

This Opinion is Not a
Precedent of the TTAB

Mailed: December 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

E. & J. Gallo Winery
v.
Thunder Road Brands, LLC

Opposition No. 91222284

Steven M. Weinberg and Michael J. Salvatore of Holmes Weinberg, PC,
for E. & J. Gallo Winery.

Dorian B. Kennedy of Baker, Donelson, Bearman, Caldwell & Berkowitz, P.C.,
for Thunder Road Brands, LLC.

Before Zervas, Wellington and Heasley,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Thunder Road Brands, LLC (“Applicant”) seeks to register the mark THUNDER ROAD in standard character form on the Principal Register for “alcoholic beverages, namely, Tennessee sour mash whiskey and moonshine” in International Class 33.¹

¹ Application No. 77859042, filed on October 28, 2009 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1501(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

E. & J. Gallo Winery (“Opposer”) has opposed registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), pleading in its Notice of Opposition,² (i) common law use of the mark THUNDERBIRD on wine since 1957; and (ii) ownership of Registration Nos. 0656907 and 3853584, both for the mark THUNDERBIRD, one in standard character form and the other in stylized form for “wines” in International Class 33;³ and (iii) ownership of Registration No. 4403211 for the mark THUNDERBIRD in standard character form for “alcoholic beverages except beers” in International Class 33.⁴

Applicant, in its Answer,⁵ denied the salient allegations of the Notice of Opposition and raised several “defenses,” which are amplifications of its denials and equitable defenses. Both parties filed trial briefs and Opposer filed a reply brief.

I. The Trial Record

In addition to the pleadings, the trial record automatically includes the involved application file pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). The trial record also includes the following:

A. The summary judgment record created in connection with Applicant’s motion (filed January 23, 2017) for summary judgment, pursuant to a stipulation submitted by the parties on November 7, 2017 and approved by the Board on the same date, submitting:

² 1 TTABVUE.

³ Registration Nos. 0656907, registered January 7, 1958, and Registration No. 3853584, registered September 28, 2010.

⁴ Registration No. 4403211, registered September 17, 2013.

⁵ 10 TTABVUE.

1. The January 23, 2017 Declaration of William H. Blalock, Jr., one of Applicant's principals (no exhibits);⁶
2. Declaration of Peter L. Brewer, Applicant's attorney, and exhibits;⁷
3. Declaration of Maia T. Woodhouse, Applicant's attorney, and exhibits;⁸
4. Applicant's "Request to take Judicial Notice ..." referring to, and providing web addresses for, the following documents, which were submitted with Ms. Woodhouse's and Mr. Brewer's declarations; (i) a dictionary definition of "thunderbird" from Merriam Webster Online Dictionary, (ii) Washington Post and Mountain Xpress Asheville, NC articles, and (iii) Washington State government webpages (<http://lcb.wa.gov>);⁹
5. Applicant's Statement of Undisputed Facts, only some of which Opposer admitted (Opposer admitted paragraphs 1-2, 6, 8-10, 30-32 and 38-39 thereof);¹⁰
6. Declaration of Tim Cannon, Opposer's Director of Marketing, and exhibits, including two brand equity studies, one from 2014 and the other from 2015;¹¹ and
7. Declaration of Michael J. Salvatore, Opposer's attorney, and exhibits.¹²

B. The parties' stipulation (filed August 17, 2017) that certain documents identified by USPTO Registration/Application Number and/or Bates Number, be admitted into evidence, approved by the Board on November 7, 2017.¹³

⁶ 17 TTABVUE 30-32.

⁷ 17 TTABVUE 33-162.

⁸ 18 TTABVUE.

⁹ 17 TTABVUE 27.

¹⁰ 17 TTABVUE 3-14.

¹¹ 21 TTABVUE 27-59.

¹² 21 TTABVUE 60-386.

