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

Proceeding	91239589
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MAKER'S MARK DISTILLERY, INC.,)	
)	
Opposer,)	
)	Opposition No. 91239589
v.)	
)	
)	USSN 87/383,989
)	Mark: BOWMAKER'S WHISKEY
BOWMAKER'S WHISKEY COMPANY,)	
)	
Applicant.)	

APPLICANT BOWMAKER'S WHISKEY COMPANY'S TRIAL BRIEF

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INTRODUCTION

Applicant Bowmaker's Whiskey Company ("Applicant") submits its trial brief in response to Opposer Maker's Mark Distillery, Inc.'s ("Opposer") Trial Brief filed April 13, 2021.

The issue for the Trademark Trial and Appeal Board ("Board") in this case is straightforward. The primary analysis to be rendered by the Board is the dissimilarity in the trademark BOWMAKER'S WHISKEY and Opposer's pleaded trademarks MAKER'S MARK; MAKER'S 46; MAKER'S; and MAKER'S MARK PRIVATE SELECT (herein collectively sometimes referred to as "the MAKER'S MARK trademarks").

Likelihood of confusion is an issue of law based on the underlying factual determinations. The Board and Federal Circuit precedent is that a finding of no likelihood of confusion may be based solely on the dissimilarity of the trademarks. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1460-61, 47 USPQ 2d 1459 (Fed. Cir. 1998) ("*Roederer*") (no likelihood of confusion between CRISTAL and CRYSTAL CREEK both for wine based on the dissimilarity of the marks alone).

Here, Applicant's mark BOWMAKER'S WHISKEY has a meaning directed to a bowmaker, i.e. a person who makes bows. Opposer's MAKER'S MARK trademark was inspired "by the unique branding of the favorite pewter craftsman of Margie Samuels" who coined the mark. "Maker's Mark" is defined in the dictionary as the hallmark on a piece of English gold, silver, or plate denoting the person or firm responsible for its production. Accordingly, the parties' respective trademarks have completely different meanings. Further, the trademarks at issue appear different, sound different and are spelled different. Therefore, like in

Roederer, the trademarks at issue create completely different commercial impressions and the first *du Pont* factor is dispositive of this opposition.

For the reasons set forth hereafter, Applicant respectfully requests that the Board dismiss the opposition on the grounds that there is no likelihood of confusion between Applicant's trademark BOWMAKER'S WHISKEY and the MAKER'S MARK trademarks.

ISSUE PRESENTED

Is there a likelihood of confusion under Section 2(d) of the Trademark Act among an appreciable number of ordinarily prudent purchasers of distilled spirits, bourbon and whiskey between the applied for trademark BOWMAKER'S WHISKEY and Opposer's trademarks MAKER'S MARK; MAKER'S 46; MAKER'S; and MAKER'S MARK PRIVATE SELECT.

Answer: No.

DESCRIPTION OF THE EVIDENCE OF RECORD

The evidence of record consists of the following:

A. Opposer's Evidence

1. Declaration of Opposer's Senior Marketing Director, Nathalie Phillips, with Exhibits 1-10, 31 TTABVUE (redacted public version) and 32 TTABVUE (confidential portions of same) ("Phillips Decl.")
2. Declaration of Opposer's Vice President of Finance, Mitch Wagner, with Exhibits 1-7, 35 TTABVUE (redacted public version) and 33 TTABVUE (confidential portions of same) ("Wagner Decl.")
3. Testimony Deposition of Applicant's founder, Bryan Parks, with trial Exhibits, 39 TTABVUE (redacted public version) and 40 TTABVUE (confidential portions of same) ("Parks Trial Test.")
4. Testimony Deposition of Applicant's marketing consultant, Marcus Jenkins, with trial Exhibits, 39 TTABVUE ("Jenkins Test.")

5. Testimony Deposition of counsel who provided Applicant with the trademark clearance opinion and prosecuted the trademark application for BOWMAKER'S WHISKEY, Ruth Khalsa, with trial Exhibits, 39 TTABVUE ("Khalsa Test.")
6. Testimony Deposition of Applicant's distilled spirits consultant Don Rodgers, with trial Exhibits, 47 TTABVUE ("Rodgers Test.")
7. Opposer's First Notice of Reliance with Exhibits 1-4, 26 TTABVUE ("Opp. NOR 1")
8. Opposer's Second Notice of Reliance with Exhibit 5, 27 TTABVUE (redacted public version) and 28 TTABVUE (confidential) ("Opp. NOR 2")
9. Opposer's Third Notice of Reliance with Exhibits 6-12, 29 TTABVUE ("Opp. NOR 3")
10. Opposer's Fourth Notice of Reliance with Exhibits 13-20, 30 TTABVUE ("Opp. NOR 4")
11. Opposer's Fifth Notice of Reliance with Exhibits 21-29, 34 TTABVUE ("Opp. NOR 5")
12. Opposer's Sixth Notice of Reliance with Exhibits 30-42, 48 TTABVUE ("Opp. NOR 6")

