

This Opinion is Not a
Precedent of the TTAB

Mailed: September 4, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Monsieur Touton Selection Ltd.

Serial No. 87874805

Gene S. Winter and Samantha Gerold of St. Onge Steward Johnston & Reens LLC
for Monsieur Touton Selection Ltd.

Andrea Koyner Nadelman, Trademark Examining Attorney, Law Office 110,
(Chris A. F. Pedersen, Managing Attorney).

Before Cataldo, Taylor and Kuczma,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Monsieur Touton Selection Ltd., filed an application to register on the Principal Register the mark PACIFIC VIEW VINEYARDS (in standard characters, VINEYARDS disclaimed as requested by the Examining Attorney) identifying “wine” in International Class 33.¹

¹ Application Serial No. 87874805 was filed on April 12, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), asserting September 28, 2017 as a date of first use of the mark in commerce.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the cited registered mark PACIFIC VISTA (in standard characters) identifying, "wine" in International Class 33.²

After the Trademark Examining Attorney made the refusal final, Applicant appealed and requested reconsideration. The appeal resumed after the Examining Attorney denied the request for reconsideration. Applicant and the Examining Attorney filed briefs.³ We affirm the refusal to register.

I. Evidentiary Matters

Applicant submitted 110 pages of evidence as exhibits to its appeal brief.⁴ We hereby exercise our discretion to take judicial notice of the definitions of "vista" and "view" submitted as part of this evidence, for such probative value as they may possess.⁵ To the extent the remainder of the evidence Applicant submitted with its appeal brief is duplicative of evidence previously submitted during prosecution, we

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs and orders on appeal are to the Board's TTABVUE docket system.

² Registration No. 3280680 issued on the Principal Register on August 14, 2007. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

³ In a June 24, 2019 order, the Board notified Applicant that its over-length brief, submitted on June 17, 2019, would receive no consideration. In a July 1, 2019 order, the Board informed Applicant that its untimely second reply brief, submitted on June 25, 2019, also would receive no consideration. 10 TTABVUE – 13 TTABVUE.

⁴ 7 TTABVUE 19-129.

⁵ 7 TTABVUE 128-129. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

need not and do not give this redundant evidence any consideration.⁶ Further, any of the evidence submitted with Applicant's appeal brief that was not previously submitted during prosecution is untimely and will not be considered.⁷ See Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TBMP § 1203.02(e) and § 1207.01 (June 2019) and authorities cited therein.

II. Likelihood of Confusion

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

We have considered each *DuPont* factor that is relevant, and have treated other factors as neutral. *In re Guild Mortg. Co.*, 129 USPQ2d at 1162 ("In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of all the evidence, whether or not confusion appears likely.

⁶ The Board discourages the practice of the submission of duplicative evidence. *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching as exhibits to brief material already of record requires Board to determine whether attachments had been properly made of record and adds to the bulk of the file); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and is unnecessary).

⁷ The proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a written request with the Board to suspend the appeal and remand the application for further examination. See Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). See also TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.02 (June 2019) and authorities cited therein.

(Citation omitted) ... In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’ (Citations omitted). This is true even though ‘not all of the *DuPont* factors are relevant or of similar weight in every case.’ (Citations omitted).”

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of 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.”); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

A. The Goods, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as

related enough to cause confusion about the source or origin of the goods and services.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004).

The identified goods need not be identical or even competitive to find likelihood of confusion. *See, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). “[L]ikelihood of confusion can be found ‘if the respective goods 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. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

In this case, however, the cited registration and involved application identify goods that are literally identical, namely, “wine.” *See In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). The identity of the goods weighs heavily in favor of a finding of a likelihood of confusion. *See, e.g., In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015).

In addition, “[w]e must presume that Applicant’s and Registrant’s goods will be sold in the same channels of trade and will be bought by the same classes of customers, because the goods are identical and legally identical in part and there are no limitations as to channels of trade or classes of purchasers in either the application or cited registration[s].” *i.am.symbolic*, 127 USPQ2d at 1629 (citing *In re Viterra, Inc.*,

671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). The presumed identity of the channels of trade and consumers also weighs in favor of a finding of likelihood of confusion.

