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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TransBorder Marketing, Inc.

Serial No. 78788371

Scott W. Petersen of Holland & Knight LLP for TransBorder Marketing, Inc.

Tina Brown, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Kuhlke and Mermelstein, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

TransBorder Marketing, Inc., applicant, has filed an application to register the mark ANTYK (in standard character form) for "alcoholic beverages, namely vodka" in International Class 33.¹

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its

¹ Serial No. 78788371, filed January 10, 2006, under Trademark Act Section 1(b), 15 U.S.C. §1051(b), alleging a bona fide intention to use the mark in commerce.

identified goods, so resembles the registered mark ANTIQUE (in typed form) for "cognac, eau-de-vie and brandies" in International Class 33,² as to be likely to cause confusion, mistake or deception. In addition, registration has been refused based on applicant's failure to comply with the requirement to submit the English translation for the word ANTYK. Trademark Rule 2.61(b); TMEP §809 (4th ed. 2005).

When the refusals were made final, applicant appealed and filed a request for reconsideration. The examining attorney denied the request for reconsideration and the appeal was resumed. The appeal is fully briefed. We affirm the refusals.

Translation Requirement

We turn first to the examining attorney's final refusal based on the requirement that applicant provide a translation for the term ANTYK. In support of this requirement the examining attorney submitted the following translation of ANTYK from Polish to English as retrieved from the translation website poltran.com:

ANTYK: Antique; Antiquity; Old-fashioned object;
Greco-Latin Civilization.

www.poltran.com

² Registration No. 1638570, issued March 19, 1991; renewed.

In addition, she submitted an excerpt from a Polish-English English-Polish dictionary translating ANTYK as ANTIQUE, Hippocrene Practical Dictionary Polish-English English-Polish Dictionary (1993), and a memorandum from the USPTO translation Office, indicating that ANTYK is a Polish word that translates to ANTIQUE in English. She also submitted several newswire reports retrieved from the Internet indicating that applicant imports vodka from Poland. Applicant did not present argument against this requirement other than to state that "for purposes of this application [applicant] would concede that 'Antyk' means 'Antique'" Br. p. 13.

In view of the above, the requirement to provide a translation for ANTYK 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 Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of the goods identified in the application 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 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 vodka is related to registrant's cognac, eau-de-vie and brandies, the examining attorney submitted third-party use-based registrations to show that numerous entities have adopted a

single mark for vodka and for cognac and brandies.³ See, e.g., Reg. No. 2743073 (OUT OF AFRICA for, inter alia, brandy spirits, cognac and vodka); Reg. No. 2758755 (ROYAL VALLET for, inter alia, brandy, vodka and cognac); Reg. No. 2887345 (ESTEPA for, inter alia, brandy, vodka and cognac); Reg. No. 2756070 (CHANTECLAIR for, inter alia, brandy, cognac and vodka); Reg. No. 2983349 (LA CHANCE for, inter alia, cognac, brandy and vodka); Reg. No. 2537645 (REMY RED for, inter alia, brandies, cognac and vodka); Reg. No. 2666039 (R. JELINEK for, inter alia, brandy, cognac and vodka); and Reg. No. 2708766 (ONISTAR for, inter alia, vodka, brandy and cognac). See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). The examining attorney argues that the registrations serve to suggest that the goods listed therein are of a kind that may emanate from a single source.

We find the examining attorney's third-party registrations persuasive evidence as to the factor of the relatedness of the goods. Applicant's argument that the goods are different and used for different purposes in that "vodka is usually a cocktail enjoyed before a meal" whereas

³ The examining attorney submitted a dictionary definition for eau-de-vie that defines it as a type of brandy. See American Heritage Dictionary of the English Language (4th ed. 2000) retrieved from bartleby.com

"brandies and cognac are nearly always associated with after-dinner refreshment" (June 5, 2006 Response p. 5) is misplaced given that it is well settled that the fact that the goods may differ is not controlling. The 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). In view of the above, we find the goods to be related.

In addition, the examining attorney submitted excerpts of websites that sell various alcoholic beverages, including vodka, cognac and brandy in support of her contention both that the goods are related and sold in the same channels of trade. See, e.g., www.800spirits.com; store.yahoo.com; beerliquors.com; and topliquor.com. While applicant concedes that the goods would be found in the same liquor store, applicant argues that they would be in separate aisles. Applicant provides no evidence to support this contention. However, as applicant admits, these goods would be sold in the same specialized retail outlets and we find that the channels of trade and class of purchasers overlap.

