

This Opinion is not a
Precedent of the TTAB

Mailed: October 10, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trinity River Distillery, LLC

Serial No. 98170756

Blake T. Dietrich of Jackson Walker LLP
for Trinity River Distillery, LLC.

Christian Martin, Trademark Examining Attorney, Law Office 301,¹
Sophia Kim, Senior Attorney.

Before Thurmon, Cohen, and Elgin, Administrative Trademark Judges.

Opinion by Cohen, Administrative Trademark Judge:

Applicant, Trinity River Distillery, LLC, seeks registration on the Principal Register of the mark 1849 BOURBON (BOURBON disclaimed) in standard characters for “distilled spirits” in International Class 33.²

¹ The Application, originally assigned to Examining Attorney Thomas M. Manor of Law Office 110, was reassigned to Examining Attorney Christian Martin during the appeal.

² Application Serial No. 98170756 was filed on September 8, 2023, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an allegation of bona fide intent to use the mark in commerce.

Citations to the prosecution file refer to the USPTO’s TRADEMARK STATUS & DOCUMENT RETRIEVAL (“TSDR”) system and identify the documents by title, date, and page in the downloadable .pdf version. Citations to the briefs and other materials in the appeal record refer to the Board’s TTABVUE online docket system.

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's proposed mark, when used in connection with the identified goods, is likely to cause confusion, to cause mistake, or to deceive because it resembles the marks in the following standard character registrations, owned by the same entity:

- 1849 on the Principal Register for “alcoholic beverages, namely, wine and sparkling wine” in International Class 33;³
- 1849 WINE COMPANY DECLARATION (WINE COMPANY disclaimed) on the Principal Register for “wine” in International Class 33;⁴ and
- 1849 WINE COMPANY TRIUMPH (WINE COMPANY disclaimed) on the Principal Register for “wine” in International Class 33.⁵

When the refusal was made final, Applicant filed a request for reconsideration. After the request for reconsideration was denied, Applicant filed an appeal which has been fully briefed.⁶ For the reasons explained below, we affirm the refusal to register.

I. Likelihood of Confusion

As an initial matter, for purposes of our likelihood of confusion analysis, we will focus on Registration No. 5273858 for the mark 1849 for “alcoholic beverages, namely,

³ Registration No. 5273858 issued on the Principal Register on August 29, 2017 and a Section 8 declaration was accepted and a Section 15 declaration was acknowledged by the Office on January 23, 2024.

⁴ Registration No. 5879405 issued on the Principal Register on October 8, 2019.

⁵ Registration No. 5879403 issued on the Principal Register on October 8, 2019.

⁶ Applicant asserts that “the arguments made in the previously filed responses ... are incorporated by reference herein as if fully set forth at length.” 6 TTABVUE 8. However, such “incorporation-by-reference statements are inadequate to present on appeal whatever arguments an applicant may thereby be contemplating.” *In re Princeton Equity Grp. LLC*, No. 97397212, 2025 WL 1638891, at *3 (TTAB 2025). Any arguments Applicant seeks to incorporate but does not specifically raise in its appeal briefs are deemed forfeited. *Id.*

wine and sparkling wine” in International Class 33 (the “1849 Registration” or “1849 Mark”) because it has the most points in common with the mark in the Application.⁷ If we do not find a likelihood of confusion with the 1849 Mark and identified goods, then there would be no likelihood of confusion with the mark and goods in the other registrations cited by the Examining Attorney. *See, e.g., Monster Energy Co. v. Lo*, No. 91225050, 2023 WL 417620, at *6 (TTAB 2023); *Sock It To Me, Inc. v. Fan*, No. 91230554, 2020 WL 3027605, at *9 (TTAB 2020) (confining Section 2(d) analysis to most similar pleaded mark) (citing *N. Face Apparel Corp. v. Sanyang Indus. Co.*, No. 91187593, 2015 WL 6467820, at *7 (TTAB 2015)).

“The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023). Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”); *Charger Ventures*, 64 F.4th at 1379. We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

⁷ Applicant also included arguments regarding Registrant’s 1849 WINE COMPANY DECLARATION and 1849 WINE COMPANY TRIUMPH marks but inasmuch as we are not relying on these marks in our likelihood of confusion analysis, we need not address those arguments. *See, e.g.,* 6 TTABVUE 15-16.

