

This Opinion is Not a  
Precedent of the TTAB

Mailed: March 26, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re LEMA*

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Serial No. 87892342

I. Edward Marquette of Kutak Rock LLP,  
for LEMA.

Ellen Awrich, Trademark Examining Attorney, Law Office 116,  
Elizabeth F. Jackson, Acting Managing Attorney.

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Before Lykos, Shaw and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

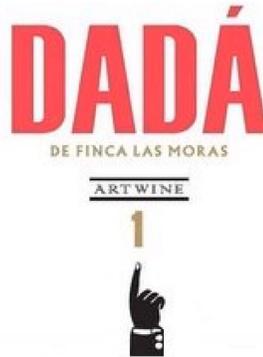
LEMA (“Applicant”) seeks to register on the Principal Register the standard character mark DADA CHAPEL for “Beer, ale, lager, stout and porter,” in International Class 32, and “Spirits and liqueurs,” in International Class 33.<sup>1</sup>

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s applied-for mark so resembles the

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<sup>1</sup> Application Serial No. 87892342, filed April 25, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

registered mark displayed below for “wines” in International Class 33,<sup>2</sup> that it is likely to cause confusion or mistake or to deceive.



When the refusal was made final, Applicant appealed. The appeal is fully briefed.<sup>3</sup>

For the reasons explained below, we reverse the refusal.

#### I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont*

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<sup>2</sup> Registration No. 5261338, registered August 8, 2017 on the Principal Register with FINCA disclaimed. The description of the mark is as follows: “The mark consists of the word ‘DADÁ’ which appears in red stylized letters and below it appears the wording ‘DE FINCA LAS MORAS’ in stylized gold letters of smaller size; below this wording is the word ‘ARTWINE’ between two horizontal black lines written in stylized black letters, below it is the number ‘1’ in gold and beneath this number is the design of a hand in black and white pointing to the number one.” The colors red, white, black and gold are claimed as a feature of the mark. According to the translation statement, “The English translation of ‘DE FINCA LAS MORAS’ in the mark is ‘OF ESTATE THE DELAYS’ OR ‘THE BLACKBERRIES.’” The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

<sup>3</sup> The Board has not considered Exhibit A attached to Applicant’s Reply Brief which consists of a chart summarizing the search results for third-party registrations comprised of the term DADA. Such evidence is not only untimely, *see* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), but also improper in format. To make a third-party registration of record, a copy of the registration (from either the electronic records of the Office or the paper USPTO record) showing the current status and title of the registration must be submitted; a mere listing of the registrations are not sufficient to make the registrations of record. *See, e.g., In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in brief insufficient to make them of record).

*de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). 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.”).

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 (CCPA 1976). These factors, neither of which favor a likelihood of confusion, are discussed below.

#### A. The Marks

The first *DuPont* factor involves an analysis of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x (Fed. Cir. 2019). (citation omitted). *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).

“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*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *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”).

The Examining Attorney argues that the shared term “DADA” in each mark is dominant, reasoning that descriptive wording and design elements of the cited mark are of lesser significance. The Examining Attorney also focuses on the fact that the first term in both Applicant’s and Registrant’s mark is DADA which is the name of an art and literature movement. However, the similarities stop there. When we

compare the marks as a whole, overall we find them to be dissimilar in sound, appearance, connotation and commercial impression.

With regard to the cited mark, while descriptive or disclaimed matter and design elements are generally considered subordinate, we are also guided by the anti-dissection rule. The design of the hand pointing to the numeral 1 in the cited mark “catches the eye.” See *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007) (“[T]he design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN.”). In addition, the wording “Art Wine” in the cited mark reinforces the connotation and commercial impression of the term DADA as referencing an art movement. These distinct design features contribute to the different appearances and impressions of the marks. By contrast, the word “DADA” as used in the context of DADA CHAPEL, alters the overall connotation. The addition of the word CHAPEL evokes a distinct connotation or commercial impression of religion or a small church. For these reasons, this *DuPont* factor weighs somewhat against finding a likelihood of confusion.

#### B. The Goods

Next, we compare the goods as they are identified in the involved application and cited registration. See *Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). The goods need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471,

1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant’s goods and the goods listed in the cited registration. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).

“There 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) (citing *G. H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635 (Fed. Cir. 1990) and *Nat’l Distillers and Chem. Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 USPQ 34 (CCPA 1974)). *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1207.01(a)(iv) (October 2018) (“[T]here can be no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto”). “[E]ach case must be decided on its own

facts,” *DuPont*, 177 USPQ at 567, meaning that we must look to the particular record before us in making our assessment.

While historically distilleries, wineries and breweries have operated as separate entities, in recent years this line of demarcation has begun to blur. The third-party websites made of record by the Examining Attorney reflects this trend. *See* excerpts from the websites <http://www.vonjakobvineyard.com>, <https://sweetgrasswinery.com>, <https://flaniganspirits.com>, <http://www.nimblehillbrewing.com>, <http://whiterock-wines.com>, <http://schramvineyards.com> submitted with August 16, 2018 and February 7, 2019 Office Actions. In addition, the websites sponsored by Von Jakob Vineyards and Flanigan’s show both wine and bottled beer offered for sale under the VON JAKOB house mark and spirits and wine sold under the same FLANIGAN’S trademark. *See* August 16, 2018 Office Action. However, the sparse third-party use evidence and the absence of any third-party registration evidence leads the Board unable to make, based on the record, a finding that a commercial relationship exists between Applicant’s and Registrant’s particular type of alcoholic beverages.

Thus, based on the record before us, we are unable, to find that a common source or commercial relationship exists between “wine” and “beer, ale, lager, stout and porter” and “spirits and liqueurs” as identified in the involved application and cited registration. Perhaps on another record we would have found otherwise. This *DuPont* factor also disfavors a finding of likelihood of confusion.

## II. Conclusion

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto. We acknowledge the case law highlighted by the Examining Attorney finding various alcoholic beverages to have been shown to be related goods for purposes of likelihood of confusion. *See In re Chatom Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (holding GASPAR'S ALE for beer and ale likely to be confused with JOSE GASPAR GOLD for tequila); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (holding RED BULL for tequila likely to be confused with RED BULL for malt liquor); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261 (TTAB 2011) (holding HB for wine likely to be confused with HB and design for beer); *Somerset Distilling, Inc. v. Speymalt Whiskey Distribs. Ltd.*, 14 USPQ2d 1539 (TTAB 1989) (holding JAS. GORDON and design for scotch whiskey likely to be confused with GORDON'S for distilled gin and vodka); *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069 (TTAB 1989) (holding BRAS D'OR for brandy likely to be confused with BRADOR for beer); *Bureau Nat'l Interprofessionnel Du Cognac v. Int'l Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (holding trademark COLAGNAC for cola flavored liqueur likely to be confused with certification mark COGNAC for brandy). In all of these cases, however, the marks at issue were much more similar than the marks involved in this appeal. "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). In this case, the record evidence showing a

commercial relationship between the goods is sparse, and the marks at issue are dissimilar enough to distinguish the goods. For these reasons, we find confusion to be unlikely and reverse the Trademark Examining Attorney's Section 2(d) refusal.

**Decision:** The Section 2(d) refusal to register Applicant's mark is reversed.