

This Opinion is Not a
Precedent of the TTAB

Mailed: October 29, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Vineyard 29, LLC
v.
29 Wine Company, LLC
—

Opposition No. 91227774
—

Kathleen E. Letourneau, Melville Owen, and Lawrence G. Townsend of Owen
Wickersham & Erikson PC for Vineyard 29, LLC.

Oliver Platz of Curi Platz LLP,
for 29 Wine Company, LLC.

—
Before Taylor, Hightower and Pologeorgis,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

29 Wine Company, LLC (“Applicant”) seeks registration on the Principal Register
for the mark HIGHWAY 29 (in standard characters) for “Wine; wines,” in
International Class 33.¹

¹ Application Serial No. 86308765, filed June 13, 2014, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Vineyard 29, LLC (“Opposer”) has opposed registration of Applicant’s mark on the following grounds:²

- (1) likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and
- (2) “that Applicant’s HIGHWAY 29 mark either (1) consists of geographically deceptive and primarily geographically deceptively misdescriptive matter in relation to the identified goods ..., or alternatively is primarily geographically descriptive of the origin of Applicant’s goods”³ under Sections 2(a) or 2(e)(3) of the Trademark Act, 15 U.S.C. §§ 1052(a) and 1052(e)(3).

With further regard to the likelihood of confusion ground, Opposer pleaded, *inter alia*, ownership of Registration No. 2469515⁴ for the mark VINEYARD 29 and design

VINEYARD 29



(VINEYARD disclaimed) [] for “wine ” (“515 registration”) and Registration No. 3671660⁵ for the standard character mark **29**⁶ for “wines” (“660 registration”), referred to collectively as the 29 marks, and common law rights in the same marks; that since long prior to any filing date or date of first use upon which Applicant can rely, Opposer adopted and continuously used the marks in connection with wine; and that Applicant’s HIGHWAY 29 mark so resembles Opposer’s pleaded

² In the prefatory paragraph to its notice of opposition, Opposer stated that, among other things, it “relies upon its ... ‘Vineyard 29’ trade name.” Opposer did not, however, set forth any specific allegations of prior trade name use and did not argue this claim in its brief. Accordingly, we have not considered this claim in our decision.

³ 1 TTABVUE 8; Not. of Opp. ¶ 18.

⁴ Issued July 17, 2001; renewed.

⁵ Issued August 25, 2009; Sections 8 and 15 affidavits accepted and acknowledged.

⁶ This mark has been displayed in bold throughout the decision for clarity.

29 marks as to be likely, when applied to the identified goods, to cause confusion, mistake, or deception.

Applicant, in its answer, denies most of the salient allegation in the notice of opposition.⁷ However, Applicant admits that:⁸

“Opposer is the owner of U.S. Trademark Registration No. 2,469,515” and that it “issued on July 17, 2001 and that an affidavit of incontestability was filed”;⁹ and

“Opposer is the owner of U.S. Trademark Registration No. 3,671,660” and that it “issued on August 25, 2009 and that an affidavit of incontestability was filed.”¹⁰

I. The Record

By operation of Trademark Rule 2.122, 37 CFR § 2.122, the record includes the pleadings and the file of the subject application. The record also includes:

A. Opposer’s Evidence

1. The testimony deposition of Charles J. McMinn, Opposer’s president, with Exhibit Nos. 1-10. (“McMinn test.”);¹¹

⁷ Applicant asserted as “affirmative defenses” Nos. 1 and 2, in different phrasing, that the notice of opposition fails to state a claim upon which relief can be granted. We consider the two enumerated “defenses” as a single one. Because Applicant did not file a motion to dismiss the opposition on the basis of Fed. R. Civ. P. 12(b)(6), we treat the “defense” as having been waived. *See Motion Picture Association of America v. Respect Sportswear Inc.* 83 USPQ2d 1555, 1557 n.5 (TTAB 2007).

⁸ While Applicant specifically makes admissions regarding Opposer’s ownership of the pleaded registrations, it made no admissions as to the current status of those registrations. 4 TTABVUE 2-3.

⁹ 5 TTABVUE 3; Answer at ¶¶ 1 and 3, respectively.

¹⁰ *Id.*; Answer at ¶¶ 1 and 2, respectively.

