

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

Mailed: August 2, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Luxco, Inc. and Heaven Hill Distilleries, Inc.

v.

Saint Lucia Distillers Limited

Opposition No. 91193668
to application Serial No. 77743036
and application Serial No. 77759962

Michael R. Annis of Husch Blackwell Sanders LLP for Luxco, Inc. and Heaven Hill Distilleries, Inc.

Mark Wisnosky of the Law Office of Mark Wisnosky for Saint Lucia Distillers Limited.

Before Bucher, Bergsman and Lykos,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Saint Lucia Distillers Limited ("applicant") filed two intent-to-use applications for the mark ADMIRAL RODNEY, in standard character form, and ADMIRAL RODNEY EXTRA OLD ST. LUCIA RUM and design, shown below, for rum, in Class 33. Applicant disclaimed the exclusive right to use "Extra Old St. Lucia Rum." In the applications, applicant stated that Admiral Rodney does not identify a living individual.



Heaven Hill Distilleries, Inc., through its predecessor in interest, Luxco, Inc., ("opposers"), opposed the registration of applicant's marks on the ground of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).¹ Specifically, opposers alleged ownership and prior use of the registered trademarks listed below for rum.

1. Registration No. 2336367 for the mark ADMIRAL NELSON'S, in typed drawing form;² and

2. Registration No. 2436494 for the mark ADMIRAL NELSON'S PREMIUM SPICE RUM and design, shown below.³



¹ Opposers also asserted dilution by blurring but did not argue that ground in its brief and, therefore, we deem that claim waived. See e.g., *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005).

² Issued March 28, 2000; renewed.

³ Issued March 20, 2001; renewed.

The original registrant disclaimed the exclusive right to use "Premium Spice Rum." Also, the original registrant stated in its applications for registration that Admiral Nelson does not identify a living individual.

Applicant, in its answer, denied the salient allegations in the notice of opposition.

After the close of discovery and trial, opposers filed a motion to substitute Heaven Hill Distilleries as the opposer because the ADMIRAL NELSON'S marks, registrations, and the goodwill associated with the marks have assigned to Heaven Hill Distilleries and that assignment has been recorded with the USPTO.⁴ Applicant opposed the motion to substitute. In light of applicant's objection, the Board joined Heaven Hill Distilleries rather than substitute it as the opposer.⁵

Evidentiary Objections

Opposers have filed numerous objections against certain testimony and exhibits introduced by applicant. None of the testimony and/or exhibits sought to be excluded is outcome determinative. Given this fact, coupled with the number of objections, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted

⁴ Reel 4574, frame 0726, recorded on July 1, 2011.

⁵ See TBMP § 512.01 (3rd ed. 2011).

by the parties. In doing so, we have kept in mind the various objections raised by opposers, and we have accorded whatever probative value the subject testimony and exhibits merit.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR § 2.122(b). In addition, the parties introduced the evidence identified below.

A. Opposers' testimony and evidence.

1. Notice of reliance on the items listed below:
 - a. copies of opposers' pleaded registrations made by the USPTO showing the current status of and title to the registrations;
 - b. Copies of the files for opposers' pleaded registrations;
2. Notice of reliance on applicant's responses to opposers' requests for admission and interrogatories; and
3. Testimony deposition of Donn Lux, Chairman, CEO and President of Luxco, Inc., with attached exhibits;

B. Applicant's testimony and evidence.

1. Notice of reliance on the items listed below:

- a. Excerpts from Frederick H. Smith, Caribbean Rum and Social and Economic History, pp. 27 and 233-237 (2008);
 - b. Excerpts from Ray Foley, The Rum 1000: The Ultimate Collection of Rum Cocktails, Recipes, Facts, and Resources, pp. 1-3 (2008);
 - c. Chapter 4 from The Beverage Alcohol Manual (BAM), A Practical Guide, Basic Mandatory Labeling Information for Distilled Spirits, Volume 2, Department of the Treasury Alcohol & Tobacco Tax & Trade Bureau, TTBP5110.7 (2007); and
 - d. Excerpts from Ian Williams, Rum, A Social and Sociable History, pp. 225 and 239-241, 309 (2006); and
3. Testimony deposition by written question of Laurie Barnard, applicant's Managing Director, with attached exhibits.

Standing

Because opposers have properly made their pleaded registrations of record, opposers have established their standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries*,

Opposition No. 91193668

Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposers' pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the products covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The fame of opposers' marks.

This *du Pont* factor requires us to consider the fame of opposers' marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir.

