

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Marisol, LLC

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Serial No. 76600373

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John Joseph Hall for Marisol, LLC

Kelly Boulton, Trademark Examining Attorney, Law Office 102  
(Karen M. Strzyz, Managing Attorney)

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Before Seeherman, Quinn and Mermelstein, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Marisol, LLC has appealed from the final refusal of the Trademark Examining Attorney to register DON THE BEACHCOMBER in standard character form as a trademark for "non-alcoholic cocktail mixes having extracts of natural and artificial beverage flavorings."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15

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<sup>1</sup> Application Serial No. 76600373, filed June 30, 2004, based on Section 1(b) of the Trademark Act (intent-to-use).

U.S.C. §1052(d), on the ground that applicant's mark, if used for its identified goods, so resembles the mark BEACHCOMBER, previously registered for "alcoholic beverages, namely flavored rum,"<sup>2</sup> as to be likely to cause confusion or mistake or to deceive.

After briefing in this appeal was completed, the Board suspended proceedings in view of an appeal that had been filed with the Court of Appeals for the Federal Circuit in a companion case, the outcome of which could have a bearing on the present appeal. The companion application, Serial No. 76600374, involved the identical mark as in the current appeal, but the goods were identified as "alcoholic beverages, namely rum." Registration of that application had been refused on the same ground, namely, that applicant's mark DON THE BEACHCOMBER for rum was likely to cause confusion with BEACHCOMBER for flavored rum, and the Board affirmed the refusal of registration in a decision mailed on August 27, 2007.

The Court issued a decision in the appeal for Application Serial No. 76600374 on June 20, 2008, in which the Court affirmed the Board's decision per curiam. The Board thereupon contacted applicant to see whether it wanted to proceed with the present appeal. Applicant

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<sup>2</sup> Registration No. 2882674, issued September 7, 2004.

informed the Board by telephone that it still wished to pursue the appeal, but it withdrew its request for an oral hearing.

In view thereof, we turn to the issue in the present appeal, which is likelihood of confusion. Because many of the arguments made by applicant and the Examining Attorney are the same as in the appeal of the refusal of the companion application, we will quote at length from the Board's August 27, 2007 opinion.

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

Much of applicant's brief focuses on the first du Pont factor, the similarity or dissimilarity of the marks. The cited mark is BEACHCOMBER; applicant's mark includes this word, and adds to it the words DON THE. The result is that the word BEACHCOMBER, in appearance, pronunciation and meaning, remains as a clear element in applicant's mark. Applicant's mark merely provides some more specific

information; rather than referring to any BEACHCOMBER, it identifies a specific BEACHCOMBER named DON.<sup>3</sup>

Applicant has strenuously argued that the dominant part of its mark is DON, and therefore the presence of this term is sufficient to distinguish DON THE BEACHCOMBER from BEACHCOMBER, while the Examining Attorney has asserted that BEACHCOMBER is the dominant part of the mark. In support of its position applicant has cited a number of cases in which the Board and the courts have said that the first word in a mark is often entitled to greater weight. We do not disagree with the holdings in these cases, but we point out that it is not a rule that the initial word in a mark must be given greater weight. Nor do these cases stand for the principle that, if the first words of marks are different, the marks cannot be confusingly similar.

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<sup>3</sup> Applicant has pointed out that there are various definitions of the word "don," i.e., it is "used as a courtesy title before the name of a man in a Spanish-speaking area"; there are two "chiefly British" meanings, "a head, tutor, or fellow at a college of Oxford or Cambridge," and "a college or university professor"; and it is defined as "the leader of a organized-crime family." The American Heritage Dictionary of the English Language, 4<sup>th</sup> ed. © 2000. We are not persuaded that consumers would view the word "don" in applicant's mark as having any of these meanings. It is not followed by a name, and therefore would not be regarded as a Spanish courtesy title; and it is unclear to what extent consumers in the United States would be aware of the "chiefly British" meanings. In any event, college heads or professors and organized crime leaders are not normally thought of as beachcombers. The only likely connotation of "don" as used in applicant's mark is that of a person's first name.