¹¹ Mr. McMinn’s deposition transcript is unsigned and there is no indication that the signature requirement has been waived by agreement of the parties. However, because Applicant made no objections to the introduction of the unsigned transcript, we have considered it in our decision. *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63

2. Opposer's notice of reliance on the following:

- a. Applicant's responses to Opposer's Interrogatory Nos. 1-45;
- b. Applicant's responses to Opposer's Request for Admissions 1-50;
- c. Plain copies of Opposer's pleaded **29** ('660 registration) and VINYARD 29 and design marks ('515 registration);
- d. Copies of office actions issued in connection with third-party, previously-filed HIGHWAY 29 and SECTION 29 marks;
- e. Printouts from various internet websites regarding: (i) Opposer's history of use of its marks; (ii) fame of Opposer's marks; (iii) public exposure to Opposer's address as 2929 Highway 29; (iv) customer and industry perception regarding the significance of Highway 29 and wine; and (v) "Highway 29" as a generally known geographic place or location in connection with wine.

B. Applicant's Evidence

1. Applicant's Notice of Reliance on the following:

- a. Opposer's responses to Applicant's Interrogatory Nos. 1-29;
- b. Official records from the California Department of Alcoholic Beverage Control to show Opposer's address; and
- c. Printouts from various internet websites to show: (i) that Opposer's address is 2929 St. Helena Highway and that consumers are exposed to this address; (ii) that St. Helena Highway is California state route 128 and California state route 29; (iii) that Opposer's marks are weak and diluted; (iv) that "Highway 29" has various meanings and identifies multiple roads in the United States; (v) that Opposer identifies its address as P.O. Box 93, St. Helena, California, that consumers have been exposed to that address, and that Opposer "has strongly associated and described itself as a Napa Valley vineyard"; and (vi) Opposer's use of its marks on wine.

Opposer and Applicant filed briefs, and Opposer filed a reply brief.

USPQ2d 1782, 1787 (TTAB 2001) (depositions which were not signed and included no waiver were nevertheless considered where no objections were made).

II. Preliminary Matter

Before proceeding to the merits of the case, we address an evidentiary matter. Opposer indicated in its notice of reliance that the copies of the registration certificates it made of record were “obtained from the United States Patent and Trademark Office [“USPTO”] website showing both the current status and the current title to the registrations.” Although apparently obtained from the USPTO website, they are not printouts from a USPTO database showing the current status of and title to these registrations pursuant to Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2). Nor are they certified copies of the registrations showing title and status prepared and issued by the USPTO under Trademark Rules 2.122(d)(2) and 2.6(b)(4), 37 C.F.R. § 2.6(b)(4). Therefore, Opposer’s registrations for the **29** and VINEYARD 29 (and design) marks are not of record by virtue of the plain copies being submitted under the notice of reliance. *Syngenta Crop. Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009) (copy of the certificate of registration issued by the USPTO is not competent evidence to show the “current status of and current title to the registration”). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); TBMP § 704.03(b)(1)(A) (2018) (“Plain copies of the registration are not sufficient.”). Nonetheless, during prosecution of Applicant’s application, Opposer’s pleaded Reg. Nos. 3671660 and 2469515 were cited, then withdrawn, as a bar to registration of Applicant’s mark. In making the refusal, the Examining Attorney made of record electronic copies of Registration Nos. 3671660

and 2469515 showing current title and status.¹² We therefore consider Registration Nos. 3671660 and 2469515 properly of record.

III. Standing

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), 135 S. Ct. 1401 (2015); *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). To establish standing in an opposition, a plaintiff must show both a real interest in the proceeding as well as a reasonable belief of damage. *Empresa Cubana Del Tabaco v. Gen. Cigar*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 50 USPQ2d at 1025. Here, Opposer's standing is established through printouts from the TSDR database of the USPTO made of record during prosecution of Applicant's application, showing that Opposer is the owner of its pleaded registrations and that those registrations are valid and subsisting. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton v. Ralston Purina*, 213 USPQ at 189. The record also shows through the McMinn testimony that Opposer produces and sells wine under the 29 marks,¹³ and this activity establishes that Opposer has a real interest in this proceeding and a reasonable belief of damage.

¹² February 17, 2015 Office Action; TSDR 4-7.