¹³ 25 TTABVUE. These documents, which were not submitted with the stipulation, include Reg. Nos. 0656907, 3853584 and 4403211, and App. Serial No. 77859042. App. Serial No. 77859042 is the application involved in this proceeding and its prosecution record is

- C. Opposer's notices of reliance submitting:
 - 1. Applicant's responses to Opposer's interrogatories and requests for admission;¹⁴
 - 2. Documents from USPTO records;¹⁵ and
 - 3. Webpage printouts.¹⁶
- D. Testimony Depositions of Messrs. Cannon and Mitchum (another of Applicant's principals, and Applicant's majority member) and exhibits.¹⁷
- E. Applicant's notices of reliance submitting:
 - 1. Opposer's responses to Applicant's requests for admission and interrogatories;¹⁸
 - 2. Webpage printouts;¹⁹ and
 - 3. Documents from USPTO and state records.²⁰
- F. Mr. Blalock's December 6, 2017 declaration.²¹

II. Evidentiary Issues

Opposer has objected in its reply brief to certain evidence submitted by Applicant. Objections raised for the first time in a reply brief are untimely (and hereby denied) because they effectively foreclose the adverse party from responding to the objections.

automatically of record pursuant to Trademark Rule 2.122(b). The parties have not indicated where the remaining documents appear in the record.

¹⁴ 26 and 27 TTABVUE (designated confidential); 29 TTABVUE.

¹⁵ 28, 30-32 TTABVUE.

¹⁶ 14 TTABVUE.

¹⁷ 50 TTABVUE (confidential materials at 52 and 53 TTABVUE).

¹⁸ 42 and 43 TTABVUE.

¹⁹ 44 and 48, 49 TTABVUE.

²⁰ 45-47 TTABVUE.

²¹ 54 TTABVUE.

Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc., 98 USPQ2d 1921, 1928 (TTAB 2011); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007). If Opposer raised some of these objections during the trial period, its objections were not repeated in Opposer's trial brief and therefore are deemed to have been waived.

Mindful of any objections, we have accorded the evidence whatever probative value (if any) it merits. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017).

With regard to Applicant's request to take judicial notice of certain documents, because Applicant submitted these documents with Mr. Brewer's and Ms. Woodhouse's declarations, they are already part of the evidentiary record.

III. Standing

Standing is a threshold issue that must be proven by a plaintiff in every inter partes case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show "both a 'real interest' in the proceedings as well as a 'reasonable basis' for its belief of damage." *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Opposer's standing is established by its three pleaded registrations, which are mentioned in the parties' August 17, 2017 stipulation and which Opposer's attorney

indicated in Mr. Cannon's trial deposition have been "stipulated into the record."²² *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing). Applicant does not dispute in its main brief that the three pleaded registrations are in the record or that Opposer has standing to oppose registration of Applicant's mark.

IV. Priority

Because Opposer's pleaded registrations are of record pursuant to the parties' August 17, 2017 stipulation, and because there is no pending counterclaim to cancel these registrations, priority is not at issue with respect to marks and goods covered by the registrations. *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1844; *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998).

V. Likelihood of confusion

We now consider Opposer's claim of likelihood of confusion under Section 2(d) of the Trademark Act. As the plaintiff in this proceeding, Opposer bears the burden of proof, which encompasses the obligation of going forward with sufficient proof of the material allegations of its complaint. *Sanyo Watch Co., Inc. v. Sanyo Elec. Co., Ltd.*, 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982) (in a proceeding to test likelihood of confusion opposer "bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the obligation of going forward with sufficient

²² 33 TTABVUE 15. In addition, Mr. Cannon's February 21, 2017 declaration states at paragraph 12 that Opposer is the owner of these three registrations and that Registration Nos. 0656907 and 3853584 are incontestable. 21 TTABVUE 29.

proof of the material allegations of the Notice of Opposition....”); *see also Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988) (because § 2(d) of the Trademark Act “provides that no trademark shall be refused unless it is shown that there is a likelihood of confusion with another mark, the requirement that the opposer both establish a prima facie case of likelihood of confusion and carry the ultimate burden of persuasion on that issue is proper....”).

