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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88662293
Applicant	Michael-David, LLC
Applied for Mark	NORTHCOAST WINE CO.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of: Michael-David, LLC

Serial No.: 88/662,293

Filed: October 21, 2019

Examiner: Tyler M. Seling

Law Office: 112

Mark: NORTHCOAST WINE CO.

**BRIEF FOR APPLICANT-APPELLANT**

**Introduction**

Applicant-appellant opened a new winery located in the Alexander Valley of the famous Sonoma Country wine region. Applicant confirmed the market would be ready and this brand would be distinctive. Parsing the Registry, it saw an overwhelming majority of AVAs in the wine valley were already in use/association with one type of wine. In addition, it felt comfortable wine consumers could easily distinguish between sources. It picked NORTHCOAST WINE CO. Using “WINE CO.” made it certain the winery would be distinctive and its products and services would not be confused with others such as breweries. But the Office, applying a strict methodology did not take the request lightly and found that “WINE CO.” really was not relevant to the mark and looking only at the first part made a slew of strange denials. Applicant respectfully requests the Trademark Trial and Appeal Board (the “Board”) reverse the Examiner’s decision and allow the mark to register, on the Principal or Supplemental Registry for the reasons articulated below.

**Applicant’s Trademark**

Applicant purchased and recently rebranded a winery located at 24625 Chianti Road, Cloverdale, CA 95425. Like jigsaw pieces, Applicant’s wine, while produced in the North Coast AVA is also produced in the Alexander Valley AVA part of the famous Sonoma Coast AVA. On

the registry already exist ALEXANDER WINE COMPANY for wine (U.S. Reg. No. 3,914,784), and SONOMA COAST VINEYARDS for wine (U.S. Reg. No. 4,525,411).

The winery is called NORTH COAST WINE CO. and below is reproduced some of the branding efforts:




**OUTERBOUND**  
CABERNET SAUVIGNON  
ALEXANDER VALLEY

AN ASSOCIATE OF PRODUCERS  
**NORTH COAST WINE CO.**  
ESTABLISHED 1968

**2018 Cabernet Sauvignon – Alexander Valley**

BOTTLING DATE	August 14, 2020
CASES PRODUCED	3050
TECHNICAL	ALC: 14.5% / TA: 0.64 / pH: 3.67
AGING	Aged in 100% French Oak – 45% New
TASTING NOTES	<i>To honor the revered wine grape of Alexander Valley and the inaugural vintage of Outerbound, this wine was sourced from three select vineyards on the west side of the A.V.A. Our Cab offers notes of black fruit, gooseberry and dried herbs from the glass. Medium to full in body, this wine is filled with flavors of black currants, plums and baking spice blending seamlessly with prominent tannins that linger until the next sip.</i>
VINEYARD DETAILS	<p><b>Estate (60%):</b> For only stretching 12 acres, our Estate Cabernet Sauvignon vineyard offers quite a variety in terroir. With the main block curving both to the southwest and the northeast, our yields produce drastically different fruit. The smaller block has terraced rows that curve from the south to the east.</p> <p><b>Smith Ranch (20%):</b> Planted in 1996, the Vaiera (Smith Ranch Co) block grows Cabernet Sauvignon, Clone 337, at around 600 feet. This Alexander Valley hilltop vineyard projects both to the west and to the east, with aromatic, intense fruitiness in the glass.</p> <p><b>Wessel (20%):</b> Located not far from the winery, Wessel is a well-managed hilltop vineyard located on the Dry Creek Ridge of the Alexander Valley. Growing Cabernet Sauvignon, Clone 337, this block produces a prominent tannin structure in the glass. Grower Dennis Wessel is often found tinkering around his vineyard making sure every vine is well maintained and to his high-quality standard.</p>

## The Goods & Services

Applicant applied for wine in Class 033 as the winery can one day produce wine under the winery name, but also made a broad request for all goods it can sell and services it would offer, including glass bottles sold empty, wine glasses, coasters (Class 021), t-shirts, sweatshirts, jackets, shorts, pants, scarves, aprons, and hats (Class 025), online retail store services featuring wine, retail store services featuring wine (Class 035), winery services (Class 040) and wine tasting, conducting guided tours of wineries, arranging, organizing, conducting, and hosting social entertainment events, entertainment services in the nature of hosting social entertainment

events, and special event planning for social entertainment purposes. The blanket rejection focusses only on wine and wine-related services while the recitations are not only limited this way.

### **The Rejection and Procedural History**

On February 4, 2020, the Examiner issued an Office Action refusing registration of NORTHCOAST WINE CO. based on nothing short of six different reasons (See 4-Feb-2020 Office Action, TSDR, p. 2):

Rejection 1: Prior filed applications: (I.1) US Ser. 88/279,413 – Northcoast Clothing Co., (I.2) US Ser. 88/660,697 – North Coast Jiu Jitsu.

Rejection 2: Refusing Class 033 for wine under Section 2(d) based on (II.1) US Reg. 4,488,084 – North Coast Brewing Co. & Design, (II.2) US Reg. 4,520,591 – NC North Coast Brewing CO. & Design, (II.3) US Reg. 4,873,545 – No. Coast All Stars, (II.4) US Reg. 4,925,309 – North Coast Brewing.

Rejection 3: Refusing Classes 021, 025, 033, 035, 040 and 041 as geographically descriptive under Section 2(e)(2).

Rejection 4: Refusing Classes 033, 035, 040, and 041 as “failure to function.”

Rejection 5: Alternative Classes 033, 035, 040, and 041 as Geographically Misdescriptive under Sections 2(a) or 2(e)(3)

Rejection 6: Refusing Class 033 under Section 2(a) as it includes a geographical indication.

The Applicant filed a response. (27-Feb-2020 Response, TSDR). On May 18, 2020, the Office issued a final rejection. (18-Mat-2020 Office Action, TSDR). Remained were Rejections 2 (without II.3) (Section 2(d) of Class 033), Rejection 3 (Section 2(e)(2)), and Rejection 4 (failure to function). Rejections 1, 5, and 6 were withdrawn. On July 24, 2020, Applicant filed a “Request for Reconsideration” offering more evidence in support of the original positions linked

with Rejections 2, 3, and 4. (24-July-2020 Request, TSDR). On November 5, 2020, the Office denied the reconsideration. (5-Nov-2020 Denial, TSDR).

