

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 Billington Imports

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Serial Nos. 76638379 and 76638381<sup>1</sup>

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Kevin Oliveira of Odin, Feldman & Pittleman, P.C. for  
Billington Imports.

Martha L. Fromm, Trademark Examining Attorney, Law Office  
106 (Mary I. Sparrow, Managing Attorney).

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Before Seeherman, Quinn and Kuhlke, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Billington Imports, applicant, has filed applications  
to register the marks BIG TATTOO RED<sup>2</sup> (in standard character  
form) and BIG TATTOO<sup>3</sup> (in standard character form) for  
"wine" in International Class 33.

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<sup>1</sup> Inasmuch as these appeals involve common issues, we address  
them in a single decision.

<sup>2</sup> Serial No. 76638379, filed May 11, 2005, alleging first use and  
use in commerce on March 14, 2002, under Trademark Act Section  
1(a), 15 U.S.C. §1051(a).

<sup>3</sup> Serial No. 76638381, filed May 11, 2005, alleging first use and  
use in commerce on March 14, 2002, under Trademark Act Section  
1(a), 15 U.S.C. §1051(a).

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Registration has been refused, in each application, under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's marks, when used in connection with its identified goods, so resembles the registered mark TATTOO (in typed form) for "alcoholic beverages, namely, distilled spirits" in International Class 33,<sup>4</sup> as to be likely to cause confusion, mistake or deception. In addition, registration of the mark BIG TATTOO RED in Serial No. 76638379 has been refused pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), based on applicant's failure to comply with the requirement to disclaim the descriptive term RED on the ground that it is merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

When the refusals were made final, applicant appealed, and briefs have been filed. We affirm the refusals.

#### Disclaimer Requirement

We turn first to the examining attorney's final refusal based on the requirement that applicant provide a disclaimer for the word RED. An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under

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<sup>4</sup> Registration No. 2975653, issued July 26, 2005.

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Trademark Act Section 2(e)(1), and, therefore, are subject to disclaimer if the mark is otherwise registrable.

Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

In support of the refusal, the examining attorney submitted excerpts from the online dictionary ENCARTA containing the following definitions:

Red: adjective 5. describes wine made from black grapes;

Syrah: noun 2. a black grape variety. Use: to make syrah wine; and

Cabernet Sauvignon: noun 1. red wine: a dry red wine made from a variety of black grape originally grown in southwestern France.

encarta.msn.com

We find that the examining attorney has made a prima facie case that the word RED used in connection with applicant's wine is descriptive. Applicant did not present argument against the disclaimer in its brief; however, in response to an Office action applicant argued that "it does not concede that the use is descriptive as while this

specimen related to a 'red' wine, [a]pplicant may also use the mark BIG TATTOO RED on other wine varieties in the future including wine varieties that may be wine from grapes other than black grapes." June 12, 2006 Response p. 11. We are not persuaded by this argument. This word clearly describes a type of wine that is encompassed by applicant's identification, namely, red wine.<sup>5</sup> Thus, the disclaimer requirement is appropriate. In view of the above, the requirement to provide a disclaimer for the word RED is affirmed.

Likelihood of Confusion

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). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie*

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<sup>5</sup> We further note that to the extent applicant may use this term in connection with other types of wine, e.g., white wine, it

Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the du Pont factor of whether applicant's marks, BIG TATTOO RED and BIG TATTOO, and registrant's mark, TATTOO, are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In considering the similarity of the marks there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re

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could be misdescriptive.

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National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In both of applicant's marks TATTOO is the dominant element. While BIG serves to modify the term TATTOO it does not serve to distinguish these marks sufficiently to avoid a likelihood of confusion, but rather merely emphasizes the same connotation of the word TATTOO. We have already determined the term RED to be descriptive and as such it has little to no source identifying significance. See *In re National Data Corp.*, supra at 751 ("[t]hat a particular feature is descriptive ... with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark.")

Applicant cites *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) in support of its contention that the examining attorney has not given sufficient weight to the other elements in applicant's marks. However, the Court in *Hearst* explicitly recognized that the weight to be given terms in a mark is "not entirely free of subjectivity" and provided examples to "illustrate the fact-dependency of such determinations." *Id.* at 1239. The Court confirmed, in *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004), that the determination is highly fact-specific (affirming the Board's decision that JOSE GASPAR GOLD for tequila was

likely to cause confusion with GASPAR'S ALE for beer and ale).

The dominant element in applicant's marks is identical in sound and appearance to the entirety of registrant's mark. Moreover, the word TATTOO would have the same connotation when used with the respective goods. We also find that the marks have the same overall commercial impression.

Applicant's argument regarding the actual use of registrant's mark in combination with a house mark is not relevant for our purposes. We must consider the mark as it appears in the registration. The mark in the registration is for the word TATTOO by itself and is not limited by the presence of a house mark.

Applicant's argument that the mark TATTOO is weak is not supported by the record. Applicant states that the word TATTOO "is broadly used by numerous applicants and registrants in respect to numerous products and services in numerous channels and trade [sic]. Such is demonstrated by recourse to the database of registrations at the USPTO for which the examining attorney can reasonably access and, of which, take notice during prosecution and for which this appellate body can take judicial notice." Br. p. 7.

It is well established that the Board does not take judicial notice of third-party registrations. In re Wada, 48 USPQ2d 1689, 1689 n. 2 (TTAB 1998), aff'd, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999). Therefore, there is nothing in the record to support applicant's contention that the term TATTOO is weak or has a suggestive meaning when used in connection with wine. See AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (CCPA 1973). In view thereof, we must treat the mark as an arbitrary mark without any limitations as to the scope of protection to be accorded the mark.

In view of the above, we find the marks to be similar and this factor weighs in favor of a finding of likelihood of confusion.