¹³ McMinn test.; 4 TTABVUE. The McMinn deposition made clear that when the 29 mark is referenced, it is referring to the two registered marks (McMinn test. p. 13). 17 TTABVUE 16. The specific testimony follows:

IV. Priority

To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-à-vis the other party, it owns “a mark or trade name previously used in the United States ... and not abandoned...” Trademark Act Section 2, 15 U.S.C. § 1052. A party may establish its own prior proprietary rights in a mark through ownership of a registration, actual use or through use analogous to trademark use. *See* Trademark Act Sections 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127; *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996). Priority is not in issue in the opposition with respect to Plaintiff’s pleaded marks for the goods listed in those registrations. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer additionally demonstrated, again through the McMinn testimony, that the pleaded registered 29 marks have been continuously used since the calendar year 1996.¹⁴

Mr. Townsend: -- clarify, when I use the word – reference the 29 mark, I’m referring to the two registered marks, one for 29 and one for the crest version of. Is that all right?

Mr. Platz: -- That’s perfect.

The Witness [Mr. McMinn]: That’s fine by me.

¹⁴ McMinn test. pp. 8 and 27; 17 TTABVUE 11 and 30.

V. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, 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). We consider these factors and any likelihood of confusion factors about which the parties introduced evidence or argued, and treat the remaining factors as neutral.

We focus our analysis on pleaded Registration No. 3671660 for the standard character mark **29** for “wines,” as this mark is the closest to Applicant’s applied-for mark and thus is most likely to support a finding of likelihood of confusion. If confusion is likely between Applicant’s mark and the mark in the ‘660 registration, there is no need for us to consider the likelihood of confusion with the ‘515 registration. On the other hand, if there is no likelihood of confusion between Applicant’s mark and the mark in the ‘660 registration, then there would be no likelihood of confusion with the other pleaded mark. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The Goods/Channels of Trade/Classes of Purchasers

We first consider the relatedness of the goods at issue, looking as we must to the goods as identified in the application and Opposer’s pleaded ‘660 registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d

1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). The goods are identical, being identified as “wine” or “wines” in both the application and pleaded registration. We find the additional singular listing of wines, i.e., wine, in Applicant’s mark as a distinction without a difference.

Given the legal identity of the goods, we must presume that they are or will be offered in the same trade channels for such goods, including the internet, tasting rooms, and retailers, such as wine shops and grocery stores, and to the same classes of purchasers, including ordinary consumers seeking wine. *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

In view of the above, the *du Pont* factors of the similarity of the goods, the channels of trade and classes of purchasers strongly favor Opposer.

B. Conditions of Purchase and Consumer Sophistication

The fourth *du Pont* factor assesses the “conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *du Pont*, 177 USPQ at 567. Applicant argues that because the average U.S. consumer of wine is “relatively unsophisticated,” those consumers “neither know about nor care about

any alleged connotation the number 29 may have for [wine] aficionados” and therefore the average consumer will not be aware of any similarity in meaning between the marks.¹⁵ This argument clearly concerns the meanings conveyed by the marks. The fourth *du Pont* factor, however, concerns whether a consumer exercises a higher degree of care than that considered ordinary, which could enable the consumer to distinguish one source of goods from another. Here, both parties’ agree that consumers of wine are unsophisticated and would not spend a great deal of care in their purchasing decisions. We thus find this factor neutral or slightly favors Opposer.

C. Fame of Opposer’s Mark

This *du Pont* factor requires us to consider the fame of Opposer’s mark. 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 identified by the mark at issue, “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,

¹⁵ Applicant’s Br. at 18; 28 TTABVUE 24.

as well as the general reputation of the products. *Bose Corp.*, 63 USPQ2d at 1305-06, 1309. However, raw numbers alone may be misleading. Thus, 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.*, 63 USPQ2d at 1309.

Opposer has supported the claim that its pleaded **29** mark is famous with the testimony of its president, Mr. Charles McMinn. According to Mr. McMinn and the exhibits accompanying his testimony,¹⁶ Opposer has produced and sold wine under the **29** mark since 1996,¹⁷ and has produced over 500 product lines of wine bearing the **29** mark from 1992-2016.¹⁸ From 2006 to 2016, Mr. McMinn states, Opposer had \$57.8 million in sales and expended \$2.7 million in advertising,¹⁹ and has participated in a variety of charitable events including by wine donations.²⁰ Opposer also made of record as support of its fame various internet materials from the websites of *The New York Times*, *Robb Cellar*, *Decanter*, and *Forbes* (www.nytimes.com, www.http://robbreport.com, www.decanter.com, and www.forbes.com),²¹ discussing

¹⁶ Exhibits Nos. 2-4 and 7-10 to the McMinn testimony deposition are barely legible and accordingly have little persuasive value. It was incumbent upon Opposer to ensure that its evidentiary submissions were readable. To the extent the exhibits could be deciphered, they were found not to be outcome determinative.

