

9/25/01

**THIS DISPOSITION
IS CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Hearing:
April 5, 2001

Paper No. 12
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Opus One, Inc.*

Serial No. 75/722,593

Marc A. Bergsman of Dickinson Wright PLLC for *Opus One, Inc.*

Kenneth Dale Battle, Trademark Examining Attorney, Law
Office 111 (Craig D. Taylor, Managing Attorney)

Before Cissel, Bottorff and Rogers, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark OPUS ONE, in typed form, for "restaurant services."¹ The Trademark Examining Attorney has issued a final refusal of registration, on the ground that applicant's mark, as used in connection with applicant's services, so resembles the mark OPUS ONE, previously

¹ Serial No. 75/722,593, filed June 9, 1999. The application is based on use in commerce, and alleges August 24, 1987 as the date of first use and first use in commerce.

registered (in typed form) for "wine,"² as to be likely to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal of registration. The appeal has been fully briefed, and an oral hearing was held at applicant's request. The arguments made by applicant and by the Trademark Examining Attorney may be summarized as follows.

In support of his Section 2(d) refusal, the Trademark Examining Attorney essentially argues that confusion is likely because applicant's mark is identical to the cited registered mark, and because applicant's "restaurant services" are related to registrant's "wine" in that wine is served in restaurants and because a restaurant may offer, under a single mark, both restaurant services and "private label" wine named after the restaurant.

Applicant contests the Section 2(d) refusal, arguing that the evidence submitted by the Trademark Examining Attorney fails to establish the requisite relationship between applicant's services and registrant's goods; that applicant's services and registrant's goods are expensive and that the purchasers thereof are discriminating,

² Registration No. 1,341,372, issued June 11, 1985. Affidavits under Trademark Act Sections 8 and 15 accepted and acknowledged.

sophisticated purchasers who exercise great care in purchasing the goods and services; that there has been no reported actual confusion despite contemporaneous use of the marks in the same trade channels for thirteen years; and that the owner of the cited registration has long been aware of, has acquiesced in, and has encouraged applicant's use of the mark in connection with its restaurant services, thereby implicitly consenting to and authorizing such use.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find, under the first *du Pont* factor, that applicant's mark OPUS ONE is identical to the cited registered mark in terms of appearance, sound and connotation, and that applicant's and registrant's marks

present identical overall commercial impressions. Applicant does not contend otherwise.

However, there is no *per se* rule that confusion is likely to result from use of similar or even identical marks for food or beverage items and restaurant services; "something more" is required to support a finding of likelihood of confusion in such cases. *Jacobs v. International Multifoods Corporation*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982). In this case, though, we find that the requisite "something more" exists, both in the strong and arbitrary character of registrant's OPUS ONE mark and the resulting broad scope of protection to which the mark is entitled, *see, e.g., In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988),³ and in the nature of the specific commercial relationship between wine and restaurant services. *See, e.g., In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990); *In re Mucky Duck Mustard Co., Inc., supra*; and *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553 (TTAB 1987).

³ Compare cases in which the weakness of the prior mark weighed against a finding of likelihood of confusion, such as *Jacobs v. International Multifoods Corporation, supra* (BOSTON TEA PARTY for tea); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987)(STEVE'S for ice cream); and *In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984)(LA POSADA for lodging and restaurant services).

We find that OPUS ONE is arbitrary as applied to wine (or as applied to restaurant services). Applicant does not contend otherwise. We further find, under the sixth *du Pont* factor, that the evidence of record pertaining to "the number and nature of similar marks in use on similar goods" is insufficient to support any conclusion other than that registrant's OPUS ONE mark for wine is a strong mark which is entitled to a broad scope of protection.

Further with respect to the sixth *du Pont* factor, we note that applicant, with its November 8, 1999 response to the first Office action, submitted (as Exhibit No. 6) printouts of the following third-party registrations: Reg. No. 1,699,273, of the mark OPUS for "chocolates, pralines"; Reg. No. 1,853,268, of the mark OPUS ONE for "manufactured tobacco";⁴ Reg. No. 2,201,921, of the mark KAFFE MAGNUM OPUS (KAFFE disclaimed) for "coffee"; and Reg. No. 1,989,060, of the mark FUENTE OPUS X FOR "cigars." Applicant also submitted, as Exhibit 5 to its November 8, 1999 response, a printout of an article from Wine Spectator magazine which reported on the 1998 dismissal of a trademark infringement

