

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

FC/PWC

Mailed: September 5, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

P.J. Valckenberg GmbH

v.

Phicon Investment Holdings (Pty) Ltd.

Opposition No. 91166355
to application Serial No. 78368528
filed on 2/16/2004

Richard J. McKenna of Foley & Lardner LLP for P.J.
Valckenberg GmbH.

Brewster Taylor of Stites & Harbison PLLC for Phicon
Investment Holdings (Pty) Ltd.

Before Quinn, Kuhlke and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Phicon Investment Holdings (Pty) Ltd., has applied to register on the Principal Register the mark MADONNA in standard character form based upon its allegation of a bona fide intent to use the mark in commerce for "Alcoholic beverages namely wines, distilled spirits, liqueurs, and brandy" in International Class 33.¹

¹ Application Serial No. 78368528 was filed on February 16, 2004.

Registration has been opposed by P.J. Valckenberg GmbH. As grounds for opposition, opposer asserts that it owns and has made prior use of the mark MADONNA on "wine and wine glasses."² Opposer argues that it has used its mark in connection with wine since prior to any date on which applicant may rely for purposes of priority of use of its involved mark. Opposer further argues that applicant's mark, when used in connection with applicant's goods, so resembles opposer's mark for its goods as to be likely to cause confusion, to cause mistake, and to deceive; and that opposer will be damaged thereby.

Applicant's answer consists of a general denial of the allegations in the notice of opposition.³

The Record

The record in this case consists of the pleadings, and the file of the involved application. In addition, during its assigned testimony period, opposer submitted the

² Because opposer is relying on common law rights in its MADONNA mark, it is restricted to such rights for the goods on which it has proven use. We note here that opposer's testimony and evidence is insufficient to establish use of the trademark MADONNA on wine glasses. Accordingly, use of the MADONNA mark on wine glasses will not be discussed further herein. We hasten to add, however, that the absence of evidence of such use does not have an impact on the outcome of this proceeding.

³ Additionally, applicant asserted as an "affirmative defense" that the notice of opposition fails to state a claim upon which relief can be granted. However, applicant did not file a motion to dismiss under Fed. R. Civ. P. 12(b)(6) by means of which any asserted insufficiency in opposer's pleading might be addressed. Accordingly, applicant's "affirmative defense" will be given no further consideration.

deposition, with accompanying exhibits, of its president Wilhelm G. Steifensand. Opposer also filed a notice of reliance upon applicant's responses to opposer's Interrogatory Nos. 1, 6, 7, 8, 10 and 11, under Trademark Rule 2.120(j)(3)(i).

Applicant filed a notice of reliance upon opposer's responses to applicant's Interrogatory Nos. 1, 2, 4 through 7, 10, 14, 16 through 19, 21 through 23 and 25, under Trademark Rule 2.120(j)(3)(i).

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief.

Evidentiary Objections

Applicant has raised various objections to the evidence presented by opposer. These are discussed below.

First, applicant generally objected to all of the documentary evidence provided during testimony, under Trademark Rule 2.120(a), claiming that opposer failed to comply with its discovery requests and therefore should be estopped from relying on the evidence that was not furnished to applicant during discovery. We note that opposer's responses to applicant's interrogatories, submitted by applicant under notice of reliance, included general and specific objections, substantive answers and indications

that relevant documents would be provided.⁴ We note that opposer does not indicate in its interrogatory responses that documents relevant to a particular request do not exist. We further note that it does not appear from the file history of this proceeding that applicant filed a motion to compel or other discovery motion whereby the asserted insufficiency of opposer's discovery responses could be addressed. See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate.) In addition, applicant did not object to the introduction of such documents during the testimony deposition of Mr. Steifensand. Having failed to address the asserted deficiencies in opposer's discovery responses or object to the introduction of the documents in question during opposer's testimony deposition, applicant will not now be heard to argue for the first time in its brief on the merits of the case that opposer should be estopped from relying upon the exhibits to its testimony deposition due to its asserted failure to produce those documents during

⁴ We further note opposer's objection number 1 to applicant's interrogatories, reiterated in its reply brief, that applicant's discovery requests were untimely filed. Inasmuch as applicant's interrogatories are not of record, we cannot determine whether they were in fact timely filed. The record also does not indicate whether applicant served additional discovery upon opposer.

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discovery. See, for example, *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996), *aff'd*, *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998). Accordingly, we have considered opposer's testimony exhibits to the extent that they are not otherwise subject to a different specific, sustained objection.

Applicant also objected generally to the use of the testimony of Mr. Steifensand to establish opposer's priority of use of the MADONNA mark on wine. Applicant asserted that opposer did not establish sufficient knowledge of the witness to testify as to the facts asserted in the testimony. Applicant's objections on the basis of lack of foundation are overruled inasmuch as opposer has laid a foundation sufficient to admit the testimony of its president. Mr. Steifensand is competent to testify about any knowledge of facts he acquired in the usual course of his business responsibilities. The uncontroverted testimony of Mr. Steifensand shows: he is the seventh-generation president of a family-owned winery, he worked in a U.S. wine retail store in 1981 where he sold MADONNA wine to consumers, and he has acted as president of opposer since 1990. This established that Mr. Steifensand has the ability to testify as to the sale of opposer's MADONNA wine in the U.S.