With respect to the mark DON THE BEACHCOMBER, we find that the word DON is not entitled to greater weight than BEACHCOMBER, since BEACHCOMBER is so intrinsically related to DON as an identifier of who DON is. We also disagree with applicant's claim that "the cadence of a person saying DON THE BEACHCOMBER naturally emphasizes DON and not BEACHCOMBER, since saying BEACHCOMBER after DON THE produces a falling inflection naturally of a person's voice." Brief, p. 10. Both DON and the syllable "BEACH" in BEACHCOMBER have an equal emphasis, and the additional three-syllable word BEACHCOMBER in applicant's mark is at least as aurally significant as the word DON. On the other hand, we do not agree with the Examining Attorney's position that BEACHCOMBER is the dominant part of applicant's mark. The impression created by applicant's mark is the phrase DON THE BEACHCOMBER, and both the name DON and the word BEACHCOMBER must be given weight in our consideration of the mark.

In comparing the marks in their entireties, we must take note of the fact that applicant has appropriated the registrant's mark in its entirety. As the Examining Attorney has pointed out, "the mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under

Section 2(d)." Brief, p. 4. We agree with the Examining Attorney that there is a line of cases holding that the addition of other matter, such as a house mark, primary mark or other material, to one of two otherwise similar marks, is not sufficient to distinguish the marks as a whole. See, generally, *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988); *In re Champion Oil Company*, 1 USPQ2d 1920 (TTAB 1986); *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985); and *In re C. F. Hathaway Company*, 190 USPQ 343 (TTAB 1976). As the Court stated in *Coca-Cola Bottling Company of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975), "When one incorporates the entire arbitrary registered mark of another into a composite mark, inclusion in the composite mark of a significant nonsuggestive element does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion."

There are exceptions to this principle, and additional matter has been found sufficient to distinguish the marks under circumstances where:

- (1) there are recognizable differences in the common term. See, for example, *Rockwood Chocolate Co., Inc. v. Hoffman Candy Co.*, 372 F.2d 552, 152 USPQ 599 (CCPA 1967) (*ROCKWOOD BAG-O-GOLD* for

candy not confusingly similar to CUP-O-GOLD for candy); or

(2) the appropriated matter is highly suggestive or merely descriptive or has been frequently used or registered by others in the field for the same or related goods or services. See *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974) (MEN'S WEAR for a semi-monthly magazine not confusingly similar to MMI MENSWEAR for fashion consulting for men because "MENSWEAR" is merely descriptive of such services); or

(3) the marks in their entireties convey significantly different meanings or commercial impressions; or

(4) the incorporated matter has been so merged with the other matter that it "loses its separate identity." See *Castle & Cooke, Inc. v. Oulevay, S. A.*, 370 F.2d 359, 152 USPQ 115 (CCPA 1967) (FARENDOLE not confusingly similar to DOLE for related food products because DOLE is so merged into FARANDOLE that it loses its individual identity therein).

Applicant's mark, however, does not fall under any of these exceptions. The word BEACHCOMBER is identical in both marks, and it retains its identity as it is used in applicant's mark. Further, BEACHCOMBER is an arbitrary term for rum and for cocktail mixes. There is no evidence of third-party registrations or third-party use of marks comprising or containing this term. Nor does applicant's mark convey a significantly different meaning or commercial

impression from the registered mark. Applicant cites Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 167 USPQ 529 (CCPA 1970), in which no likelihood of confusion was found between the marks PEAK for dentifrice and PEAK PERIOD for personal deodorant, despite the fact that PEAK PERIOD incorporates PEAK in its entirety.

However, the word PEAK per se has the meaning of the top of a hill or mountain, the brim of a cap, a jut of land and a high point in the course of development, while PEAK PERIOD has a different meaning: reaching the high point or maximum of an activity during a specified portion of time. For the same reason, applicant's citation of Lever Brothers Company v. The Barcolene Company, 463 F.2d 1107, 174 USPQ 392 (CCPA 1972), is inapposite. In that case, the mark ALL CLEAR! was found not confusingly similar to ALL because it was a play on an expression popularized in connection with air raid drills, and this meaning is different from the meaning of the word ALL.