In any likelihood of confusion analysis, different *DuPont* factors may play a dominant role and some factors may not be relevant. *Naterra Int'l, Inc. v. Bensalem*, 92 F.4th 1113, 1116 (Fed. Cir. 2024) (citing *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022)). In addition, varying weight may be assigned to each factor depending on the evidence presented, and “any one of the factors may control a particular case.” *Id.*; see also *Charger Ventures*, 64 F.4th at 1381. Two key considerations are the similarities between the marks and the similarities between the goods or services, which are addressed under the first two *DuPont* factors. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65 (Fed. Cir. 2002)). We discuss the relevant factors below.

A. Relatedness of the Goods, Channels of Trade, and Classes of Customers

We consider the “similarity or dissimilarity and nature of the goods or services as described in an application or registration”; “[t]he similarity or dissimilarity of established, likely-to-continue trade channels”; and the classes of consumers to which the goods are marketed under the second, third, and fourth *DuPont* factors. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1320 (Fed. Cir. 2014) (quoting *DuPont*, 476 F.2d at 1361).

The goods need not be identical or even competitive in order to find a likelihood of confusion. Rather, the question is whether the goods are marketed in a manner that “could give rise to the mistaken belief that they emanate from the same source” or are sponsored or endorsed by the same entity. *Coach Servs., Inc. v. Triumph Learning*

LLC, 668 F.3d 1356, 1369 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, No. 91117739, 2007 WL 1431084, at *6 (TTAB 2007)); *Majestic Distilling Co.*, 315 F.3d at 1316; see also *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (“Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.”).

Applicant asserts that Registrant has “explicitly acknowledged the different types of alcoholic beverages are not inherently related or similar for purposes of consumer confusion”;⁸ and that during prosecution of the application for the 1849 Registration, Registrant acknowledged that marks incorporating 1849 can co-exist for “different forms of adult beverages”⁹ asserting that there is no per se rule that there is a likelihood of confusion when the goods involved are both alcoholic beverages¹⁰ and that there was no likelihood of confusion with Registration No. 4671096¹¹ for the

⁸ 6 TTABVUE 9.

⁹ *Id.*

¹⁰ *Id.*

¹¹ A copy of this registration was not submitted during prosecution. The Board does not typically take judicial notice of registrations in Office records. *In re Seminole Tribe of Fla.*, No. 87890892, 2023 WL 3751113, at *3 (TTAB 2023) (referring to the Board’s “well-established practice is not to take judicial notice of third-party registrations” even when requested) (citations omitted); *In re Jonathan Drew Inc.*, No. 77099522, 2011 WL 481329, at *5 n.11 (TTAB 2011). Nonetheless, because the Examining Attorney addressed the registration in Office Actions, referred to it in briefs, and did not object to its discussion, we will treat the registration as though it is of record. See Final Office Action at TSDR 4-5; see also, e.g., *In re Olin Corp.*, No. 86651083, 2017 WL 4217176, at *10 n.22 (TTAB 2017) (because the examining attorney addressed applicant’s registrations in her brief and did not object to its discussion, Board treated the registrations as though they were of record). Registration No. 4671096 was cancelled August 20, 2021.

mark 1849 for “beer.”¹²

With respect to Registrant’s statements made during the prosecution of its application, Applicant is essentially asserting that Registrant’s statements are file wrapper estoppel; however, file wrapper estoppel is not applicable in trademark cases nor are the statements about a third-party registration not at issue here an admission against interest. *See Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 929 (CCPA 1978) (finding that a likelihood of confusion argument made in support of an application for registration is a legal conclusion, and therefore, cannot constitute an admission because only facts may be admitted); *Calypso Tech. Inc. v. Calypso Cap. Mgmt. LP*, No. 91184576, 2011 WL 4090446, at *12 (TTAB 2011) (recognizing that a party’s position in a prior proceeding “is not an admission, but may be considered only as illuminative of shade and tone in the total picture”); *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, No. 91171509, 2009 WL 4075365, at *12 (TTAB 2009) (“The doctrine of ‘file wrapper estoppel’ does not apply in trademark cases” nor does a party’s position in a prior proceeding “rise to the level of an admission against interest.”).

Here, the evidence of record supports the Examining Attorney’s assertion that distilled spirits and wine are related. While it is true that there is no per se rule that all alcoholic beverages are related, one way to show that consumers perceive goods as related (in the trademark sense) is to show that other companies offer the goods identified in an application and those identified in a cited registration under the same

¹² 6 TTABVUE 9; January 29, 2025 Request for Reconsideration at TSDR 13.

mark. *See, e.g., Naterra Int'l*, 92 F.4th at 1117; *In re Detroit Athl. Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018); *Hewlett-Packard*, 281 F.3d at 1267; *In re White Rock Distilleries Inc.*, 2009 WL 3401827, at *2 (TTAB 2009).