**Arguments**

**I APPLICANT SHOWS MOST AVAs AROUND ITS WINERY ARE ALREADY FULLY REGISTERED FOR WINE USING THEIR AVAs**

Applicant offered evidence (Id(27-Feb-2020 Response, TSDR, p. 10-21) that the North Coast region of California is in fact broken down into nothing short of 71 “pieces” including “North Coast AVA.” Applicant went down the alphabetical list and offered evidence that nothing short of 52 out of 71 (73%) stand registered or issued. (*Id.* at p. 147). The compelling evidence shows a landscape in the business of wine where customers know and distinguish between these wines, commonly use geographic designations and how bottles of wine are normally used. In the table below, the rare AVAs that are not used have been shaded.

This mountain of evidence shows the PTO routinely registers these marks alone or used next to a “descriptive” final expression:

<b>AVA</b>	<b>Mark Used</b>	<b>Registration</b>
Alexander Valley AVA	ALEXANDER WINE COMPANY for wine	U.S. Reg. 3,914,784
Anderson Valley AVA	ANDERSON VALLEY WINEGROWERS ASSOCIATION for wine promotion services	U.S. Reg. 4,904,025
Atlas Peak AVA		
Benmore Valley AVA		
Bennett Valley AVA	BENNETT RIDGE VINEYARDS for wine	U.S. Reg. 5,750,531
Big Valley District AVA	BIG VALLEY WINE for wine, wine services and wine grapes	U.S. Reg. 4,151,960
Calistoga AVA	1- CALISTOGA RANCH for wine 2- CALISTOGA FOOD AND WINE NAPA VALLEY, for wine festivals 3- CALISTOGA WINE GROWERS for wine services 4- CALISTOGA CELLARS for wine	1- U.S. Reg. 3,074,205 2- U.S. Reg. 4,981,642 3- U.S. Reg. 5,075,339 4- U.S. Reg. 5,772,795
Chalk Hill AVA	CHALK HILL WINERY for wine	U.S. Reg. 1,442,381
Chiles Valley AVA		
Clear Lake AVA		
Cole Ranch AVA	COLE CREEK VINEYARDS for	U.S. Reg. 4,645,455

	wine	
Coombsville AVA	COOMSVILLE for wine	U.S. Reg. 5,323,080
Covelo AVA		
Diamond Mountain District AVA	DIAMOND MOUNTAIN WINERY for wine	U.S. Reg. 4,240,689
Dos Rios AVA		
Dry Creek Valley AVA	1- DRY CREEK VALLEY SONOMA WINE COUNTRY for wine services 2- DRY CREEK VINEYARD for wine	1- U.S. Reg. 5,541,676 2- U.S. Reg. 3,241,992
Eagle Peak Mendocino County AVA	EAGLE PEAK for wine	U.S. Reg. 5,964,332
Fort Ross-Seaview AVA	1- FORT ROSS VINEYARD for fresh grapes 2- FORT ROSS WINERY for wine	1- U.S. Reg. 2,594,976 2- U.S. Reg. 2,636,029
Fountaingrove District AVA	FOUNTAINGROVE for wine	U.S. Reg. 1,548,561
Green Valley of Russian River Valley AVA	GREEN VALLEY for wine	U.S. Reg. 4,263,025
Guenoc Valley AVA	GUENOC for wine	U.S. Reg. 4,853,692
High Valley AVA	HIGH VALLEY for wine	U.S. Reg. 2,764,622
Howell Mountain AVA		
Kelsey Bench-Lake County		
Knights Valley AVA		
Los Cameros AVA		
McDowell Valley AVA		
Mendocino AVA		
Mendocino Ridge AVA		
Moon Mountain District Sonoma County AVA	MOON MOUNTAIN for wine	U.S. Reg. 2,536,209
Mt. Veeder AVA	MOUNT VEEDER WINERY for wine	U.S. Reg. 3,457,637
Napa Valley AVA	1- NAPA RIVER WINERY for wine 2- NAPA VALLEY OLDEST WINERY for wine 3- NAPA CELLARS for wine 4- NAPA VALLEY for win	1- U.S. Reg. 5,179,861 2- U.S. Reg. 5,475,718 3- U.S. Reg. 4,200,838 4- U.S. Reg. 4,853,438
North Coast AVA		
Northern Sonoma AVA		
Oak Knoll District of Napa Valley AVA	OAK KNOLL for wine	U.S. Reg. 1,028,865
Oakville AVA	OAKVILLE WINERY for wine	U.S. Reg. 3,610,587
Petaluma Gap AVA	PETALUMA GAP for wine	All'd Ser. 88/449,597
Pine Mountain – Cloverdale Peak AVA		
Potter Valley AVA		
Red Hills Lake County AVA	RED HILLS VINEYARDS for wine	Ser. 88/745,439
Redwood Valley AVA	REDWOOD VALLEY CELLARS for wine	U.S. Reg. 2,629,603

Rockpile AVA	1- ROCKPILE WINERY for wine 2- ROCKPILE VINEYARDS for wine	1- U.S. Reg. 3,266,881 2- U.S. Reg. 3,324,212
Russian River Valley AVA	RUSSIAN RIVER RANCHES for wine	U.S. Reg. 1,587,070
Rutherford AVA	RUTHERFORD RANCH for wine	U.S. Reg. 3,355,098
Solano County Green Valley AVA		
Sonoma Coast AVA Sonoma Mountain AVA Sonoma Valley AVA	1- SONOMA VINEYARDS for wine 2- SONOMA COAST VINEYARDS for wine	1- U.S. Reg. 997,656 2- U.S. Reg. 4,525,411
Spring Mountain District AVA	SPRING MOUNTAIN for wine	U.S. Reg. 1,885,177
St. Helena AVA	SANTA HELENA for wine	U.S. Reg. 2,323,871
Stags Leap District AVA	STAGS' LEAP for wine	U.S. Reg. 1,987,337
Suisun Valley AVA		
Wild Horse Valley AVA	WILD HORSE for wine	U.S. Reg. 1,483,753
Yountville AVA	YOUNTVILLE WINE CO.	U.S. Reg. 4,667,669