⁴ Review of the Office's automated records reveals that the Section 8 affidavit for Registration No. 1,853,268 was due on September 6, 2000; the six-month grace period for filing the affidavit expired on March 6, 2001. It appears that no Section 8 affidavit has been filed, and that the registration will be cancelled in due course.

action which had been brought by Opus One winery (presumably the registrant herein) against the use by Fuente, a Dominican Republic cigar-maker, of the mark OPUS X for cigars (presumably the mark referenced in the third-party registration applicant has made of record; see *supra*). The article states that, as a result of the decision, "Fuente can continue selling its cigars."⁵

It is settled that third-party registrations are not evidence that the marks depicted therein are in use or that the public is aware of them, and they are thus of no probative value under the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). As for the Wine Spectator article, if we assume that it can be deemed to be evidence of Fuente's use of OPUS X as a mark for cigars, we find that it

⁵ Applicant submitted these exhibits to its November 8, 1999 response in order to rebut the Trademark Examining Attorney's argument, made in the first Office action, that wine and restaurant services are related because wine is served at restaurants. Applicant argued that if candy, nuts, coffee, tobacco and cigars, all of which can be served or enjoyed at restaurants, can coexist on the Register with OPUS ONE wine, "then there is no reason to believe that OPUS ONE restaurant services is likely to cause confusion." Applicant concluded by arguing that, "[a]ccordingly, [the] number and nature of similar marks in use is a *du Pont* factor that weighs against a likelihood of confusion." (November 8, 1999 response, at 8.) After this November 8, 1999 response, applicant never again referred to or offered any argument concerning these exhibits, either in its March 10, 2000 Request for Reconsideration or in its opening or reply briefs on appeal. However, inasmuch as the exhibits are of record, we have considered them for whatever probative value they might have.

is not particularly probative evidence under the sixth *du Pont* factor. We cannot conclude from this article that Fuente's use of the mark OPUS X (or, as registered, FUENTE OPUS X) has been so extensive as to affect the scope of protection to be afforded to registrant's mark. More importantly for purposes of the sixth *du Pont* factor, it appears from the court's decision dismissing the infringement action that OPUS X and OPUS ONE are not similar marks, and/or that cigars and wine are not similar goods.

Having found that registrant's mark is a strong, arbitrary mark and that applicant's mark is identical thereto, we turn next to a consideration, under the second *du Pont* factor, of the similarity or dissimilarity between applicant's "restaurant services" and registrant's "wine." It is not necessary that these respective goods and services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an

association or connection between the sources of the respective goods or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion. Where the applicant's mark is identical to the registrant's mark, as it is in this case, there need be only a viable relationship between the respective goods or services in order to find that a likelihood of confusion exists. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

However, as noted above, the requisite "viable" relationship between registrant's goods and applicant's services, even if they are sold under identical marks, must consist of "something more" than the fact that registrant uses the mark on a food or beverage item (wine) and applicant uses the mark in connection with restaurant

services. In addition to the "something more" derived from the arbitrary, strong nature of registrant's mark, we also find the requisite "something more" to exist in the nature of the commercial relationship between wine and restaurant services.

It is undisputed that restaurants commonly serve wines by the bottle, and that patrons of a restaurant are exposed to both the restaurant's service mark and to the trademarks with which the wines are labeled and by which they are listed on the restaurant's wine list. To that extent, applicant's "restaurant services" and registrant's "wine" clearly are complementary goods and services which may be encountered together by the same purchasers.⁶ Indeed, the record in this case reveals that registrant's OPUS ONE wine is offered and served by applicant at its OPUS ONE restaurant. The fact that applicant's restaurant serves the type of goods (indeed the actual goods) identified in the cited registration is certainly probative evidence which

⁶ This complementary relationship also is evident in the well-known expression "wine and dine," which is defined as "to entertain lavishly" (The Random House College Dictionary, 1509 (Rev. Ed. 1982); see also the references to the expression in the verb definition of "wine" in Webster's Third New International Dictionary (1993): "vt : to treat to wine : provide with wine esp. at a dinner < would ~ and dine the ... members of Congress - *American* > ~ vi : to drink wine esp. with a dinner < *wined* and dined with the leading citizens of each country during his tour of Europe >."

supports a finding under the second *du Pont* factor that applicant's services and opposer's goods are related. See, e.g., *In re Azteca Restaurant Enterprises Inc.*, *supra*; *In re Golden Griddle Pancake House Ltd.*, *supra*; *In re Mucky Duck Mustard Co., Inc.*, *supra*; and *In re Appetito Provisions Co., Inc.*, *supra*.