B. Strength of the Cited Mark / Number and Nature of Similar Marks

We next evaluate the strength of the registered mark and the scope of protection to which it is entitled. The fifth *DuPont* factor is the “fame” or strength of the prior mark, and the sixth factor is the number and nature of similar marks in use for similar goods or services. *DuPont*, 177 USPQ at 567. In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *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).”).

Turning first to inherent strength, the Examining Attorney submitted with her August 2, 2018 first Office Action⁸ the following definitions:

- vista – a pleasing view, especially one seen through a long, narrow opening; a distant view or prospect, especially one seen through an opening, as between rows of buildings or trees.

As noted above, we have taken judicial notice of the following definitions from dictionary.com submitted by Applicant with its brief:⁹

⁸ At .pdf 7-8 (oxforddictionaries.com); at .pdf 12-13 (ahdictionary.com).

⁹ 7 TTABVUE 128-29. (merriam-webster.com).

- vista – a distant view through or along an avenue or opening; and
- view – extent or range of vision, sight, scene; prospect.

Based upon these definitions, the registered mark PACIFIC VISTA suggests a pleasing, distant view of the Pacific Ocean or coast, or such a view from the Pacific Ocean or coast. Thus, the mark appears to be arbitrary as applied to “wine.” There is no evidence regarding the registered mark’s commercial or marketplace strength.¹⁰

In support of its argument that the cited PACIFIC VISTA mark is commercially weak, Applicant submitted with its December 5, 2018 Response to the Examining Attorney’s First Office Action¹¹ copies of 19 third-party registrations consisting of marks retrieved from a search of the USPTO’s Trademark Search and Data Retrieval (TSDR) database for “PACIFIC-” formative marks identifying various types of alcoholic beverages including wines.¹² However, those marks include additional matter which is substantially different from that in the registered mark, inasmuch

¹⁰ Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect an examining attorney to submit evidence as to the fame of the cited mark in an ex parte proceeding. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006).

¹¹ At .pdf 20-94. The marks, all in standard characters unless otherwise noted, include: PACIFIC HEIGHTS; PACIFIC STANDARD; PACIFIC GROVE; PACIFIC DRAGON; PACIFIC BAY; PACIFIC COAST SPIRITS; PACIFIC PINOT (concurrent use registration naming Applicant as excepted user); PACIFIC RIM DRY RIESLING (stylized) and PACIFIC RIM; PACIFIC PEAK; PACIFIC SPRINGS; GRAND PACIFIC; PACIFIC OASIS; PACIFIC CREST; PACIFICANA; PACIFIC VINTNERS; PACIFICO SUR; PACIFIC DISTILLERY; and PACIFIC PINEAPPLE.

¹² The five pending applications also submitted by Applicant possess little, if any, value. *See, e.g., Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003) (applications show only that they have been filed).

as none includes as an additional element the term “VISTA” or a term similar to “VISTA.”

As noted above, we find that the registered mark appears arbitrary as applied to the identified goods. There is no evidence of third-party use. *Cf. In re FabFitFun, Inc.*, 127 USPQ2d 1673-4. However, there is evidence of third-party registrations of less similar marks for alcoholic beverages including wines. *Cf. Juice Generation, Inc. v. GS Enters LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015). In addition, the common element PACIFIC and its derivations may be considered geographic in nature and therefore a less dominant portion of the marks. We therefore find that the registered PACIFIC VISTA mark is to be accorded a somewhat narrower scope of protection than that to which inherently distinctive marks are normally entitled due to the presence of the third-party registrations of PACIFIC- formative marks for wines and other alcoholic beverages. *See Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak).

C. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc.*

v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted). *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018). “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.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (internal quotation marks omitted). *See also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in proximity to one another and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d at 1468.

Applicant’s mark PACIFIC VIEW VINEYARDS and Registrant’s mark PACIFIC VISTA are similar inasmuch as they share the term PACIFIC as the first term in both marks and the following terms VIEW and VISTA that are similar in structure and sound. The disclaimed word VINEYARDS in Applicant’s mark has little, if any, trademark significance because it is at a minimum highly descriptive of Applicant’s identified goods. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *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 the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 41 USPQ2d at 1533-34; *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). 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 Corp.*, 224 USPQ at 751.