2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposers have introduced the following testimony and evidence regarding the fame of the ADMIRAL NELSON'S marks:

1. Opposers, through their predecessors-in-interest, have been selling ADMIRAL NELSON'S rum since at least 1990;⁶

2. ADMIRAL NELSON'S rum is the fifth-largest selling rum in the United States;⁷

3. ADMIRAL NELSON'S rum is sold in all fifty states;⁸

4. Since 2002, revenues generated by the sale of ADMIRAL NELSON'S rum and the number of units sold have been significant;⁹

5. Opposers have extensively marketed ADMIRAL NELSON'S rum;¹⁰ and

6. ADMIRAL NELSON'S rum has won several awards, including being named as a "Hot Brand" from 2006 through

⁶ Lux Dep., p. 20. In their brief, opposers cited their pleaded registrations as evidence of their use of the mark since 1986. However, the dates of use claimed in an [application] for registration are not evidence on behalf of a registrant. "[A] date of use must be established by competent evidence." Trademark Rule 2.122(b)(2), 37 CFR § 2.122(b)(2). See also *J. C. Hallmark Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965) (the presumption emanating from a certificate of registration relates back to the filing date of the application on which registration is predicated); *Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). The testimony of Mr. Lux establishes 1990 as the earliest date of use.

⁷ Lux Dep., pp. 53 - 54.

⁸ Lux Dep., p. 38.

⁹ Lux Dep., pp. 38 - 50, Exhibits 8 - 10. Opposers' testimony and evidence regarding their sales and advertising expenditures has been designated confidential. Accordingly, we may only refer to the sales and advertising figures in general terms.

¹⁰ Lux Dep., Exhibit 9.

2011 by *Market Watch* magazine, a leading trade publication in the "beverage alcohol industry."¹¹

While opposers have achieved commercial success and a high degree of renown, the evidence of record is not sufficient to establish that opposers' ADMIRAL NELSON'S marks are famous for purposes of likelihood of confusion. Nevertheless, in view of opposers' extensive sales and advertising expenditures, as well as the unsolicited media attention they have received, we find that opposers' ADMIRAL NELSON'S marks have a high degree of public recognition and renown. Indeed, when coupled with the arbitrary nature of the mark, ADMIRAL NELSON'S is entitled to a broad scope of protection or exclusivity of use.

B. The similarity or dissimilarity and nature of the products described in the applications and registrations, the likely-to-continue trade channels and classes of consumers.

The goods at issue are identical: rum. Because the goods are identical, we may presume that the channels of trade and classes of purchasers are the same. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed.

¹¹ Lux Dep., pp. 75 - 78, Exhibits 22 - 26.

Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

C. The number and nature of similar marks in use on similar goods.

There was no evidence of any other "Admiral" marks in use in connection with rum or any other alcoholic beverage.

D. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683,

Opposition No. 91193668

196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods at issue are rum, we are dealing with average consumers.

We also note that where, as here, the goods are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

The marks are similar to the extent that they both begin with the word "Admiral" and are followed by a two syllable name (*i.e.*, Nelson's and Rodney). In addition, they engender similar commercial impressions by suggesting a nautical theme. On the other hand, there is nothing particularly distinctive with using a nautical theme in

connection with the sale of rum because there is a long-time association between rum and sailors. Applicant submitted the following excerpts from books in general circulation to show that authors have written about the association between rum and sailors.¹²

1. Frederick H. Smith, Caribbean Rum and Social and Economic History, (2008).

a. Page 27

In early modern Europe, alcohol was deeply ingrained in maritime communities, and seamen considered it a necessary provision on trading ventures. The potential disasters that could result from the limited availability of fresh water on long sea voyages made alcohol a critical store in long distance maritime trade. ... While wine, brandy, and gin filled the hulls of ships departing Europe, Caribbean sugar planters exploited the maritime demand for alcohol on the other side of the Atlantic and sold rum to traders for the return voyage. As early as the mid-seventeenth century, planters in Barbados sold rum to "Ships [where it was] ... drunk by the way." These seamen helped spread the taste of rum to other regions of the Atlantic.

b. Page 236

Rum labels embrace symbols of masculinity. Pirates adorn Old Brigand, Captain Morgan, Buccaneer, and Tortola Spiced rums. Some labels portray maritime images that highlight the

¹² As opposers point out in its objections to applicant's evidence, the excerpts from these books are admissible and probative only for what they show on their face and not for the truth of the matters asserted therein.

rugged and independent seafaring life. Sailing ships, for example, grace varieties of Nelson, Montebello, El Dorado, and Bounty. Two sailors lean on a cask of rum on the label of Cruzan 151. Pusser's rum romanticizes the tradition of rum rations in the British Royal Navy. Bounty and Captain Bligh honor the career of the mutiny-struck ships. Don Q, Grand Corsaire, and Cavalier labels are adorned with images of swashbuckling gentlemen from a more adventurous age.