The Trademark Examining Attorney further contends that purchasers who encounter the same or a similar mark used in connection with both wine and restaurant services are likely to assume that a source connection between the two exists, because, according to the Trademark Examining Attorney, it is an increasingly common practice in the industry for restaurants to offer and serve to their patrons "private label" wines which are named after the restaurant, i.e., wine which is specially-made for the restaurant and served in bottles labeled with the restaurant's service mark. In support of this contention, he has submitted excerpts of thirty-five articles obtained from the NEXIS automated database.⁷

⁷ The Trademark Examining Attorney's search request was "private label wines w/10 restaurants" in the NEWS library, ALLNWS file. The search retrieved thirty-five articles, all of which the Trademark Examining Attorney printed out in KWIC format. Eight of the excerpts (nos. 4, 14, 16, 17, 21, 24, 26 and 33) have not been considered herein, inasmuch as they are either newswire stories (presumably unpublished), stories from foreign publications, or duplicates (of excerpts retrieved from the same edition of the same publication).

Applicant argues that this NEXIS evidence does not prove the Trademark Examining Attorney's contention that it is common in the industry for restaurants to serve private label wines named after the restaurants themselves, or that consumers are aware of such a practice and would accordingly assume the existence of a source connection between wines and restaurant services offered under the same mark.

Applicant notes that in several of the stories the private label wine in fact is not named after the restaurant, citing the Chateau de Beaupre 1995 private label wine served by Chicago's Le Colonial (story no. 1), the Kiawah private label wine served by the Jasmine Porch Restaurant (story no. 3), the Wycliffe private label wine served by various restaurants (story no. 18), "a Merlot del Vento and a Pinot del Vento" served as private label wines by Sfuzzi restaurants (story no. 29), and the Proprietors' Selection Chardonnay and the Beaujolais Villages private label wines served by Bistro 110 (story no. 31).

We note, however, that story no. 9 suggests by its headline, "Branding your own at Harris Ranch," that Harris Ranch's private label wine is sold under "Harris Ranch" brand name. Story no. 19 states, right in its headline, that "restauranters use their names on fine wines." Story no. 27 states that "a private label wine means both prestige

and profit for the restaurant offering it. Moreover, the bottle has souvenir value." The "souvenir value" of the bottle would undoubtedly be derived from the appearance of the restaurant's name on the label, which would serve to remind the restaurant patron of his presumably pleasurable dining experience. Story nos. 32 and 34 inform readers that a restaurant can contract for production of, and offer to its patrons, a custom-designed wine labeled with the restaurant's name or logo; story no. 34 further notes that such private label wine "has the image appeal that many customers want when they go out to dine."⁸

These articles inform their readers, who may include potential purchasers of wine and of restaurant services, that a restaurant may in fact have a private-label wine named after itself. Being aware of that possibility, purchasers are more likely to assume, upon encountering a wine and a restaurant bearing the same mark, that the wine is the restaurant's private label wine or that some other source connection between the wine and the restaurant exists, and they are less likely to assume that it is a mere

⁸ With respect to the remaining NEXIS excerpts which make reference to restaurants offering private label wines, it is not clear from the excerpts themselves that those private label wines are named after the restaurants which offer them, but neither is it clear that they are not so named.

coincidence that the restaurant and the wine use the same mark.

Furthermore, the NEXIS evidence made of record by the Trademark Examining Attorney informs readers that a restaurant's private label wines may also be made available for separate retail sale. Story no. 6 refers to a restaurant which, under two separate liquor licenses, both serves alcohol and sells packaged liquor in the form of private-label wines. Story no. 28 refers to the California Culinary Academy's plans for retail distribution of the private label wines it serves at its public restaurants. It has been held that the requisite relationship between restaurant services and food items exists where a restaurant separately packages and sells food items under the restaurant's mark. *See, e.g., In re Azteca Restaurant Enterprises Inc., supra* (Mexican restaurant selling jars of salsa bearing restaurant's mark).

Finally, purchasers encountering wine and restaurant services offered under a single mark may reasonably assume that the winery which produces the wine has some source or sponsorship connection with the restaurant. The NEXIS evidence includes articles from The Indianapolis Star (story no. 11) and the Greater Cincinnati Business Record (story no. 20) which refer to the "Chateau Pomije Winery and

Restaurant" which, readers might reasonably assume, offers both its wine and its restaurant services under a single mark. Additionally, the evidence of record with respect to applicant's relationship to registrant's winery, discussed in further detail *infra*, supports a finding that purchasers might reasonably assume that a source connection exists where, as here, a restaurant is touted as being "named after" a particular wine.