As discussed above, VINEYARDS is at best highly descriptive of Applicant’s goods. VISTA and VIEW, defined above, are similar in meaning. Vista is defined, inter alia, as a pleasing or distant *view*. In addition, the Examining Attorney submitted with her December 21, 2018 final Office Action¹³ further evidence indicating that “vista” is a synonym for “view.” In both marks, the terms modify PACIFIC and thus serve to reinforce it. The registered mark suggests a pleasant or distant view of the Pacific Ocean or coast and Applicant’s mark similarly suggests a vineyard with a view of the Pacific Ocean or coast.

Based upon the above analysis, we find that PACIFIC VIEW VINEYARDS is more similar than dissimilar to PACIFIC VISTA in terms of appearance, sound, connotation and commercial impression. As a result, consumers encountering

¹³ At .pdf 5-12. (Thesaurus.com.)

PACIFIC VIEW VINEYARDS could mistakenly believe that it represents a variation on the registered mark used to identify wine emanating from the same source. This is particularly the case because, “[w]hen marks would appear on virtually identical ... [goods or] services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” See *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d at 1700. See also *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443, 449 (TTAB 1980).

In view thereof, the *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

D. Consumer Sophistication

The fourth *DuPont* factor is the conditions under which and buyers to whom sales are made. Applicant argues that

Here, both Appellant and Registrant use their marks in connection with wine. More often than not, buyers of wine are sophisticated purchasers with very specific preferences. As such, it is likely that consumers of both Appellant’s and Registrant’s goods are exercising enough care in purchasing the wine to avoid a likelihood of confusion.¹⁴

Because the wine identified in the involved application and cited registration are not restricted by price point, we must presume that they include wines at all price points and varieties offered to the full range of usual consumers for such goods. *Stone Lion*, 110 USPQ2d at 1162 (stating that registrability must be decided based on the identification of goods or services “regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class

¹⁴ 7 TTABVUE 17.

of purchasers to which sales of the goods are directed”) (quoting *Octocom*, 6 USPQ2d at 1787); *In re Hughes Furn. Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015). That is, Applicant’s and Registrant’s wine includes both modestly priced wines subject to casual purchase and consumption as well as more expensive wines directed toward a more discerning palate. We find that the fourth *DuPont* factor is neutral.

E. Applicant’s Prior Registration

Applicant argues that it “already owns a “PACIFIC” mark for wine. Specifically, Appellant is the owner of U.S. Registration No. 5183577 for the mark PACIFIC PINOT. Registrant’s PACIFIC VISTA mark already coexists with Appellant’s prior registration for PACIFIC PINOT.”¹⁵ Applicant submitted with its December 5, 2018 Response to the Examining Attorney’s First Office Action¹⁶ a TSDR copy of its prior



Registration No. 5183577 for the mark  identifying “wine.”¹⁷

However, the mark in Applicant’s prior registration is less similar either to the mark in the cited registration or the mark in Applicant’s subject application. Despite

¹⁵ 7 TTABVUE 17.

¹⁶ At .pdf 20-23.

¹⁷ Reg. No. 5183577 issued on April 11, 2017 on the Principal Register with a disclaimer of “PINOT” and the following description of the mark: The mark consists of the stylized wording “pacific pinot” above two curved rows of grape vines. Registration is restricted to the territory comprising the District of Columbia and the States of Connecticut, Delaware, Florida, Georgia, Maine, Maryland, Massachusetts, New Hampshire, New Jersey, New York, North Carolina, Pennsylvania, Rhode Island, South Carolina, Vermont and Virginia pursuant to Concurrent Use Proceeding No. 94002782.

the identity of the goods in Applicant's prior registration and involved application, the marks are not substantially similar, let alone identical, and Applicant's prior registration has coexisted with the cited registration for only a short amount of time. *Cf. In re Strategic Partners*, 102 USPQ2d 1397, 1399-1400 (TTAB 2012) (Section 2(d) refusal reversed based in part upon finding that the applicant owned a registration for a substantially similar mark that had coexisted with the cited registration for over four years); *see also In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790 1792 (TTAB 2017).

Further, our determination of likelihood of confusion must be based on the facts and record before us. We are not bound by a previous examining attorney's determination that Applicant's prior registration was entitled to register over the cited registered mark. *See In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits").

F. Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant's arguments relating thereto, we conclude that consumers familiar with Registrant's goods offered under its mark would be likely to believe, upon encountering Applicant's mark, that the goods originated with or are associated with or sponsored by the same entity.

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