The Examining Attorney submitted evidence of ten third-party websites that offer both distilled spirits¹³ and wines under the same or very similar marks such as BARTLETT;¹⁴ FLAG HILL;¹⁵ MOUNTAIN VIEW DISTILLERY;¹⁶ NAHOBA;¹⁷

¹³ In addressing the Examining Attorney's third-party evidence submitted during prosecution, Applicant argues that "distilled spirits' is [sic] not the goods of the cited marks in the refusal and therefore the evidence is irrelevant to [the July 29, 2024] Office Action." 6 TTABVUE 17. Applicant's argument fails to consider that "distilled spirits" are the goods identified in its application and thus, are quite relevant to our analysis.

Applicant also argues that the Examining Attorney submitted "about 5 overlapping wineries/distilleries in the July 29, 2024 Final Office Action," 6 TTABVUE 18 n.1; and that these examples are outliers and account for only .043% of wineries, *id.* Applicant mischaracterizes the Examining Attorney's evidence failing to account for the evidence submitted with the April 2, 2024 Office Action. Also, Applicant appears to rely on evidence of the number of wineries and distilleries in the US in 2023 by providing a hyperlink to an article. To properly introduce Internet evidence into the record, a party must provide: (1) an image file or printout of the downloaded webpage, (2) the date the evidence was downloaded or accessed, and (3) the complete URL address of the webpage. *See In re I-Coat Co., LLC*, No. 86802467, 2018 WL 2753196, at *2-3 (TTAB 2018) (discussing the requirements for submitting Internet materials in ex parte appeals). Providing only a URL or hyperlink to Internet materials in a brief, for example, is insufficient to make such materials of record. *See, e.g., Olin Corp.*, 2017 WL 4217176, at *5 n.15 ("Because the information displayed at a link's Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record."). Even if properly made of record, the evidence has been untimely submitted for the first time with this appeal. Trademark Rule 2.142(d), 37 C.F.R. 2.142(d); *see In re Midwest Gaming & Entm't LLC*, No. 85111552, 2013 WL 1442237, at *2 n.3 (TTAB 2013) (new evidence submitted with brief is "untimely and therefore not part of the record for this case").

¹⁴ April 2, 2024 Office Action at TSDR 15-16.

¹⁵ *Id.* at 19-27.

¹⁶ July 29, 2024 Final Office Action at TSDR 19-34.

¹⁷ *Id.* at 45-65.

SWEETGRASS;¹⁸ and WOLLERSHEIM.¹⁹

The Examining Attorney also submitted over thirty-five third-party use-based registrations for both distilled spirits and wine under the same mark, including:

- DOUBLE UP FOR A BUCK (Registration No. 2994872) for “wines, potable spirits, and distilled spirits”;²⁰
- MANO A MANO (Registration No. 3340905) for “wines, sparkling wines, and distilled spirits”;²¹
- LIQUID ALTITUDE (Registration No. 5209678) for “blended spirits; distilled spirits; spirits, wine; wine-based drinks; wines”;²²
- SANTA ANITA (Registration No. 2116793) for “wines and distilled spirits”;²³
- PACHANGA SUNROOT (Registration No. 2004688) for “wines and distilled spirits”;²⁴
- NIRVANA (Registration No. 2304607) for “wines and distilled spirits”;²⁵
- DON MAXIMIANO (Registration No. 2125395) for “wines, distilled spirits and liquors”;²⁶
- ROCKLEDGE VINEYARDS (Registration No. 257847) for “wines, sparkling wines, distilled spirits, and liquors”;²⁷ and

¹⁸ *Id.* at 66-73.

¹⁹ *Id.* at 75-82.

²⁰ July 29, 2024 Final Office Action at TSDR 83.

²¹ *Id.* at 84.

²² *Id.* at 86.

²³ *Id.* at 88.

²⁴ *Id.* at 90.

²⁵ *Id.* at 92.

²⁶ *Id.* at 95.

²⁷ *Id.* at 99.

- BUNRATTY CASTLE (Registration No. 2798817) for “wines and distilled spirits.”²⁸

The third-party websites and registrations demonstrate that distilled spirits and wines are offered under the same mark by the same party or emanate from the same source under the same mark, and are thus, related. *See, e.g., Detroit Athl.*, 903 F.3d at 1306 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard.*, 281 F.3d at 1267 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”); *DeVivo v. Ortiz*, No. 91242863, 2020 WL 1227592, at *14 (TTAB 2020) (“While not evidence of use of the marks therein, third-party registrations may serve to suggest that the parties’ goods ... are of a type which may emanate from a single source.”); *In re Country Oven, Inc.*, No. 87354443, 2019 WL 6170483, at *5 (TTAB 2019) (as a general proposition, third-party registrations that cover goods from both the cited registration and an applicant’s application are relevant to show that the goods are of a type that may emanate from a single source under one mark). In other words, the evidence demonstrates that consumers are accustomed to seeing a single mark associated with a single source that offers both distilled spirits and wines. *See Detroit Athletic*, 903 F.3d at 1306.