In summary, we find that in addition to the "something more" which is to be found in the strength of registrant's mark and the broad scope of protection to which it is entitled, the requisite "something more" required by *Jacobs v. International Multifoods Corporation, supra*, may also be found in this case in the nature of the relationship between restaurant services and wine, especially those involved in the present case.

Applicant argues that the evidence of record with respect to several other of the *du Pont* factors weighs in its favor in this case, namely, the high cost of the applicant's and registrant's respective goods and services and the resulting care and sophistication with which they are purchased (the fourth *du Pont* factor); the absence of actual confusion, despite the opportunity therefor (the seventh and eighth *du Pont* factors); and the market

interface between applicant and registrant (the tenth *du Pont* factor). We shall address each of these issues in turn.

Applicant is correct in noting that if the goods and/or services at issue are expensive, such that purchasers may be expected to be more careful and sophisticated in making their purchasing decisions, the likelihood of confusion is decreased. See *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Applicant has offered evidence to show that registrant's OPUS ONE wine is an expensive wine; press reports indicate that the 1996 vintage of the wine retails for \$125 a bottle and is served by restaurants for \$220 a bottle.⁹ Applicant contends that its restaurant services likewise are upscale and expensive, with a dinner for two (without drinks) said to cost approximately \$150.¹⁰ The Trademark Examining Attorney has conceded that registrant's wine and applicant's restaurant services are expensive. (Brief, at 8.)

However, applicant's evidence concerning the expensive nature of applicant's restaurant services and of

⁹ See applicant's November 8, 1999 Response to the first office action, at Exhibit 1 (The Washington Post, October 26, 1999), and Exhibit 4 (The San Jose Mercury News, October 20, 1999).

¹⁰ See applicant's November 8, 1999 Response to the first office action, at Exhibit 2 (applicant's menu).

registrant's wine, as well as the Trademark Examining Attorney's concession that applicant's and registrant's respective goods and services are expensive, are legally irrelevant and cannot be considered in our likelihood of confusion analysis. That analysis must be made on the basis of the goods and services as they are identified in applicant's application, i.e., "restaurant services," and in registrant's registration, i.e., "wine," regardless of what the evidence might show as to the nature of applicant's and registrant's actual goods and services. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Applicant's "restaurant services" therefore must be presumed to encompass inexpensive or moderately-priced restaurant services, and registrant's "wine" must be presumed to encompass inexpensive or moderately-priced wine. In view thereof, applicant's arguments regarding the high cost of its actual restaurant services and of registrant's actual wine, and the resulting carefulness and sophistication of the purchasers, miss the mark. See *In re Bercut-Vandervoort & Co.*, 229 USPQ2d 763 (TTAB 1986) (rejecting the applicant's arguments regarding the high cost and quality of its wine and the sophistication of its purchasers, where application identified goods merely as "wine").

There is no evidence in the record from which we might conclude that wine and restaurant services, in general, are necessarily expensive, or that purchasers thereof are necessarily sophisticated and careful in making their purchasing decisions. Accordingly, this *du Pont* factor does not weigh in applicant's favor in this case.

Applicant next argues that the evidence of record, especially the declaration of applicant's president James E. Kokas and the exhibits thereto, establishes that there has been no actual confusion between applicant's mark and registrant's mark despite substantial opportunity for such confusion to have arisen, and that the seventh and eighth *du Pont* factors accordingly weigh heavily in favor of a finding of no likelihood of confusion.¹¹

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 no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any

¹¹ The seventh and eighth *du Pont* factors are "the nature and extent of any actual confusion," and "the length of time and conditions under which there has been concurrent use without evidence of actual confusion." 177 USPQ at 567.

significant opportunity for actual confusion to have occurred. See, e.g., *In re Jeep Corporation*, 222 USPQ 333 (TTAB 1984); *In re Barbizon International, Inc.*, 217 USPQ 735 (TTAB 1983).

Applicant argues, however, that in the case of *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992), the Board "identified three factors in an *ex parte* setting which allows it to assess the probative value of the absence of actual confusion," i.e., "a long period of marketing success," "marketing expensive products and services," and "no reported instances of confusion." (Reply brief, at 7.) Applicant contends that, as in *General Motors*, there exists in this case a "confluence of facts" which justifies giving significant probative weight to the absence of any evidence of actual confusion.

