicant's mark shares the term "TABOO" with that mark. Applicant attempts to distinguish its mark arguing that "taboo" comes at the end of the cited mark HANDSOME DEVIL TABOO rendering Applicant's mark TABOO dissimilar.

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

⁵ November 24, 2017 Office Action, at TSDR 10, <<https://www.ahdictionary.com/word/search.html?q=tabu>>, The American Heritage® Dictionary of the English Language, Fifth Edition copyright © 2017 by Houghton Mifflin Harcourt Publishing Company, 11/24/2017; TSDR 11-12, <https://www.dictionary.com/browse/tabu>, Dictionary.com Unabridged, based on the Random House Unabridged Dictionary, © Random House, Inc. 2018, 08/17/2018.

into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *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.”). However, 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 Nat'l Data*, 224 USPQ at 751.

While potential purchasers will likely recognize the apparent differences between Applicant's applied-for mark TABOO and Registrant Sutter Home's mark HANDSOME DEVIL TABOO, noting the additional terms “HANDSOME DEVIL” in Registrant's mark, they could still mistakenly assume, due to the overall similarities in sound, appearance, connotation, and commercial impression in the respective marks, that Applicant's goods sold under the TABOO mark constitute a new or additional product line from the same source as the goods sold under the HANDSOME DEVIL TABOO mark with which they are acquainted or familiar, and that Applicant's applied-for mark TABOO is merely a variation of the above, or vice versa. Additionally, they may mistakenly assume that Applicant's mark is the name of the parent company or a house mark, and that HANDSOME DEVIL TATOO is a sub-brand. *See e.g., SMS, Inc. v. Byn-Mar Inc.*, 228 USPQ 219, 220 (TTAB 1985) (applicant's marks ALSO ANDREA and ANDREA SPORT were “likely to evoke an

association by consumers with opposer's preexisting mark [ANDREA SIMONE] for its established line of clothing."); *In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (addition of house mark in LE CACHET De DIOR does not avoid likelihood of confusion with registered CACHET mark).

In view of the foregoing, we find that the marks are sufficiently similar for likelihood of confusion purposes. The first *DuPont* factor thus supports a finding that confusion is likely.

B. Similarity of the Goods, Purchasers and Channels of Trade

We next turn to the *DuPont* factor involving the similarity of the goods, keeping in mind that determining likelihood of confusion is based on the identification of the goods as stated in the application and registrations at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 123 USPQ2d at 1749).

Applicant's alcoholic beverages (except beer) are identical to the goods in Registrant Sutter Homes' Registration No. 5267746, and are legally identical to the "spirituous beverages" identified in Registrant Rauter's Registration No. 3896666 inasmuch as the definition of "spirituous" is "containing, of the nature of, or pertaining to alcohol; alcoholic."⁶

⁶ Spirituous: Adjective 1 containing, of the nature of, or pertaining to alcohol; alcoholic. <<https://www.dictionary.com/browse/spirituous>>; Dictionary.com based on the Random House Unabridged Dictionary © Random House, Inc. (2019). The Board may *sua sponte* take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format. *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 definitions in online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests.*

Applicant argues that Registrant Rauter's mark TABU is used "solely on absinthe. It is not used on any other alcoholic products."⁷ However, the nature, scope and similarity of the goods must be determined based on the identification of goods listed in the application and cited registration, not on extrinsic evidence of actual use. *See, e.g., Stone Lion*, 110 USPQ2d at 1162 (citing *Octocom Sys. Inc. v. Hous. Comp. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). This is so regardless of what the record may reveal as to the particular nature of a cited registrant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed. Even if we were to consider Registrant Rauter's goods to be limited to absinthe, Applicant's argument is futile because absinthe is included within Applicant's "alcoholic beverages, except beer." *See Stone Lion*, 110 USPQ2d at 1163 ("Parties that choose to recite services in their trademark application that exceed their actual services will be held to the broader scope of the application.").