In view thereof, the du Pont factors of the similarity of the goods, the channels of trade and class of purchasers favor a finding of a likelihood of confusion.⁴

We turn now to the du Pont factor of whether applicant's mark and registrant's mark 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

⁴ 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 (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 (9th 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").

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). Finally, "[u]nder the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine...similarity of connotation in order to ascertain confusing similarity with English word marks." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1377 (Fed. Cir. 2005).

As shown above, the examining attorney has established that ANTYK is the Polish word for ANTIQUE in English. Further, she has shown that an "appreciable segment of American consumers" speak Polish. See excerpt from www.census.gov attached to Final Office Action.

The doctrine of foreign equivalents is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Palm Bay*, supra at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). See also *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006). "The 'ordinary American purchaser' in this context refers to the ordinary American

purchaser who is knowledgeable in the foreign language."

In re Thomas, supra at 1024.

We find that ANTYK is the exact translation of ANTIQUE and that the mark would be translated by those who are familiar with the Polish language. This is not a case where the mark would not be translated because of the inherent nature of the mark. See In re Thomas, supra, citing, In re Tia Maria, Inc. 188 USPQ 524 (TTAB 1984). We acknowledge that this doctrine is not absolute and "where the only similarity between the marks is in connotation, a much closer approximation is necessary...to justify a refusal to register on that basis alone." In re Sarkli, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (REPECHAGE not confusingly similar to SECOND CHANCE). See also In re Buckner Enterprises Corp., 6 USPQ2d 1316 (TTAB 1987) (PALOMA, meaning both "dove" and "pigeon," not confusingly similar to DOVE). However, in this case, the only translation of ANTYK is ANTIQUE, the marks sound the same, and there are similarities in appearance inasmuch as both begin with ANT and end with phonetic equivalents.

Moreover, applicant's mark may be pronounced identically to registrant's mark. RE/MAX of America, Inc. v. Realty Mart, Inc., 207 USPQ 960, 964 (TTAB 1980) (similarity in sound alone may be sufficient to support a

finding of likelihood of confusion). We are not persuaded by applicant's argument that ANTYK is "considerably closer to the word 'Antic'...." It is settled that there is no correct pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. *Kabushiki Kaisha Hattori Tokeiten v. Acuotto*, 228 USPQ 461 (TTAB 1985). Thus, even if ANTYK may be pronounced ANTIC it also may be pronounced ANTIQUE, therefore, for our purposes they are phonetically identical. Even without translation, when spoken, the marks have the same meaning and connotation in connection with these related goods.

Taking into consideration the foreign and phonetic equivalency of the marks, and their similarities in connotation, appearance and overall commercial impression, we find the marks to be similar and this factor weighs in favor of a finding of likelihood of confusion.

Applicant's argument that the mark ANTIQUE is weak is not supported by the record. Applicant has submitted TESS printouts of three registrations.⁵ One has been canceled under Section 8 and, thus, is of no probative value.

⁵ The printout of a report from TESS listing various applications and registrations is of little to no probative value. As to the applications, they are only evidence of the fact that they were filed. With regard to the registrations, the list does not

Another one is for carbonated beverages which are more distant from vodka, brandy and cognac. The last one is for the mark YALUMBA ANTIQUE TAWNY for wine. One third-party registration is hardly evidence that the term ANTIQUE has some meaning in the field of alcoholic beverages such that minor differences between marks allow consumers to distinguish the source of the goods. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (CCPA 1973).

Applicant contends that the purchasers of the respective goods are "usually more sophisticated consumers who will know that producers of vodka do not produce brandy just as wine producers do not brew beer." June 5, 2006 Response p. 5. Applicant provides no evidentiary support for this contention. Moreover, applicant's goods and channels of trade are not limited. Therefore, we must consider applicant's potential purchasers to include all usual purchasers of the goods, and make our determination on the least sophisticated. In this case that would include members of the general public who are ordinary purchasers. In *re Bercut-Vandervoort & Co.*, 229 USPQ 763,

provide the goods or services for which the marks were registered.

765 (TTAB 1986) (average ordinary wine consumer must be looked at in considering source confusion).

Finally, applicant states that "the cited registration has been used since 1991 [and there] has been no confusion (and not a whisper of comment from the Registrant)." Br. p. 12. We note that the application is based on an intention to use the mark and there is no statement or evidence in the record that the mark in the application has been used in commerce. Therefore, this factor carries no weight. In any event, The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

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, [citation omitted], especially in an ex parte context.

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Majestic Distilling, 65 USPQ2d at 1205. With regard to the other du Pont factors mentioned by applicant, they do not outweigh the factors discussed above.

Decision: The refusal to register under Section 2(d) and the refusal based on the requirement for a translation are affirmed.