Specifically, applicant contends that it has enjoyed a long period of marketing success, inasmuch as it has been rendering restaurant services under the OPUS ONE mark for thirteen years and has received many national awards, including the Wine Spectator Award of Excellence every year since 1988. Applicant also contends, as noted above, that its restaurant services are expensive, with dinner for two costing approximately \$150 (without drinks). Applicant argues that, in fact, there has been substantial opportunity

for actual confusion between applicant's mark and registrant's mark to have occurred, inasmuch as the respective goods and services are offered together to the same purchasers, as evidenced by the fact that applicant's OPUS ONE restaurant sells six hundred bottles of registrant's OPUS ONE wine every year. (Kokas Decl., ¶¶4-5.) Despite this opportunity for actual confusion to have occurred, applicant argues, no instances of actual confusion have been reported, as evidenced by paragraphs 6-7 of Mr. Kokas' declaration, in which he states that he "would be aware of virtually any inquiry about the relationship of OPUS ONE wine and OPUS ONE restaurant services because of my availability to customers" and that "there have been no reported instances of confusion between OPUS ONE wine and OPUS ONE restaurant services." Finally, applicant argues that it is not dispositive that we have not heard from registrant in this *ex parte* case on the issue of actual confusion: "... because of the relationship between Opus One and registrant and because the registrant has not reported any instances of confusion to Opus One, it may be logically deduced that the registrant has not received any reasonable instances of confusion." (Reply brief, at 6.)

We have carefully considered applicant's arguments, but we are not persuaded that the apparent absence of actual

confusion is entitled to significant weight in this case. Initially, we are not persuaded by applicant's argument that a "confluence of facts" of the type that was found in *General Motors* is present in this case. Indeed, *General Motors* is readily distinguishable on its facts in several important respects. First, in *General Motors*, the applicant had been selling goods under its mark nationwide for nearly thirty years without any reported instances of actual confusion; by contrast, applicant herein has used its mark for thirteen years, operating a single restaurant in a single city. Second, and relatedly, the *General Motors* applicant's GRAND PRIX mark for automobiles had achieved nationwide renown and prominence, as evidenced by the national scope of the applicant's advertising and the applicant's sale of 2.7 million such automobiles nationwide over approximately thirty years; we cannot conclude on this record that applicant's OPUS ONE restaurant services have achieved the same degree of national renown and prominence. Third, even assuming that applicant's restaurant services are expensive for restaurant services, they clearly are not of the same cost magnitude as were the goods involved in *General Motors*, i.e., automobiles, which the Board found to be "a major and expensive purchase" for most consumers. Finally, and most importantly, the GRAND PRIX mark involved

in *General Motors* was found to be highly suggestive as applied to the prior registrant's automobile parts, and therefore entitled to only a narrow scope of protection. By contrast, registrant's OPUS ONE mark for wine is, as discussed above, a strong mark entitled to a broad scope of protection. Thus, to the extent that *General Motors* sets forth an exception to the general rule that the absence of evidence of actual confusion is entitled to little probative weight in an ex parte case, we find that applicant does not fall within that exception.

We also are not persuaded by applicant's argument that, due to the close relationship between applicant and registrant, registrant would have informed applicant of any instances of actual confusion of which registrant had been made aware. "It should also be noted that competent evidence of actual confusion is difficult to come by where as here both applicant and registrant may be performing their respective activities in a commendable or exemplary fashion." *In re Richard Bertram & Co.*, 203 USPQ 286, 291 (TTAB 1979).

Finally, we are not persuaded on this record that the absence of any reported instances of actual confusion on the part of applicant's restaurant customers is necessarily attributable to any assumption or understanding by those

customers that there is no source connection between applicant and registrant, or to any belief on their part that it is a mere coincidence that applicant's restaurant and registrant's wine have the same name. Rather, we find it to be equally plausible that if applicant's restaurant customers have not inquired as to the existence of any source relationship between applicant and registrant, it is because they already assume that applicant is using the OPUS ONE mark pursuant to an agreement or arrangement with registrant, and with registrant's permission and consent.

