

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing:
October 29, 2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Taylor Wines Pty Ltd

Serial No. 78854872

Sheldon H. Klein and Adam D. Resnick of Arent Fox LLP for
Taylor Wines Pty Ltd.

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112 (Angela B. Wilson, Managing Attorney).

Before Hairston, Grendel and Rogers, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On April 5, 2006 Taylor Wines Pty Ltd filed an
intent-to-use application to register the mark shown below,



WAKEFIELD

ST ANDREWS

CABERNET
SAUVIGNON
CLARE VALLEY

for "wine" in International Class 33.¹

Registration has been finally 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 applicant's goods, will so resemble the mark shown below,



which is registered for "red and white still wines" in International Class 33,² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed and applicant's counsel and the trademark examining attorney appeared at an oral hearing.

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

¹ The words WAKEFIELD, CABERNET SAUVIGNON, and CLARE VALLEY are disclaimed apart from the mark as shown. The application contains the statement that "[t]he mark consists of a gray tile with an X above the words WAKEFIELD ST ANDREWS CABERNET SAUVIGNON CLARE VALLEY in black."

² Registration No. 2745189, issued July 29, 2003.

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 and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Considering first the goods, we note that they are legally identical. Applicant's application covers wine which encompasses the red and white still wines listed in the cited registration. In view of the identity of the goods, they must be deemed to be sold in the same channels of trade to the same classes of customers, which in this case would include restaurants and retail outlets, such as wine stores and grocery stores, where the purchasers would include the general public and wine connoisseurs.

Applicant does not dispute this, but concentrates the arguments in its appeal brief on asserted differences in the marks. Applicant argues that:

Primarily, appellant's mark contains the distinguishing wording "WAKEFIELD," "CABERNET SAUVIGNON," and "CLARE VALLEY." In addition, the cited mark contains the distinguishing wording "CERAVOLO" and "ESTATE." This additional wording renders Appellant's mark, when properly considered in its entirety, clearly distinct in appearance from the cited CERAVOLO ST ANDREWS ESTATE & Design mark. Moreover, Appellant's mark contains the

highly distinguishable and distinctive "X" Design, while the cited mark contains its own distinguishable and distinctive design. Finally, Appellant's mark is composed of seven words and a design, while the cited mark contains only four words and a design. The only common element in the marks is the diluted wording "ST ANDREWS." The dominant features of Appellant's mark are the "X" design and the first word "WAKEFIELD." Meanwhile, the dominant features of the registrant's mark are its distinctive design and the first word "CERAVOLO." Overall, this militates against a likelihood of confusion.

Brief, pp. 3-4.

The examining attorney, on the other hand, argues that when applicant's and registrant's marks are considered in their entireties, giving appropriate weight to the features thereof, they are similar due to the dominant term ST ANDREWS in each mark.

After careful consideration of the arguments of applicant and the examining attorney, we find that when considered in their entireties, applicant's mark,



WAKEFIELD

ST ANDREWS

CABERNET
SAUVIGNON
CLARE VALLEY

and registrant's mark,



are sufficiently similar in sound, appearance, connotation and overall commercial impression that, if used in connection with identical goods, confusion as to source or sponsorship is likely to occur.

We agree with the examining attorney that the dominant element of each of the marks is the term ST ANDREWS. As our primary reviewing court has noted, while the marks at issue are to be considered in their entireties, including any descriptive or generic terms, it is also the case 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, 751 (Fed. Cir. 1985). For example, "[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 a mark . . .” Id. at 751. Additionally, it is well settled that “[w]hen a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods” and, therefore, “the word portion is normally accorded greater weight in determining likelihood of confusion.” See, e.g., *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); and *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Furthermore, we note that when, as in this case, “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 864, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applying these principles to the marks in this case, we find that ST ANDREWS is the dominant portion of applicant’s mark. The disclaimed and descriptive/geographically descriptive terms CABERNET SAUVIGNON, WAKEFIELD and CLARE VALLEY in applicant’s mark are not ignored, but purchasers are more likely to rely on the non-descriptive literal portion of such mark, that is,

the term ST ANDREWS as an indication of source. Furthermore, CABERNET SAUVIGNON, WAKEFIELD and CLARE VALLEY are all in smaller letters than ST ANDREWS and therefore have less of an impact. With respect to the design element in applicant's mark, i.e., "a grey tile with an X," while it is visually prominent and is not insignificant, it is still the case that in terms of what customers would refer to when asking about or otherwise calling for applicant's goods, it is the literal portion, ST ANDREWS on which they would rely.³ Applicant argues that the design element is "distinctive," and serves to distinguish its mark from registrant's mark. We disagree. We find that the design element merely reinforces the term ST ANDREWS. In this regard, we judicially notice that the term "*Saint Andrew's cross*" is defined, in pertinent part, as: "[a] cross shaped like the letter X." The American Heritage Dictionary of the English Language (4th ed. 2000).⁴ Thus, the design

³ In restaurants, for example, wines in a wine list typically would be listed by name and not with images of wine labels. Patrons ordering bottles of applicant's wine would therefore become accustomed to using the literal element to indicate their choice of this particular wine from the list. In addition, references to applicant's wine from its website, which have been made of record, do not employ the letter X or the tile design. This, too, would lead consumers to rely on ST ANDREWS.

