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

Ex Parte Appeal - Serial No.	90313836
Appellant	CIMA MERKENBEHEER VBA
Applied for mark	GRAN CASTILLO
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Submission	Appeal brief
Attachments	02783402.PDF(381217 bytes)
Appealed class	Class 033. All goods and services in the class are appealed, namely: Brandy; Brandy spirits
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Date	08/25/2022

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

Application No.: 90313836
Application Date: August 25, 2022
Trademark: GRAN CASTILLO (in red, stylized with design elements)
Applicant: CIMA MERKENBEHEER VBA

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Attention: Trademark Trial and Appeal Board

APPLICANT'S APPEAL BRIEF

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STATUTES, REGULATION(S) & TMEP

37 C.F.R. §2.142

15 U.S.C. §1052(d) (Trademark Act Section 2(d))

TMEP §1207.01

TMEP §1207.01(b)

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APPLICANT'S APPEAL BRIEF

Applicant, CIMA MERKENBEHEER VBA, hereby submits its Appeal Brief pursuant to 37 C.F.R. §2.142.

I. PRELIMINARY STATEMENT

This Appeal addresses the Final Office Action that issued on November 28, 2021.

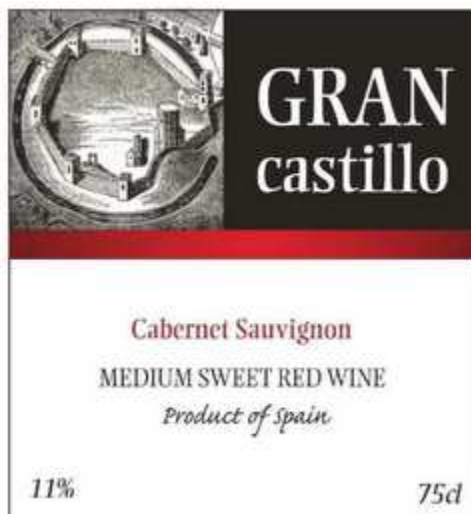
A Request for Reconsideration was denied (Denial) on June 27, 2022.

The issue on appeal is whether the applied-for mark, GRAN CASTILLO (in red, stylized with design elements), which is reproduced below, was correctly refused registration under 15 U.S.C. §1052(d) (Trademark Act Section 2(d)) on the grounds of likelihood of confusion with the mark in U.S. Registration No. 5472246 (registered mark), which is reproduced below also.

APPLIED-FOR MARK

GRAN CASTILLO

REGISTERED MARK



II. DISCUSSION

The applied-for mark, which is reproduced above, was refused registration under 15 U.S.C. §1052(d) (Trademark Act Section 2(d)) on the grounds of likelihood of confusion with the registered mark, which is reproduced above also.

In short, the applied-for mark was rejected on the grounds that the word portion of the applied-for mark is identical to the allegedly dominant word portion of the registered mark regardless of the additional elements in the applied-for mark and the registered mark.

According to the TMEP §1207.01, the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression” must be taken into consideration.

Section 1207.01(b)(iii) of TMEP states, “Determining whether there is a likelihood of confusion requires careful consideration of the nature of the common elements of the marks at issue, as well as the overall commercial impression created by each mark.”

Section 1207.01(b)(iii) of TMEP further states, “Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey

significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.”

Section 1207.01(b)(viii) explains, “When assessing the likelihood of confusion between compound word marks, although each mark must be considered as a whole, it is appropriate to consider whether a portion of the mark is dominant in creating the mark’s commercial impression.”

The applied-for mark and the registered mark are both composite marks, not word marks. The Office Action appears to be analyzing the literal elements of the marks as if the applied-for mark and the registered mark are word marks. It is respectfully submitted that such an approach is not proper in this case. .

According to the so called anti-dissection rule, conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. See Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 345-46 (1920). The anti-dissection rule is based on the common sense understanding that the average customer only retains an overall, general impression created by the composite mark, not by the impression created by a meticulous comparison of the composite marks. See, for example, Daddy’s Junky Music Stores, Inc. v. Big. Family Music Center, 109 F.3d 275 (6th Cir. 1997).