Such an assumption on the part of applicant's customers certainly would be reasonable in light of the publicity surrounding the opening of applicant's restaurant in 1988. The Detroit News of January 11, 1988 (Kokas Decl., Exh. 1) reported that the Mondavi family "approved the restaurant's use of the name of winery's famous Opus One wine..." and that "[s]uch a request has never before been granted, [Tim] Mondavi explained. After much study, he said, the winery felt the restaurant would have the same mark of quality as the wine." Applicant's customers and potential customers reasonably could and would gather from this article that applicant had specifically requested permission from Mondavi to use the OPUS ONE name, that Mondavi had approved that request, and that such approval is the reason applicant is

entitled to use the name. We further note that other contemporary reports in the Detroit press about the opening of the OPUS ONE restaurant included specific references to "the Napa Valley winery of the same name," and to OPUS ONE wine as the restaurant's "namesake." (*Id.*)

Similarly, applicant's own February 1991 newsletter to its customers (Kokas Decl., Exh. 2) makes specific reference to registrant's "Opus One label, for which our restaurant is named." In its September 1997 newsletter (Kokas Decl., Exh. 3), applicant promoted its sponsorship of two 1997 fundraiser benefits for the Detroit Opera House by informing customers that the events "will be held in conjunction with Robert Mondavi Winery, and will showcase a range of Mondavi wines exclusively," and that the events would include a Grand Prize drawing for a trip to Napa Valley featuring a stay at Michael Mondavi's guest house and a tour of the Opus One winery. Finally, we note that applicant's newsletters and the news articles applicant has made of record inform their readers, who are or include applicant's customers, that representatives from registrant's winery were present and prominently honored at major events in the restaurant's history, such as the restaurant's opening in 1988, the restaurant's special "Winemaker Dinner" in 1991, and the restaurant's tenth anniversary celebration in 1997.

In light of this evidence, it is plausible that applicant's restaurant customers, instead of assuming that it is a mere coincidence that both the restaurant and the winery use the arbitrary mark OPUS ONE, rather would assume that there is a source, sponsorship, or license-type arrangement between applicant and registrant which allows for, and accounts for, applicant's use of registrant's mark. Similarly, if Mr. Kokas and other restaurant personnel, in responding to inquiries from customers as to why the restaurant bears the same name as the wine, were to reply (as applicant has stated in its customer newsletters) that the restaurant is "named after the wine," it is plausible to assume that this response would satisfy the customer and that no further inquiry would ensue.

We hasten to add that we are not saying that the evidence of record establishes with certainty that applicant's customers are, in fact, actually confused as to the nature of the relationship between applicant and registrant as a result of applicant's use of registrant's mark. We are merely saying that we cannot conclude on this record, as applicant would have us conclude, that there in fact has been no actual confusion.

In summary, we are not persuaded that the absence of any evidence of actual confusion is entitled to significant

weight in our likelihood of confusion analysis, and we therefore find that the seventh and eighth *du Pont* factors to be essentially neutral in this case.

We turn next to applicant's arguments regarding the "market interface" between applicant and registrant, under the tenth *du Pont* factor.¹² Applicant argues that registrant is and has long been aware of applicant's use of the OPUS ONE mark in connection with its restaurant services, and that registrant has not complained of or objected to such use by applicant, but rather has affirmatively encouraged it. Applicant argues that registrant accordingly has authorized, consented to and/or acquiesced in applicant's use of the mark, a fact which should weigh heavily in favor of a finding under the tenth *du Pont* factor that confusion is not likely.

In support of this argument, applicant relies on Mr. Kokas' declaration and the exhibits thereto, which show, applicant contends, that registrant has made and continues to make substantial sales of its OPUS ONE wine to applicant

¹² The tenth *du Pont* factor is "the market interface between applicant and the owner of a prior mark: (a) a mere "consent" to register or use; (b) agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party; (c) assignment of mark, application, registration and good will of the related business; (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion." 177 USPQ at 567.

(Kokas Decl. ¶¶4-5); that prior to the opening of applicant's restaurant, Marci Mondavi (Robert Mondavi's daughter) learned and "was thrilled to hear" that applicant planned to name its restaurant OPUS ONE (Kokas Decl. ¶8); that shortly after the opening of the restaurant, Robert Mondavi himself congratulated applicant by sending applicant six bottles of the original vintage of OPUS ONE wine from his personal cellar (Kokas Decl. ¶9); that, since the opening of the restaurant, Robert Mondavi Winery representatives have attended and participated in numerous winetasting events at the restaurant and have made numerous sales calls at the restaurant (Kokas Decl. ¶10); that, as noted above, Tim Mondavi, managing partner of Robert Mondavi Winery, was the featured guest at applicant's grand opening celebration in 1988, at a 1991 "Winemaker Dinner" special event at the restaurant, and at the restaurant's tenth anniversary celebration in 1997 (Kokas Decl. ¶¶11-12); and that, as also noted above, the restaurant's tenth anniversary celebration included a Grand Prize drawing for a trip to Napa Valley featuring a stay at Michael Mondavi's guest house and a tour of the Opus One winery (applicant's September 1997 newsletter, in Exhibit 3 to the Kokas declaration).