Our determination is based on an analysis of all of the 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) (“*du Pont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). “[W]e need to consider only the factors that are relevant and of record.” *M2 Software Inc. v. M2 Commc’ns Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

We focus on Opposer’s pleaded Registration No. 4403211 for the mark THUNDERBIRD in standard character form for “alcoholic beverages except beers.” If we find confusion likely between this mark and Applicant’s mark for their respective goods, we need not consider the likelihood of confusion between Applicant’s mark and Opposer’s other pleaded marks for their respective goods. On the other

hand, if we find no likelihood of confusion between Applicant's mark and the mark of Registration No. 4403211 for their respective goods, we would not find confusion likely between Applicant's mark and Opposer's other pleaded marks for their respective goods, which are less similar to Applicant's mark for its identified goods. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The Fame of Opposer's Mark.

We first address Opposer's contention that its mark THUNDERBIRD is "a very strong, if not, famous mark."²³ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. 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 Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). For purposes of analysis of likelihood of confusion, fame is not an "all-or-nothing factor"; rather, it "varies along a spectrum from very strong to very weak." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). Fame is "determined from the viewpoint of consumers of like products," and not from the viewpoint of the general public. *Id.* at 1735. Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives,

²³ 59 TTABVUE 17.

and the dominant role fame plays in the likelihood of confusion analysis, “[i]t 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).

To demonstrate the fame of its mark, Opposer relies on its continuous use of its mark since 1957, and pertinent financial and advertising data. The data includes the retailers who offer Opposer’s THUNDERBIRD wine in the United States, and annual sales volume and revenue for the years 2009 through 2016.²⁴ Mr. Cannon testified that Opposer currently does not advertise the THUNDERBIRD product, but did so until about eighteen years ago.²⁵ The advertising expenditures for THUNDERBIRD branded goods for the period from 2009-2015 are minimal.²⁶ Opposer notes that there are two YouTube videos featuring THUNDERBIRD television advertisements which have over 221,000 combined views;²⁷ the slogan “What’s the word? THUNDERBIRD!” is the title of a rock and roll song performed by a number of artists including ZZ Top;²⁸ and the musical group The Beastie Boys references “Thunderbird” in the song “Hold It Now, Hit It.”²⁹

There is no information, however, indicating that these songs were widely distributed by the artists or were popular at the time of trial. One unsolicited article

²⁴ Opposer’s Resp. Interrog. No. 8, 43 TTABVUE 69, designated confidential.

²⁵ Cannon Depo. at 43, 33 TTABVUE 46 (“we haven’t done a whole lot of recent advertising and most of the advertising was done prior to 2000.”).

²⁶ Opposer’s Resp. Interrog. No. 6, 43 TTABVUE 68, designated confidential.

²⁷ 32 TTABVUE.

²⁸ 32 TTABVUE 4.

²⁹ 32 TTABVUE 23.

from 2003, part of a handful of unsolicited articles in the record, states that THUNDERBIRD wine was in its glory days thirty years ago, characterizes THUNDERBIRD as an “old brand,” and states that “ten years ago, Gallo sold 3 million cases a year; now it sells only 300,000”³⁰ The Washington State Liquor Control Board lists Thunderbird (having 17.5 % alcohol content by volume) as a banned product as of May 7, 2015 for “Olympia’s Downtown Alcohol Impact Area.”³¹ Turning to Opposer’s advertising and sales figures, they are not impressive in and of themselves, and Opposer has not placed such figures in any context. *C.f.*, *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, ___ F.3d ___, 128 USPQ2d 1686, 1690 (Fed. Cir. 2018) (not requiring contextual evidence for advertising and sales figures when plaintiff had evidence that it spent over \$45 million in one year to advertise its goods and processed over 100,000 orders per day during December holiday season, along with testimony on how it promoted its products to the public). The YouTube videos featuring THUNDERBIRD television advertisements indicate that they were first published in 2008, over ten years ago, and the evidence does not indicate how many of such views were recent. Fame, if it exists, is determined at the time of trial. *See General Mills Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1595 n.13 (TTAB 2011). Also, one Youtube comment states, “[i]t’s been so long, I didn’t

³⁰ C. Brown, “Last call for Thunderbird” (Los Angeles Times January 8, 2003), Applicant’s Not. of Rel. Exh. III, 50 TSDR 6. Of course, we do not rely on the truth of any assertions made in the article about Applicant’s sales or goods in reaching our findings. It reflects the public perception of the THUNDERBIRD mark.