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We note however, that certain parts of the witness' testimony were not based on personal knowledge, but on company lore and family history, and not sufficiently supported by documentary evidence or otherwise eligible for an exception to the hearsay rule. Thus, it has not been clearly shown that Mr. Steifensand had sufficient "personal knowledge" on these topics to satisfy the requirements of Fed. R. Evid. 602. We did not rely on such testimony to reach a decision in this case. In coming to our determination we have considered only that testimony based on Mr. Steifensand's personal knowledge. Accordingly, this objection is sustained only as to the testimony not made on personal knowledge of the witness.

Applicant specifically objected to Exhibits 3 through 36 on the basis that they are inadmissible as hearsay, and not properly authenticated to qualify under the business record exception under Fed. R. Civ. P. 803(6). We have considered applicant's arguments but find that Exhibits 3 through 27 were properly authenticated as records kept in the course of a regularly conducted business activity, and therefore admissible.⁵ Accordingly, this objection is denied.

⁵ We note that applicant's attorney stipulated to the authenticity of opposer's archived documents during the testimony deposition of Mr. Steifensand, pages 45 and 46, lines 22 through 3. Nonetheless, Exhibit 17 is in German, and while the trademark

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With regard to Exhibit 28, opposer stipulated that this Exhibit was incomplete and therefore it would not be relied upon. Therefore Exhibit 28 has not been considered.

Turning to Exhibits 29 through 35, applicant objected to these documents as Internet evidence that has not been properly authenticated. We have reviewed this evidence and sustain this objection. However, as to the photograph of opposer's labeled wine bottles, seen in Exhibit 35, the witness established the proper foundation to admit this photograph into evidence during cross-examination. Accordingly, Exhibits 29 through 35 have not been considered, with the exception of the photograph of opposer's labeled wine bottles, found in Exhibit 35, as discussed further, below.

Opposer's Standing

Opposer, through its testimony and related exhibits, has established that it uses the mark MADONNA in connection with wine. Opposer has asserted a likelihood of confusion claim directed toward applicant's intended use of a virtually identical mark for goods that are identical in part. Thus, opposer has demonstrated it possesses a real interest in this proceeding beyond that of a mere intermeddler, and a reasonable basis for its belief of

MADONNA clearly appears on it, we have not considered this exhibit.

damage. See *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023 (Fed. Cir. 1999). See also *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). We find, therefore, that opposer has proven its standing to bring the instant opposition proceeding.

Priority of Use

Because opposer has not pleaded ownership of any registered trademark, opposer must rely on its common law use of its MADONNA mark to prove priority. Inasmuch as applicant has not established use of its mark in connection with its goods prior to the filing date of its intent-to-use application, the earliest date upon which applicant may rely for priority purposes is February 16, 2004. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 36 USPQ2d 1328, 1332 (TTAB 1998), quoting *Alliance Manufacturing Co., Inc. v. ABH Diversified Products, Inc.*, 226 UPSQ 348, 351 (TTAB 1985) ("an applicant is entitled to rely upon the filing date of its application as a presumption of use of the mark subject of the application as of that date"). Thus, in order to establish priority, opposer must show that it used its mark in connection with its goods prior to February 16, 2004.

Opposer's witness Mr. Steifensand testified that the MADONNA brand was adopted and used in Germany since 1908. Based on personal knowledge, Mr. Steifensand testified as to

sales of MADONNA branded wine in the U.S. as early as 1981.⁶

Regarding recent sales, on page 22 of his deposition, Mr. Steifensand stated:

A: We still sell Madonna wines, in the range of maybe 70,000 bottles on average, let's say, during the past five years.

Q: So as I understand it, for about the past five years, the sales volume has been on the order of 70,000 bottles of MADONNA wine per year in the United States; is that correct?

A: Yeah, roughly. And not only to one customer but to many different states.

An example of the label for opposer's MADONNA branded wine was provided as part of Exhibit 35, provided with the Steifensand testimony deposition.⁷ The foundation for this evidence is found in the cross-examination of Mr. Steifensand, on deposition page 95, between lines 2 and 20, which read, in part:

Q: If you look at Exhibit 35...third to the last page... Is that the label you're referring to?

A: That is the Madonna label.

Q: With the old label, same label?

A: Same label.

⁶ In Mr. Steifensand's deposition page 47, lines 3 - 6, the witness stated, regarding sales of MADONNA wine at Premier Liquors in Buffalo, NY: "I personally worked at that store in 1981, and I remember that I physically sold myself to consumers on the floor a lot of cases of MADONNA."

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Q: With the big statue on it?

A Same label we sell to the U.S. and the U.S. business...