Finally, applicant places special emphasis on (and apparently cites for its factual accuracy) the above-referenced January 11, 1988 article from The Detroit News which reported, apparently based on an interview with Tim Mondavi at applicant's grand opening celebration, that the Mondavi family had "approved the restaurant's use of the name of the winery's famous Opus One wine" and that, although "such a request has never before been granted," the winery, "after much study, ... felt the restaurant would have the same mark of quality as the wine." (Kokas declaration, Exhibit 1.)

Based on this evidence, applicant argues that "[r]egistrant's conduct, through its managing partner and winemaker Tim Mondavi[,] constitutes affirmative acts of encouragement. It implicitly, if not explicitly authorized Opus One to use the OPUS ONE service mark in connection with restaurant services" (Brief, at 7); that "[t]he market interface between Opus One and registrant evidences registrant's consent to the use of OPUS ONE for restaurant services" (*id.*, at 17); that "[t]hrough its actions or inaction, registrant implicitly, if not explicitly, authorized Opus One to use the OPUS ONE service mark in connection with its restaurant services" (Reply Brief, at 6); and that "registrant has implicitly, if not explicitly,

consented to [applicant's] use of OPUS ONE for restaurant services by virtue of its acquiescence in the use of OPUS ONE for restaurant services and its attendance at events sponsored by Opus One" (*id.*, at 11).

Nearly all of the reported decisions involving the tenth *du Pont* factor, which deals generally with "the market interface between applicant and the owner of a prior mark," have focused on factor 10(a), "a mere 'consent' to register or use," and on factor 10(b), "agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party." These cases teach that a "naked" consent to register or use is entitled to little probative weight in the likelihood of confusion analysis, but that if the applicant and the prior user have entered into an agreement which evidences their business-driven conclusion and belief that there is no likelihood of confusion, and which includes provisions designed to avoid any potential confusion, the existence of such an agreement weighs heavily in favor of a finding that confusion is not likely. See, e.g., *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *Bongrain Int'l (Am.) Corp. v. Delice De France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and *In re du Pont*, *supra*.

In the present case, however, we have neither a consent from registrant (as contemplated by *du Pont* factor 10(a)), nor an agreement between applicant and registrant (as contemplated by *du Pont* factor 10(b)).¹³ Instead, the "market interface" asserted by applicant in this case is the alleged "laches and estoppel attributable to owner of prior mark and indicative of lack of confusion," under *du Pont* factor 10(d).

It is settled that the equitable defenses of laches, acquiescence and estoppel are not applicable in *ex parte* proceedings. That is, notwithstanding the language of *du Pont* factor 10(d), the applicant in an *ex parte* appeal of a Section 2(d) refusal may not rely on "laches and estoppel attributable to the owner" of the prior registration as affirmative "defenses" to the refusal. The owner of the prior registration is not a party to the applicant's *ex*

¹³ As noted above, applicant has strenuously argued, based on its evidence of the long-standing amicable relationship between applicant and registrant, that registrant has "implicitly, if not explicitly" authorized and consented to applicant's use of the OPUS ONE mark. However, to the extent that applicant is arguing that registrant's alleged "implicit consent" to applicant's use of the mark constitutes a "consent" under *du Pont* factor 10(a) or an "agreement" under *du Pont* factor 10(b), we reject the argument. We will not impute such a consent or agreement to registrant in the absence of explicit documentary evidence thereof. There is no indication in the record that applicant ever sought to obtain a consent or agreement from registrant, nor is it apparent that registrant is even aware that applicant has applied to register the mark.

parte appeal; accordingly, any equitable defenses, including laches and acquiescence, which the applicant might be able to assert against the registrant in an inter partes case are unavailable to the applicant in an ex parte proceeding. See *In re National Distillers and Chemical Corporation*, 132 USPQ 271 (CCPA 1962); and *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984).¹⁴

However, under *du Pont* factor 10(d), evidence which would support an applicant's affirmative defenses of laches or acquiescence in an inter partes proceeding between the applicant and the prior registrant might also be entitled to some probative value in the applicant's ex parte appeal, at least to the extent that it "is indicative of a lack of confusion," i.e., to the extent that it shows that the prior registrant believes that confusion is not likely to result from applicant's use of the mark it seeks to register. See *In re Collegian Sportswear Inc.*, *supra*.¹⁵