The above is compelling evidence that not only are these marks granted, function as marks as millions of bottles of wine are sold and purchased under these names, but also that customers in the business of wine use such brands to distinguish producers. The Board should note that of the 54 out of 71 in the above table, eight (8) use “vineyards” (BENNETT RIDGE VINEYARDS, COLE CREEK VINEYARDS, DRY CREEK VINEYARD, FORT ROSS VINEYARD, ROCKPILE VINEYARDS, RED HILLS VINEYARDS, SONOMA VINEYARDS, SONOMA COAST VINEYARDS), eight (8) use “wineries” (CHALK HILL WINERY, DIAMOND MOUNTAIN WINERY, FORT ROSS WINERY, MOUNT VEEDER WINERY, NAPA RIVER WINERY, NAPA VALLEY OLDEST WINERY, OAKVILLE WINERY, ROCKPILE WINERY), three (3) use “ranches” (CALISTOGA RANCH, RUSSIAN RIVER RANCHES, RUTHERFORD RANCH), three (3) use “cellars” (CALISTOGA CELLARS, NAPA CELLAR, REDWOOD VALLEY CELLARS), and two (2) use “WINE CO.” (ALEXANDER WINE COMPANY, YOUNTVILLE WINE CO.).

73% (54/71) are already registered or in use in commerce, and of those more than half (24/54) use some type of end word like cellars, winery, ranch, etc. WINE CO. for example is the

less common and the most distinctive of these. The Office cannot brush these facts aside, single out the Applicant and reject the request. The U.S. Supreme Court has reminded the Patent and Trademark Office that Applicants are free to seek protection over expressions and specifically the PTO may not deny applications under 15 U.S.C. § 1052(a) that are selected over others that are granted. *Joseph Matal v. Simon Shiao Tam*, 137 S. Ct. 1744, 122 U.S.P.Q.2d 1757 (2017) (Free Speech Clause of the First Amendment applies to the process of Registration at the PTO). “[T]he First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others” *Matal*, 137 S. Ct. at 1757 quoting *Lamb’s Chapel v. Center Moriches Union Free School Dist.*, 508 U. S. 384, 394 (1993).” To Applicant, this feels like its choice is singled out and its free speech is limited.

## **II THE RECITATION OF GOODS AND SERVICES**

Applicant broadly applied for wine in Class 033 as the winery could produce wine under the winery name, but also applied for: Class 021: Glass bottles sold empty; Wine glasses; Coasters, not of paper or textile, Class 025: T-shirts; Sweatshirts; Jackets; Shorts; Pants; Scarves; Aprons; Hats, Class 033: Wine, Class 035: Online retail store services featuring wine; Retail store services featuring wine, Class 040: Winery services, and Class 041: Entertainment services, namely, wine tasting; Conducting guided tours of wineries; Arranging, organizing, conducting, and hosting social entertainment events; Entertainment services in the nature of hosting social entertainment events; Special event planning for social entertainment purposes. Not all of the above are linked with wine and wine-related services.

As part of the Section 2(d), 2(e)(2) and functional rejections described below, the Office singled out Class 033 for the Section 2(d) but rejected all Class 021, 025, 033, 035, and 041 as “geographically descriptive” under Section 2(e)(2), but only services in Class 033, 035, 040, and 041 as to the “failure to function.” This broad analysis is improper as shown below and must be reversed.



### III THE SLOGAN / FUNCTIONAL EXPRESSION REJECTION CLEARLY DOES NOT APPLY HERE

The Office notes that the failure to function rejection is so central, no protection can be secured even on the Supplemental Register. Applicant showed above that in the field of wine, the use of an AVA as the name of a wine alone or with a term like winery, vineyards is not only possible but is common. Trying to reason the PTO Applicant shown five bottles, each from the above table on a side-by-side comparison<sup>1</sup>: (24-July-2020 Request, TSDR, p. 14).



Each is branded with an AVAs and clearly these brands work for wine but also for related wine-related services, websites, and of course wine-related goods and souvenirs. MOUNT VEEDER is an AVA but MOUNT VEEDER WINERY is a perfectly valid brand for wine and other goods / services. The Office's suggestion that WINE CO. is generic, descriptive and does not alter this mark as a whole is false. The above shows that MOUNT VEEDER wine is possible but also that MOUNT VEEDER WINERY is very different in this field.

The Office in rejecting Applicant's mark writes:

Registration is refused because the applied-for mark is a slogan or term that does not function as a trademark or service mark to indicate the source of applicant's goods and/or services and to identify and distinguish them from

<sup>1</sup> Five bottles of five wines named after AVAs include MOUNT VEEDER WINERY, ROCKPILE RIDGE VINEYARDS, RUSSIAN RIVER RANCHERS, OAKVILLE WINERY, and SPRING MOUNTAIN VINEYARD. Each of these brands has websites, bottling, wine tasting and other services live or online.

others. Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127. In this case, the applied-for mark is a slogan or term that is commonly used by those in applicant's particular trade or industry to merely convey information about applicant's or similar goods and/or services. *See In re Boston Beer Co.*, 198 F.3d 1370, 1372-74, 53 USPQ2d 1056, 1058-59 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA for beer and ale a common claim of superiority and incapable of registration); *In re Melville Corp.*, 228 USPQ 970, 971 (TTAB 1986) (holding BRAND NAMES FOR LESS for retail clothing store services a common promotional phrase and incapable of registration); TMEP §1202.04(a). (18-May-2020 Office Action, TSDR, p. 2)

This seriously misunderstands how the functional rejection works.

At the heart of this strange rejection is the notion that some goods or services are routinely offered using certain key expressions that CANNOT function as marks in that field. For example, a new chocolate bar should not be branded as "OPEN THE WRAPPER" as this expression is commonly used in the chocolate bar world. In the field of wine, subject to a "functional" rejections could be expressions like "UNCORK IT", or "SIP AND TASTE" or even "CHILL BEFORE SERVING" as all three of these expressions are in fact commonly used in the wine industry. Saying that a geographical or descriptive term is "functional" does not understand the nature of the rejection. If the mark is "DRINK" for wine, the term is descriptive of a function of the goods. If the mark is NORTH COAST the expression is geographic. Here, the Office tires to argue that DRINK or NORTH COAST are in fact functional. No evidence was offered to suggest that.