³¹ Woodhouse Decl. Exh. 11, 18 TTABVUE 59.

think they made that crap anymore, guess they do,”³² suggesting a lack of notoriety of the THUNDERBIRD brand.³³

Opposer relies on two brand awareness studies of THUNDERBIRD wines that indicate a sizable percentage of consumers within a particular age range who participated in the studies are aware of such wines.³⁴ These studies have limited probative value on the question of fame because no witness with first-hand knowledge testified about the studies. *See Coach Services, Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1607 (TTAB 2010), *aff'd in relevant part*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012). Mr. Cannon stated he did not work on them and was working on another brand at the time the studies were conducted.³⁵ Their probative value on the question of fame is also diminished by the fact that they are not particularly recent. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1049 (Fed. Cir. 2018) (the court discounted survey stating, “this survey is not contemporaneous with the question of whether registration should be permitted here.”)

In light of the limitations in the evidence noted above, we find that the strength of Opposer’s mark does not reach a level of fame sufficient to play “a ‘dominant’ role

³² 32 TTABVUE 12.

³³ The comment bears the notation “three months ago,” ostensibly three months prior to March 23, 2017, the print date reflected on the webpage.

³⁴ Cannon Testimony at 42-69, Exhs. 23-24, 33 TTABVUE 46-72, 34 TTABVUE 135-209. Because portions of the testimony and exhibits have been designated confidential, we do not provide details about the studies.

³⁵ Cannon Depo. at 44, 34 TTABVUE 47.

in the process of balancing the *du Pont* factors.” *Recot v. Becton*, 54 USPQ2d at 1897. *See also Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000). On balance, however, we find that Opposer has demonstrated a moderate degree of renown for “alcoholic beverages except beers” and particularly in connection with low-priced wine with a high alcohol content, and hence some strength in its mark that continues today, despite its minimal advertising expenditures. Opposer’s mark is entitled to a broader than normal scope of protection for such goods. *See Joseph Phelps Vineyards v. Fairmont Holdings, LLC*, 122 USPQ2d at 1734 (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak).

B. Similarity of Goods, Channels of Trade, Classes of Purchasers

Opposer has registered its mark for “alcoholic beverages except beers” which encompass the “alcoholic beverages, namely, Tennessee sour mash whiskey and moonshine” identified in Applicant’s application. The parties’ goods are therefore legally identical.

In view of the legal identity of goods, we can presume that the channels of trade and classes of purchasers for those goods are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. 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); *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.”). The ultimate purchaser of Opposer’s and Applicant’s goods is an adult member of the general purchasing public who consumes alcoholic beverages.

C. Purchasing Conditions.

“When the products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Recot v. Becton*, 54 USPQ2d 1899. Mr. Cannon testified that Opposer’s fortified wine sells for \$5.00,³⁶ and that it is subject to impulse purchasing.³⁷ The BevMo! webpage advertises moonshine for \$2.99 for a 50 mL bottle.³⁸ Thus, Opposer’s and Applicant’s goods are not only legally identical; they are sold through identical trade channels to identical classes of consumers, who are likely to exercise a relatively low degree of care when making purchasing decisions, all of which increases the likelihood of confusion. *See, e.g., In re Majestic Distilling Co.*, 65 USPQ2d at 1205 (affirming Board finding that malt liquor and tequila are both relatively inexpensive products likely to be purchased on impulse).

³⁶ Cannon Depo. at 72, 33 TTABVUE 75.

³⁷ Cannon Depo. at 64-65, 34 TTABVUE 67-68 (“those lower price points are essentially impulse purchases. They’re not something that people are spending a lot of thought on.”). This testimony has been marked confidential by Opposer, but does not constitute trade secret or commercially sensitive information. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g), provides, in part, that “[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.” Accordingly, we will not be bound by the parties’ designation.

³⁸ 31 TTABVUE 19.