B. Applicant's Evidence

1. Declaration of Applicant's distilled spirits consultant Don Rodgers, 41 TTABVUE ("Rodgers Decl.")
2. Declaration of Applicant's counsel, Theodore Breiner, authenticating Exhibits 87-95, 44 TTABVUE ("Breiner Decl.")
3. Applicant's First Notice of Reliance with Exhibits 22-33, 36 TTABVUE ("App. NOR 1")
 - Opposer's responses to Applicant's discovery requests.
4. Applicant's Second Notice of Reliance with Exhibits 34-74, 37 TTABVUE ("App. NOR 2")
 - Dictionary definitions of "BOWMAKERS" and "MAKER'S MARK"
 - Third-Party Registrations and Applications from the USPTO database re third-party use of the words "Maker's," "Maker" and "Mark"

5. Applicant's Third Notice of Reliance with Exhibits 75-86, 43 TTABVUE ("App. NOR 3")

Applicant submitted limited testimony during its testimony period because Opposer called Applicant's primary witnesses, Mr. Parks, Mr. Jenkins and Ms. Khalsa, during its *prima facie* case and Applicant essentially took the direct testimony of its witnesses during Opposer's case. *See, e.g.*, 39 TTABVUE, Parks Test., pages 58-90; 39 TTABVUE, Jenkins Test., pages 98-102; and 39 TTABVUE, Khalsa Test., pages 69-89.

C. Stipulation of Facts

The parties have stipulated that:

The Trademark Office records examined by the Examining Attorney in the BOWMAKER'S WHISKEY application would have included MAKER'S MARK, Registration No. 678,192; MAKER'S 46, Registration No. 3,967,288; MAKER'S, Registration No. 4,964,096; and MAKER'S MARK PRIVATE SELECT, Registration No. 5,286,883, the registrations at issue in this opposition and not cited by the examining attorney under Section 2(d) of the Trademark Act. 38 TTABVUE (the "Search Stipulation").

D. Applicant's Objections To Opposer's Evidence

Applicant objects to the testimony in the Phillips declaration at paragraph 27 and the underlying Exhibit 1, the Kantar Millward Brown "Beam 2017 Whiskey Report March 2018" on the grounds that the Exhibit is hearsay; that is, the *alleged* percentages that 69% of consumers are aware of MAKER'S MARK and MAKER'S MARK is consumed on premise approximately 40% of the time is presented for the truth of the matter asserted. This is expert survey evidence without any underlying documentation, e.g. how the percentages were derived and who the respondents were, e.g. all U.S. citizens, U.S. citizens who are bourbon drinkers, etc. Applicant

has not had the ability to cross-examine the survey expert providing these percentages and Opposer did not list any survey expert.

Applicant respectfully submits that Opposer's witness declarations and a number of the underlying exhibits (e.g. Phillips Exhibit 2 and Wagner Exhibit 7) and Opposer's Notice of Reliance Exhibits (e.g. Opp. NOR 4, Exhibits 13-20 and Opp. NOR 5, Exhibit 21) are objectionable, including on the grounds of hearsay. However, in order to avoid burdening the record, Applicant relies on the Board's standards for considering evidence as set forth in *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017) as follows:

[T]he Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations. . . . [W]e find no basis on which to strike any testimony or other evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections raised by the parties and we have accorded whatever probative value the subject testimony and evidence merit.

STATEMENT OF FACTS

A. Applicant's Application

Applicant filed intent-to-use Application Serial No. 87/383,989 on March 24, 2017 for the trademark BOWMAKER'S WHISKEY for distilled spirits, whiskey and bourbon ("the Application"). The Examining Attorney in the Application, Laura Wright, Esquire, conducted a search for the BOWMAKER'S WHISKEY trademark. While the search turned up the MAKER'S MARK trademarks, Attorney Wright did not cite any of these trademarks under Section 2(d) of the Trademark Act, thereby finding no likelihood of confusion between the trademark BOWMAKER'S WHISKEY and the MAKER'S MARK trademarks. 38 TTABVUE,

Search Stipulation. An Examiner's Amendment was entered with a disclaimer of the wording "whiskey," and the application was published for opposition.

B. Applicant's Business

Bowmaker's Whiskey Company was started in 2016 by Bryan Parks, the sole owner of the business. 39 TTABVUE, Parks Test., pages 10, 15. Mr. Parks is a retired nurse anesthesiologist, providing about 25,000 anesthetics to patients over his 25 year career. *Id.*, pages 65-66. Mr. Parks started Bowmaker's Whiskey Company as a second career. *Id.*, page 66. He has invested about \$400,000 in the business which includes the land and building, purchase of equipment and barrels and the purchase of the product. *Id.*, pages 69-70. Mr. Parks has whiskey aging in barrels at his warehouse/tasting room, has applied for label approval and has obtained a distributor for his products for distribution in Michigan. *Id.*, pages 17, 22-23, 55.

