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TTAB

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AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re William Cole Vineyards, LLC

Serial No. 76398982

Montgomery G. Frankel, Esq. for William Cole Vineyards,
LLC.

T. Whittaker-Brown, Trademark Examining Attorney, Law
Office 111 (Craig D. Taylor, Managing Attorney).

Before Seeherman, Drost, and Kuhlke, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 17, 2002, William Cole Vineyards, LLC
(applicant) filed an intent-to-use application to register
the mark WILLIAM COLE VINEYARDS in typed or standard
character form for "wine" in Class 33. Serial No.
76398982. Applicant has disclaimed the term "Vineyards"

and indicated that the name William Cole does not identify a living individual.¹

The examining attorney² ultimately refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because she determined that there was a likelihood of confusion in view of a registration of the mark WILLIAM COLE in typed or standard character form for "alcoholic beverages, namely, wines" in Class 33.³

After the examining attorney made the refusal final, this appeal followed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must 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

¹ Applicant has filed a statement of use alleging January 1, 1997, as its dates of first use anywhere and in commerce.

² The current examining attorney was not the original examining attorney in this case.

³ Registration No. 2664416 issued December 17, 2002.

in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by comparing the goods of applicant and registrant. Registrant's goods are alcoholic beverages, namely, wines and applicant's goods are wines. Therefore, inasmuch as both applicant's and registrant's goods are wine, we must treat the goods as being identical.

Applicant disagrees.

While it is true both subject products - applicant's and registrant's - are wines, there the similarity ends abruptly: Applicant's goods are very high end, very low volume, specialized Napa Valley Cabernet Sauvignons, priced at \$125-180 per bottle, produced in limited quantities of less than 300 cases per year, and directly sold only through applicant's customer's list (a fact supporting the conclusion that "applicant has limited its channels of trade"). Registrant produces a wide variety of different wines in volumes of well over 100,000 cases per year, priced at between \$8 and \$12 per bottle, from the Casablanca Valley in Chile. The two products would never be sold on the same shelf, or even in the same location.

Brief at 3.

It has long been established that we must consider the goods as they are identified in the identification of goods in the application and registration. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set

forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

Therefore, we do not read limitations into the goods based on applicant's or registrant's current use. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Because there are no limitations in the identification of applicant's and registrant's wines, we simply must conclude that both applicant and registrant are selling wines of all types, including expensive and inexpensive wines and wines from similar geographic locations. In a similar case, the board held:

Applicant does not dispute the identity of the goods but, rather, argues that its wine and the wine sold under the cited "PETRUS" trademark are expensive, high-quality wine sold to a small group of extremely sophisticated wine connoisseurs through high-quality

wine and spirits stores and that these well-informed consumers are cognizant of the vineyard naming conventions in France and are sensitized to the vineyard naming practices whereby no connection between vineyards is presumed due to the inclusion of part of one vineyard's name in the name of another nearby, albeit unrelated, vineyard. The problem with this argument is that applicant is attempting to restrict the scope of its goods in its application and the scope of the goods covered in the cited registration by extrinsic argument and evidence while neither the recitation of goods in applicant's application nor the recitation of goods in the cited registration is so restricted. It is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined by an analysis of the marks as applied to the goods identified in the application vis-a-vis the goods recited in the registration, rather than what extrinsic evidence shows those goods to be.

In re Bercut-Vandervoort & Co., 229 USPQ 763, 764-65 (TTAB 1986). See also *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (While the applicant "offered evidence to show that registrant's OPUS ONE wine is an expensive wine ... 'wine' must be presumed to encompass inexpensive or moderately-priced wine"). For purposes of our likelihood of confusion analysis, we must assume that there are no differences between applicant's and registrant's wines.

The identical nature of the goods also requires us to conclude that the purchasers and channels of trade of applicant's and registrant's wines are also identical.

Hewlett-Packard Co. v. Packard Press, Inc., 281 F.2d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) ("[A]bsent

restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers"); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Applicant maintains that "sophisticated wine drinkers are also by their very nature very sophisticated readers of labels and thus very sophisticated distinguishers of winery trademarks." Brief at 3 (emphasis omitted). As we pointed out above, neither applicant's nor registrant's goods are limited to any particular type or price of wine. We must also assume that the purchasers of these products would be identical and that they would include sophisticated and non-sophisticated purchasers. In a case involving champagne and sparkling wines, the Federal Circuit held:

Although some champagne can be expensive, many brands sell for around \$25 a bottle, and sparkling wines for less than \$10 a bottle. Moreover, general consumers, not just connoisseurs, occasionally purchase champagne or sparkling wines on celebratory occasions, with little care or prior knowledge. And even more sophisticated purchasers might be aware that champagne houses offer both types of products under similar marks, and could easily conclude that VEUVE ROYALE was Veuve Clicquot's sparkling wine. This market expansion rationale undercuts Palm Bay's argument that because VCP has never sold a sparkling wine product or low-priced champagne, and that it has always used its CLICQUOT house mark in connection with its sales, consumers would be unlikely to confuse Palm Bay's inexpensive sparkling wine and VCP's slightly more expensive champagne products.

Palm Bay Imports, 73 USPQ2d at 1695.

The next factor that we consider is "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression."

Palm Bay Imports, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). We note that when "marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)). The marks here are WILLIAM COLE and WILLIAM COLE VINEYARDS. Applicant does refer to the marks' "differing fonts" (Reply Brief at 2), but both marks are displayed in typed form so we must assume that the marks can be displayed identically.

Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"); and *Squirtco*, 216 USPQ at 939 ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

As a result, applicant's mark includes the entire registered mark with the only difference being the addition of the disclaimed term "Vineyards." Disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). Here, the term "Vineyards" would be at least descriptive for wines. "Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" *Cunningham*, 55 USPQ2d at 1846, quoting, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). A vineyard is defined as "a plantation of grapevines, esp., one producing grapes for winemaking." *The Random House Dictionary of the*

English Language (unabridged) (2d ed. 1987).⁴ Because both goods are wines that could originate from a vineyard, it is unlikely that purchasers would rely on this term in applicant's mark to distinguish the marks. Thus, the marks WILLIAM COLE and WILLIAM COLE VINEYARDS are very similar. *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and design held likely to be confused with CONCEPT for hair care products).

Applicant also argues that there has been no actual confusion, but this factor is not significant here where we have little evidence of the actual use of applicant and registrant.

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 52 C.C.P.A. 981, 340 F.2d

⁴ We take judicial notice of this definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an ex parte context.

Majestic Distilling, 65 USPQ2d at 1205.⁵

Finally, applicant points out that the original examining attorney did not cite the '416 registration, and the next examining attorney did not cite the mark until after applicant's mark was allowed.⁶ Certainly, the fact that the '416 registration was not cited in the first Office action is regrettable, but this fact does not circumscribe the protection to which the cited registration is entitled. *Accord In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ("[T]hird party registrations relied upon by applicant cannot justify the registration of another confusingly similar mark"), quoting *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

In this case, when we consider that the goods (wine), channels of trade, and purchasers are legally identical, and the marks are very similar (WILLIAM COLE VINEYARDS and WILLIAM COLE), we conclude that there is a likelihood of confusion.

⁵ While applicant also argues that it is "the senior user," (Brief at 5), "[p]riority of use is not an issue in this ex-parte Section 2(d) case." *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373, 1374 n.3 (TTAB 2001).

⁶ The examining attorney reported that because "the application was abandoned, the Office records have been searched again." Final Office Action at 2.

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Decision: The refusal to register applicant's mark
WILLIAM COLE VINEYARDS under Section 2(d) of the Trademark
Act is affirmed.