²⁸ *Id.* at 106.

As to channels of trade and classes of consumers, Applicant attempts to distinguish its trade channels and consumers by arguing that “while both distilled spirits and wine may end up in the same store, the trade channels are distinct as the manufacture and sale of alcoholic beverages are regulated by law”; and “based on the intrinsic nature of alcoholic beverages wherein products are always delineated by sections and not sold side-by-side (e.g., wine sections are separate from distilled spirit sections).²⁹ These arguments are unavailing.

Because the identifications of goods contain no limitations, Applicant’s and Registrant’s goods are presumed to move in all ordinary channels of trade and would be available to all classes of purchasers. *See Stone Lion*, 746 F.3d at 1323; *Coach Servs.*, 668 F.3d at 1369 (absent limitation “goods are presumed to travel in all normal channels . . . for the relevant goods.”). Indeed, the Federal Circuit has repeatedly held that different types of alcoholic beverages share identical trade channels and classes of consumers. *See, e.g., In re Chatam Int’l Inc.*, 380 F.3d 1340, 1345 (Fed. Cir. 2004); *In re Majestic Distilling*, 315 F.3d at 1316. Such is the case here. The Internet evidence discussed above showing that Applicant’s distilled spirits and Registrant’s wines are related demonstrates that those types of goods are advertised on the same third-party websites, under the same mark, to the same consumers. *See, e.g., Embiid*, 2021 WL 2285576, at *15 (Board found “channels of trade and classes of customers plainly overlap” where record demonstrated relevant goods sold together on third-party websites and offered and registered under a single mark by numerous

²⁹ 6 TTABVUE 13.

businesses). Not only does the evidence indicate that the relevant goods are advertised on the same websites, they may also be available in other channels of trade such as bars and restaurants. *Cf. In re Bay State Brewing Co., Inc.*, No. 85826258, 2016 WL 1045677, at * (TTAB 2016) (Trade channels for beer “include liquor stores, beer sections of grocery and convenience stores, and the like, as well as bars and restaurants, and the customers would include ordinary consumers.”). Moreover, Applicant admits that both distilled spirits and wine may be available in the same store.³⁰

Based on the foregoing, we find that the respective goods are related, channels of trade and classes of customers overlap, and the second and third *DuPont* factors weigh in favor of a likelihood of confusion.

B. Strength of 1849

Before we make our comparison of the marks, we consider the strength of the 1849 Mark. We do so because a determination of the strength of this mark helps inform us as to its scope of protection.

The sixth *DuPont* factor³¹ considers “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 476 F.2d at 1361. “A mark’s strength is measured both

³⁰ 6 TTABVUE 13 (“while both distilled spirits and wine may end up in the same store”); *id.* at 19 (“Each of these products are very expensive and are marketed towards sophisticated consumers who are purchasing these products for different social uses in different sections of stores/the internet”).

³¹ As is normally the case in *ex parte* proceedings, the fifth factor is neutral because the record generally includes no evidence as to fame, particularly since the owner of the cited registration is not a party to the proceeding and thus cannot introduce evidence regarding its use of the cited registered mark. *See In re Thomas*, No. 78334625, 2006 WL 1258862, at *8 n.11 (TTAB 2006).

by its conceptual strength ... and its marketplace strength ...” *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010). In determining the strength of the 1849 Mark, we consider inherent strength, based on the nature of the mark itself. *In re FCA US LLC*, No. 85650654, 2018 WL 1756431, at *13 (TTAB 2018). We also consider whether the mark has commercial weakness in the marketplace if there is evidence in the record. *DuPont*, 476 F.2d at 1361 (the sixth *DuPont* factor considers “the number and nature of similar marks in use on similar goods.”); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, No. 91157248, 2011 WL 6099691, at *9 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, No. 91118587, 2006 WL 2460188, at *20 (TTAB 2006).

“The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1368, 1371 (Fed. Cir. 2005)). Evidence that a mark, or an element of a mark, appears in the marks of many different third-party registrants may undermine the common element’s conceptual or inherent strength. *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is 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 relatively weak.”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39 (Fed. Cir. 2015)).