2. Ray Foley, The Rum 1000: The Ultimate Collection of Rum Cocktails, Recipes, Facts, and Resources, pp. 1 and 3 (2008):

Other names used for rum are: Nelson Blood,
Navy Neater,
Demon Water, and
Pirate's Drink.

* * *

The British Royal Navy gave its sailors a daily rum ration until July 31, 1970.

3. Ian Williams, Rum, A Social and Sociable History, pp. 225 (2006).

In 1931, H. Warner Allen, every bit as patriotic and with just as much or as little evidence as Taussig had for annexing the spirit of the United States, wrote:

Rum is the Englishman's spirit, the true spirit of adventure. Whiskey belongs to Scotland and Ireland, Brandy to France, Gin to Holland, but Rum is essentially English despite its tropical origin. The very word calls up heroic memories

of the iron seamen who on the lawful and unlawful occasions built up the British Empire overseas, and if ever Rum were to disappear from navy rations, a great tradition would be tragically broken.

"Admiral" is a title that means "1. the commander in chief of a fleet. 2. a navel officer of the highest rank. 3. a naval officer of high rank."¹³ Therefore, the marks identify separate and distinct individuals - Admiral Nelson and Admiral Rodney - and the term "Admiral" is akin to the terms "Mister" or "Doctor."

In fact, during the prosecution of applicant's application, the examining attorney submitted evidence identifying Admirals Rodney and Nelson and demonstrating that they are different historical figures.

Admiral Rodney is "[t]he British admiral George Brydges Rodney, 1st Baron Rodney (1718-1792), by winning notable victories in the Caribbean waters over French, Spanish and Dutch forces, contributed substantially to British command of the seas in the late 18th century."¹⁴

Admiral Nelson is Vice Admiral Horatio Nelson (1758-1805), another noted British naval hero.¹⁵

¹³ The American Heritage Dictionary of the English Language (Unabridged), p. 26 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹⁴ August 26, 2009 Office action.

¹⁵ August 26, 2009 Office action. Admiral Nelson "is still generally accepted as the most appealing of Britain's national heroes." "Horatio Nelson, Viscount Nelson," *Encyclopedia*

Nelson's victories ensured that the British controlled the seas for the duration of the Napoleonic wars and prevented the French for ever attempting to invade Britain. His strategic vision and tactical flexibility set him apart from his contemporaries and have been emulated in the centuries since his death. Nelson possessed the innate ability to inspire his men to achieve beyond what they thought possible. This "Nelson Touch" was a hallmark of his command style and has been sought by subsequent leaders.¹⁶

The above-noted facts regarding Admiral Nelson and Admiral Rodney are not referenced to show that typical U.S. consumers recognize British naval heroes, but to demonstrate that the names Admiral Nelson and Admiral Rodney identify different individuals and, when used as marks, are likely to be construed as different names. Accordingly, we find that the marks have different meanings.

In analyzing the similarities and dissimilarities of the marks, the differences in their appearance, sound and meaning outweigh the similarity arising from the fact that both marks begin with the word "Admiral." Accordingly, we find that applicant's ADMIRAL RODNEY marks are not similar to opposers' ADMIRAL NELSON'S marks.

Britannica Online Academic Edition, Encyclopedia Britannica Inc. (2012). The Board may take judicial notice of standard reference works. *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (other standard reference works); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88, 96 n.3 (TTAB 1980).

¹⁶ August 26, 2009 Office action.

E. Balancing the factors.

Despite the strength of opposers' marks, the identity of the goods and presumption that the goods move in the same channels of trade and are sold to the same classes of consumers, consumers will distinguish the marks because ADMIRAL RODNEY is not confusingly similar to ADMIRAL NELSON'S. In other words, in this case, the dissimilarity of the marks is the most important factor. See, e.g., *Kellogg Co. v. Pack-Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive. ... 'each [of the thirteen elements] may from case to case play a dominant role.'"). Accordingly, we find that applicant's ADMIRAL RODNEY marks for rum are not likely to cause confusion with opposers' ADMIRAL NELSON'S marks for rum.

In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

Decision: The opposition is dismissed and applicant's applications will be forwarded for the issuance of notices of allowance in due course.