Mr. Parks' hobby is making bows. *Id.*, pages 67-68. Mr. Parks has been making bows for close to 30 years. *Id.* Mr. Parks has been using the name "bowmaker" in his email address for about the last 30 years. *Id.*, page 71. Mr. Parks testified that with respect to the selection of the BOWMAKER'S WHISKEY trademark as follows:

Well, it was actually my wife's suggestion. One night, we were sitting there watching a little television. We had been talking a little bit about names just bantering some things back and forth between her and I. And she said you know what? You're a bowmaker. In Michigan, bows and archery hunting is a very big deal. Why don't you just call it Bowmaker's Whiskey Company? And that was the impetus. That's what started it.

Q. And why would that have an impetus with respect to Michigan being a hunting -- I don't know -- I'm not a hunter so -- relating to hunters.

A. Bowmaking in Michigan is -- every year is a month and a half process that starts the first of October and ends the 14th of November. It is widely participated in Michigan. You can't hardly throw a stone without hitting a bow hunter. Primitive archery and natural archery is an offshoot of that, of -- kind of a subcategory, if you would. And it had been my e-mail handle for close to 30 years since I started building bows. I adopted bowmaker as my e-mail handle, and it just, kind of, followed suit.

Id., pages 70-71.

After selecting the name BOWMAKER'S WHISKEY, Mr. Parks worked with an outside consulting firm, iDeed, with respect to developing the Bowmaker's Whiskey Company business. *Id.*, pages 71, 19-20. iDeed's services to Applicant included the design of the BOWMAKER'S WHISKEY labels, overseeing a trademark clearance search for the name BOWMAKER'S WHISKEY conducted by LegalForce in Arizona and developing Applicant's social media platform, including developing a Website for Applicant. *Id.*, 39 TTABVUE, Jenkins Test., pages 13-14. iDeed is a minority owned business and run by Marcus Jenkins. *Id.*, page 18.

Mr. Jenkins contacted Trademarkia on behalf of Applicant with respect to conducting a trademark clearance search for the BOWMAKER'S WHISKEY trademark. *Id.*, pages 26-27. Trademarkia used LegalForce as the law firm responsible for conducting the search, providing their trademark clearance opinion that the trademark BOWMAKER'S WHISKEY was open for use and registration in the United States and the filing and prosecution of the Application. 39 TTABVUE, Khalsa Test., pages 71-77. The attorney responsible for the trademark clearance search opinion and Application was Ruth Khalsa, Esquire. *Id.* Ms. Khalsa testified that a trademark search was conducted for the trademark BOWMAKER'S WHISKEY and that she provided an opinion that the trademark was open for use and registration, including over the MAKER'S MARK trademarks. *Id.* Ms. Khalsa further testified on the issue of likelihood of confusion that:

Q. As the trademark attorney who provided the trademark clearance search for Bowmaker's Whiskey and as the trademark attorney who prepared and prosecuted the trademark application for Bowmaker's Whiskey and based on your preparation for this deposition and the documents you have seen during this deposition, do you have an opinion whether there is a likelihood of confusion under Section 2(d) between the applicant's trademark, Bowmaker's Whiskey, and the opposer's trademarks, Maker's Mark and Maker's?

MS. NASH: Objection. This is a compound question. And as I mentioned earlier, it mischaracterizes her prior testimony. She did not testify that she provided the clearance search.

Q. You may answer the question, Ms. Khalsa.

MS. NASH: It also calls for an expert opinion, legal conclusion.

Q. You may answer the question, Ms. Khalsa.

A. I don't believe there's any likelihood of confusion between the two marks under Section 2(d).

Q. And what is the basis for that opinion?

A. They're very different in commercial impression, which is one of the DuPont factors. They're very different in appearance, which is another DuPont factor. There's difference in the sound and pronunciation, the third DuPont factor. These are all legal conclusions.

Do you want legal conclusions?

Q. Yes.

A. Okay. People who drink bourbon are generally fairly discriminating, and they know what they're looking for. I find it highly unlikely that somebody who is discriminating like that would -- you know, so sophistication of the consumer, it's another DuPont factor. I think all the DuPont factors weigh against likelihood of confusion in this situation. That's my opinion.

Id., pages 88-89.

Mr. Parks has also retained Rodgers Consulting run by Don Rodgers with respect to the startup and operation of Bowmaker's Whiskey Company. 41 TTABVUE, Rodgers Decl., ¶5. Mr. Rodgers has been involved in the distilled spirits industry for more than 40 years. *Id.*, ¶3, 40 TTABVUE, Rodgers Test., pages 23-27. He worked for Beam Global Spirits and Wine ("Jim Beam") for 34 years. *Id.*, ¶3. In fact, Mr. Rodgers was at Jim Beam when Jim Beam acquired Maker's Mark and he oversaw aspects of the Maker's Mark business. *Id.*, ¶7. Mr. Rodgers testified that he was fully familiar with the MAKER'S MARK trademarks and that if he thought there was any likelihood of confusion between BOWMAKER'S WHISKEY and the

MAKER'S MARK trademarks, he would have advised Mr. Parks and would have told Mr. Parks to select a different name. *Id.*, ¶8. He did not do so. *Id.* Mr. Rodgers testified through his declaration and on cross-examination that he does not believe that there is any likelihood of confusion between the trademark BOWMAKER'S WHISKEY and the MAKER'S MARK trademarks. *Id.*, ¶10 and 40 TTABVUE, Rodgers Test., pages 17-20, 35-37, 51-52. Specifically, Mr. Rodgers testified on his direct examination that:

I disagree with Mr. Wagner that there is any likelihood of confusion between the trademarks BOWMAKER'S WHISKEY for distilled spirits, whiskey and bourbon and the trademarks MAKER'S MARK; MAKER'S 46; MAKER'S; or MAKER'S MARK PRIVATE SELECT for bourbon and whiskey. The BOWMAKER'S WHISKEY trademark and the Maker's Mark Trademarks are different in appearance and pronunciation. They create different commercial impressions. For example, the BOWMAKER'S WHISKEY name provides the distinct impression of a person who makes bows. On the other hand, the MAKER'S MARK trademark indicates the mark or branding of a craftsman. Additionally, purchasers of the Maker's Mark product are sophisticated in knowing the brand of bourbon that they are buying due to the nature of bourbon and the expense of the bourbon which may be in the range of \$25 to \$80. Accordingly, I do not believe that there will be any likelihood of confusion in the market between the BOWMAKER'S WHISKEY products and the Maker's Mark products, and clearly not among an appreciable number of ordinarily prudent purchasers of bourbon. Purchasers of bourbon would not make a mistake in thinking that the BOWMAKER'S WHISKEY bourbon is affiliated with the completely different names used by Maker's Mark.

Id., ¶10.

He testified on cross-examination that:

Q. Turning back to your testimony here today, did you discuss your -- this deposition with anyone?

A. I have talked to Ted and I refreshed my -- I talked to Bryan.

Q. Yeah. Anyone else?

A. I have discussed it with a lot of people in the industry.

Q. Okay. And who was that?

A. Other consultants.

Q. You've discussed this lawsuit with the consultants or your declaration?

A. The whole thing, about what they think about Maker's Mark and Bowmaker's being the same thing.

Q. Okay.

A. I can say it's been universal that nobody associated the two.

Id., pages 9-10 (emphasis added).

He testified on cross-examination that he had discussions with other bourbon drinkers, including a former Vice-President of Jim Beam, that:

Q. . . . Who is Mr. Hardwick?

A. He was vice president of purchasing for Jim Beam. And now that he has retired, he consults craft distillers on bottles, labels, caps, contract bottling, operations-type stuff. He and I work a lot together.

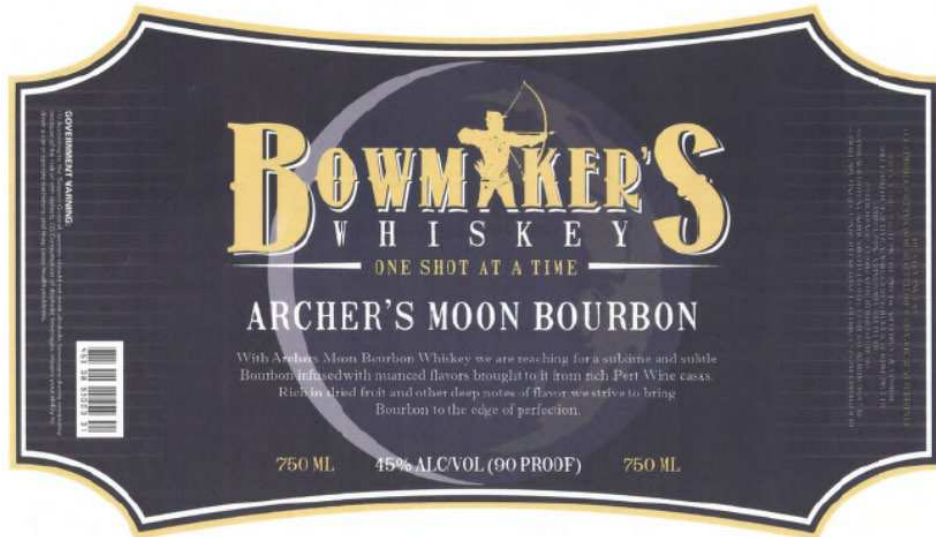
Q. And what was your discussion with him that you referred to?

A. I -- I told him I was going to have to -- I was being deposed by Jim Beam. And he said, Really? What for? What did you do? I said they're in a conflict with one of my clients. And he said which one? And I said Bowmaker's. And he said what's their problem with Bowmaker's? And I said it sounds too much like Maker's Mark to them. And he laughed. He said, "You got to be kidding me." So, like I say, everyone that I have talked to cannot believe it.

Id., pages 51-52. Messrs. Rodger and Hardwick are both former officers of Jim Beam which company owned Maker's Mark. They are unbiased and, if anything, are biased toward Maker's Mark.

Accordingly, Mr. Parks did everything that he was supposed to do when selecting a new trademark, namely, hiring trademark counsel to conduct a trademark clearance search and obtaining the opinion of counsel that the trademark BOWMAKER'S WHISKEY was open for use and registration, and thereafter filing the Application. Mr. Parks clearly gave respect to other trademark owners, including Opposer.

