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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 Capital Brewery Company, Inc.

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Serial No. 78655889

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Sverre David Roang and Norman D. Farnam of Stroud, Willink & Howard, LLC for Capital Brewery Company, Inc.

Kristina Kloiber, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

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Before Hairston, Taylor and Mermelstein,  
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Capital Brewery Company, Inc. has filed an application to register the mark ISLAND WHEAT (in standard character form) for "beer" in International Class 32.<sup>1</sup> The term "WHEAT" has been disclaimed.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the

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<sup>1</sup> Application Serial No. 78655889, filed June 22, 2005. On August 25, 2005, applicant filed an amendment to allege use, alleging August 18, 2005 as the date of first use of the mark anywhere and in commerce.

ground that applicant's mark, when used on the identified goods, so resembles the registered mark, shown below,



for "beer" in International Class 32.<sup>2</sup> The words "BREWING COMPANY" have been disclaimed.

After the refusal was made final, applicant appealed and requested reconsideration of the final refusal. On December 13, 2006, the examining attorney denied the request for reconsideration and the appeal was resumed. Applicant and the examining attorney filed briefs. We affirm the refusal to register.

**Preliminary Matters**

Before addressing the merits of the appeal, we must address two preliminary matters. We note that applicant is maintaining that the examining attorney is making certain arguments for the first time in her appeal brief and applicant requests that we therefore disregard such arguments. While an examining attorney may not advance a

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<sup>2</sup> Registration No. 2805704, issued January 13, 2004.

new ground for refusing registration in the appeal brief, an examining attorney is not prohibited from offering additional arguments or case law in support of a previously raised ground for refusal. We consider the examining attorney's additional arguments and supporting authority as a continuation of her arguments relative to the likelihood of confusion ground and not a new ground for refusal.

Accordingly, in determining the merits of the case, we have considered all of the examining attorney's arguments and case law in support thereof.

We also note that applicant has cited a number of cases in support of its position that the refusal should be reversed. Further, applicant complains that the examining attorney has failed to distinguish such cases. Contrary to applicant's contention, the examining attorney is not required to distinguish each and every case with particularity. Moreover, it is well settled that each case must be decided on its own merits, on the basis of the record therein. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001.)

**Refusal Based on Likelihood of Confusion**

Turning now to the merits of this appeal, our determination of the issue of likelihood of confusion is based on an analysis of all 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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

**Similarity of the Goods/Trade Channels/Class of Purchasers**

Turning first to a consideration of the respective goods, applicant's goods and registrant's goods are identical (i.e., beer). Since neither the application nor the cited registration contains any limitations, we must consider both to encompass identical goods, sold in the usual trade channels for such goods and to the same class of purchasers. It is apparent that both applicant and registrant would sell their beer to ordinary consumers, through the same channels of trade (e.g., grocery stores, convenience stores and liquor stores).

Accordingly, the du Pont factors of similarity of goods, channels of trade and class of purchasers strongly favor a finding of likelihood of confusion.

**Similarity of the Marks**

We next consider the similarity of the marks, keeping in mind that when marks would appear on identical goods, as they do here, 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, 1700 (Fed. Cir. 1992). In determining the similarity or dissimilarity of the marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See du Pont, supra. See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test 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 their entireties 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. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

The examining attorney argues that when the marks are compared in their entireties, applicant's mark is confusingly similar to the registered mark in appearance

and overall commercial impression because the dominant element of each mark, i.e., the term "ISLAND," is identical.

Applicant, on the other hand, contends that:

[T]he Trademark Examining Attorney improperly failed to give appropriate weight to the entirety of the marks and designs in relation to the goods at issue and has, instead, improperly focused on a single common element in each mark and design, the word "island." This focus on the single common element in each mark and design has caused the Trademark Examining Attorney to erroneously conclude that there is a substantial likelihood of confusion between the proposed mark ISLAND WHEAT and the registered word and design mark for ISLAND BREWING COMPANY.

(Applicant's brief at p. 8).

It is a well-established principle, however, that in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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 consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). For instance, as our principal reviewing court has observed, "[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark."

Moreover, with a composite mark comprising a design and words, the word portion of the mark is usually the one most likely to indicate the origin of the goods to which it is affixed. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) ["words are normally accorded greater weight because they would be used by purchasers to request the goods"]; *In re Nat'l Data Corp.*, 753 F.2d at 1056.