D. Third-Party Marks on Similar Goods.

To counter Opposer's claim that its mark is strong, Applicant submitted evidence of third-party use and registration of THUNDER-formative marks for alcoholic beverages including beer. Third-party registrations may be relevant to show the sense in which a mark is used in ordinary parlance; that is, an element common to both parties' marks may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is inherently relatively weak as a source indicator. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016) ("*Jack Wolfskin*"); *see also In re Dayco Products-Eagle Motive, Inc.*, 9 USPQ2d 1910, 1912, (TTAB 1988) (third-party registrations may be "useful to demonstrate the sense in which a term is used in ordinary parlance and they can show that a particular term has been adopted by those engaged in a certain field or industry and that said term has less than arbitrary significance with respect to certain goods or services."). Additionally, third-party uses may show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different marks on the bases of minute distinctions. *Omaha Steaks v. Greater Omaha Packing*, 128 USPQ2d at 1693; *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). The "relevant *du Pont* inquiry is '[t]he number and nature of similar marks in

use on *similar* goods.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (quoting *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990)).

Some of the evidence Applicant relies on has little, if any, probative value. Specifically, the pending applications are evidence only that an application was filed on a certain date; they are not evidence of use of the marks. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Servs. Ltd. v. Doctors & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003). The cancelled registrations are not evidence of anything except that they issued. *See Action Temporary Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything”); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1654 n.6 (TTAB 2002). Also, the statements of use and related specimens of use taken from third-party USPTO registration files do not establish that the subject marks are in use or demonstrate the extent of their use. *See* Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2), which states in relevant part:

The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony. Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not testimony on behalf of the applicant or registrant.

Turning to the remaining third-party registrations and uses for THUNDER-formative marks, a large percentage of such registrations and uses are for beer. These registrations and uses for beer are relevant because beer is a good similar to wine, whiskey and moonshine. First, they are all alcoholic beverages. Second, the record establishes that these goods are marketed in the same trade channels to the same purchasers.³⁹ Third, Opposer's September 30, 2014 "Boone's Farm and Thunderbird Brand Equity" study, marked "Confidential-For Attorneys' Eyes Only" and submitted under seal as Exhibit F to the declaration of Mr. Cannon, Opposer's witness, contains conclusions and statements from study participants that indicate associations with beer.⁴⁰ Fourth, this finding of similarity is consistent with *In re Majestic Distilling*, 65 USPQ2d at 1204, where the court considered articles demonstrating that malt liquor and tequila are occasionally found in some of the same places, the court stating "we agree, that malt liquor and tequila are similar by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers."⁴¹

³⁹ See ThunderRoad Wines & Spirits webpage, listing "Wine, Shine, Spirits, & Brew" and offering both moonshine and beer, Woodhouse Decl. Exh. 66, 18 TTABVUE 645; Thunder Liquors webpages offering liquor and showing signage for Coors, Lite and Corona in store photographs, Woodhouse Decl. Exh. 66, 18 TTABVUE 635-644; Regency Wine & Liquor webpage offering wine and beer, Woodhouse Decl. Exh. 18, 18 TTABVUE 194; ShopRite Liquors webpages offering wine and beer, Woodhouse Decl. Exh. 18, 18 TTABVUE 201-203; MC's Wine & Liquor webpage offering whiskey, wine and beer, Woodhouse Decl. Exh. 18, 18 TTABVUE 207; and BevMo webpages offering wine and beer, Opposer's Not. of Rel., 31 TTABVUE 4.

⁴⁰ See 20 TTABVUE 84 and 95. These statements are proper for our consideration under Fed. R. Evid. 801(d)(2)(B).