The U.S. Trademark Office accepts the anti-dissection rule as applied to composite marks. Regarding the examination of composite marks, TMEP § 1207.01(c)(ii) provides:

Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. See, e.g., In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); Giant Food, Inc. v. Nation’s Foodservice, Inc., 710 F.2d 1565, 1570-71, 218 USPQ 390, 395 (Fed. Cir. 1983); see also TMEP § 1207.01(b)(iii). However, the fundamental rule in this situation is that the marks must be considered in their entirety. See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U., 797 F.3d 1363, 1371, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687,

1688 (Fed. Cir. 1993); Massey Junior Coll., Inc. v. Fashion Inst. of Tech., 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (C.C.P.A. 1974) .

If a mark comprises both wording and a design, greater weight is often given to the wording, because it is the wording that purchasers would use to refer to or request the goods or services. See, e.g., Viterra, 671 F.3d at 1366, 101 USPQ2d at 1911; In re Max Capital Grp. Ltd., 93 USPQ2d 1243, 1247 (TTAB 2010) ; In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987) . The Court of Appeals for the Federal Circuit has cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." In re Electrolyte Labs. Inc., 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).

The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction.

The Office Action appears to rely on the conclusion that the words “gran castillo” are the dominant portion of the registered mark. The registered mark (reproduced below) is a composite of many different elements.



REGISTERED MARK

As is clear more than half of the design is devoted to the presentation of additional words, namely, Cabernet Sauvignon, Medium Sweet Red Wine, Product of Spain 11% 75CL. The

additional words are presented in relatively large font size (not small print) and centered in the lower half portion of the composite mark with a white background, drawing attention to the product itself. A customer casually shopping for wine is not likely to gloss over the additional words as alleged in that the additional words are prominently displayed. In fact, it appears the purpose of the design is to draw the customer's attention to the contents of the bottle (Cabernet Sauvignon, Medium Sweet Red Wine, Product of Spain) probably to make a quick sale.

About one third of the design is devoted to a rather interesting picture of a castle.

The words gran castillo (meaning great castle) appear next to the picture of the castle, implying that it is a description of the castle appearing in the picture and not a mark. Also, the word GRAN (all caps) is larger in font size than the word castillo (in lower case), giving prominence to GRAN over castillo, which creates an entirely different impression than GRAN CASTILLO presented in all caps and the same font size in the applied-for mark.

Furthremore, the word GRAN means great, which is merely laudatory, and should be considered weak. See section 1207.01(b)(iii) of TMEP.

Imagining the registered mark as a whole (in its entirety) appearing on a wine bottle on a shelf, the most prominent features are in fact the additional words (Cabernet Sauvignon, Medium Sweet Red Wine, Product of Spain) to grab the shopper's attention.

The applied-for mark is reproduced below for comparison.

GRAN CASTILLO

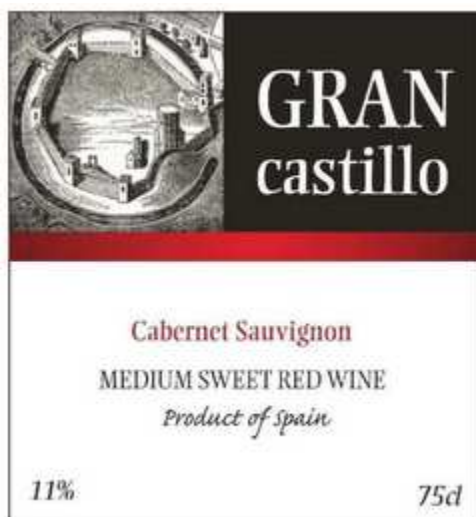
As is clear, the words GRAN CASTILLO, presented in all caps, in the same font, and in red, are the prominent features of the applicant's mark. The design features three parallel lines of different lengths, above and below GRAN CASTILLO to further frame and to highlight the words GRAN CASTILLO, creating a commercial impression around the mark GRAN CASTILLO, and not any other additional words or graphic element.