¹⁴ Regarding the availability of laches, estoppel and acquiescence as defenses in inter partes proceedings, see generally *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

¹⁵ However, any such evidence upon which an applicant in an ex parte appeal might rely under *du Pont* factor 10(d) must pertain to the "market interface" between the applicant and the prior registrant; applicant may not rely, *jus tertii*, on laches or estoppel which could be asserted against the prior registrant

It appears from the evidence submitted by applicant that registrant is and has always been aware of applicant's use of OPUS ONE as the name of its restaurant in Detroit, Michigan; that registrant and applicant have had ongoing commercial dealings with each other, in that registrant's representatives make regular sales calls to applicant's restaurant, and applicant purchases from registrant and sells to its restaurant patrons approximately six hundred bottles of registrant's OPUS ONE wine per year; that representatives of registrant's winery were active participants in, and featured guests at, the grand opening of applicant's restaurant in 1988, at a restaurant "Winemaker Dinner" special event in 1991, and at the tenth anniversary celebration of applicant's restaurant in 1997; and that, on this record, registrant apparently has never complained of or objected to applicant's use of the OPUS ONE mark in connection with its restaurant.

We cannot conclude, however, that registrant's actions and/or inaction with respect to applicant's use of the OPUS ONE mark, as detailed by applicant, are necessarily attributable to, and necessarily evidence of, a business-driven belief on the part of registrant that there is no

only by a third party with whom applicant is not in privity. See *In re Wilson*, 57 USPQ2d 1863, 1868-69, n.13 (TTAB 2001).

likelihood of confusion. Rather, registrant's conduct, particularly the fact that registrant has not objected to applicant's use of the mark, reasonably might also be attributable to a belief on registrant's part that applicant is using the mark pursuant to registrant's approval and permission, and that registrant has the right to require applicant to cease using the mark in the event that the quality, nature or extent of applicant's restaurant services were to change in a way detrimental to registrant's interests. Indeed, the most direct evidence in the record as to registrant's belief or opinion with respect to applicant's use of the OPUS ONE mark supports such a conclusion. The January 11, 1998 article from The Detroit News, which applicant has cited and relied upon for its factual accuracy, reveals that, according to Tim Mondavi, the Mondavi family approved applicant's request to use the OPUS ONE name because, after much study, "the winery felt the restaurant would have the same mark of quality as the wine." Implicit in this statement is Mr. Mondavi's belief that, if applicant's restaurant were to no longer have the same mark of quality as the wine, the winery would no longer approve of the restaurant's use of the OPUS ONE name.

Again, we are not saying that registrant in fact holds this belief as to the nature of applicant's rights in the

OPUS ONE mark. We find merely that, on this record, registrant's lack of objection to applicant's use of the mark, which applicant attributes to registrant's belief that there is no likelihood of confusion, may be equally attributable to registrant's belief that applicant's use of the OPUS ONE mark is at registrant's sufferance and is currently unobjectionable, given the apparently high quality and geographically limited scope of applicant's restaurant services. Because that reasonable possibility exists, we cannot conclude that registrant's conduct necessarily is "indicative of a lack of confusion," within the meaning of *du Pont* factor 10(d). Just as we will not infer from this record that registrant has consented or agreed to applicant's registration of the mark, see *supra* at footnote 13, so also we will not impute to registrant, for purposes of *du Pont* factor 10(d), a belief that confusion is unlikely.

Likewise, even if registrant has to date voiced no objection to applicant's use of the OPUS ONE mark in connection with a single, high quality restaurant in Detroit, Michigan, we will not assume, on this record, that registrant has no objection to the issuance of a federal registration to applicant. If registrant in fact has no such objection, there is available to applicant in a future

application a type of evidence which, under *du Pont* and subsequent case law, is entitled to great weight in the likelihood of confusion analysis, i.e., a valid consent agreement between applicant and registrant. The evidence of record applicant relies on in the present case simply does not suffice as a substitute for such an agreement. We have given that evidence due consideration, but conclude that the tenth *du Pont* evidentiary factor, i.e., the "market interface" between applicant and registrant, does not weigh in applicant's favor to any significant degree in this case.

In summary, we have carefully considered all of the evidence of record pertaining to the *du Pont* evidentiary factors, as well as applicant's arguments with respect thereto. For the reasons discussed above, we conclude that a likelihood of confusion exists, and that registration of applicant's mark is barred under Trademark Act Section 2(d). Any doubts as to this conclusion must be resolved against applicant. *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register is affirmed.