

This Opinion is not a
Precedent of the TTAB

Mailed:
November 29, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Patron Spirits International AG
v.
Les Bienheureux
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Opposition No. 91223657
to application Serial No. 79152228
filed on July 18, 2014
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Bernard R. Gans and Jessica Bromall Sparkman of Jeffer Mangels Butler & Mitchell LLP, for Patron Spirits International AG.

Scott S. Havlick and Nadya Davis of Holland & Hart LLP,
for Les Bienheureux.

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Before Kuhlke, Bergsman and Kuczma, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Les Bienheureux, seeks registration of the mark PARATI in standard characters for “alcoholic beverages, except beers; spirits,” in International Class 33 on the Principal Register.¹

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¹ Serial No. 79152228, filed July 18, 2014, based on a request for extension of protection under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), claiming a priority date of February 17, 2014, under Section 67, 15 U.S.C. § 1141(g). The application includes the

Opposer, Patron International Spirits AG, has opposed registration of Applicant's mark on the ground that, as applied to Applicant's goods, the mark so resembles Opposer's previously used and registered marks PYRAT for "distilled spirits," in International Class 33 and PYRAT RUM for "rum," in International Class 33, as to be likely to cause confusion under 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).² By its answer, Applicant denies the salient allegations.

RECORD

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the application subject to the notice of opposition. In addition, Opposer submitted, with its notice of reliance: (1) USPTO Trademark Electronic Search System (TESS) printouts of its pleaded registrations, which show that the registrations are subsisting and owned by Opposer;³ (2) third-party registrations; and (3) excerpts from online resources, including Applicant's Facebook page and third-party websites. Applicant did not take any testimony, submit any evidence or file a brief.

following translation statement: The English translation of "PARATI" in the mark is "ADORN"; "DECORATE."

² The Notice of Opposition also includes a claim of geographic descriptiveness under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), that was not addressed in the brief and is therefore waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner's pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

³ Pleadings registrations may be made of record by attaching "a current copy of information from the electronic database records of the Office showing the current status and title of the registration." Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d).

STANDING AND PRIORITY

The pleaded registrations made of record, which are in full force and effect and are owned by Opposer, are summarized as follows:

Registration No. 2727996 for the mark PYRAT in typed form⁴ for “distilled spirits” in International Class 33, filed on November 7, 2001, issued on June 17, 2003, Sections 8 and 15 combined declaration accepted and acknowledged, renewed; and

Registration No. 2058075 for the mark PYRAT RUM in typed form for “rum” in International Class 33, filed on May 9, 1995, issued on April 29, 1997, Sections 8 and 15 combined declaration accepted and acknowledged, renewed.

Because Opposer has made its pleaded registrations summarized above properly of record, Opposer has established its standing to oppose registration of Applicant’s mark and its priority is not in issue. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Ind’us., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *King Candy Co., Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

LIKELIHOOD OF CONFUSION

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

⁴ Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (October 2017).

1201 (Fed. Cir. 2003). Two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). For purposes of our likelihood of confusion analysis, we confine our analysis to Opposer's mark in pleaded and proven Registration No. 2727996, because if we do not find likelihood of confusion with the mark and goods in this registration, we would not find it as to the other pleaded and proven registration. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Relatedness of Goods, Channels of Trade, Classes of Purchasers

We turn first to a consideration of the goods, channels of trade and class of purchasers. We must make our determinations under these factors based on the goods as they are recited in the registration and application. *See In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Opposer's "distilled spirits" listed in Registration No. 2727996 are legally identical to Applicant's "spirits" and "alcoholic beverages, except beer" as they are encompassed by them.

Considering the channels of trade and classes of purchasers, because the goods are legally identical and there are no limitations as to channels of trade or classes of purchasers in either the application or Opposer's registration, we must presume that Applicant's and Opposer's goods will be sold in the same channels of trade and will be bought by the same classes of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (TTAB 2012); *Hewlett-Packard Co. v. Packard Press*

Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003); *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

In view of the above, the *du Pont* factors of the similarity of the goods, the channels of trade and classes of purchasers favor a finding of likelihood of confusion.