Applicant asserts that “the common term 1849 appears in many other co-existing marks in the alcohol industry”³² and thus, 1849 is diluted for goods and services in the alcohol industry.³³ Applicant did not introduce evidence of third-party marketplace uses but instead, reproduced the table submitted by Registrant during the prosecution of its 1849 Registration which lists two registrations (OLD FITZGERALD’S 1849 and COINTREAU NOIR A BLEND OF ORANGE LIQUEUR & COGNAC IMPORTER LIQUEUR PRODUCT OF FRANCE ANGERS-FRANCE E. COINTREAU 1849) and two applications (REICHRAT VON BUHL DEIDESHEIM 1849 and COINTREAU BLOOD ORANGE 1849).³⁴ Applicant’s reliance on this table is problematic for several reasons.

First, copies of the two registrations listed in the table are not of record,³⁵ and while the listing identifies the marks and relevant goods, the listing is of extremely limited probative value. There is no indication as to who owns the registrations, whether the third-party registrations issued on either the Principal Register or Supplemental Register, or whether the registrations are live and subsisting, and the

³² 6 TTABVUE 22.

³³ *Id.* at 23.

³⁴ *Id.*

³⁵ To make registrations of record, copies of the registrations or the complete electronic equivalent must be submitted. *In re Ruffin Gaming LLC*, No. 75899614, 2002 WL 1941140, at *2 n.3 (TTAB 2002).

Board does not usually take judicial notice of third-party registrations. *See, e.g., Whitserve, LLC v. Computer Packages, Inc.*, 694 F.3d 10, 23 (Fed. Cir. 2012) (“arguments of counsel cannot take the place of evidence lacking in the record”) (cleaned up; citation omitted); *Seminole Tribe of Fla.*, 2023 WL 3751113, at *3.

Second, the table lists two applications which are evidence of nothing more than that they were filed; they have no probative value. *See, e.g., Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003) (“[T]hird-party applications are evidence only of the fact that they were filed; they have no other probative value.”). To the extent any of the third-party applications have subsequently registered, again, we do not take judicial notice of records residing in the Patent and Trademark Office. *Seminole Tribe of Fla.*, 2023 WL 3751113, at *3.

Last, even if the applications have since registered and the listed registrations were all of record, it would not support Applicant’s arguments. These third-party marks all contain additional wording that is significant enough to make them less similar to the 1849 Mark. *See Sabhnani v. Mirage Brands, LLC*, No. 92068086, 2021 WL 6072822, at *13 (TTAB 2021) (“[W]hile the registered marks all contain the word ‘MIRAGE,’ they contain additional elements that cause many of them to be less similar to Petitioner’s mark than Respondent’s marks are.”). None of the listed marks is for 1849 alone or use 1849 as the first term, like those involved here.

We find that Applicant has not demonstrated that the 1849 Mark is conceptually weak. Because the 1849 Mark is registered on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, we afford it “the

normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, No. 91215896, 2017 WL 6525233, at *9 (TTAB 2017); *see Tea Bd. of India*, 2006 WL 2460188, at *22. And as noted, because Applicant did not submit any evidence regarding any third-party marketplace use, it has not demonstrated that the 1849 Mark is commercially weak.

The sixth *DuPont* factor is neutral.

C. Similarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.’” *Sabhnani v. Mirage Brands, LLC*, No. 92068086, 2021 WL 6072822, at *13 (TTAB 2021) (quoting *Palm Bay Imps.*, 396 F.2d at 1371). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, No. 87075988, 2018 WL 2734893, at *5 (TTAB 2018), *aff’d* 777 Fed. Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, No. 85497617, 2014 WL 2531200, at *2 (TTAB 2014)). “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.” *i.am.symbolic*, 866 F.3d at 1323 (quoting *Coach Servs.*, 668 F.3d at 1368 (internal quotation marks omitted)). We keep in mind that consumers must depend on their recollection of marks to which they have previously been exposed and that their memories are fallible. *See, e.g., In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014); *Sage Therapeutics, Inc. v. Sageforth*

Psych. Servs., LLC, No. 91270181, 2024 WL 1638376, at *5 (TTAB 2024) (quoting *In re i.am.symbolic, llc*, No. 85916778, 2018 WL 3993582, at *4 (TTAB 2018)).

“No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1295 (CCPA 1974)). On the other hand, “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 entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985).

The Examining Attorney argues that Applicant’s 1849 BOURBON mark and the 1849 Mark are confusingly similar because both are in standard characters;³⁶ the common element, 1849, is the dominant portion of both marks;³⁷ the additional wording in Applicant’s mark is merely descriptive, if not generic, and disclaimed;³⁸ and the marks are phonetically³⁹ similar and “almost certainly connote[] the year 1849 in the Gregorian Calendar.”⁴⁰

Applicant does not dispute that both marks share the element 1849 but primarily contends that its mark is distinct from the 1849 Mark because its use of “‘1849’ is [in]

³⁶ 8 TTABVUE 6.