Also, strangely the rejection broadly tries to cover all services. Class 041 relates for example to arranging, organizing, conducting, and hosting social entertainment events, entertainment services in the nature of hosting social entertainment events, or special event planning for social entertainment purposes. This would cover, for example, at a nice winery named NORTHCOAST WINE CO. marriages or other social events. If the Applicant one day only offers social event and no longer produces and sells wine, that should be inconsequential to the Class 041. In the field of special event planning for social entertainment purposes, a functional mark could be, for example, "GET A CATERER" or "WEDDING PLANNER" and

definitely not “NORTH COAST WINE CO.” As explained by the rules of the Office, a functional mark must align with these services, here “PAY THE CATERER” might be a functional mark in this field. In Applicant’s Class 035 online retail store services featuring wine, a functional mark would be “CASE REBATE” or “MIX OF WHITE AND RED” as many websites offer a rebate on the purchase of twelve bottles or where packages of 12 bottles can be created with a mixture of both white and red wine.

The Office’s rejection fails and bypasses the notion that NORTH COAST WINE CO. is not functional in any way as to any of the goods and services filed. The rejection is improper and should be withdrawn. It is important to note that once the functional rejection is reversed, this Applicant will be given the option of securing a Supplemental Registration certificate.<sup>2</sup>

#### **IV THE SECTION 2(E)(2) REJECTION IS OVERLY BROAD**

Every good and service currently stands rejected as “geographically descriptive.” This includes wine glasses, coasters, or even hosting a wedding. Applicant understands NORTH COAST to be geographically descriptive, the mark is not simply those two words but instead is NORTHCOAST WINE CO. As shown above, in the field of wine-making, using a word like “winery” or “ranch” transforms a descriptive mark into a fully functional non-descriptive mark.

The Office kindly offers the three prong test to show that goods or services are “primarily geographically descriptive” by demonstrating that (1) The primary significance of the mark is a generally known geographic place or location, (2) the goods and/or services for which applicant seeks registration originate in the geographic place identified in the mark, and (3) purchasers would be likely to make a goods-place or services-place association; that is, purchasers would likely to believe goods and/or services originate in the geographic place identified in the mark. (18-May-2020 Office Action, TSDR, p. 7-8).

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<sup>2</sup> Applicant is a winery which operates over decades as the process of wine-making and wine storing is a long one. As a consequence, the Applicant does not mind securing either a Principal Registry or a Supplemental Registry application as a result of this appeal. Specimens of use were entered in some of the classes to help the Board given expressly the authority to amend the request to Supplemental Registry to favor allowance of the mark.

### *The Primary Significance Of The Mark*

Applicant's mark is NORTHCOAST WINE CO. and the Office strangely suggests that "WINE CO." has no influence in the analysis for the primary significance. This is incorrect as evidenced by all of the other wine now on the market. "When a geographic term is combined with additional matter (e.g., wording and/or a design element), the examining attorney must determine the primary significance of the composite." *See* TMEP §§1210.02(c)–1210.02(c)(iii). By using the rare "WINE CO." the primary significance of the mark is a corporation, a source of wine. "When it is not clear on its face that the primary significance of the mark is that of a geographic location, the record must include substantial evidence to support a conclusion that the mark identifies a place 'known generally to the relevant American public.' *See In re Newbridge Cutlery*, 776 F.3d at 862, 113 USPQ2d at 1450. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738(TTAB 2016) (reversing a §2(e)(3) refusal of a mark containing the wording MT. RAINIER THE MOUNTAIN OF SEATTLE ESPRESSO & MILK, noting that '[w]hile there is no doubt that the term SEATTLE identifies a generally known geographic location, as it is used in the context of Applicant's mark, we do not find that the relevant public would consider it to indicate of the origin of the goods')" TMEP § 1210.02(b). In this record, the Office offered no "substantial evidence" that people know this expression and originate that source of origin as a primary significance. The question is simple, if a spouse tells their friend, "I am getting married at NORTH COAST WINE CO." the Examiner must prove that to the average consumer of these services, the person will know the person is getting married in North California. There is no evidence suggesting such is the primary significance of the expression NORTH COAST or of NORTH COAST WINE CO. Further, the Office cannot even show people know this as a location for wine but more importantly that glasses, coasters, t-shirts and website services would be believed to originate from this location.

### *The Geographic Origin Of The Goods And Services*

One wonders why as to Class 021 and Class 025, a buyer of wine glasses or of a hat branded NORTHCOAST WINE CO. will have any belief the hat must come from California. The same is true as to a website which sells wine. A website called “The Hawaiian Wine Co.” which would offer wines online would never be considered that wines sold there must come from Hawaii or that the island has any relationship with the service. Applicant agrees that wine and wine-related services in fact have this geographic origin. But a person being invited to a wedding at “NORTHCOAST WINE CO.” has no expectation of a location of origin and will ask “where is the wedding?” If the mark was simply NORTH COAST, the same would be true for most goods and services. There are hundreds of “north coasts” in the United States, one on each lake for example. There is no demonstration shown and no evidence offered that any of the goods and services are connected by consumers with a specific piece of land located in California.

*The Service/Place Association Is Missing*

“Geographic matter may be so obscure or remote that it would not be recognized as an indication of the geographic source of the goods or services. In such a case, the mark is treated as an arbitrary designation because its geographic meaning is likely to be lost on consumers. Thus, consumers will not perceive the geographic significance of the term as its primary significance and will not make a goods/place or services/place association. *See In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820, 1827 (TTAB 2006)” TMEP § 1210.04(c). Since an example is worth 1000 words. In the below, the middle wine is called OAKVILLE WINERY. Oakville is an AVA located in California. This term is obscure and not know by most.



In the above, arguably if someone reads “OAKVILLE WINERY” one can imagine someplace called Oakville has a winery. But more importantly, if a person sees a wine coaster branded “OAKVILLE WINERY” in a wine store, or a t-shirt called “OAKVILLE WINERY” that person will not believe that the coaster or the apparel comes from any specific geographic location, much less the Oakville AVA. A website selling wine online branded “OAKVILLE WINERY” cannot be assumed to only offer wines from a single source and that the source must be the Oakville AVA.