In short, when viewed side by side, the registered mark applied, for example, to a wine bottle and the applied-for mark applied to, for example, a bottle of brandy, would not create the same commercial impression on a shopper.

Furthermore, brandy (which is a spirit) and wine are not sold in the same section of a liquor store. So, a shopper casually shopping for wine is not likely to have the opportunity to be confused by the two marks.

The central point of the Office Action is that the words "gan castillo" are the dominant portion of the conflicting mark, and that the other elements in the conflicting mark do not contribute to the creation of a commercial impression that is different from the commercial impression of the applied-for mark.

For convenience, the conflicting mark and the Applicant's mark are reproduced below.



GRAN CASTILLO

The registered conflicting mark is “GRAN CASTILLO CABERNET SAUVIGNON MEDIUM SWEET RED WINE PRODUCT OF SPAIN 11% 75CL”. See Exhibit 1.

The registration of the registered mark indicates that “NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE ‘CABERNET SAUVIGNON’, ‘MEDIUM SWEET RED WINE’, ‘PRODUCT OF SPAIN’, ‘11%’ AND ‘75CL’ APART FROM THE MARK AS SHOWN”.

The registration describes the registered mark as follows:

The color(s) black, grey, red, and white is/are claimed as a feature of the mark. The mark consists of a design of a castle and circular fortress surrounded by a moat, in black, white, and grey on a white background in a square on the upper left, with the wording "GRAN CASTILLO" in white on a black square background in the upper right hand corner of the mark; a thick red gradient bar appears below both squares; below the two upper squares is a red gradient bar separating a larger white rectangle covering the entire bottom of the mark; on the white rectangle appears the wording "CABERNET SAUVIGNON" in red, followed by the stacked wording "MEDIUM SWEET RED WINE", PRODUCT OF SPAIN", "11%" and "75cl" in black; a black outline encompasses the entire design.

The Office Action explains that applicant's side-by-side contrasting of the designs in the mark is not persuasive:

When comparing marks, "[t]he 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 [consumers] who encounter the marks would be likely to assume a connection between the parties." Cai v. Diamond Hong, Inc., 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. In re Inn at St. John's, LLC, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing In re St. Helena Hosp., 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); Geigy Chem. Corp. v. Atlas Chem. Indus., Inc., 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b). In this case, the shared wording comprises all of the wording in applicant's mark, and the

largest, most prominent, distinctive, and dominant portion of registrant's mark. As such, the differences in the designs are not likely to overcome the general recollection retained by the average consumer.

In the Office Action, it was stated that,

The shared wording GRAN CASTILLO is the dominant portion of registrant's mark for several reasons. First, this wording is the only wording in the mark that is not descriptive for the goods. All of the other wording in the mark describes a feature of the goods and has been disclaimed. See disclaimer statement in the record.

First, the graphical portion (picture of a castle) of the registered mark is not descriptive of the goods either, and it is also prominent.

Second, the words gran castillo of the registered mark do not constitute the largest portion of the registered mark. More than 75% of the conflicting mark is dedicated to other claimed features:

The mark consists of a design of a castle and circular fortress surrounded by a moat, in black, white, and grey on a white background in a square on the upper left, with the wording "GRAN CASTILLO" in white on a black square background in the upper right hand corner of the mark; a thick red gradient bar appears below both squares; below the two upper squares is a red gradient bar separating a larger white rectangle covering the entire bottom of the mark; on the white rectangle appears the wording "CABERNET SAUVIGNON" in red, followed by the stacked wording "MEDIUM SWEET RED WINE", PRODUCT OF SPAIN", "11%" and "75cl" in black; a black outline encompasses the entire design.

In addition, the "color(s) black, grey, red, and white is/are claimed as a feature of the mark."

The Applicant agrees that the proper test is whether the marks are sufficiently similar in terms of their commercial impression.