³⁷ *Id.* at 4-5.

³⁸ *Id.* at 6.

³⁹ *Id.* at 7.

⁴⁰ *Id.* at 8.

reference to the year of Texas independence and the establishment of Fort Worth, Texas (Applicant’s home location);⁴¹ the owner of the 1849 Registration is based in California “and is inspired by the ‘Gold Rush’ of 1849 which was pervasive in California”;⁴² that Applicant and Registrant use of their respective marks is distinct as evidenced by their bottle labels;⁴³ and that “every use of ‘1849’ by [Registrant] is accompanied by ‘Wine’ which connotes a single product and no cross-use for different products.”⁴⁴ These arguments are unavailing.

Both marks lead with the identical and dominant date 1849.⁴⁵ The marks’ “lead words are their dominant portion and are likely to make the greatest impression on consumers.” *Detroit Athl.*, 903 F.3d at 1303; *see also In re Dare Foods Inc.*, No. 88758625, 2022 WL 970319, at *6 (TTAB 2022). Further, the term 1849 is the entirety of the mark shown in the 1849 Registration and is subsumed in its entirety by Applicant’s 1849 BOURBON mark. While there is no explicit rule that we must find marks similar where one mark incorporates the entirety of another mark, the fact that it does typically increases the similarity between the two. *See, e.g., China Healthways Inst. Inc. v. Wang*, 491 F.3d 1337, 1340 (Fed. Cir. 2007) (applicant’s mark CHI PLUS is similar to opposer’s mark CHI both for electric massagers); *Coca-Cola Bottling Co. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 557-58 (CCPA 1975)

⁴¹ 6 TTABVUE 16.

⁴² *Id.*

⁴³ 6 TTABVUE 15.

⁴⁴ 6 TTABVUE 18.

⁴⁵ 8 TTABVUE 5.

(applicant's mark BENGAL LANCER for club soda, quinine water and ginger ale is similar to BENGAL for gin); *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201 (CCPA 1972) (WEST POINT PEPPERELL and griffin design for fabrics is similar to WEST POINT for woolen piece goods). Contrary to Applicant's arguments,⁴⁶ if a portion of both marks is the same, then the marks may be confusingly similar notwithstanding some differences. *See, e.g., Charger Ventures*, 64 F.4th at 1382 ("an additional word or component may technically differentiate a mark but do little to alleviate confusion"); *Hewlett-Packard*, 281 F.3d at 1266 (similar commercial impression even though applicant's mark PACKARD TECHNOLOGIES, with "TECHNOLOGIES" disclaimed, does not incorporate every feature of opposer's HEWLETT PACKARD marks); *Double Coin Holdings, Ltd. v. Tru Dev.*, No. 92063808, 2019 WL 4877349, at *8 (TTAB 2019) ("likelihood of confusion often has been found where the entirety of one mark is incorporated within another.") (quoting

⁴⁶ Applicant references several cases that involve various marks which share identical terms but were not found to be confusingly similar (e.g., HEALTHY CHOICE v. HEALTHY SELECTIONS, BREATH SAVERS v. BREATH PLEASERS) and argues that we should find 1849 and 1849 BOURBON are also not confusingly similar. 6 TTBVUE 21-22. This argument, however, is not persuasive. Some of the cases Applicant relies on are from district courts or the Second Circuit Court of Appeals and involve the issue of infringement applying the *Polaroid* factors. *See id.*; *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2nd Cir. 1961). This analysis presents certain differences from the issue of likelihood of confusion as it concerns registrability. We are not bound by these authorities, as we apply the law set forth by the Federal Circuit and its predecessor. At any rate, these cases, including those from the Federal Circuit and TTAB, are distinguishable from the situation in the present appeal and we will not burden this opinion with a discussion of them. As already explained, "the [US]PTO must decide each application on its own merits, and decisions regarding other registrations do not bind either the [USPTO] or [the reviewing] court." *See In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003); *see Shinnecock Smoke Shop*, 571 F.3d at 1174 (Fed. Cir. 2009). The cited cases allowing registration of these other marks were based on records which were unique to the individual cases and which are necessarily different than the record before the Examining Attorney and us in the present appeal. Therefore, the fact that these other marks were allowed to register does not require a similar result here.