Mr. Jenkins was responsible for developing Applicant's labels, Website and social media. 39 TTABVUE, Jenkins Test., pages 13-15. One of Applicant's labels is as follows:



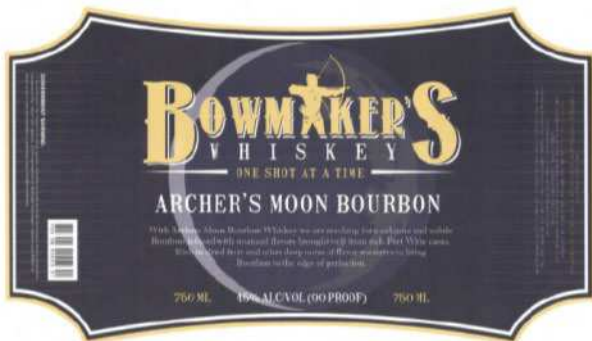
39 TTABVUE, Parks Test., pages 74-77, Exhibit 1.¹ The Website is not yet up and running. *Id.*, pages 62-64. There is only a place holder page at the Website which appears as follows:



44 TTABVUE, Breiner Decl. ¶5, Exhibit 98.

¹ All of Applicant's labels and proposed merchandise are at Parks Test., pages 77-88 and Exhibits 1-8. As apparent from the labels and Mr. Parks' testimony, each label has a theme with respect to archery and bows.

Opposer argues that because Mr. Jenkins used the Maker's Mark age entry page for a *mock-up* for the Applicant's age entry page that this is evidence of copying by Applicant. This is not correct. Mr. Jenkins testified that he does not drink because "alcohol killed his mom," and that he is not familiar with the MAKER'S MARK brand or other whiskey brands. 39 TTABVUE, Jenkins Test., pages 47, 69. He asked Mr. Park's to provide him with the names of some companies that sell whiskey to look at their Websites to determine what others were doing in the field. *Id.*, pages 66-69. Mr. Park's provided him with the names of Maker's Mark, Pendleton Whiskey, Jack Daniels and Canadian Club. *Id.*, Exhibits 17-20, the pages from these Websites that Mr. Jenkins printed out. Mr. Jenkins testified that he took wording from the Maker's Mark Website for use as a mock-up only; the mock-up of the entry page was not functional, i.e. there was no way to enter a birth date; that the website was not publicly available and was not intended to be publicly available; that he was responsible for the mock-up, not Mr. Parks or Applicant; and that the site is not even up yet. *Id.*, pages 98-100, 71-73, 76. Accordingly, there was no wrongful intent by Mr. Jenkins as alleged by Opposer. A side-by-side comparison of the BOWMAKER'S WHISKEY label and the MARKER'S MARK label are as follows:



The products look completely different. There was no intent by Applicant to trade on Opposer's trademarks as alleged by Opposer and there is no evidence to support this argument.

C. The Notice of Opposition

Opposer filed this opposition on February 20, 2018 and alleged as the sole grounds of the opposition a likelihood of confusion under Section 2(d) of the Trademark Act.

Opposer's brief references the "fame" of the MAKER'S MARK trademarks and asserts that MAKER'S MARK is a "famous" trademark. However, Opposer has not pleaded that the MARKER'S MARK trademarks are famous trademarks as that term is understood under the Trademark Act, 15 U.S.C. § 1125(c)(2). Accordingly, there is no issue in this opposition whether the MAKER'S MARK trademarks are famous trademarks.

D. The Proceedings In This Opposition

The MAKER'S MARK trademark "was inspired by the unique branding of the favorite pewter craftsman of Margie Samuels." 36 TTABVUE, App. NOR 1, Exhibit 23, Interrogatory 1 Answer. Margie Samuels was a person responsible for conceiving and designing the MAKER'S MARK trademark. *Id.*, Interrogatory 2 Answer.

Opposer's position on the issue of likelihood of confusion is set forth by Opposer in response to Applicant's Interrogatory No. 9 as follows:

Interrogatory No. 9:

Please state the factual basis with specificity for opposer's allegation that there is a likelihood of confusion between applicant's mark BOWMAKER'S WHISKEY and Opposer's Marks as alleged in the notice of opposition, including identifying all documents in support thereof and identifying all witnesses who have personal knowledge thereof.

Response to Interrogatory No. 9:

Maker's incorporates by reference the Preliminary Statement and General Objections set forth above. Maker's objects to Applicant's definition of "Opposer" (which includes, without limitation, "predecessors, subsidiaries, divisions, officers, attorneys, and all other persons in

privity with opposer”) as unduly burdensome and overly broad. Maker’s further objects to this Interrogatory to the extent it seeks documents and information covered by the attorney-client privilege, work product privilege, common interest doctrine, any other applicable privilege or immunity, or which are otherwise immune from discovery pursuant to any applicable law or rule. Maker’s objects to the request to identify “all” documents and “all” witnesses as overbroad and unduly burdensome. Maker’s objects to this Interrogatory to the extent it calls for attorney argument. Maker’s also objects to this Interrogatory as being compound and as improperly having multiple discrete subparts, each of which would be considered a separate interrogatory. Subject to and without waiving the foregoing general and specific objections, and in addition to the above, *Maker’s responds that there is a likelihood of confusion between BOWMAKER’S WHISKEY and Opposer’s Marks due to, among other things, confusingly similar trademarks used in connection with identical goods, the proximity of the goods in the marketplace, the similarity of marketing channels used or intended to be used, and Opposer’s priority of use of the well-known MAKER’S MARK trademark in the marketplace.* Maker’s will produce and specify records to be reviewed in accordance with this interrogatory, in accordance with Fed. R. Civ. P. 33(d). Maker’s expressly reserves the right to supplement and/or amend its response to this Interrogatory at an appropriate time and as its investigation continues in accordance with Fed. R. Civ. P. 26(e).

Id., (emphasis added).² Accordingly, as acknowledged by Opposer, the sole issue is the similarity (or dissimilarity) of the parties’ respective trademarks as Applicant accepts for the purpose of this opposition that the parties’ goods are the same, the proximity of the goods in the market place, the same channels of trade, priority of use and the MAKER’S MARK trademark is well-known.

ARGUMENT

A. The Section 2(d) Law

The issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key

² To the extent Opposer argues any other grounds for confusion, such grounds should not be considered as Opposer has not supplemented this response.

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, 29 (CCPA 1976) (“The 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.”).

To establish a likelihood of confusion, there must be a likelihood of confusion among an appreciable number of ordinarily prudent purchasers of the parties’ respective goods, namely, distilled spirits, whiskey and bourbon. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 202 USPQ 81 (2nd Cir. 1979); McCarthy On Trademarks §23:91.

The dissimilarity of the parties’ respective trademarks and the commercial impressions conveyed thereby may be dispositive of the likelihood of confusion determination. *Roederer, supra*.

B. The *du Pont* Factors Favor Applicant

1. The Trademarks Are Not Similar

Applicant’s trademark is BOWMAKER’S WHISKEY. The word “Bowmaker’s” in Applicant’s trademark designates a bowmaker, i.e. a person who makes bows. Opposer’s trademarks are MAKER’S MARK; MAKER’S 46; MAKER’S; and MAKER’S MARK PRIVATE SELECT.³ The MAKER’S MARK trademarks were admittedly inspired by and refer to the branding or mark made by a pewter craftsman and have nothing to with a “bowmaker.” There is even a dictionary definition for the words “Maker’s Mark,” indicating the common nature of the mark. Accordingly, the parties’ respective trademarks have completely different

³ Opposer’s primary trademark is MAKER’S MARK as seen from all of the exhibits submitted by Opposer. See also, 43 TTABVUE, App. NOR 3, Exhibits 82-84, pages from Opposer’s website showing the MAKER’S MARK product. For example, the specimen for the MAKER’S trademark and registration shows use of MAKER’S 46, not MAKER’S. 26 TTABVUE, Opp. NOR 1, Exhibit 3. Opposer has moved away from using MAKER’S 46 to MAKER’S MARK 46. *Id.*, Exhibit 83.

meanings. Further, the parties' trademarks sound different, are spelled different and appear different. Based on all of these dissimilarities, the parties' trademarks create completely different commercial impressions. This is in accord with the testimony of Mr. Rodgers and Attorney Khalsa, two third-party unbiased witnesses. It is also in accord with the Examining Attorney's decision not to cite *any* of the MAKER'S MARK trademarks. It is further in accord with the numerous third-party trademarks using the words "maker's," "maker" and "mark" as trademarks as discussed hereafter.

This case is directly on point with the Federal Circuit decision in *Roederer*. In *Roederer*, the Federal Circuit affirmed the Board's decision finding no likelihood of confusion between the trademarks CRISTAL and CRYSTAL CREEK for the same goods, wine. The Federal Circuit, in affirming the Board, found that the single *du Pont* factor of the dissimilarity of these trademarks was dispositive. Despite the facts that the goods were the same and that the CRISTAL trademark had a very strong indication of origin (as also argued by Opposer herein), the Court found that the commercial impressions conveyed by the trademarks were different based on the differences in the meaning of the trademarks and the differences in the sound and appearance of the trademarks. The same is true in this opposition.

This *du Pont* factor favors Applicant and is dispositive of the issue of likelihood of confusion.

2. **The Parties Goods and Channels of Trade**

For the purposes of this opposition only and in accord with the Application, the asserted registrations and Board precedent, Applicant does not dispute that the parties' goods and channels of trade are the same.

This *du Pont* factor favors Opposer.

3. **Purchasers of the Parties Goods Exercise Care**

The parties' goods are expensive and purchased by a discriminating and sophisticated customers exercising a substantial degree of care. 39 TTABVUE, Park Test., page 88.