Purchasing Conditions

With regard to the conditions of sale, because we are bound by the description of goods in the application and registration and because the descriptions of goods are not restricted as to price, the goods at issue are presumed to include inexpensive as well as expensive goods. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014). Moreover, we consider this factor in the context of the least sophisticated purchaser. *Id.* (“Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”) (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, *Gen. Mills, Inc. v. Fage Luxembourg S.A.R.L.*, 110 USPQ2d 1679 (nonprecedential) (TTAB 2014)). The spirits sold under Applicant’s mark and Opposer’s mark include relatively inexpensive products that would be purchased by ordinary purchasers and would not be purchased with a great deal of care or require purchaser sophistication, which increases the likelihood of confusion. *Recot Inc. v. M.C. Becton*, 214 F.3d

1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (“When 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”) (citations omitted). In addition, the trade channels for these goods include bars and restaurants where they would be ordered in a typically noisy atmosphere orally without seeing the bottle. *See In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016). Thus, this factor also favors Opposer.

Similarity of the Marks

We now consider the similarity or dissimilarity of Applicant’s mark PARATI and Opposer’s mark PYRAT when compared in their entirety in terms of appearance, sound, connotation and commercial impression, keeping in mind that “when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). *See also Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011).

The marks are similar in appearance and sound in that they both begin with P, the second syllable is “RAT” with only one letter separating the P and RAT. The difference in the vowel in the first syllable (Y v. A) and the addition of the letter I at the end of Applicant’s mark are not sufficient to distinguish the marks. The importance of the sound of the mark is heightened in the case of these types of

products as they are often ordered orally in a bar or restaurant. *See In re Bay State Brewing Co.*, 117 USPQ2d at 1960. We further observe as to the element of appearance, because the marks in the application and registration are in standard characters, we must consider all depictions of the marks including the same manner of depiction regardless of the font style, size, or color. *See In re Viterra Inc.*, 101 USPQ2d at 1910; *Citigroup Inc. v. Capital City Bank Group, Inc.*, 98 USPQ2d at 1259.

As to connotation, we find that a substantial number of potential purchasers will simply take the marks as they are without assigning a specific meaning, and any recognition of the word “pirate” in Opposer’s mark will not sufficiently distinguish the marks.⁵ *See Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1756 (TTAB 2009).

We find the marks to be similar in appearance, sound, meaning and overall commercial impression, and this similarity in the marks, where the goods are legally identical as discussed above, outweighs the dissimilarities, including the possible recognition of the dissimilarity in meaning by some consumers. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d at 1701 (“When marks would appear on virtually identical goods or services, the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines.”). This factor weighs in Opposer’s favor.

⁵ *See* “Pyrat Rum Reviews: XO Reserve and Cask 1623,” *The Spruce* (January 19, 2017) (thespruce.com) (“The Pyrat brand is owned by Patron Spirits and gets its name from the Old English word for ‘pirate.’”). 11 TTABVUE 96.

Strength of Opposer's Mark

Opposer points to its use of the mark PYRAT for nearly two decades and submitted examples of third-party mentions of PYRAT products in various media. In addition, there is no evidence of similar marks being used on similar goods.

While the mark PYRAT may be conceptually strong, this scant record does not establish that it is commercially strong. It may have been in use for many years, but there are no sales or advertising figures or other evidence which supports the scope of consumer exposure to the mark. For example, there is no information to understand the level of commercial impressions (how many consumer views) from the handful of third-party websites mentioning PYRAT rum.

Intent

Opposer argues that Applicant had constructive notice of Opposer's marks through its registrations and by selecting "a mark that is similar in appearance to and nearly identical in sound to the PYRAT Marks, for the identical category of goods suggests that Applicant acted willfully, in disregard of Opposer's rights in the PYRAT Marks, and sought to trade on Opposer's goodwill in the PYRAT Marks." 12 TTABVUE 14. Bad faith, or intent to confuse, falls under the thirteenth *du Pont* factor "any other established fact probative of the effect of use." *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). "[A] party which knowingly adopts a mark similar to one used by another for related goods should not be surprised to find scrutiny of the filer's motive." *L'Oreal S.A. and L'Oreal USA, Inc. v. Robert Victor Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012). "[W]hen there is evidence of

an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, the Board may, and ought to, take into account that intent when resolving the issue of likelihood of confusion when that issue is not free from doubt." *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988). However, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 1565, 4 USPQ2d 1793 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. *E.g., Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he 'only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.'" (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:113 (4th ed. 2012))).

Inasmuch as the only evidence here merely pertains to Applicant's prior constructive knowledge and not to Applicant's intent, we find this factor to be neutral.

Balancing the Factors

We have considered all of the evidence pertaining to the relevant *du Pont* factors, as well as Opposer's arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion). In balancing the relevant factors, we conclude that because the goods are legally identical, the trade channels

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and classes of customers are the same, and the marks are similar, confusion is likely.

Decision: The opposition is sustained.