Hunter Indus., Inc. v. Toro Co., No. 91203612, 2014 WL 1649332, at *11 (TTAB 2014)).

While the addition of the disclaimed BOURBON may be a point of difference in Applicant's proposed mark in sound when fully articulated or in appearance, it does not alleviate confusion. *Charger Ventures*, 64 F.4th at 1382 (citing *Detroit Athl.*, 903 F.3d at 1304-05). BOURBON is disclaimed and thus, an admission of descriptiveness by Applicant. See *In re Zuma Array Ltd.*, No. 79288888, 2022 WL 3282655, at *7 (TTAB 2022) ("Applicant 'disclaimed exclusive rights in the term 'Smart,' thus conceding that 'smart' is merely descriptive of electronic sensor modules.") (citing *In re Six Continents Ltd.*, No. 88430142, 2022 WL 407385, at *8 (TTAB 2022) (disclaimer of the word SUITES in mark ATWELL SUITES "is a concession that 'Suites' is not inherently distinctive")). Disclaimed matter that is descriptive of a party's goods is typically less significant or less dominant when comparing marks. *Detroit Athl.*, 903 F.3d at 1305. The non-source identifying nature of BOURBON and the disclaimer thereof constitutes a rational reason for giving the term less weight in our analysis. See *Detroit Athl.*, 903 F.3d at 1305. Consumers will focus more on the 1849 portion of Applicant's mark as the source-indicator for the goods, as opposed to the non-source identifying and disclaimed BOURBON.⁴⁷

⁴⁷ The nature of Applicant's goods also means that there will be circumstances when the goods may be called for by the shortened, 1849, as in a restaurant or bar. See, e.g., *In re Aquitaine Wine USA, LLC*, No. 86928469, 2018 WL 1620989, at *7 (TTAB 2018) ("[C]onsumers often have a propensity to shorten marks when ordering [goods] orally[.]"). Additionally, bar and restaurant patrons are unlikely to see Applicant's or Registrant's label before ordering, and may never see the label if served by the glass, as wine and distilled spirits are often served in bars and restaurants. See, e.g., *In re Bay State Brewing Co.*, No. 85826258, 2016 WL 1045677, at *3 (TTAB 2016) ("Beer is often ordered by name, in a bar or restaurant, or from

BOURBON in Applicant's mark may convey the meaning and commercial impression of a type of distilled spirit, as argued by Applicant,⁴⁸ yet at the same time, Applicant's mark does not necessarily convey a different meaning or impression from the 1849 Mark. Consumers familiar with Registrant's mark, 1849, who encounter Applicant's mark, 1849 BOURBON, could perceive it as indicating that the makers of 1849 have added a distilled spirit or bourbon to their product line. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010).

Contrary to Applicant's arguments regarding its reference to the intended meaning of 1849 as the date of independence for Texas or the Gold Rush and the parties' bottle labels and marketplace use, "the likelihood of confusion issue before us involves the marks as shown in [the] registration certificate and Applicant's application." *See In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4 (Fed. Cir. 1993) (disregarding the applicant's argument that its use of the house mark SHELL with the mark at issue would weigh against confusion); *Aquitaine Wine*, 2018 WL 1620989, at *5 ("the *Viterra* court addressed only the fact that applicant's standard character mark could be depicted in the stylized fashion of the *literal* portion of registrant's design mark; the court did not extend the finding to the background 'splatter' dot design of the registrant's mark.") (citing *In re Viterra Inc.*, 671 F.3d 1358, 1365 n.4 (Fed. Cir. 2012)). We must disregard Applicant's arguments based on the particular

a menu, where only the name of the beer will be used (in this case, [1849]). Many consumers ordering these goods from a bartender or waiter/waitress will not have the opportunity to see a label when they order the product. Further, if the beer is served in a glass because it is a draft beer from a keg, the consumer may never see a label.").

⁴⁸ 6 TTABVUE 8.

trade dress, designs and logos used by Registrant and Applicant in the marketplace. Our analysis focuses on the marks in the Application and 1849 Registration, not “extrinsic evidence concerning the actual uses of the marks.” *i.am.symbolic*, 866 F.3d at 1323. Registrant’s and Applicant’s marks are standard character marks which do not incorporate design elements and there is no evidence of record that consumers would necessarily associate 1849 with Texas, Fort Worth, the Gold Rush or some other event or place. Indeed, it is equally as likely that consumers would consider 1849 as the date when the goods were first offered or when the company was founded or that if consumers attribute Applicant’s suggested meaning of 1849 to its goods that consumers would attribute the same meaning to Registrant’s goods. We, therefore, are not persuaded that 1849 has a different meaning when used by either Registrant or Applicant.