⁴¹ Opposer cited *E. & J. Gallo Winery v. Wade*, Canc. No. 92063116, 2017 WL 2876830, *3-4 (TTAB June 7, 2017) (nonprecedential) in its main brief. There, the Board agreed with

Accordingly, we consider the following:

● Third-party registrations:

TENNESSEE THUNDER, Reg. No. 4818189 alcoholic beverages except beers;

CAJUN THUNDER, Reg. No. 4187586 for alcoholic beverages, namely, prepared alcoholic cocktails;

THUNDERSNOW, Reg. No. 4764461 for beer;

THUNDERHEAD, Reg. No. 3102282 for beer and ale;

THUNDERWEIZEN ALE, Reg. No. 4417434 for beer;

THUNDERHOP, Reg. No. 3986879 for beer;

THUNDER ROAD, Reg. No. 4416317 for beer;

THUNDER FUNK, Reg. No. 5065971 for beer;

THUNDER ANN, Reg. No. 4168008 for ales, beer, lager, stout and porter, beers, and pale beer;

THUNDER ANN AMERICAN PALE ALE and design, Reg. No. 4963402 for beer;

THUNDER RIVER, Reg. No. 4178720 for beer;

THUNDER CANYON BREWERY, Reg. No. 2345077 for beer, ale, porter;

THUNDER CANYON BREWERY RESTAURANT & PUB and design, Reg. No. 2521553 for beer, ale, porter;

THUNDERLIPS INDIA PALE ALE THUNDER, Reg. No. 4712650 for beer, ale, lager, stout, porter, shandy;

MOO THUNDER, Reg. No. 4060039 for beer;

MOO THUNDER STOUT FARMHOUSE ALE ALL MALT and design, Reg. No. 4066770 for beer;

Opposer's argument that beer and wine are related goods based in part on third-party websites offering wine and beer under the same mark at the same establishment.

SILVER THUNDER, Reg. No. 1369382 for malt liquor;

SILVER THUNDER and design, Reg. No. 1388485 for malt liquor;

GOD OF THUNDER, Reg. No. 4891358 for beer;

GOURD OF THUNDER, Reg. No. 4564267 for beer;

CHOCOLATE THUNDER, Reg. No. 4868468 for beer, craft beer, craft beer brewed on the premises;

BLACK THUNDER, Reg. No. 4932310 for beer;

FEATHER FALLS CASINO BREWING COMPANY THUNDER ALE APRICOT WHEAT ALE and design, Reg. No. 4358204 for beer;

THUNDER HOLE ALE, identified as application Serial No. 87141766, now registered as Registration No. 5239901 for beer; and

THUNDERHAWK ALEMENTS, application Serial No. 86429219 now registered as Registration No. 5475793 for beer.

- Internet uses for beer:⁴²

THUNDERHAWK, THUNDERSNOW, THUNDERHEAD, THUNDERWEIZEN ALE, THUNDERHOP IPA, THUNDER ROAD, THUNDER FUNK IPA, THUNDER ANN AMERICAN PALE ALE, THUNDER CANYON BREWERY, THUNDERLIPS, MOO THUNDER, GOD OF THUNDER, GOURD OF THUNDER CHOCOLATE THUNDER, BLACK THUNDER and THUNDER ALE.

- Internet uses for wineries and/or wine products:⁴³

THUNDER OAK, THUNDER MOUNTAIN WINERY, THUNDER BAY WINERY, THUNDER RIDGE VINEYARDS, SWEET THUNDER AMERICAN REISLING and PRAIRIE THUNDER.

⁴² Woodhouse Decl. Exhs. 47-62; 18 TTABVUE 463-578.

⁴³ Woodhouse Decl. Exh. 63, 18 TTABVUE 580-594.

- Internet uses for breweries and/or beer products:⁴⁴

THUNDER ISLAND BREWING CO. THUNDER FOAM, BALTIC THUNDER, RED THUNDER, THUNDERHEAD BREWING COMPANY and TROPIC THUNDER RADLER.

- Internet uses for distilled spirits products:⁴⁵

TROPICAL THUNDER, TENNESSEE THUNDER, THUNDER VODKA and GLEN THUNDER.

- Internet uses for liquor stores:⁴⁶

THUNDER LIQUORS and THUNDER ROAD WINE AND SPIRITS.

- Internet use for a cocktail recipe with bourbon:⁴⁷

CAJUN THUNDER.

Several internet uses are for the same marks as those identified in the registrations. Discounting duplicate marks, we count 25 registrations and 13 internet uses, totaling almost 40 THUNDER-formative marks.