Applicant's whiskey will sell for approximately \$38.00 to \$40.00. 39 TTABVUE, Parks Test., page 89. Opposer's goods sell in the range of about \$16.00 to \$75.00, depending on bottle size and quality. 44 TTABVUE, Breiner Decl. ¶2, Exhibits 97-95; 37 TTABVUE, App. NOR 3, Exhibit 78, pages 8-9 (\$18 to \$58) and Rodgers Decl. ¶10 (\$25 to \$80).⁴ Opposer's bourbon sold in restaurants or bars sell for about \$12.00 - \$16.00. 44 TTABVUE, Breiner Decl. ¶3, Exhibit 96 (\$12); 37 TTABVUE, App. NOR 3, Exhibit 86 (\$13 to \$16). Accordingly, the parties' goods are expensive and consumers exercise care in purchasing the goods. *See Sazerac Co. v. Fetzer Vineyards, Inc.*, 265 F. Supp. 3d 1013, 1028 (N.D. Cal. 2017) (finding that wine consumers exercise a high degree of care in purchasing wine in the \$17.00 to \$19.00 price range).

Applicant's position as to the expensive nature of Opposer's goods is in accord with Opposer's own trademark Registration No. 1,002,995 for the trademark IT TASTES EXPENSIVE ... AND IS and its marketing campaign touting the expense of its goods and the discriminating nature of its customers. 37 TTABVUE, App. NOR 2, Exhibits 75, 76 and 77.

This *du Pont* factor favors Applicant and a finding of no likelihood of confusion.

4. **Opposer is Estopped from Arguing for a Broad Scope of Protection Based on the Numerous Similar Third-Party Trademarks**

⁴ Opposer's objection to the Breiner Declaration and these exhibits is not well taken. The Breiner Declaration offers no testimony and merely authenticates the exhibits. This is the same as a Notice of Reliance, e.g. compare Opposer's Opp. NOR 5 and Exhibits 21-24 which are essentially the same.

Opposer's trademark MAKER'S MARK is not a strong trademark. There is even a dictionary definition for the words "Maker's Mark."

There are numerous other marks similar to the MAKER'S MARK trademarks for similar or related goods as follows:

<u>Mark</u>	<u>Reg. No.</u>	<u>Goods (Summary)</u>
MAKER'S MARK	1,693,478	Marketing consulting services
MAKER'S MARK	1,040,945	Dinnerware and related service pieces
MAKER'S MARK	795,289	Men's and Boys' outer garments
MAKER'S MARK	87/746,837	Men's skincare, grooming and beauty products
MAKER'S TABLE	3,114,487	Alcoholic beverages
MAKER'S TABLE	85/807,684	Wines
THE MAKER	4,403,990	Wines
BARREL MAKER	4,790,239	Wine
MAP MAKER	3,653,684	Wine
MAGIC MAKER	4,460,225	Wine
SIN MAKER	4,049,639	Alcoholic energy drinks
SIN MAKER and Design	4,053,946	Alcoholic energy drinks
S STRIKE MAKER	5,308,828	Alcoholic beverages
THE PARTY MAKER	3,651,463	Alcoholic beverages
MAGICK MAKER	85/852,405	Wine
BABY MAKER	88/278,457	Wine
THE BABY MAKER	86/397,072	Wine

BLACK MAKER	88/205,021	Alcoholic beverages
MISCHIEF MAKER	86/736,259	Wines
MATE MAKER BEVERAGES	88/914,627	Beers
MEMBER'S MARK	3,941,793	Alcoholic beverages
MEMBER'S MARK	5,396,943	Alcoholic beverages
COOPER'S MARK	4,115,536	Distilled spirits
OLD MARK	4,739,555	Vodka
OLD MARK and Design	4,739,553	Vodka
GREEN MARK	3,744,765	Vodka
SILVER MARK	4,429,720	Alcoholic beverages
SHEPHERDS MARK	4,083,804	Wines
VINTNER'S MARK	4,238,105	Wines
BEAUTY MARK	5,222,540	Wines
ROYAL MARK	1,285,527	Whiskey
KING'S MARK	842,977	Whiskey
FANCY MARK	600,119	Gin
EIGHTH MAKER	6,086,233	Wine
WINE MAKER'S ESSENTIALS	5,044,213	Wine making equipment kits
MEMBER'S MARK	5,396,942	Cocktail mixes
MEMBERS MARK	2,582,569	Malt beer
MARK MAKER	1,635,458	Marking products and equipment

See App. NOR 2, Exhibits 16-74, 37 TTABVUE.⁵ Evidence of use of similar marks by third parties for similar or related goods is relevant to a mark's commercial strength and the scope of protection to be accorded the asserted trademark(s). *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1346 (TTAB 2017) (holding no likelihood of confusion between INNOVATION BREWING and INSPIRED BREWING both for beer).

