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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mendocino Brewing Company

Serial No. 76/026,048

Anthony P. Vecino of Coblenz, Patch, Duffy & Bass for
Mendocino Brewing Company.

Elizabeth A. Hughitt, Trademark Examining Attorney, Law
Office 111 (Kevin R. Peska, Acting Managing Attorney).

Before **Cissel**, Seeherman and Bottorff, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 12, 2000, applicant, a California
corporation, filed the above-identified application to
register the mark BLACKHAWK STOUT on the Principal Register
for "malt beverages, namely, beer, ale and stout," in Class
32. Use of the mark in commerce in connection with these
products since 1983 was claimed. Applicant disclaimed the
exclusive right to use the word "STOUT" apart from the mark
a shown.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark so resembles the mark BLACKHAWK, which is registered¹ for "restaurant and catering services," that confusion is likely. Submitted in support of this refusal to register were copies of a dozen third-party registrations wherein the lists of goods and services include both restaurant services and beer, ale, stout, porter and/or malt liquor. The Examining Attorney reasoned that confusion is likely because the marks are very similar and because beer is commercially related to restaurant services.

Applicant responded to the refusal to register with argument that confusion is not likely because its mark is distinguishable from the cited registered mark, because applicant's goods are different from the services rendered under the registered mark, and because the ways in which applicant and the owner of the cited registration actually use their marks and the trade dress in which their products are presented make confusion unlikely. In support of this argument, applicant submitted copies of pages retrieved

¹ Reg. No. 918,209 issued on the Principal Register on August 10, 1971 to Roth, Inc.; affidavit under Section 8 of the Act accepted; renewed twice.

from the registrant's website. Additionally, applicant argued that the state of Illinois, where registrant's restaurant is located, has stringent statutory regulations governing the brewing of beer on the premises of a restaurant (copies of the regulations were attached), so that in Illinois, at least, expanding restaurant services to include brewpub services is not an ordinary expansion of the restaurant business.

The Examining Attorney was not persuaded by applicant's arguments, and in her second Office Action, she made the refusal to register final. In further support of the refusal, she made of record additional third-party registrations wherein the listed goods and services include both beer and restaurant services. In some of these registrations, the restaurant services are further narrowed to "microbrewery restaurant services" or "brewpub" services. Additionally, excerpts from various publications and a beer encyclopedia were submitted to show that a brewpub is a type of restaurant which brews and serves its own beer on the premises; that brewpubs are a growing trend in the beer industry; and that many restaurants now serve private-label beers. The Examining Attorney maintained her position that applicant's beer, ale and stout are sufficiently related to the restaurant services identified

in the cited registration that the use of these two very similar marks in connection with both would be understood as an indication that these goods and services emanate from a common source.

Applicant concurrently filed a request for reconsideration and a Notice of Appeal. The Board instituted the appeal, but suspended action on it and remanded the application file to the Examining Attorney for reconsideration in view of applicant's request. She reconsidered the refusal to register in light of applicant's arguments, issued a brief Office Action maintaining the refusal to register and returned the application to the Board for resumption of action on the appeal. Both applicant and the Examining Attorney filed appeal briefs, but applicant did not request an oral hearing before the Board.

The sole issue before the Board in this appeal is whether confusion is likely between applicant's mark, BLACKHAWK STOUT, for malt beverages, namely beer, ale and stout, and the mark BLACKHAWK, which is registered for restaurant and catering services. Based on careful consideration of the record, the arguments presented by applicant and the Examining Attorney and the relevant legal

precedents, we hold that confusion is likely and that the refusal to register is therefore well taken.

The predecessor to our primary reviewing court set forth the factors to be considered in determining whether confusion is likely in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). First, we must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. Then, we must compare the goods and services to determine if they are related or if the activities surrounding their marketing are such that confusion as to source or origin is likely. In this regard, we consider similarities in the channels of trade and the people who purchase the goods and services.

Contrary to applicant's contention that these marks create distinct commercial impressions, applicant's mark is very similar to the registered mark. Applicant's argument is based on consideration of its label specimen and copies of pages from registrant's website, but it is well settled that in comparing the marks, we must consider only the marks as depicted in the application drawing page and the registration, respectively. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2002).

On this record, we have no basis upon which we could conclude that these marks create different commercial impressions. It is well settled that under appropriate circumstances, one feature or element of mark may be recognized as playing a more significant role in creating the commercial impression of a mark. Greater weight is properly given to that dominant portion in determining whether confusion is likely. In re National Data Corp., 224 USPQ 749 (Fed. Cir. 1985). While the generic, and hence disclaimed, portion of applicant's mark, STOUT, cannot be ignored, we can recognize that this word has no source-identifying significance when it is combined with BLACKHAWK and used in connection with stout. The mere addition of a generic word is insufficient to overcome a finding of likelihood of confusion under Section 2(d) of the Act. In re Corning Glass Works, 229 USPQ 65 (TTAB 1985). In the case at hand, these two marks create commercial impressions which are the same.