We find these third-party registrations and uses establish weakness of the term THUNDER as a source indicator for alcoholic beverages. *See Juice Generation*, 115 USPQ2d at 1675 (weakness shown by at least 26 third-party uses and registrations containing the same phrase for the same services); *Jack Wolfskin*, 116 USPQ2d at 1136 (third-party weakness evidence characterized as “voluminous”). The evidence demonstrates that relevant customers have been exposed to so many different

⁴⁴ Woodhouse Decl. Exh. 64, 18 TTABVUE 596-624.

⁴⁵ Woodhouse Decl. Exh. 18, 19 and 65, 18 TTABVUE 190-226, 626-633.

⁴⁶ Woodhouse Decl. Exh. 66; 18 TTABVUE 635-666.

⁴⁷ Woodhouse Decl. Exh. 20; 18 TTABVUE 215-226.

THUNDER-formative marks in connection with alcoholic beverages that they likely have become alert to “minute distinctions” among the various marks. *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1691. A mark having the term THUNDER in connection with alcoholic beverages therefore should be given a restricted scope of protection, and the THUNDERBIRD mark is not entitled to such a broad scope of protection that it is a bar to the registration of any mark comprising in part, the word “thunder.” We arrive at this finding even though none of the third-party registrations and uses is for the single term THUNDERBIRD. We recognize too that THUNDERBIRD is an arbitrary mark for Opposer’s goods, defined in The Merriam Webster Dictionary as “a bird that causes lighting and thunder in American Indian myth.”⁴⁸ Further, it has not escaped our notice that only one third-party use and no third-party registrations contain the word THUNDER followed by the name of a bird.

E. The Similarity or Dissimilarity of the Marks.

We now turn to the *du Pont* factor concerning the similarities or dissimilarities of the marks, and compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. While marks must be compared in their entireties and the analysis cannot be predicated on dissecting the marks into their various components, different features may be analyzed to

⁴⁸ Woodhouse Decl. ¶ 6, Ex. 5; 18 TTABVUE 4, 33.

determine whether the marks are similar. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *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.”); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (citing *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955)). Similarity in any one of the elements of sound, appearance, meaning, or commercial impression is sufficient to support a determination of likelihood of confusion. *See, e.g., Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009).

In addition, Opposer reminds us that when the goods at issue are legally identical, as they are here, the similarity for likelihood of confusion declines, citing *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1773 (TTAB 2014) (“the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion.”).⁴⁹

The marks THUNDERBIRD and THUNDER ROAD are similar in that they both begin with the term THUNDER, are three syllables in length and have the letter “D” as the terminal component. Opposer argues that THUNDER, the initial term in each mark, is the dominant term in each mark and entitled to greater weight in our

⁴⁹ Opposer’s brief at 11, 59 TTABVUE 12.

analysis. Even if it is the dominant term by virtue of its position as the first term in each mark, due to our finding that the term THUNDER is a weak source indicator in connection with alcoholic beverages, consumers will look to other parts of marks to distinguish the source of the goods.

Of particular significance in our analysis is the meaning of the marks considered as a whole. A “thunderbird” is a mythical bird, while THUNDER ROAD on its face refers to the name of a road. “Thunder Road” may also be associated with the name of a movie released in 1958 starring Robert Mitchum, the father of Applicant’s principal James Mitchum,⁵⁰ or the name of a song by Bruce Springsteen from 1975.⁵¹ The marks have entirely different connotations and hence different commercial impressions.

Opposer mentions that it has leveraged its association with the term THUNDER through its line extensions of THUNDERBIRD. Mr. Cannon testified, “[w]e leveraged the strength of the ‘Thunder’ with the brand and leveraged that into Thunder Tropics ... [Thunderbird with fruit juice] and then Thunder Cola, so really took the equity of Thunderbird and brought that into two line extensions.”⁵² And when asked why “thunder” was used, Mr. Cannon responded:

⁵⁰ Mitchum Depo. at 10, 51 TTABVUE 13; Brewer Decl. ¶¶ 7-9 and 11, 17 TTABVUE 34-35.