Based upon the above analysis, when comparing the marks overall, they are similar in sound, meaning, connotation and commercial impression. On the whole, the first *DuPont* factor weighs in favor of finding a likelihood of confusion. *See Double Coin Holdings*, 2019 WL 4877349, at *9.

D. Purchase Conditions and Consumer Care

The fourth *DuPont* factor considers “the conditions under which and buyers to whom sales are made, i.e., ‘impulse vs. careful, sophisticated purchasing.’” *DuPont*, 476 F.2d at 1361. “Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchase of inexpensive items may tend to have the opposite effect.” *Palm Bay Imps. Inc.*, 396 F.3d at 1376.

Applicant asserts that its “1849 BOURBON products sell for far more than \$12 to \$24 – typically around \$40 per bottle – and thus the expected purchaser would be expected to be even more sophisticated with respect to these products and their differentiation. ... The same is true of 1849 Wine (... appears on at least one website for ~\$40 per bottle of wine)”;⁴⁹ and thus, the products are very expensive and are marketed towards sophisticated consumers who are purchasing these products for different social uses in different sections of stores/the internet.⁵⁰

The problem with Applicant’s assertion is that, beyond inferences we can draw from the broadly identified goods themselves, there is no evidence in the record to give us any insight as to the possible sophistication of consumers of Applicant’s or Registrant’s goods. *See In re I-Coat Co., LLC*, No. 86802467, 2018 WL 2753196, at *11 (TTAB 2018); *S.W. Mgmt., Inc. v. Ocinomled, Ltd.*, No. 94002242, 2015 WL 4464550, at *17 (TTAB 2015) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *Estée Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) (“arguments of counsel cannot take the place of evidence lacking in the record”) (citation omitted). It is common knowledge that distilled spirits and wines can range in price from a few dollars on the low end to hundreds and even thousands of dollars on the higher end.

⁴⁹ 6 TTABVUE 19-20. Applicant seeks to make of record webpages purportedly displaying Applicant’s and Registrant’s products by providing hyperlinks to Internet materials, 6 TTABVUE 19, which is insufficient to make such materials of record. *See, e.g., Olin Corp.*, 2017 WL 4217176, at *5 n.15.

⁵⁰ *Id.*

The Application and Cited Registration identify goods that are not restricted by target market, price, or any other manner that might suggest higher than normal consumer sophistication. While we can infer from the nature of Applicant's and Registrant's relevant goods that potential purchasers may include sophisticated as well as unsophisticated consumers, "[p]recedent requires that we base our decision on the least sophisticated potential purchasers." *Stone Lion*, 746 F.3d at 1325.

Accordingly, we find that the fourth *DuPont* factor is neutral in our analysis of likelihood of confusion.

E. Actual Confusion

The seventh *DuPont* factor considers the "nature and extent of any actual confusion." *DuPont*, 476 F.2d at 1361. The eighth *DuPont* factor contemplates the "length of time during and conditions under which there has been concurrent use without evidence of actual confusion." *Id.*

Applicant asserts that it has peacefully co-existed with Registrant for "at least 2 years."⁵¹ Even where there is co-existence, it is of limited value in proving actual confusion in the ex parte context where there is no opportunity to hear from the owner of the cited mark. See *In re Opus One Inc.*, No. 75722593, 2001 WL 1182924, at *7 (TTAB 2001) ("The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has

⁵¹ 6 TTABVUE 20.

no way to know whether the registrant likewise is unaware of any instances of actual confusion....”) (citations omitted).

Further, absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by the Registrant under the 1849 Mark. *Opus One*, 2001 WL 1182924, at *8-9. In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara’s Bakery Inc. v. Landesman*, No. 91157982, 2007 WL 196406, at *5 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred).

Here, the alleged period of co-existence is minimal and there is no evidence of record regarding the marketing and sales of Applicant’s or Registrant’s goods or whether any overlap exists. On this record, we are not convinced that there has been a reasonable opportunity for confusion to occur. Moreover, it is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Assocs. Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 1549 (Fed. Cir. 1990).

This factor is neutral.

II. Conclusion

Having considered all evidence and argument bearing on the relevant *DuPont* factors, we find that the similarity of the marks, the relatedness of the respective goods, and overlap in channels of trade and classes of customers weigh in favor of finding a likelihood of confusion. The factors regarding purchasing conditions and

customer sophistication and actual confusion are neutral. No factor supports Applicant's position.

We conclude that confusion is likely.

Decision: The refusal to register Applicant's proposed mark is affirmed under Section 2(d), 15 U.S.C. § 1052(d).