We also note that opposer has provided representative examples of price lists for wine sold for export from Germany to the United States from as early as 1965. See, *Swingline, Inc. v. Ardco, Inc.*, 215 U.S.P.Q. 436 (TTAB 1982) (Price lists accepted to establish priority of use).

Opposer has also provided invoices from as early as 1978, with extensive examples of invoices provided for the years after 1999 and continuing up to 2003.

Based on opposer's uncontroverted testimony and the exhibits provided with it, opposer has demonstrated use of the mark MADONNA on wine sold in retail stores in the United States since at least as early as 1981. We need not rule on whether the MADONNA trademark was in use before the dates for which Mr. Steifensand has testified based on personal knowledge, because opposer has established that is has made prior use before February 16, 2004, applicant's filing date.

Applicant asserts in its brief that opposer's evidence fails to demonstrate that it has made continuous use of its MADONNA mark. First, in order to establish priority, opposer is required only to show prior use, not continuous use of its mark. See *West Florida Seafood Inc. v. Jet*

⁷ We are not persuaded by applicant's assertion that the label in question is "illegible" or otherwise fails to display opposer's MADONNA mark on its goods.

Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). To the extent that applicant's continuity argument may be construed as an abandonment claim, we note that applicant has not pleaded abandonment as an affirmative defense. Further, there is no evidence of record showing that opposer discontinued use of the MADONNA mark with intent not to resume such use. We note that while opposer has admitted that it may have stopped distributing wine to the United States during the years of the Second World War, it has clearly established use beginning at least as early as 1981, and has testified to uninterrupted use for the five years prior to the testimony period.

Based on the foregoing, opposer has shown priority of use over applicant of its mark MADONNA on wine.

We now turn to the issue of likelihood of confusion between opposer's mark and applicant's mark as used on their respective goods.

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In*

re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot, supra.* In this case, applicant's MADONNA mark in standard character form is identical to opposer's MADONNA mark in sound, and nearly identical in appearance. There is nothing in the record to suggest that the stylization, such as it is, in opposer's MADONNA mark, which appears on its labels in rather ordinary block capital letters, conveys a different connotation or commercial impression than applicant's MADONNA mark in standard characters. Further, there is nothing in the record to suggest that MADONNA is anything but a distinctive mark as applied to opposer's goods. As a result, we find that the marks are identical in sound and meaning, and nearly identical in every other respect. This *du Pont* factor heavily favors opposer.

The Goods

Next, we turn to our consideration of the similarities or dissimilarities between the parties' respective goods.

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In this case, applicant's goods are "Alcoholic beverages namely wines, distilled spirits, liqueurs, and brandy." Opposer has proven use of its mark on "wine." Thus, applicant's goods include those of opposer and are identical to them in part. Further, opposer has introduced testimony and evidence that wine is distributed and encountered with distilled spirits, liqueurs and brandy in retail stores and restaurants. Finally, we note that applicant does not argue that the parties' goods are dissimilar. This *du Pont* factor also heavily favors opposer.

Channels of Trade

Because applicant's and opposer's goods are identical in part, and because there are no restrictions as to their channels of trade or classes of purchasers, the goods are presumed to be marketed in all the normal channels of trade to all the usual purchasers for such goods, and that the channels of trade and the purchasers for opposer's goods as well as applicant's goods would be the same. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). It is settled that in making our determination regarding the relatedness of the parties' goods, we must look to the goods as identified in the involved application. See *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973) (Trademark cases involving the issue of likelihood of confusion must be decided on the

basis of the goods, as identified on the application).

Thus, this *du Pont* factor also favors opposer.

Conditions of Sale

The next *du Pont* factor discussed by the parties is that of the conditions of sale. Applicant asserts that the increased sophistication of wine buyers supports a finding that the parties' goods would be purchased by careful and discriminating consumers. However, there is nothing in the record to support a finding that opposer's wines are expensive or otherwise restricted to sophisticated consumers. Rather, opposer's wines appear to be moderately priced and available to anyone. Inasmuch as applicant has not yet made use of its mark, there is no evidence regarding the pricing of its wines and other goods or the nature of the consumers to whom they are intended to be marketed. As such, the record in this case does not support a finding that the consumers of opposer's goods and the intended consumers of applicant's goods are necessarily sophisticated purchasers. Furthermore, even if some degree of care were exhibited in making the purchasing decision, because the marks both consist of the identical term MADONNA, even careful purchasers are not likely to distinguish between the marks based only on the typestyle of the capital letters comprising the parties' marks. Thus, this *du Pont* factor also slightly favors opposer.

Summary

In view of the foregoing, we find that opposer has established its standing to bring this proceeding; priority of use; and that purchasers of opposer's wine, upon encountering applicant's wines, distilled spirits, liqueurs, and brandy under nearly identical MADONNA marks, are likely to experience confusion as to the source of the parties' respective goods.

DECISION: The opposition is sustained on the ground of priority and likelihood of confusion, and registration to applicant is refused.