⁵¹ Elliott, Joe, “Thunder Road: Remembering the making of a cult classic in Asheville,” (May 4, 2016) (accessed at <http://mountainx.com/movies/thunder-road-remembering-the-making-of-a-cult-classic-in-asheville/>), Jan. 23, 2017 Blalock Decl. Exh, F, 17 TTABVUE 107-119. (“Embedding [Thunder Road] even more deeply in the popular culture was Bruce Springsteen’s 1970s rock anthem ‘Thunder Road;’ the title of which he took from the movie poster.”).

⁵² Cannon Depo. at 36, 33 TTABVUE 38.

The strength of Thunder. Thunder, obviously this brand had been established at this point it would have been nearly 40 years of history and a very strong brand but bringing the equity of Thunder into new usage as a fruit product, fruit juice product, and as a cola, but bringing the strength of the Thunder brand into a line extension.⁵³

The evidentiary record undercuts these claims of strength and association of THUNDER with Opposer. Moreover, Opposer has not pleaded or proven that any of these THUNDER-formative marks are part of a family of marks.

In sum, in light of the differences in meanings and commercial impression, we find that the differences in the marks outweigh any similarities (primarily from the shared initial term THUNDER in both marks, which we have found is a weak term as a source indicator for alcoholic beverages) and that the *du Pont* factor regarding the similarity or dissimilarity of the marks weighs against a finding of likelihood of confusion.

F. Lack of Actual Confusion.

Next, we assess Applicant's argument that there has been concurrent use for over eight years and there have been no instances of actual confusion.⁵⁴

The Federal Circuit has noted that it is unnecessary to show actual confusion to establish a likelihood of confusion. *See, e.g., Herbko Int'l, Inc. v. Kappa Books, Inc.*, 303 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 14 USPQ2d at 1842-43. The court has also stated that a "showing of

⁵³ Cannon Depo at 36-37, 33 TTABVUE 38-39.

⁵⁴ Applicant's brief at 27, 60 TTABVUE 28; Mitchum Depo. at 140-41, 51 TTABVUE 143-144.

actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not necessarily true, however. The lack of evidence of actual confusion carries little weight.” *In re Majestic Distilling Co.*, 65 USPQ2d at 1205. We consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of the parties’ subject marks. *du Pont*, 177 USPQ at 567.

Opposer’s goods are sold nationally and Applicant has one distillery in Kodak, Tennessee where some of its goods are sold.⁵⁵ Royalty statements from 2015 - 2017, marked as confidential Exhs. 18-21⁵⁶ to Mr. Mitchum’s testimony deposition, reflect sales that can neither be characterized as significant nor insignificant. The extent to which the parties’ branded products have appeared in proximity to one another in the marketplace is unclear. Also, there is no information from either party on how any instances of actual confusion would be reported. *See Nina Ricci S.A.R.L. v. E.T.F. Ent., Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (absence of any reported instances of actual confusion was not probative because the record failed to establish that there was a reasonable opportunity for confusion to have occurred). We are therefore at a disadvantage to gauge the opportunity for actual confusion to have occurred in the marketplace. Consequently, the *du Pont* factors regarding the nature and extent of any actual confusion, in light of the length of time and conditions under

⁵⁵ Mitchum Depo. at 144, 51 TTABVUE 41.

⁵⁶ 53 TTABVUE 97-109.

which there has been contemporaneous use of the parties' subject marks, are neutral in our analysis.

G. Conclusion.

We have considered all of the evidence of record pertaining to the likelihood of confusion issue, as well as all of the arguments related thereto, including any evidence or arguments not specifically discussed in this opinion. We have found that the goods are legally identical, the trade channels and purchasers are the same, and Opposer's mark has some degree of strength in connection with low priced wine with a high alcohol content. Due to weakness of the shared word "thunder," as demonstrated by numerous third-party registrations and uses, and the differences between the marks particularly in meaning and commercial impression, we are not persuaded that there is a likelihood of confusion between the parties' marks.

Decision: The opposition is dismissed.