In the absence of limitations as to channels of trade or classes of purchasers in Applicant's application or in the cited Registrations, the presumption is that the goods move in all the normal and usual channels of trade and methods of distribution to all potential purchasers, and these purchasers would include the general public.⁸

LP, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018).

⁷ Applicant's Brief pp. 4-5 (8 TTABVue 5-6).

⁸ Applicant's argument that "[s]ophisticated consumers purchasing expensive alcoholic drinks such as wine and others have learned to differentiate between the products bearing

See Stone Lion, 110 USPQ2d at 1161; *see also Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344 , 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (where there are no limitations as to channels of trade or classes of purchasers in either the involved application or registration, we must presume that the identified goods and services move in all channels of trade normal for such goods or services and are available to all potential classes of ordinary consumers of such goods or services); *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); *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Thus, the goods for which Applicant and Registrants use their marks are legally identical and are provided to the same purchasers in the same channels of trade. This overlap weighs in favor of a finding of likelihood of confusion under the second and third *DuPont* factors.

similar but not identical marks” is not supported by evidence or case law. Purchasers of alcoholic beverages including “[w]ine purchasers are not necessarily sophisticated or careful in making their purchasing decisions, and where, as here, the goods are identified without any limitations as to trade channels, classes of consumers or conditions of sale, we must presume that Applicant’s and Registrant’s wine encompasses inexpensive or moderately-priced wine. *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Bercut-Vandervoort & Co.*, 229 USPQ2d 763 (TTAB 1986) (rejecting the applicant’s arguments regarding the high cost and quality of its wine and the sophistication of its purchasers, where application identified goods merely as “wine”);...” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 (TTAB 2018).

C. Strength or Weakness of Marks

Under the sixth *DuPont* factor, we consider evidence of third-party use of similar marks on similar goods. Applicant argues that the coexistence of the cited marks supports that “TABOO or TABU is a weak mark which is diluted.”⁹

The two cited registered marks containing similar terms for alcohol products does not indicate dilution or weakness of those terms or the marks. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods. *See Nat’l Cable Tel. Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *DuPont*, 177 USPQ at 567. Evidence of widespread third-party use of similar marks with similar goods “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection” in that particular industry or field. *Palm Bay Imps. v. Veuve Clicquot*, 73 USPQ2d at 1693; *see In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003). However, evidence comprising only a small number of third-party registrations for similar marks with similar goods, as in this case, is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic*, 123 USPQ2d at 1751-52; *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Thus, the two cited registrations are “not evidence of what happens in the market place or that customers are familiar

⁹ Applicant’s Appeal Brief p. 11 (8 TTABVUE 12); Request for Reconsideration p. 11 (6 TTABVUE 20).

with them.” *AMF v. Am. Leisure Prods.*, 177 USPQ at 269; see *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1745 (TTAB 2016); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

Applicant also contends that in light of the co-existence of the cited registered marks, both containing the similar wording “TABU” or “TABOO,” Applicant’s mark should likewise be permitted to co-exist on the register. However, prior decisions and actions of 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. 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, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits. . . . Even if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”)). Each case is decided on its own facts, and each mark stands on its own merits. See *In re Boulevard Entm’t*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003); *AMF v. Am. Leisure Prods.*, 177 USPQ at 269; *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). Therefore, the previous decisions by the examining attorneys in approving the cited marks are without evidentiary value and are not binding on the USPTO or the Board. *In re Davey Prods. Pty*, 92 USPQ2d 1198, 1206 (TTAB 2009); *In re Wilson*, 57 USPQ2d 1863, 1871 (TTAB 2001); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

Thus, the two cited third-party registrations are insufficient to establish that the wording TABOO or TABU is weak or diluted.

D. Conclusion

The goods described in Applicant's application and in the cited Registrations are legally identical and travel in the same trade channels to the same purchasers. Their corresponding marks are similar such that there exists a likelihood of confusion under § 2(d) of the Trademark Act.

Decision: The refusal to register Applicant's mark TABOO under § 2(d) of the Trademark Act is affirmed.