¹⁷ McMinn test. p. 27; 17 TTABVUE 30.

¹⁸ McMinn test. p. 15-16; 17 TTABVUE 18-19.

¹⁹ McMinn test. pp. 24, Exh. 6; 17 TTABVUE 27, 58.

²⁰ McMinn test. p. 25; 17 TTABVUE 28.

²¹ 18 TTABVUE 128-140. Complete URLs are available on TTABVUE. Opposer is reminded that its internet evidence is only probative for what it shows on its face and not the truth of what has been printed. See *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110

Opposer, its owners and its wines, including wines issued under the pleaded mark(s). The examples highlighted by Opposer in its brief at page 21 follow (citations omitted):²²

“Few properties in California’s Napa Valley boast as impressive a succession of winemaking alumni as Vineyard 29 ...” (From the Robb Carr Cellar: Vineyard 29 2009 29 Estate Cabernet Sauvignon);

“Just a tiny amount of Vineyard 29’s Sauvignon Blanc is made, but it reveals a whole new side of what is possible in the Napa Valley – namely, to make a complex, luxurious, age worthy Napa white on par with top white Bordeaux. The wine is a showstopper ...” [Decanter]

“Vineyard 29 2011 Estate Blanc (\$135) Whereas the Melka (below) is mercurial, this wine -- which star consultant Philippe Melka also made -- is ultrarefined [sic] with a closely knit, Bordeaux-like polished intensity. Both are flat-out dazzling.” (The Un-Chardonnay: Limited Edition, Cutting Edge Gems).

We find Opposer’s evidence as a whole lacks context and thus fails to convey to us the extent to which consumers recognize Opposer’s **29** mark. With regard to Opposer’s sales and advertising figures, Opposer has not provided any context for them, *i.e.*, how they translate into evidence of market share for its goods. As the Federal Circuit has stated, “[r]aw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today’s world may be misleading ... Consequently, some context in which to place raw statistics is reasonable.” *Bose Corp.*, 63 USPQ2d at 1309. Opposer also did not break out its sales

USPQ2d 1458, 1467 n.30 (TTAB 2014) (internet webpage evidence admissible only to show what has been printed and not for the truth of what has been printed).

²² Opposer’s Br. p. 21; 25 TTABVUE 31.

and advertising figures by mark. In addition, while news articles showcasing Opposer's vineyard, owners and wines have been featured in prominent magazines, on this record, we are unclear how often the marks appear in those magazines and, thus, if the exposure translated into notoriety. Similarly, in the absence of particulars other than event name and cost of participation, we also are unclear how Opposer's participation in charitable events translates into consumer recognition of Opposer's **29** mark.

In the context of likelihood of confusion, fame varies along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 1734 (Fed. Cir. 2016) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). "In view of the extreme deference that is accorded to 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, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it." *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005). While Opposer has shown that its mark(s) has some recognition, the evidence is not sufficient to support a finding that it has achieved more than a minimal amount of fame. Therefore, under the fifth *du Pont* factor, we accord Opposer's mark(s) the normal degree of protection to which inherently distinctive marks are entitled.

D. Number and Nature of Third-Party Uses/Strength of Opposer's Mark

The sixth *du Pont* factor requires us to consider evidence pertaining to the number and nature of similar marks in use on similar goods. Applicant argues that there are quite a few marks for wine in use by third parties that contain the number "29" and, therefore, Opposer's mark is relatively weak and only entitled to a narrow scope of protection. Applicant points to 7 examples of third-party use of "29" as part of the mark, 3 of which, however, reference the 29 & Oak use.²³ The relevant excerpts from websites demonstrating such use on their face are shown below.