We turn next to a consideration of the goods identified in the applications and the cited registration. We must consider the cited registrant's goods as they are described in the registration and we cannot read limitations into those goods. See Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the cited registration describes goods broadly, and there is no limitation as to the nature, type, channels

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of trade or class of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

In support of her contention that applicant's "wine" is related to registrant's "alcoholic beverages, namely, distilled spirits," the examining attorney submitted third-party use-based registrations to show that numerous entities have adopted a single mark for wine and for distilled spirits. See, e.g., Reg. No. 2099825 (KITTLING RIDGE ESTATES for alcoholic beverages, namely, wines and distilled spirits); Reg. No. 2567847 (ROCKLEDGE VINEYARDS for, inter alia, wines, sparkling wines, distilled spirits); Reg. No. 2472217 (WESTERLY VINEYARDS for, inter alia, wines and distilled spirits); Reg. No. 2709874 (BRADFORD MOUNTAIN for, inter alia, wine and distilled spirits); Reg. No. 2745943 (REDWOOD VINEYARDS for, inter alia, wines and distilled spirits); Reg. No. 2676913 (GEORGIA - CRADLE OF WINE for wine and distilled spirits); Reg. No. 2798817 (BUNRATTY CASTLE for wines and distilled spirits); and Reg. No. 2860948 (DUCHAMP WINERY for wine and distilled spirits). In addition, the examining attorney

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submitted excerpts of websites that sell various alcoholic beverages, including wine and distilled spirits. See, e.g., [www.nashobawinery.com](http://www.nashobawinery.com); [www.cbrands.com](http://www.cbrands.com); [www.recherche.bluewine.com](http://www.recherche.bluewine.com); and [www.charbay.com](http://www.charbay.com).

We find the examining attorney's third-party registrations persuasive evidence as to the factor of the relatedness of the goods. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). The website excerpts serve to bolster that evidence by showing wines and distilled spirits being sold under, at least, the same house mark and being offered on the same specialty websites. In addition to the websites, these goods would be sold in the same specialized retail outlets. Therefore, given that there are no limitations in the identifications in the applications or registration, we find that the channels of trade and class of purchasers overlap. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Applicant's argument that the goods are unrelated because "they are manufactured differently from different ingredients, are used differently and consumed differently" (br. p. 8.) is misplaced given that it is well settled that the fact that the goods may differ is not controlling. The

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issue to be determined is whether there is a likelihood of confusion as to the source of the goods, not as to the goods themselves. In re Rexel Inc., 223 USPQ 830, 831 (TTAB 1984).

The cases cited by applicant as examples where courts found no likelihood of confusion or infringement "when apparently similar marks were used, respectively, in connection with wine and brandies" (br. p. 9) are distinguishable from the facts of this case. Two of the cases involved agreements. In the first one, a prior agreement between the parties was considered by the Court in its determination. Peyrat et al. dba Societe Saint-Louvent Peyrat & Cie et al. v. L.N. Renault & Sons, Inc. et al., 148 USPQ 77 (SDNY 1965). In the other case, the Court considered an agreement between the applicant and the cited registrant in its determination of no likely confusion. See In re National Distillers and Chemical Corp., 132 USPQ 271 (CCPA 1962). In the third case, the word elements in the marks were not identical, BUITONI and BUTON, and the court considered the manner in which the marks were displayed in making its determination of no likely confusion in the context of an infringement case. See Buitoni Foods Corp. v. Gio. Buton & C.S.p.A., 216 USPQ 558 (2d Cir. 1982).

In view thereof, the du Pont factors of the relatedness of the goods, the channels of trade and class of purchasers favor a finding of a likelihood of confusion.<sup>6</sup>

Moreover, because applicant's goods and channels of trade are not limited, we must consider applicant's potential purchasers to include all usual purchasers of the goods. In this case that would include members of the general public who are ordinary purchasers. In re Bercut-Vandervoort & Co., 229 USPQ 763, 765 (TTAB 1986) (average ordinary wine consumer must be looked at in considering source confusion).

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<sup>6</sup> We note the Board and other tribunals have often found various alcohol products to be related and have overlapping channels of trade. See, e.g., In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (beer and tequila closely related; Jose Gaspar Gold v. Gaspar's Ale); In re Majestic, supra at 1204 (brewed malt liquor and distilled tequila similar "by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers"); The Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 160, 136 USPQ 508, 518 (9<sup>th</sup> Cir. 1963) (beer and whiskey "being both within the alcoholic beverage industry, are 'so related as to fall within the mischief which equity should prevent.'"); White Horse Distillers, Ltd. V. Ebling Brewing Co., Inc., 30 USPQ 238 (CCPA 1936) (scotch whiskey and ale are "goods of the same descriptive properties within the meaning of the statute"); Somerset Distilling Inc. v. Speymalt Whiskey Distributors Ltd., 14 USPQ2d 1539, 1542 (TTAB 1989) ("scotch whiskey, gin and vodka are all closely related, in that they are what might be characterized as basic alcoholic beverages"); and In re AGE Bodegas Unidas, S.A., 192 USPQ 326 (TTAB 1976) ("there is clearly a relationship between wine and whiskey, both of which alcoholic beverages are sold through the same specialized retail outlets to the same purchasers, and are frequently bought at the same time").

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In conclusion, we find that because of the related goods, the overlap in the trade channels, and the similarities in the marks, confusion is likely between applicant's marks and the mark in the cited registration. To the extent there are any doubts, we resolve them, as we must, in registrant's favor. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

**Decision:** The refusals to register under Section 2(d) of the Trademark Act in application Serial Nos. 76638379 and 76638381 are affirmed. The requirement for a disclaimer of RED in application Serial No. 76638379 is also affirmed.