Coasters which read “NORTHCOAST WINE CO.” found at the local wine store in Anchorage Alaska are not reasonably believe to originate from the North Coast AVA. Even if we assume the most famous wine source such as NAPA VALLEY, people who buy coasters, apparels or surf online to a site called NAPA VALLEY WINE CO. will not think they only sell wines from the Napa Valley AVA. Applicant asks this Board to overturn this rejection.

#### **V THE SECTION 2(D) REJECTION IS EQUALLY IMPROPER (CLASS 33)**

Only Class 33 (wine) stands rejected by the Office by three related applications owned by a single Registrant for beer: (a) U.S. Registration No. 4,488,084 (NORTH COAST BREWING CO. & Design I for beer), (b) U.S. Registration No. 4,520,591 (NC NORTH COAST BREWING CO. & Design II - Disclaimed NORTH COAST BREWING CO. for beer), and U.S. Reg. No. 4,925309 (NORTH COAST BREWING for beer – Disclaimed “Brewing” and 2F Statement Entire Mark).

As part of this analysis, the review can be limited to the broadest grant, namely the word mark NORTH COAST BREWING.

*a. The Same Way The Registry Is Filled With AVA Registrations, The Registry Is Also Filled With “Coast” Marks Showing Beer / Wine Are Easily Distinguished*

In determining strength of a mark, the TTAB considers both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *Bell’s Brewery*, 125 USPQ2d at 1345; see also *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 Board may often find the evidence sufficient to establish that there is such widespread use that consumers have come to distinguish marks containing certain terms based on minute differences. See *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017). In the field of wine/beer, that is precisely the case.

Applicant boldly asks for NORTH COAST WINE CO. for wine while on the registry is NORTH COAST BREWING for beer. Below is another table showing the evidence offered to the Examiner. (27-Feb-2020 Response, TSDR, p. 144-45).

<b>Coast</b>	<b>Mark</b>	<b>Registration</b>
SOUTH	SOUTH COAST WINERY for wine	U.S. Reg. No. 2,930,266
	SOUTH COUNTY IPA for beer	U.S. Reg. No. 5,365,057
CENTRAL	CENTRAL COAST COLLECTION for wine	U.S. Reg. No. 2,852,132
	CENTRAL COAST CALLIE COLLECTION all but beers	U.S. Reg. No. 5,520,070
	CENTRAL COAST WINE COUNTRY for wine services	U.S. Reg. No. 4,456,804
	CENTRAL COAST VINEYARD TO TABLE all but beers	U.S. Reg. No. 4,783,441
EAST	EAST COAST HOOCH for wine	U.S. Reg. No. 4,722,320
	EAST COAST LAGER for beer	U.S. Reg. No. 5,236,133
WEST	WEST COAST WINE GROUP for wine	U.S. Reg. No. 4,979,168
	WEST COAST IPA for beers	U.S. Reg. No. 4,244,323
	WEST COAST HAZE for beer	U.S. Reg. No. 5,530,320
	WEST COAST ORIGINAL all alcohols but beer	U.S. Reg. No. 4,423,323
SOUTH	SOUTHERN PACIFIC BREWING for beer	U.S. Reg. No. 5,708,785

PACIFIC	PACIFIC COAST SPIRITS for wine	U.S. Reg. No. 5,056,340
NORTH	NORTH COAST BREWING for beer	U.S. Reg. No. 4,520,591

As shown easily above, the arrival of NORTHCOAST WINE CO. will slide in this set rather normally and without creating confusion. For each (West, East, South, Pacific) there already are several marks that peacefully coexist between wine and beer or even different types of beer. In the above context, it is clear that the arrival of NORTHCOAST WINE CO. for wine does not overlap or create confusion with NORTHCOAST BREWERY and this is compelling evidence these marks are weak and consumers know, from decades of practice that beers and wines are sold in closely related names without confusion.

*b. Wine / Beer Branding Has Exploded These Past Decades And Requires Unique Treatment (e.g. These Marks Are Incredibly Weak)*

Historically, wine originated mostly from Europe and its southern countries like Spain, France and Italy. Other Countries like Germany, Austria, and Switzerland began to produce and with time, their wines became more important. In the 20<sup>th</sup> Century, slowly began the production of more “American Wine” long snubbed over European counterparts.

As shown in the a forum, as of 2015, the USA’s wine industry exploded and has reached 8,000 wineries and up to 3,700 breweries. (27-Feb-2020 Response, TSDR, p. 37-55). As part of the Examiner’s prima facie evidence, the Office showed that some of these wineries (a few actually) are joint wineries and breweries. The Office attached the websites of three locations where a party produces both wine and beer (i.e. a winery and brewery). First, the Office offers BIAS Winery ([www.biaswinery.com](http://www.biaswinery.com)) which has both a winery and a microbrewery. Next it pointed to Fenton Winery & Brewery ([www.fentonbrewery.com](http://www.fentonbrewery.com)) as evidence of a source selling both beers and wine, and next Schilling Bridge Brewing Company ([www.schillingbridgewinery.com](http://www.schillingbridgewinery.com)). It is first important to note that with all respect to these wineries / brewing locations, none are truly known.



Applicant easily demonstrates the weakness and uniqueness of the wine-branding v. beer branding as it points to the evidence offered by the Office. Fenton™ offers Fenton Light, Igniscent Amber Ale, Unbridled IPA, Staggering Bull, Eminent IIPA, Swingin' Berries, Hans' Golden Tripel, YES Honey, Lochnessary, Kickin' Strong, Bloomin' Berries, St. Gin's, at least 12 brand of beer. Fenton™ next sells Orange Label White, Fenton White, Celebrate, Moonlight, Breeze, Crisp, Wild, Grin, Fenton Red, Summit Red, Orange Label Red, 1545 North, Crimson Vine, First Frost Ice Wine, Winter Warmth, Opulence Ruby, Cocoa, at total of 17 brands of wine.<sup>3</sup> The evidence suggests none are registered.

So above, we easily can show that 12,000+ wineries and breweries sell at least 20+ products each for a total of at least 240,000 different products flooding this market. The TESS system alone shows 54,825 live records for “wine”, a total of 54,699 with the word beer. (27-Feb-2020 Response, TSDR, p. 42). Consumers must manage hundreds of thousands of brands.<sup>4</sup> In comparison, the second edition of the Oxford English Dictionary contains 171,476 words. Removing the 47,156 obsolete words, one can say there are as many live “beer” and “wine” pending or issue trademarks as there are words in the dictionary. (27-Feb-2020 Response, TSDR, p. 38). English natives know about 20,000 words and the common words that are used repeatedly are closer to 5,000 words. As shown by the evidence of the Examiner alone, most wineries and breweries do not hesitate to sell 20+ brands, a small fraction are registered or pending and the Office must make the analysis of “likely confusion” in this very unique context. For example, while roasted peanuts and dried raisins may be related goods, there are simply not 100,000+ brands of peanuts and raisins fighting for consumers.

As recently as June 26, 2018, the TTAB in *Justin Vineyards & Winery LLC v. Crooked State, LLC* (Opposition No. 91/229,132) found that HOP SAVANT for beer (HOP disclaimed),

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<sup>3</sup> The other two joint Brewery / Winery also list 10+ products in both types.

<sup>4</sup> The above calculation does not include all foreign wineries and breweries which export wine and beer to the United States.

was not confusingly similar to SAVANT for wine. Finding in that case that wine and beer were not related, the Board reminded:

“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). 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 decisions cited by Opposer are not to the contrary. *In Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816 (TTAB 2015), for example, the Board acknowledged that “beer and wine (among other alcoholic beverages) certainly can be, and frequently are, found to be related,” but stated in the same sentence that “each case must be decided on its own record.” *Id.* at 1827.

Of course Applicant knows each case stands on its own, but the Board then looked carefully at all the evidence before it, the strength of the senior mark, the impulse of the customers, and the similarity of the trade channels and decided on the merits. The Examiner has provided evidence suggesting that some sources do both wine and beer via 3 of the 12,000+ wineries in the USA.

*c. Wine / Beer Is Sold In Unique Conditions Designed To Help Consumers Avoid Confusion*

The Federal Circuit has instructed that a single *DuPont* factor may be dispositive in any particular case. *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“DuPont recognized that in determining likelihood of confusion ‘each case must be decided on its own facts.’ *DuPont*, 476 F.2d at 1361, 177 USPQ at 567. It also recognized that ‘each [of the thirteen elements] may from case to case play a dominant role.’ *Id.*”).

The Federal Uniform Drinking Age Act of 1984, provides that to drink alcohol in the United States, no one can be under the age of 21 year old. Said in terms of relevance here, no child can purchase alcohol and no one under the age of 21 year old can be confused. (27-Feb-2020 Response, TSDR, p. 55-58). Only people 21 year old or more are subject to possible confusion as to branding of products. This regulation in the sales conditions of alcohol make confusion much less likely.

Beer and wine are sold (a) online, (b) in retail, (c) in restaurants, and (d) in locations of production / concert venues. Because of an explosion in the number of wine products and beer products sold –all under thousands of brands - all four of these channels of trade have grown to develop guides at the point of sale (e.g. develop conditions of sale) which completely avoid any confusion. Restaurants who sell wine all have a wine section, a beer section, a wine list, or a wall where beers are listed or spigots of beer taps are displayed. Restaurant owners make quite a profit on alcohol and it is normal to sort the wines, use numbers. The wine list in most sophisticated restaurant is a standalone. For example, Applicant provided the following example.

Wines by the Bottle				Wines by the Bottle			
<b>Chardonnay</b>				<b>Merlot</b>			
Matchbook, Dunningan Hills	'15	\$31	YC	Ryder Cuvée 948, Monterey	'15	\$31	
Votre Santé, California	'15	\$35		14 Hands, Columbia Valley, WA	'14	\$30	
La Crema, Sonoma Coast	'15	\$38		Rombauer, Carneros	'12	\$49	
Sonoma Cutrer, Russian River	'15	\$39		Frog's Leap, Rutherford	'14	\$57	
Frank Family, Napa	'15	\$50		<b>Cabernet</b>			
Rombauer, Carneros	'16	\$59		Franciscan, Napa Valley	'14	\$99	
<b>Sauvignon Blanc</b>				Michael David, Freakshow, Lodi	'14	\$35	
Bogle, California	'14	\$26	YC	Alexander Valley, Alexander Valley	'15	\$39	
Simi, Sonoma County	'16	\$31		Rodney Strong, Alexander Valley	'14	\$40	
Hutch, Mendocino	'15	\$32		Rombauer, Carneros	'14	\$68	
Frog's Leap, Rutherford	'16	\$46		Stag's Leap Artemis, Napa Valley	'14	\$92	
<b>Other Whites</b>				Cakebread Cellars, Napa Valley	'14	\$98	
Chateau Ste. Michelle, Rose	'15	\$27		Frank Family Reserve, Napa Valley	'14	\$105	
Kim Crawford Pinot Gris, NZ	'17	\$31		Charles Krug - Mondavi Family Reserve			
Pine Ridge Chevin-Viognier, CA	'14	\$32		Howell Mountain, Napa Valley	'13	\$115	
Stone Barn White Zinfandel	'17	\$25		Frank Family Patriarch Reserve	'13	\$255	
<b>Bubbles</b>				<b>Zinfandel</b>			
Mionetto Prosecco Brut	nv	\$8/\$31		Bogle Old Vine, California	'15	\$28	YC
Wilson Creek Almond Sparkling	nv	\$9/\$31		7 Deadly Zins, Lodi	'14	\$30	
Mumm Napa Brut Rose	nv	\$38		Branc Old Vine Zin, Lodi	'14	\$30	
Schramsburg Mirebelle Brut	nv	\$40		Frank Family, Napa	'14	\$52	
				Seghesio Vineyards, Sonoma County	'13	\$58	
<b>Pinot Noir</b>				<b>Other Reds</b>			
Bogle, CA	'15	\$25	YC	Michael David, Petite Petit, Lodi	'15	\$32	
Mark West, CA	'14	\$30		Running River, Barbara-Grenache	'14	\$27	YC
Votre Santé, CA	'14	\$35		Estancia GSM, Monterey County	'14	\$28	
Hutch, Anderson Valley	'14	\$38		Ménage a Trios Red, St. Helena	'13	\$28	
Frank Family, Napa	'15	\$50		Turkovich "The Boss", Yolo County	'15	\$38	YC
Robert Mondavi Reserve, Napa	'13	\$65		Bogle Phantom Red, CA	'13	\$35	YC
				Matchbook Tempranillo, Dunningan Hills	'13	\$38	YC
				Bogle Phantom Red, CA	'13	\$35	YC
				Matchbook Tempranillo, Dunningan Hills	'13	\$38	YC
				Turkovich Tempranillo, Yolo County	'14	\$38	YC
				Girard Artistry, Napa Valley	'11	\$58	
				Frank Family Winston Hill Red, Napa	'13	\$160	