Website for Global Wines, Inc. listing 29 & Oak Cabernet Sauvignon, 29 & Oak Red Blend and 29 & Oak Zinfandel as available wines,²⁴ and website for CellerTracker discussing 29 & Oak Cabernet Sauvignon Oakville, bottle shown below;²⁵



Website for Route Stock wines discussing Cabernet Sauvignon Route Stock 29, bottle shown below;²⁶

²³ Applicant's Br. pp. 9 and 21, Applicant's Not. of Rel. Exhs. 7-14; 28 TTABVUE 15 and 27, 21 TTABVUE 40-71.

²⁴ 21 TTABVUE 41; (www.globalwines.com).

²⁵ *Id.* at 63; (www.cellartracker.com/wine.asp?i2227777).

²⁶ *Id.* at 50-62; (www.routestock.com).



Website for OneHope wine discussing the 29 Twelve California dessert wine, and noting that the “wine is named for the winery’s location in Napa – between Highway 20 (home of some of the world’s most iconic wineries and Highway 12 (another popular winery destination that runs through Sonoma),” bottle shown below;²⁷



Website for CellarTracker discussing the 2009 Fleury Estate Winery Cabernet Sauvignon le fleur 29, bottle shown below;²⁸ and

²⁷ *Id.* at 64; (www.onehopewine.com).

²⁸ *Id.* at 66; (www.cellartracker.com/wine.asp?i1831212).



Website of Wine Enthusiast Magazine discussing the 29 Songs 2004 Soscol Ridge Vineyard Back Porch Syrah (Napa Valley), review shown below.²⁹

WINE & RATINGS

29 Songs 2004 Soscol Ridge Vineyard Back Porch Block Syrah (Napa Valley)

85
POINTS



From a cool vineyard in the southeast part of the valley, this wine opens with a refined scent of blackberry pie sprinkled with pepper and cocoa. It's a beautiful scent, like a pastry. In the mouth, it turns soft and slightly sweet, somewhat of a letdown.

PRICE
\$55; [Buy Now](#)

DESIGNATION
Soscol Ridge Vineyard Back Porch Block

VARIETY
Syrah, Shiraz/Syrah

APPELLATION
[Napa Valley, Napa, California, US](#)

WINERY
[29 Songs](#)

Although Applicant has not presented specific evidence concerning the extent and impact of these uses, it nevertheless presented “evidence of these marks being used in internet commerce” for wines, goods identified in the application and pleaded registration. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium*

²⁹ *Id.* at 68; (www.winemag.com). The reference to 29 Songs appears to be to the vineyard and not the wine.

Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *see also Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (internet printouts “on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein”). These five uses of “29”-formative marks for wine, although somewhat probative, are insufficient to “show that customers ... have been educated to distinguish between different ... marks on the basis of minute distinctions.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (internal quotations omitted). As opposed to the third party evidence of record in *Juice Generation*, which included at least 26 uses or registrations of the same phrase for restaurant services, *id.* at 1673 n.1, or in *Jack Wolfskin* where there were at least fourteen, 116 USPQ2d at 1136 n.2, the third-party evidence here is far less in quantity and quality.

At bottom, five third-party uses of “29” simply do not evidence such a widespread and significant use of the number “29” in the wine industry that we can conclude that Opposer’s pleaded mark is so weak that the public would be able to distinguish the source of Applicant’s goods from those of Opposer by the differences in their respective marks.

Moreover, even if we attribute some degree of inherent weakness to the number “29” when used on marks in connection with wine originating in the Napa Valley region, explained below, even weak marks are entitled to protection against registration of a similar mark for legally identical goods. *See In re FabFitFun, Inc.*,

127 USPQ2d 1670, 1676 (TTAB 2018) (citing *China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007)).

E. Similarity/Dissimilarity of the Marks

We next consider the similarity or dissimilarity of the marks. In comparing the marks, we consider their appearance, sound, meaning, and commercial impression. *Palm Bay v. Veuve Clicquot* 73 USPQ2d at 1691. “The 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 persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). “[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Finally, we keep in mind that “[w]hen marks would appear on virtually identical goods ..., as is the case here, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Max Capital Group*, 93 USPQ2d at 1248 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)).

In comparing Opposer’s **29** mark with Applicant’s HIGHWAY 29 mark, we find them similar to the extent that they consist of or include the number “29.” Indeed,

Applicant has incorporated the entirety of Opposer's mark, making it similar in appearance and sound. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); *Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re South Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing).