As noted above, there are a number of prior registrations for the trademark MAKER'S MARK for other goods. This indicates the common nature of the trademark. There are also a number of similar marks such as BARREL MAKER and MAP MAKER. Possibly one of the more pertinent third-party marks is the MEMBER'S MARK trademark for alcoholic beverages. MEMBER'S MARK and MAKER'S MARK are substantially the same. Both MAKER'S and MEMBER'S being two syllables and starting with the letter "M." The goods are the same. The channels of trade are the same. When inserting "Member's Mark Bourbon" into Google, the search results reference Maker's Mark products. 43 TTABVUE, App. NOR 3, Exhibit 79. The MEMBER'S MARK Whiskey is shown at Exhibit 81. *Id.* However, when searching under "Bowmaker's Whiskey," the search results come back with nothing for Maker's Mark products. 44 TTABVUE, Decl. Breiner ¶4, Exhibit 97. Thus, MEMBER'S MARK trademark is much closer to MAKER'S MARK than BOWMAKER'S WHISKEY. Opposer has admitted that it did not oppose the MEMBER'S MARK registrations or object to use of the MEMBER'S MARK trademark. Opposer is now estopped from asserting any broader claim to the MAKER'S MARK trademarks.

This *du Pont* factor favors Applicant and a finding of no likelihood of confusion.

⁵ Applicant notes that certain of these trademarks are not active or abandoned or still pending. This has no bearing on the fact that these trademarks were registered; were allowed and abandoned; or were allowed, as it indicates the common use of these words, and that Opposer did not oppose these marks and did not object to the use of these marks. 37 TTABVUE, App. NOR 1, Exhibit 27, Opposer's Responses to Applicant's Requests for Admission Nos. 2-86.

5. **Opposer Mark's May Be Well Known But This One Factor Does Not Establish a Likelihood of Confusion**

Opposer has alleged that the MAKER'S MARK trademarks are well known. For purposes of this opposition only, Applicant does not dispute this allegation.⁶ However, no matter how much fame there is in the MAKER'S MARK trademarks, this cannot change the fact that there is absolutely no similarity in the parties' respective trademarks. This is in accord with the *Roederer* decision where the Federal Circuit and the Board acknowledged the well known nature of CRISTAL champagne but found *no* likelihood of confusion.

6. **Applicant Did Not Copy Anything of Opposer**

Opposer wrongfully and incorrectly argues that Applicant copied wording from Opposer's Website and this evidences a willful attempt to trade on Opposer's trademarks. This argument is without merit. *See*, 39 TTABVUE, Parks Test., pages 86-88; 39 TTABVUE, Jenkins Test., pages 98-100. As the testimony of Mr. Jenkins establishes, Mr. Jenkins, not Applicant or Mr. Parks, made a *mock-up* of a non-functional age verification page for his private use. He acknowledged that he took wording from the Opposer's Website but only as a *mock-up* and subject to revision. He testified that this is often done in creating a new website by his firm and others. There was no intent that the page be made public, as is clear from the *errors* in typeface font on the mock-up, and to his knowledge the mock-up, which does not work, was not made public. Applicant's design firm's mock-up of one page of a Website, which is not even a live Website, has no bearing on the issue of likelihood of confusion.⁷

⁶ Opposer cites Mr. Rodgers' testimony that MAKER'S MARK is well known. Mr. Rodgers previously oversaw certain of the MAKER'S MARK operations. However, he has *also* testified that there is *no* likelihood of confusion in this case. Opposer cannot pick and choose what testimony to believe from Mr. Rodgers.

⁷ Counsel for Opposer examined Messrs. Parks and Jenkins extensively on this issue. A complete reading of their testimony is contrary to Opposer's arguments and allegations.

Applicant exercised care in selecting its trademark BOWMAKER'S WHISKEY, including in having a trademark clearance search conducted by LegalForce and obtaining the opinion of trademark counsel.⁸ Accordingly, Applicant fully complied with the Trademark Laws and steered well clear of Opposer's trademarks. This is in complete accord with the Examining Attorney's trademark search and opinion that there is no likelihood of confusion between BOWMAKER'S WHISKEY and the MAKER'S MARK trademarks.

CONCLUSION

The BOWMAKER'S WHISKEY trademark is completely different from the MAKER'S MARK trademarks in pronunciation, appearance, spelling and meaning. The BOWMAKER'S WHISKEY trademark connotes a person who makes bows. The dictionary definition of MAKER'S MARK is the hallmark on a piece of English gold, silver or plate denoting the person responsible for its production. These meanings are completely different. As such the commercial impression of the parties' respective marks is completely different establishing no likelihood of confusion. This position is supported by the Examining Attorney's allowance of the BOWMAKER'S WHISKEY trademark; the trademark clearance opinion of LegalForce; the testimony of Ms. Khalsa, a trademark attorney; and Mr. Rodgers, a person with more than 40 years experience in the distilled spirits business, including at Jim Beam, the owner of Maker's Mark.

For the foregoing reasons, Applicant respectfully requests that the Board dismiss the Opposition with prejudice.

⁸ Opposer casts aspersions on the LegalForce trademark search because it was conducted in India. However, the LegalForce personnel responsible for the search and overseeing the search were former examining attorneys at the U.S. Trademark Office. 39 TTABVUE, Khalsa Test., pages 51, 74.

Respectfully submitted,

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May 11, 2021

CERTIFICATE OF SERVICE

It is hereby certified that on this 11th day of May 2021, a true copy of the foregoing paper entitled –

APPLICANT BOWMAKER'S WHISKEY COMPANY'S TRIAL BRIEF

was served by email on -

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