(27-Feb-2020 Response, TSDR, p. 134)

In the above, wine is grouped in types of grapes, regions, or country of origin. To further help reduce confusion, names are given next to the winery name. The restaurants with the largest wine lists have a “sommelier” or a wine expert whose sole job is to help you select the right wine and avoid confusion.

In the above Applicant’s winery is called “MICHAEL DAVID” the wine’s name next to it is PETITE PETITE. To help avoid confusion at the condition of sale, the year is offered, the

price, and even the region of origin. In the above, there are no beers listed next to the wine. While beers are often sold with some different types of information at a restaurant (e.g. the year of vintage not being critical for beers who do not age), attached below is one website with a massive 200+ beer list. (27-Feb-2020 Response, TSDR, p. 136).



**6 HOME SICK BREWING**  
 I'm Okay, Just Peachy! | Blonde Ale with Peaches, White Oak, and Honey Whiskey, 5% ABV  
 Daaamn You Got a Sweet Cass | Sweet Potato Casserole Amber, 6.7% ABV  
 Basic Blonde B\*tch | Blonde Ale with Roasted Pumpkin and Chai Tea, 5.9% ABV  
 Karamel Sutra Swirl | Espresso, White Chocolate, and Caramel Milk Stout, 5.7% ABV

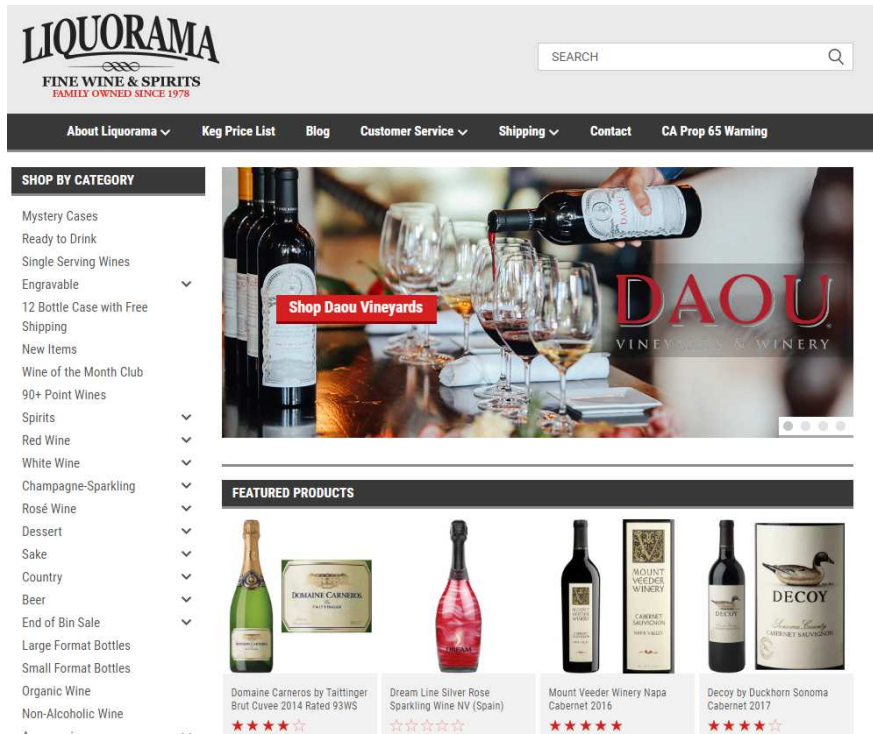
In the above also at Exhibit F to Applicants 27\_Feb-2020 Response, each source is given a number and their products are listed.

Let us be honest, the above is designed as a roadmap to help customers and avoid confusion. This is unrelated to different brands selling sliced bread at the store. Beers are selected by the percentage of alcohol, their types which is unrelated and other adjectives. While a grosser may have at most 10 types of peanuts and dried raisins on a shelf in the “snacks” section of the store, retail spaces must be very careful and avoid selling any wine or beer to someone under the age of 21. In addition, because of the sheer volume of brands (a store can easily have 100+ brands of wine and 50+ brands of beer), everyone has observed Herculean efforts from all retailers to avoid confusion via sales conditions. For example, below is a sample stock photo of the section where wine are stored in a local store. (27-Feb-2020 Response, TSDR, p. 137).

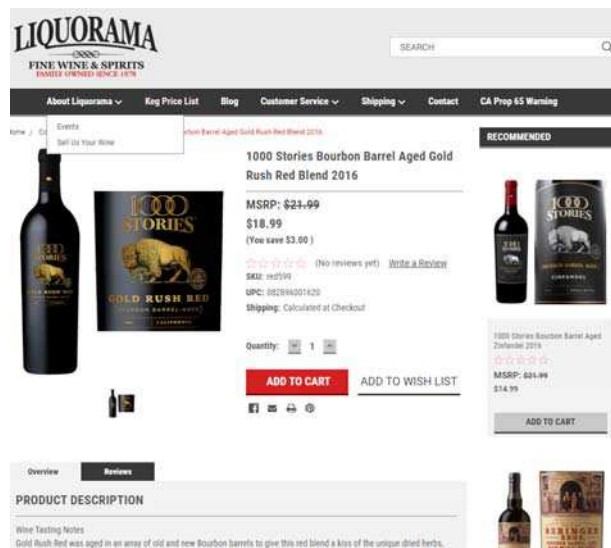


In addition to the name, the full bottle with the label is present, and under the retailer offers information. Wines are racked, grouped, and a whole bunch of tools exist to help clients distinguish white wines, beer, etc. The selection of a product is not done quickly and randomly the same way a bag of peanuts is selected. Truth is, it is often impossible to find a wine we are looking for without the help of the local expert. What is certain is that in retail, wine and beer are NEVER mixed. No one places one bottle of beer next to one bottle of wine. Often beer is sold in larger boxed containers in six or twelve pack. Wine is never sold in packs.