When the marks at issue resemble each other this much, the relationship between the goods or services of the applicant and the registrant does not have to be as close in order to find confusion likely as would be the case if the marks were less similar. Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70 (TTAB 1981). Moreover, even

when the marks are not this close, the goods or services do not have to be identical or even directly competitive in order to find that confusion is likely. Rather, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same people under circumstances that could give rise to the mistaken belief that the goods and services come from one source. As noted by the Examining Attorney, the proper comparison of the goods and services must be based on the ways that they are identified in the application and registration, respectively, and not on any extrinsic evidence as to what the goods or services actually offered in the marketplace are. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In the case at hand, the Examining Attorney made of record thirty-two third-party registrations for goods and services which include both beer and restaurant services; a listing from The Encyclopedia of Beer and excerpts from published articles which show that brewpubs are a type of restaurant specializing in beer and that restaurants sell private-label beers. This evidence clearly establishes that restaurant services are related to beer in such a way

that the use of similar marks in connection with both is likely to cause confusion.

Applicant argues to the contrary, however, contending that all these third-party registrations, the dictionary listing and the excerpts from publications do not satisfy the requirement for the Examining Attorney to prove that the goods and services in question are related. Applicant cites *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), for the proposition that in order to establish that confusion is likely, the Examining Attorney must show "something more" than just that similar marks are used for both food products and restaurant services. Applicant argues that this record does not show that the owner of the cited registration is engaged in providing brewpub restaurant services or sells private-label beer products, or, for that matter, that it "places any significant commercial focus on beer." (brief p. 2).

We agree with the Examining Attorney, however, that the "something more" required by the Court in the Lloyd's case has been provided in the case at hand. The third-party use-based registrations, although not evidence of the use of the marks shown therein or that the public is familiar with them, nevertheless have probative value to

the extent that they serve to suggest that the listed goods and services are of the type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988). The dictionary definition and the excerpts from published articles demonstrate that the ordinary consumers who purchase beer and stout have reason to expect these products to be available in restaurants, and that some restaurants offer private-label beers and/or brew their own beer. This evidence plainly satisfies the test established by the court for demonstrating that the goods identified in the application are related to restaurant services.

Applicant's argument that because significant legal barriers exist in Illinois which would make registrant unlikely to expand its business to include brewpub services is not well taken. As the Examining Attorney points out, the scope of registrant's services is properly determined by reference to the recitation of services in the registration, in this case "restaurant and catering services." We must interpret the term "restaurant services" as including services rendered in all types of restaurants, including the type known as brewpubs, wherein beer and stout are made and sold. It would not be

inconsistent with the recitation of services in the cited registration for registrant to be providing brewpub services, or for that matter, for the registrant to offer private-label beers for sale. Whether it would be difficult or easy for registrant to render brewpub services in Illinois is immaterial to our inquiry.

Applicant contends that the Examining Attorney failed to give proper weight to the fact that these two marks were contemporaneously registered for almost seven years, until applicant's registration was canceled for failure to file the required affidavit under Section 8 of the Act; that these marks have been in contemporaneous use for over 18 years with no known instances of actual confusion; and that the interest of the registrant would not be compromised by reversing the refusal to register because if registrant believed it would be damaged by the issuance of a registration to applicant, the registrant could oppose registration. None of these arguments is well taken.

As the Examining Attorney points out, she is not bound by prior decisions of other Examining Attorneys, which may have been based on different records. In re Perez, 21 USPQ2d 1075 (TTAB 1991). The evidence in this record establishes that at this time, it is common for restaurants to brew their own beer and to sell private-label beer.

This may not have been the case ten years ago, when the application which resulted in applicant's prior registration was examined. As noted by applicant (brief p. 2), "Each case must be decided on its own merits and the differences are often subtle ones." *Industrial Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 1199, 177 USPQ 386, 387 (CCPA 1973). Given the evidence in the case at hand that clearly shows that beer and restaurant services are related in today's marketplace, the fact that the prior application was approved does not warrant reversal of the refusal to register in the instant case.

As to applicant's argument that there is no evidence that actual confusion has taken place, it is well settled that such evidence is not necessary in order to resolve the issue before us in this appeal, which is not whether confusion has occurred, but rather whether confusion is likely. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1993).

Applicant's argument that the registrant would be adequately protected if we were to reverse the refusal to register and allow the mark to be published for opposition is similarly not well taken. As the Examining Attorney points out, such an approach would essentially shift the burden of the Examining Attorney to the registrant. This

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argument was explicitly rejected by the court in *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In summary, the Examining Attorney has met his burden of establishing that the use of these very similar marks in connection with both restaurant services and beer is likely to cause confusion within the meaning of Section 2(d) the Lanham Act.

DECISION: The refusal to register is affirmed.