The Applicant disagrees that, in view of all the other features in the registered mark, the words gran castillo are the “prominent, distinctive, and dominant portion” such that “the differences in the designs are not likely to overcome the general recollection retained by the average consumer.”

Furthermore, the Applicant’s description of the mark is GRAN CASTILLO in a red stylized font with three black lines above and beneath, which serve to “frame” the words GRAN CASTILLO. The words GRAN and CASTILLO are presented in capital letters, are the same size, are the same font, and are located next to one another. In the registered mark, the word GRAN is much larger than the word castillo and in capital letters, while the word castillo is in lower case letters, and appears above (not next to) the word castillo. Thus, the word GRAN stands out and overshadows the word castillo, thereby creating a commercial impression that is different from GRAN CASTILLO presented as two words all in capital letters, appearing on the same line, side by side, and in the same font and size.

In addition, while the word GRAN does not describe a characteristic of wine, its prominence in the registered mark, could be read as grand, and thus serves as a laudatory aspect of the mark, and not as a source identifier.

It is further submitted that focusing on the words gran castillo in the registered mark, and ignoring the remaining elements in the registered mark (which severely limit the scope of the registered mark) would elevate the limited scope of the registered mark far beyond the actual registration which requires,

- 1) a design of a castle and circular fortress surrounded by a moat, in black, white, and grey on a white background in a square on the upper left,
- 2) the wording "GRAN CASTILLO" in white on a black square background in the upper right hand corner of the mark;
- 3) a thick red gradient bar appears below both squares;
- 4) below the two upper squares is a red gradient bar separating a larger white rectangle covering the entire bottom of the mark;

5) on the white rectangle appears the wording "CABERNET SAUVIGNON" in red, followed by the stacked wording "MEDIUM SWEET RED WINE", "PRODUCT OF SPAIN", "11%" and "75cl" in black; a black outline.

It is further submitted that the disclaimer of the elements CABERNET SAUVIGNON and MEDIUM SWEET RED WINE, PRODUCT OF SPAIN, 11% and 75cl means that these words in the registered mark will not be enforced as a mark separate and apart from the rest of the mark. The disclaimer does not mean that these words are not to be considered part of the mark as a whole. In other words, the disclaimer should not serve to extend the scope of the registered mark.

III. CONCLUSION

Accordingly, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal to register Applicant's GRAN CASTILLO (in red, stylized with design elements).

Dated: August 25, 2022
New York, New York

Respectfully submitted,

/Kourosh Salehi/

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Attorneys for Applicant

Exhibit 1

United States of America

United States Patent and Trademark Office



Reg. No. 5,472,246

Registered May 22, 2018

Int. Cl.: 33

Trademark

Principal Register

Global Wine House OÜ (ESTONIA Osühing (oü))
Kortsi Tee 3, Lehmja Küla,
Rae Valdee-75306 Harju Maakond
ESTONIA

CLASS 33: Wines of Spanish origin

The color(s) black, grey, red, and white is/are claimed as a feature of the mark.

The mark consists of a design of a castle and circular fortress surrounded by a moat, in black, white, and grey on a white background in a square on the upper left, with the wording "GRAN CASTILLO" in white on a black square background in the upper right hand corner of the mark; a thick red gradient bar appears below both squares; below the two upper squares is a red gradient bar separating a larger white rectangle covering the entire bottom of the mark; on the white rectangle appears the wording "CABERNET SAUVIGNON" in red, followed by the stacked wording "MEDIUM SWEET RED WINE", "PRODUCT OF SPAIN", "11%" and "75cl" in black; a black outline encompasses the entire design.

OWNER OF INTERNATIONAL REGISTRATION 1000615 DATED 04-03-2009,
EXPIRES 04-03-2019

No claim is made to the exclusive right to use the following apart from the mark as shown:
"CABERNET SAUVIGNON", "MEDIUM SWEET RED WINE", "PRODUCT OF SPAIN",
"11%" AND "75CL"

The English translation of the wording "GRAN CASTILLO" in the mark is "grand castle".

SER. NO. 79-218,534, FILED 09-06-2017