Online the stores selling wines and/or beer also have a massive amount of structure, guides, menus, to help guide the buyer away from confusion. As part of the factors, one relates to how the consumer encounters the products and how easy it can be confused into buyer the wrong product. The last place where wine is purchased is online (27-Feb-2020 Response, TSDR, p. 140 ) shows a website where both wine and beer can be purchased.



The number of submenu is insane. Here, the beer menu structure is clear, the products are classified under many different elements but once any given product is reached, we no longer are in 1990 at the start of the internet where the brand alone was present with a « purchase » button.



As shown above, images are offered, labels, descriptions, overviews, reviews from other customers, etc. This is quite a unique context of purchase, one that leaves little to no room for error. The notion that anyone is confused in the above context of selection is rather amusing.

In the above table of 71 marks, what is shown is that most AVAs have their own brand. Of the three applications, only one is word and is the broadest as per a 2(d) rejection. U.S. Reg. No. 4,925,309 is for the words NORTH COAST BREWING. Historically, Examiners and the Board have been given a great level of discretion to decide overlap under Section 2(d) between similar marks when applied-for beer and wine. Applicant understands such rule and respects it. Each Examiner and each Board reviews these requests for the totality of the circumstances.

One key point at reconsideration is the fact that over time, consumer of beer and wine in the United States now are faced with a completely new situation, one not present 20 years ago. As shown, the sale of branded alcohols has increased at least 20x these past years. Putting aside the role of the Office, consumers have changed their habits. We are no longer in America of the 1960's when a handful of brewery and wine producers occupied the large American market. In the television show "Cheers" the actors just asked for "a beer" and Sam, the bartender, was free to pick what he wanted. Today that is fanciful. The law factors in changes in consumer habits as it is written very broadly.

*"No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it— Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d).*

As the market changes, so does likely confusion. For example, there are only a dozen automotive manufacturers today and back in 1960 because of the logistics associated with building a car, but once 3D printing becomes popular, there will be a multiplication of brands. As this happens, consumers will know and understand that different brands are from different sources. In the United States, wine and beer have followed such a meteoric explosion in numbering and the diversity of products. The Examiner addresses this issue. He explains that "This appears to be in essence a sophisticated purchaser argument." This is partly correct. Yes,



consumers are more sophisticated but not because they are educated, but because they must now choose from walls and walls of similar products. For example, in today’s hectic world, large massive online or physical alcohol retailers are now very common. One is reproduced below: (24-July-2020 Request, TSDR, p. 11).



The above is “Total Wine & More®” one of the largest chains in the country fills a 30,000 sq/ft location once reserved for the toy brand Toys-R-Us®. Said simply, there are rows after rows of alcohol. Below are a couple of images from this store:



The rule today, as articulated is that in this massive store, all these types of alcohol overlap in relatedness of goods and services. The Examiner was able to point to a handful who indeed produce both wine and beer. Total Wine & More® can manage massive amounts of wine and beer each from different producers. It does so, as explained using multiple sophisticated indexing tools.



The current request is not between NORTH COAST for beer and wine, instead between NORTH COAST BREWING for beer and NORTH COAST WINE CO. for wine. While in 1990, this confusion might be possible, today this confusion is inconceivable. When was the last time anyone saw a beer, any beer and figured a bottle of wine would be from the same source? Also, here the third semi-descriptive word clearly indicate one is a “wine company” and the other a “beer company.”

The analysis is not between NORTH COAST PLEASURE for wine and NORTH COAST BLACK for beer, instead the last portion clearly serves to distinguish between sources. The analysis appears to suggest that the marks are simply NORTH COAST v. NORTH COAST. But the two respective marks are unique in one key point, each incorporates the nature of the product.

The law clearly provides “... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” The Office must prove that knowing beer is sold under NORTH COAST BREWING in commerce, that a bottle of wine named NORTHCOAST WINE CO. once it arrives will likely confuse, cause mistake, or deceive.

### **III ALL DOUBTS SHOULD BE RESOLVED IN FAVOR OF APPLICANT**

To the extent that there is any doubt, the Board has held that all doubts should be resolved in favor of Applicant. *See In re Aid Labs., Inc.*, 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:51 (2004). Disputed marks should thus be permitted to proceed to publication in light of the fact that competitors would have the opportunity to oppose the registration at a later time. *See id.* That is the case with NORTH COAST BREWING’s owner.

### **Conclusion**

Some concepts, like secondary meaning, weakness of marks, presumptions of ownership are often mishandled. Today, the Examiner confuses the functional rejection with a geographical / descriptive rejection. The requested mark is not functional, period. The Examiner also has applied the descriptive and functional rejections indiscriminately to all goods and services as applied. Once again, that was a mistake. The mark is really NORTHCOAST WINE CO. In the field of wine and beer, the use of WINE CO. creates a new mark and avoids confusion. Customers in the field of wine and beer are now educated and dispose of a hundreds of tools to avoid any potential confusion.

Here the question is simple. If the Board members were used to drinking beer from NORTH COAST BREWING, walking into a wine store or sitting at a restaurant where a list has NORTHCOAST WINE CO. wine, would there be any possible confusion? Would the wrong product be purchased? The answer is simple, no. No one today buys the wrong wine or beer. In restaurants, people are paid to help customers and entire menus are printed to help. Children are excluded by law from participating in the purchase of these products. The analysis offered by the Office was technically correct and the Applicant now asks this Board to use common sense to a rigid analysis. As shown, Applicant is not asking for something new. Every other wine and beer maker in the United States has been given these marks.

For the foregoing reasons, Applicant submits its mark is entitled to registration, respectfully requests the Board to reverse the Examiner's decision, and approve the mark for publication.

Respectfully submitted,

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