In making our finding, we are simply unpersuaded by Applicant's contention that the term HIGHWAY visually dominates the cited mark. While we are aware of the principle that prospective consumers are more likely to focus on the first portion or word in a trademark (*see Palm Bay*, 73 USPQ2d at 1692), it is likewise true that likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding other distinctive matter. If an important portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See. e.g., Stone Lion*, 110 USPQ2d at 1161 (affirming Board's finding that confusion likely where applicant's mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1266, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (finding that, even though applicant's mark PACKARD TECHNOLOGIES, with "TECHNOLOGIES" disclaimed, does not incorporate every feature of opposer's HEWLETT PACKARD marks, a similar overall commercial

impression is created); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (holding VANTAGE TITAN for MRI diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion, noting that the marks are more similar than they are different and that the addition of applicant’s “product mark,” VANTAGE, to the registered mark would not avoid confusion); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (holding CAREER IMAGE (stylized) for clothing and retail women's clothing store services, and CREST CAREER IMAGES (stylized) for uniforms, likely to cause confusion, noting that CAREER IMAGE would be perceived by consumers as a shortened form of CREST CAREER IMAGES). We find the situation here similar, as explained below, as HIGHWAY merely enhances the commercial impression engendered by the “29” portion of Applicant’s mark.

As to connotation, Applicant contends that its mark “invokes the picture of a federal highway, a road for long distance travel, new and different locations, a new beginning” while Opposer’s mark is just a number. Opposer, on the other hand, argues that the connotation created by both Applicant’s HIGHWAY 29 mark and Opposer’s 29 mark is nearly identical, namely a connection with California’s Highway 29. We agree with Opposer and find that the record supports a finding that both Applicant’s and Opposer’s marks are likely to be perceived as alluding to California’s HIGHWAY 29 which runs through Napa Valley, California – an area known for its wines, goods identified in both Applicant’s application and the pleaded registration. Specifically, the record shows that Opposer’s address is 2929 St. Helena Highway,

also known as Highway 29, a major roadway through Napa Valley, California,³⁰ and that California Highway 29 is a geographic area known for wineries.³¹ For example, an article in American Winery Guide.com (www.americanwineryguide.com) entitled St. Helena Wineries notes, in part, that: “With its long stretch of Highway 29, St. Helena has more wineries than any other Napa [area].”³² As Applicant argues, it is likely that some consumers of wine may not be aware of the significance of the number “29” as it relates to Highway 29 in Napa Valley; however, it is just as likely that many will. Indeed, Applicant admitted that it selected its HIGHWAY 29 mark, in part, for its allusion to California’s Highway 29.³³

We recognize that in comparing the marks, we must consider Applicant’s mark in its entirety. We nonetheless find that the similarities between the marks in sound, appearance and meaning due to the shared number “29” outweigh any differences between them, and that they engender very similar overall commercial impressions.

The *du Pont* factor of similarity of the marks thus favor a finding of likelihood of confusion.

³⁰ Opposer’s Not. of Rel. Exhs. P-LL; 18 TTABVUE 144-74, 19 TTABVUE 2-35.

³¹ Opposer’s Not. of Rel. Exhs, MM-BBB; 19 TTABVUE 36-121.

³² 19 TTABVUE 36.

³³ 18 TTABVUE 41. The specific admission and answer read:

REQUEST NO. 18:

Admit that Applicant selected the Disputed Mark in part for its allusion to California’s Highway 29.

RESPONSE TO REQUEST NO. 18:

Applicant admits that State Route 29 played a small part in Applicant’s selection of the Disputed mark.

VI. Conclusion

After considering all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion, we conclude that confusion is likely between Applicant's HIGHWAY 29 mark for "wine; [and] wines" and Opposer's **29** mark for wines. We conclude so principally due to the similarities between the marks, the legally identical goods and the presumed identity in trade channels and classes of purchasers.

VII. Geographic Deceptiveness/Geographically Deceptive Misdemptiveness and Geographic Descriptiveness

Because we have found Applicant's HIGHWAY 29 mark to be confusingly similar to Opposer's pleaded **29** mark, we need not address Opposer's alternative geographically deceptive/primarily geographically deceptively misdescriptive and geographically descriptive claims. *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

Decision: The opposition on the ground of likelihood of confusion is sustained.