Finally, the issue of likelihood of confusion must be decided based upon a comparison of applicant's mark ISLAND WHEAT and the registered mark ISLAND BREWING COMPANY (and design), and not upon a comparison of applicant's mark as it appears on its label and the registered mark as it appears on its label. In our likelihood of confusion analysis, the Board is not permitted to consider the trade dress of the products or any additional wording that may appear on the products, other than to the extent that these elements may show possible bad faith adoption on the part of the applicant. *Ultracahsmere v. Spring Mills*, 828 F.2d 1580, 4 USPQ2d 1252, 1254 (Fed. Cir. 1987). This is so

because the issue before the Board in this proceeding is registrability and not use.<sup>3</sup>

Applicant's mark is ISLAND WHEAT. The term WHEAT, as evidenced by the disclaimer thereof, merely describes a style of beer. Indeed, applicant admits that its mark ISLAND WHEAT refers to a variety of beer. (Applicant's Response, filed March 13, 2006, at p. 9). Further, the examining attorney made of record, by exhibits to her Office action issued April 13, 2006, excerpts from websites showing that it is common practice in the beer industry for a brewery to market a number of different styles of beers, e.g., pale ale, stout, and wheat, under the same house mark and that customers are used to this practice. As such and contrary to applicant's contention, the term WHEAT would not be looked to by consumers as a strongly source-identifying element of the mark. Accordingly, the dominant portion of applicant's applied-for mark is the term ISLAND.

The cited registration consists of the term ISLAND BREWING COMPANY in a stylized font superimposed on a design element featuring an island scene. The words BREWING COMPANY in registrant's mark also have been disclaimed, as

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<sup>3</sup> For this reason, the infringement cases cited by registrant in support of its position that the Board should consider the respective product labels as actually used are readily distinguishable.

they merely describe the type of entity from which registrant's goods emanate, and likewise would not be looked upon as a source-identifying element.

Applicant argues that the distinction between its mark ISLAND WHEAT and the registered mark ISLAND BREWING COMPANY and design "becomes more evident" when comparing the appearance of each mark as it actually appears on the labels, (i.e., the tan label featuring the words ISLAND WHEAT with a prominent design of a "Capitol Dome flanked by wheat grain" on applicant's beer vis-à-vis the bright blue and orange ISLAND BREWING CO. label with the design of an island scene on registrant's beer), and that the examining attorney discounted the significance of the design portion of the registered mark. We find these arguments unavailing. As previously indicated, we must compare the marks as they appear in applicant's application and the cited registration. In so doing, although applicant's mark contains no design element, we find that the design in the registered mark, consisting of an island scene featuring palm trees, a beach and the ocean, while clearly noticeable, does not detract from the significance of the term "island." The design simply reinforces the meaning of the wording "ISLAND BREWING COMPANY" in registrant's mark.

We thus find that the term ISLAND is the dominant portion of the registered mark.

In sum, even though applicant's and registrant's marks contain some different wording, because of the descriptive nature of the term WHEAT in applicant's mark and the words BREWING COMPANY in registrant's mark, and the lesser weight to which these terms are entitled as we compare the marks in their entireties, applicant's mark and the registered mark are similar in sound, appearance, connotation and commercial impression.

Thus, the factor of the similarity of the marks favors a finding of likelihood of confusion.

Applicant argues that because of the presence of the term WHEAT in its mark and the term BREWING COMPANY in the registered mark, its mark can be readily distinguished from the registered mark and that the examining attorney committed an "analytical error" by disregarding the significance of the terms "wheat" and "brewing company." Applicant principally relies on Application of Blanchard Importing and Distributing Company, 360 F.2d 254, 149 USPQ 699 (CCPA 1966) and In re Hearst Corp., 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) in support of its position. These cases, however, are distinguishable from the facts of this case and do not control our determination. In