In comparing the marks in their entireties, we find that the similarities between the marks far outweigh the dissimilarities. Because BEACHCOMBER is an arbitrary word for cocktail mixes, the word BEACHCOMBER in applicant's mark stands out. Further, the initial words DON THE in applicant's mark modifies BEACHCOMBER, in effect telling

which BEACHCOMBER he is, and therefore emphasizes the BEACHCOMBER portion. Because the marks share the word BEACHCOMBER, which is the only element in the registered mark and is a clearly recognizable and prominent element in applicant's mark, we find that there are strong similarities between the marks in terms of appearance, sound, meaning and commercial impression.

Applicant has relied on a letter from the beverage manager of Southern Wine and Spirits of Nevada,<sup>4</sup> in which he gives his opinion that "the word DON is the first word and is what gives the entire DON THE BEACHCOMBER mark importance and meaning and distinguishes it from BEACHCOMBER." This opinion is based on the labels shown in photographs of applicant's bottles, and labels for registrant's products that applicant downloaded from the Internet. However, in the labels for its product applicant emphasizes the DON portion of the mark and, in fact, the exhibit photograph submitted with the letter and declaration does not even show the word BEACHCOMBER on the bottles; on one bottle, only the word DON is shown; on a

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<sup>4</sup> Applicant also submitted the declaration of its business manager, which merely serves to authenticate the letter from the Southern Wine and Spirits beverage manager.

second bottle one can see only a "B"; while on the third bottle one can make out only THE and BEA."

We give the letter from the beverage manager very limited probative value, since his opinion is based on specific labels (not to mention photographs in which the entire mark cannot even be seen). Applicant has applied for the mark DON THE BEACHCOMBER in standard character format, not for the particular manner in which the mark is shown on the labels in the exhibits. If applicant were to obtain a registration for this mark, it would give applicant protection to use the mark without limitation as to a particular stylized format. Thus, applicant could depict the mark with the words THE BEACHCOMBER in the same size and typestyle as the word DON, or even in a larger size, similar to the way it has depicted the word DON in larger size on the labels shown to the beverage manager.

Citing Long John Silver's Inc. v. Lou Scharf Incorporated, 213, USPQ 263 (TTAB 1982), applicant has argued that the marks must be compared using a "subjective eyeball" test, in which it is appropriate to do a side-by-side comparison of the applicant's and registrant's labels, as was done by the beverage manager. We do not read this decision, which involves design marks, as stating that a side-by-side comparison is the appropriate test for

comparing the word marks at issue, or that similarity of marks should be based on trade dress or other elements that are not part of the applied-for and registered marks.

The du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.

With respect to the fifth and sixth du Pont factors, as we previously stated, there is no evidence of record of third-party registrations or third-party uses of BEACHCOMBER marks. Although there is no evidence of fame of the registrant's mark, BEACHCOMBER is an arbitrary mark for rum, and therefore the registration must be accorded a broader scope of protection than would be the case if it were a suggestive mark.

We turn now to a consideration of the goods. We start our analysis with reiterating the well-established principle that it is not necessary that the goods or services of applicant and the registrant be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See In re

International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Here, the Examining Attorney has made of record third-party webpages that advertise both cocktail mixes and alcoholic beverages from the same party under the same mark. For example, [www.bacardi.com](http://www.bacardi.com) lists BACARDI Mixers as coming in the flavors strawberry daiquiri, pina colada and rum runner, and says that they "can be found where you buy BACARDI Rum, and in most grocery stores." The Jimmy Buffett's Margaritaville website, [www.margaritaville.com](http://www.margaritaville.com), displays MARAGARITAVILLE margarita mix and MARAGARITAVILLE Flavored Tequila, and the website [www.diageobrand.com](http://www.diageobrand.com) shows JOSE CUEVO tequila and JOSE CUERVO margarita mix, while another website shows a recipe for the SKYY Cosmo as containing SKYY vodka and SKYY cosmo mix, and has a link to buy the cosmo mix.

The Examining Attorney has also submitted numerous third-party registrations showing that parties have registered a single mark for both distilled spirits (which includes rum) and beverages used as mixers for cocktails. See, for example, Registration No. 2595289 for TTL for, inter alia, rum and fruit juices and soda water; Registration No. 2764973 for FORNI & FATTORI for, inter alia, rum and soft drinks, fruit juices and mineral and

aerated water; Registration No. 2653809 for T.J. TOAD for, inter alia, distilled spirits and non-alcoholic cocktail mixes and non-alcoholic punch; Reg. No. 2304424 for BIOLUME for, inter alia, distilled sprits and prepared alcoholic cocktails and non-alcoholic punch and carbonated and non-carbonated soft drinks; and Registration No. 2361694 for, inter alia, distilled spirits and fruit drinks and fruit juices. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).<sup>5</sup>

Even without this evidence, it is clear that non-alcoholic cocktail mixes and flavored rum are related products because of their complementary nature. That is, cocktail mixes can be used with rum to make various cocktails. The Board and the courts have held in many cases that alcoholic beverages and non-alcoholic beverages that can be used with alcoholic beverages are related. As

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<sup>5</sup> We have given no consideration to the third-party registrations submitted with the first Office action, mailed February 7, 2005. Not one of the numerous registrations attached to that Office action was based on use in commerce. Nor have we considered Registration No. 2942238, which was submitted with the second Office action, because this registration, too, was not based on use in commerce.

the Board stated in *In re Rola Weinbrennerei und  
Likorfabrik GmbH & Co. KG*, 223 USPQ 57, 58 (TTAB 1984):

Decisions of this Board and its reviewing courts have made clear that, in appropriate factual contexts, alcoholic beverages and non-alcoholic beverages or non-alcoholic drink mixes may be so related as to be likely to generate confusion when similar marks are used thereon. See *Coca Cola Bottling Co. of Memphis, Tennessee, v. Joseph E. Seagram & Sons, Inc.*, 188 USPQ 105, 526 F.2d 556 (CCPA 1975) (*BENGAL* for gin and *BENGAL LANCER* for non-alcoholic carbonated soft drinks); *Pink Lady Corp. v. L.N. Renault & Sons, Inc.*, 121 USPQ 465, 265 F.2d 951 (CCPA 1959) (*PINK LADY* with women's picture for wines and *PINK LADY* for citrus fruit juices); *In re Jakob Demmer, KG*, 219 USPQ 1199 (TTAB 1983) (*GOLDEN HARVEST* with design for wines and *GOLDEN HARVEST* stylized for non-alcoholic apple cider); *In re Daily Juice Products, Inc.*, 163 USPQ 658 (TTAB 1969) (ready made cocktails and non-alcoholic cocktail mix considered related goods but registration allowed based on dissimilarity of *COCKTAIL HOUR* and *DAILY'S COCKTAIL TIME*).

Applicant does not really dispute that cocktail mixes and rum are related products. Instead, applicant contends that the owner of the cited registration does not use the mark *BEACHCOMBER* for "non-alcoholic cocktail mixes or prepared cocktails or related goods." Reply brief, p. 8. According to applicant, "there is no probative evidence relating applicant's non-alcoholic cocktail mixes to the

BEACHCOMBER rum goods because the BEACHCOMBER registrant does not provide cocktail mixes of any kind under the mark BEACHCOMBER." Reply brief, p 9. Applicant further states that the evidence that the registrant uses a different mark for its non-alcoholic cocktail mixes "establishes that applicant's non-alcoholic cocktail mixes and the rum goods of the cited BEACHCOMBER registration do NOT emanate from one source under the mark BEACHCOMBER." Id., emphasis in original.

Applicant's argument misses the point. The question is not whether the registrant in fact sells non-alcoholic cocktail mixes under the mark BEACHCOMBER. The question is whether consumers who are familiar with the registrant's flavored rum sold under the mark BEACHCOMBER, upon encountering non-alcoholic cocktail mixes under a mark that is confusingly similar to BEACHCOMBER, in this case DON THE BEACHCOMBER, will believe that both the non-alcoholic cocktail mixes and the flavored rum emanate from a single source. For the reasons discussed above, in particular, the complementary nature of the goods, we find that they will.

In addition, both cocktail mixes and rum are products that can be sold in liquor stores, where they will be purchased by adult members of the general public and used

for the same purpose—to make rum cocktails. Such consumers would include those who are not particularly sophisticated or knowledgeable about rum or cocktail mixes. In our analysis, we must consider all potential customers, including the less sophisticated. In re Bercut-Vandervoort & Co., 229 USPQ 763, 765 (TTAB 1986) (average ordinary wine consumer must be looked at in considering source confusion).

The du Pont factors of the relatedness of the goods, channels of trade and conditions of sale favor a finding of likelihood of confusion.

The Examining Attorney has also addressed the fact that there is no evidence of actual confusion. We agree with the Examining Attorney that the absence of such evidence is not sufficient for us to find that there is no likelihood of confusion. As the Examining Attorney has pointed out, applicant's application is based on an intention to use the mark, rather than use, and to the extent that applicant may have begun using its mark, there is no evidence of the length or extent of such use. Thus, we cannot ascertain whether there has been an opportunity for confusion to occur if it were likely to occur. See In re Majestic Distilling Co., supra, 65 USPQ2d at 1205 ("The

lack of evidence of actual confusion carries little weight"). This du Pont factor is neutral.

Applicant and the Examining Attorney have limited their arguments to the above du Pont factors. Because of this, and because no evidence has been submitted on other factors, we, too, have limited our discussion to these factors. To the extent that any other factors are applicable, we must treat them as neutral.

Finally, we note that applicant has stated that, because the Examining Attorney did not specifically discuss cases that applicant cited in its brief, the holdings in those cases should control on the issue of likelihood of confusion in the present case. However, there is no requirement that an Examining Attorney discuss every case that an applicant cites, nor will the Board regard the lack of such discussion as an acknowledgement by the Examining Attorney that those cases should control the result in the present case. To do otherwise would place an intolerable burden on the Examining Attorney. Moreover, the fact that we, too, have chosen not to address in this opinion each case cited by applicant in its 22-page appeal brief and 18-page reply brief does not mean that we agree with applicant that such cases are controlling herein. We have chosen not to burden this opinion with a discussion of each case, or

an explanation as to why we find each to be distinguishable. Just as an example, applicant has relied on *In re Daily Juice Products, Inc.*, 163 USPQ 658 (TTAB 1969), in which the Board found no likelihood of confusion between DAILY'S COCKTAIL TIME for non-alcoholic cocktail mix and COCKTAIL HOUR for ready-made cocktails. Although the Board stated, at p. 659, that "if products of this character were to be sold under the same or similar marks, purchasers would be likely to attribute them to the same, albeit anonymous, source," it did not find likelihood of confusion because the registered mark was highly suggestive. As opposed to that case, where the only word common to both marks was the descriptive and disclaimed word COCKTAIL, in the present case the common element, BEACHCOMBER, is arbitrary and the cited mark, because it is arbitrary, must be treated as a strong mark.

In addition, just as we have elected not to discuss and distinguish each case cited by applicant, we have also chosen not to discuss each statement made by applicant in its brief with which we disagree. That, too, would unduly burden this opinion. As an example of such a statement, applicant says in its reply brief, at p. 6, that the Board should disregard the Examining Attorney's statement that "BEACHCOMBER is the registrant's full mark and by necessity

is the dominant portion of that mark." Applicant contends that:

This statement is total speculation and pure conjecture without support by any legal authority or probative evidence. Further, applicant does not understand how a trademark consisting of a single word BEACHCOMBER can have that single word be the dominant portion of the trademark since the trademark has no other word or term over which BEACHCOMBER is to be dominant.

Moreover, the Examining Attorney's Brief fails to give any explanation of how "necessity" is a legitimate basis to determine which part of a mark is dominant, let alone determine that the single word of a single word mark is dominant.

We belabor the obvious in saying that since BEACHCOMBER is, as applicant recognizes, the only word in the cited registration, there is no other part of the mark that could be given greater weight, and therefore this single word "of necessity" is the dominant-and only-part of the mark. Suffice it to say that merely because we have not directly taken issue with statements made in the briefs does not mean that we agree with all of them.

In conclusion, we find that applicant's mark DON THE BEACHCOMBER for non-alcoholic cocktail mixes having extracts of natural and artificial beverage flavorings is

**Ser No. 76600373**

likely to cause confusion with the registered mark  
BEACHCOMBER for flavored rum.

Decision: The refusal of registration is affirmed.