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

element does not alter the commercial impression of applicant's mark.

Similarly, it is the ST ANDREWS portion of registrant's mark that is more dominant as it appears in larger letters and more prominently than the terms CERAVOLO and ESTATE. Furthermore, while the design portion of registrant's mark is not ignored, there is nothing of record to indicate that it has any particular significance, and it is not so unusual that it alters the commercial impression of registrant's mark. Again, in terms of what customers would refer to when asking about or otherwise calling for registrant's goods, it is the literal portion, namely, ST ANDREWS.

With respect to the common term ST ANDREWS, we also note that both applicant and registrant depict ST ANDREWS in remarkably similar fonts and underscore the letter "T" in "ST". The marks do have a different number of words as applicant points out. However, this difference is not especially significant in this case, and is outweighed by the similar presentations of ST ANDREWS.

Relying on *Palm Bay, Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee*, supra, applicant argues that the first word in a mark is deemed to be dominant, and therefore, WAKEFIELD and CERAVOLO are the dominant portions

of the respective marks. In Palm Bay, the Federal Circuit held that the term VEUVE is the dominant feature of the marks VEUVE CLICQUOT and VEUVE ROYAL as it is the first word in such marks and an arbitrary term as applied to champagne and sparkling wine, respectively. In this case, however, WAKEFIELD and CERAVOLO do not appear to be arbitrary terms; rather WAKEFIELD is geographically descriptive and CERAVOLO appears to be a surname. Thus, we are not persuaded by applicant's contention that WAKEFIELD and CERAVOLO are the dominant features of the respective marks. See *In re Chatham International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) [despite differences in the marks JOSE GASPAR GOLD for tequila and GASPAR'S ALE for beer and ale, "the Board had good reason to discount ALE, JOSE, and GOLD as significant differences between the marks."].

In sum, we find that although the marks at issue include other wording and designs, it is the ST ANDREWS portion of each mark that conveys the strongest impression.

Insofar as the meanings and commercial impressions of the marks are concerned, the term ST ANDREWS itself appears to have no intrinsic meaning in relation to wine. Based on the record in this case, the term appears in both marks to be arbitrary. Even if the term ST ANDREWS in the context

of wines did have a suggestive meaning, as perhaps evoking the "renowned" Saint Andrews golf resort,⁵ the meanings and overall commercial impressions of the marks would still be the same.

Applicant, in contending that the marks are not confusingly similar, asserts that the term ST ANDREWS is "diluted." Specifically, applicant contends that this term is so widely used in marks for wines and alcoholic beverages that the commonality of the term is an insufficient basis upon which to find that the marks are confusingly similar. In support of its contention, applicant submitted a copy of a third-party registration, namely, Registration No. 1518200 for the mark OLD ST. ANDREWS for scotch whiskey. In addition, applicant made of record the results of a search of "Wine-searcher.com" for wines that include "St. Andrews" in their names,⁶ which

⁵ The definition of "*Saint Andrews*" taken from The American Heritage Dictionary of the American Language (4th ed. 2000) indicates that it is a "burgh of eastern Scotland" that is "now primarily a resort known for its golf courses."

⁶ After filing its notice of appeal, applicant filed a request for remand of the application in order to submit copies of two third-party applications for ST ANDREWS marks. The Board, in an order issued June 25, 2008, denied applicant's request as untimely. In view thereof, we have given no consideration to the third-party applications.

shows 268 matches.

This evidence does not compel a different result in determining the likelihood of confusion. Apart from the fact that the third-party registration covers whiskey rather than wine, such registration is not evidence of use of the mark shown therein or that the public is aware of it. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Insofar as the search results from Wine-searcher.com are concerned, the Federal Circuit has stated that "[t]he probative value of third-party trademarks depends entirely upon their usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee*, supra at 1693. The record is devoid of any evidence of the consuming public's awareness of the use, if any, of the designations retrieved by the search. Additionally, a number of the matches are duplicative; others are for whiskey rather than wine. In view of the above, we cannot conclude that there is such significant third-party use of ST ANDREWS marks or trade names that consumers are likely to make a distinction between applicant's mark and registrant's mark if these marks were used in connection with identical goods.

Finally, applicant argues that there is no likelihood of confusion in this case because its mark and registrant's

mark coexist on the Australian trademark register. It is well settled, however, that trademark rights are territorial in nature and that the protection of a trademark in a certain country depends exclusively on the law of that country. In short, the determination under Australian law that applicant's mark is registrable is not controlling on this Board.

In view of the identity of the goods, trade channels and purchasers, and the similarity of the marks, we find that there is a likelihood of confusion in this case.

To the extent that any of the points raised by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register under Section 2(d) is affirmed.