*Blanchard Importing*, the mark CANADIAN CHAMP for whiskey was held not to be confusingly similar to CHAMPION for whiskey. The Court found that the "[B]oard erred in placing too much emphasis on 'CHAMP' and too little emphasis on the composite mark as a whole." 149 USPQ at 700. In *Blanchard Importing*, the dominant portion of the applicant's composite mark, CHAMP, slang for the registered mark, and the registered mark, CHAMPION, were self-laudatory terms. In this case, the dominant portion of both applicant's mark and the registered mark is the arbitrary term, ISLAND. In *Hearst*, the mark VARGA GIRL for calendars was held not to be confusingly similar to VARGAS for, among other things, calendars. The Court found that "the Board erred in its diminution of the contribution of the word 'girl'" and that "[w]hen GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely." 25 USPQ2d at 1239. In *Hearst* the applicant did not add a descriptive and disclaimed term to the registered mark as applicant has done to the dominant portion of the registered mark here. Rather, the registered mark was VARGASS (emphasis added), while the applicant's mark was VARGA GIRL (without an "S"), and the word GIRL was not disclaimed. Moreover, the Court in

Hearst explicitly recognized that the weight to be given terms in a mark is "not entirely free of subjectivity."

Accordingly, in considering the marks in their entirety, it is entirely proper that we give more weight to the term ISLAND in the respective marks, and less weight to the descriptive terms WHEAT and BREWING COMPANY.

### **Third-Party Use**

Applicant asserts that marks containing the term ISLAND are weak marks which are therefore entitled to only a narrow scope of protection. In particular, applicant maintains that the term ISLAND is so frequently used in trademarks for liquor and beer, that its use in both the ISLAND WHEAT and ISLAND BREWING COMPANY (and design) marks is not likely to lead to consumer confusion. We are not persuaded by this argument. In support of its position, applicant submitted: (i) excerpts of search results from searches of the TESS database of the U.S. Patent and Trademark Office for marks including the words ISLAND or ISLANDS; (ii) copies from the TESS database records of eight applications and eighteen registrations for marks consisting of the term ISLAND in combination with other matter; and (iii) excerpts from websites purportedly showing that there are numerous brewing companies using the word ISLAND in their names. As regards the TESS search

reports, they consist simply of lists of marks with registration numbers and serial numbers and fail to indicate the particular goods and services in connection with which the marks are registered or sought to be registered. A mere listing of registration/application numbers and marks is insufficient to make the registrations and applications properly of record. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). As regards the copies of third-party applications, they show only that the applications have been filed. See *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003). As regards the copies of third-party registrations, while they may be used to demonstrate that a portion of a mark is suggestive or descriptive, they are not evidence that the marks shown therein are in use or that the public is aware of them. See *AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973) ["little weight is to be given such registrations in evaluating whether there is likelihood of confusion."]. Moreover, our review of such registrations reveals that six are for goods or services unrelated to the goods involved herein. In addition, none of the marks in the third-party registrations is as similar to registrant's mark as is applicant's mark. As our principal reviewing court noted

in *Nett Designs*, supra at 1447, “[e]ven if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind this Board or this court.”<sup>4</sup>

Further, the website excerpts are of limited probative value because there is no information as to the extent of exposure of the websites to the public or the public’s familiarity with them. See *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782 (TTAB 2001).

Nonetheless, we note that even if marks which contain the word ISLAND are considered to be weak, due to an asserted degree of suggestiveness conveyed by such term, even weak marks are entitled to protection where confusion is likely. See *Matsushita Electric Company v. National Steel Co.*, 442 F.2d 1383, 170 USPQ 98, 99 (CCPA 1971) [“Even though a mark may be ‘weak’ in the sense of being a common word in common use as a trademark, it is entitled to be protected sufficiently to prevent confusion from source arising”]. Here, notwithstanding any alleged weakness in

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<sup>4</sup> In this regard, we note that most of the marks in the third-party registrations have a specific geographic connotation (e.g. GOOSE ISLAND (Registration No. 1957898); VIRGIN ISLANDS BREWING COMPANY (Registration No. 2360946); and RABBIT ISLAND (Registration No. 2358637), and therefore differ from the registered mark ISLAND BREWING COMPANY and design.

**Ser No.** 78655889

the term "ISLAND," the registered mark is still similar in sound, appearance, connotation and commercial impression to applicant's mark. We accordingly find this *du Pont* factor is neutral.

**Conclusion**

We conclude that purchasers familiar with registrant's beer, sold under the mark ISLAND BREWING COMPANY (and design) would be likely to believe, upon encountering applicant's mark ISLAND WHEAT for beer, that the goods originate from or are associated with or sponsored by the same source.

**Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed.