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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Wine Oh! LLC
v.
Stafford L. Lombard

Opposition No. 91174450
to application Serial No. 78813809
filed on February 13, 2006

Michael D. Hobbs, Jr. of Troutman Sanders LLP for Wine Oh!
LLC.

Jefferson Coulter of AXIOS Law Group for Stafford M.
Lombard.

Before Bucher, Rogers, and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Stafford M. Lombard, applicant, seeks registration of
the following mark:

wine-

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for goods identified as "blank note cards; cards bearing universal greetings; coasters made of paper; greeting cards; note cards; social note cards" in International Class 16.¹ The application contains statements that the colors black, red, white and light red are claimed as a feature of the mark; that the color white appears in the label on the bottle; that the color black appears in the wording wine, the letter "O" and the dash; and that the red appears in the shape of the bottle; that the color light red appears in the cork. The application also contains a statement describing the mark as "consist[ing] of the word 'Wine-O' to the left of a stylized bottle of wine. The 'O' in 'Wine-O' encircles the neck of the stylized wine bottle."

Wine Oh! LLC has opposed registration of applicant's mark. In the notice of opposition, opposer claims ownership of an application (Serial No. 78463007) for the mark WINE OH!² for a variety of paper goods and office/school supplies, including stationery, paper labels, telephone message pads, stationery portfolios, greeting cards, paper party invitations, gift wrapping paper, paper gift tags, paper gift bags, and paper cardboard gift boxes.³ Opposer

¹ Application Serial No. 78813809, filed on February 13, 2006, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² Filed on August 5, 2004, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b). The word WINE has been disclaimed.

³ The identification of goods, in total, is as follows:

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alleges that its has rights in its mark that are prior to:

(i) applicant's filing date..., and (ii) applicant's constructive and/or actual first use date, if any, in United States commerce for applicant's mark," and that the use and registration of applicant's mark is likely to "cause confusion in the minds of the purchasing public."

Applicant filed an answer wherein he admitted that opposer filed the pleaded application (Answer, paragraph 7) and, going beyond the scope of any allegations contained in the notice of opposition, admitted that opposer "has several pending intent-to-use applications for services unrelated to

Printed matter and paper goods, namely, books magazine and newspapers in the field of food, wine, restaurants, health and nutrition; address books; children's activity books; comic books; coloring books; notebooks; composition books; picture books; children's story books; books containing puzzles and games; sticker books; scrapbooks; stationery; office and school supplies, namely, pens, pencils, markers, drafting and drawing rulers, desk top organizers, pencil holders, pen holders, adhesive tape for household and stationery use, tape holders and tape dispensers for use with household and stationery adhesive tape, paper clips, paper clip holders, paper labels, paper badges, telephone message pads, clip boards, pencil cases, pencil sharpeners, stationery portfolios, stencils, rubber bands, paper files, greeting cards, staples, staplers, staple removers, paper fasteners, binders, report covers, paper reinforcements, index marking tabs, corkboard pushpins, thumbtacks, blotters, desk-top business card holders, cork boards, chalk boards, memorandum boards, book covers, book marks; art supplies, namely, crayons, arts and crafts kits for painting and drawing, modeling materials and compounds for use by children, painting sets, paint brushes, sketchbooks; posters and photographs; diaries and calendars; crossword puzzles; party supplies, namely, paper party decorations, paper party invitations, paper tablecloths, paper napkins, paper ribbons, paper cake decorations, paper party bags; paper party hats, gift wrapping paper, paper gift tags, paper gift bags, paper cardboard gift boxes.

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its registered mark WINE OH! (Reg. No. 2936549), which is used with the State of Georgia in connection with restaurant and bar services" (Answer, paragraph 5). Applicant otherwise denied the salient allegations of the notice of opposition; specifically, he denied that opposer has superior rights, that there is a likelihood of confusion and that use and registration of applicant's mark will be injurious to opposer.

The Record

By rule, the record consists of the pleadings and the file of the involved application. During its assigned testimony period, opposer introduced copies of applicant's responses to interrogatories and requests for admission as well as various documents produced by applicant in response to opposer's discovery requests by way of a notice of reliance. Likewise, applicant filed a notice of reliance during his testimony period introducing copies of opposer's responses to interrogatories and requests for admission, and documents produced by opposer in response to applicant's discovery requests.⁴

⁴ Generally, documents produced in response to document requests may not be introduced by notice of reliance alone. Trademark Rule 2.120(j)(3)(ii); see also TBMP § 704.11 (2d ed. rev. 2004). However, the documents identified by the parties in their notices of reliance are considered of record because both parties sought to introduce the documents in the same manner, albeit improperly, and neither party objected to the other's offering. TBMP § 704.11(8); see, e.g., *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (improper subject of notice of reliance but no objection raised); *Autac Inc. v. Viking*

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For sake of clarity, we address the issue of opposer's unpleaded but acknowledged registration and applications. As noted, applicant admitted *sua sponte* in his answer that opposer is the owner of Registration No. 2936549 for the mark WINE OH!⁵ for use in connection with restaurant and bar services, as well as several other applications for the same mark in connection with various goods. And, in a response to one of applicant's admission requests which have been introduced into the record, opposer acknowledged ownership of the unpleaded registration and five applications (in addition to its pleaded application) for the mark WINE OH! for various goods.⁶ However, copies (certified or otherwise) of the unpleaded registration and applications were not properly introduced into the record by either applicant or opposer.⁷ As a consequence, opposer's registration and applications have not been considered in

Industries, Inc., 199 USPQ 367, 369 n.2 (TTAB 1978) (neither party objected to other's offering of Rule 34 documents by notice alone); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566, 569 n.1 (TTAB 1977) (applicant did not object to documents produced and introduced by notice alone and referred to those documents in its brief); and *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, *supra* (no objection to notice of reliance). Cf. *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.8 (TTAB 1985). Accordingly, we consider the parties to have stipulated to entry of produced documents by notice of reliance.

⁵ Issued on March 29, 2005.

⁶ Opposer's response to Admission Request No. 7; see footnotes nos. 10-15 for further identification of these applications.

⁷ A status and title copy of the registration was not filed nor was there any testimony to establish validity and ownership of this registration. See Rule 2.122(d); see also, TBMP §

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our determinations regarding opposer's standing and priority. Likewise, our likelihood of confusion analysis is limited solely to opposer's mark and goods in the pleaded application vis-à-vis the mark and goods in the subject application.

Both parties filed briefs.⁸

Standing

In view of applicant's admission of opposer's ownership of the pleaded application, and in view of opposer's pleading of a reasonable claim of likelihood of confusion, we consider there to be no issue regarding opposer's standing. 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).

Priority

An opposer with an intent-to-use application may rely on the filing date of its application to establish priority. See *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 at n. 7 (TTAB 1995) ("An opposer may rely on Section 7(c) to establish priority if it owns a registration for the mark it is asserting under Section 2(d) or if it has filed an

704.03(b)(1)(a)(2d ed. rev. 2004) regarding introduction of a registration not subject of proceeding.

⁸ Applicant's motion (filed May 7, 2008) to strike opposer's reply brief because it was not timely-filed is granted as conceded and well-taken. Trademark Rules 2.127(a) and 2.129(a)(1). The reply brief has not been considered.

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application for registration of that mark. We might put the matter more simply by saying that in proceedings before the Board the constructive use provisions of Section 7(c) may be used both defensively and offensively." See also *Zirco Corp. v. American Telephone & Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

Thus, in this case, opposer may rely on the filing date of its pleaded intent-to-use application (Serial No. 78463007) to establish priority, which was on August 5, 2004. Applicant, on the other hand, may rely only on the filing date of the subject intent-to-use application, which was on February 13, 2006, and he has admitted that he first used his mark in mid-June 2006.⁹ Inasmuch as opposer's constructive use date precedes the earliest possible date that applicant may rely on, we find that opposer has priority.

Applicant has attacked opposer's ability to rely on the constructive use date of its pleaded application in establishing priority. Specifically, applicant argues that opposer "has not met its burden of establishing priority because it has not demonstrated a bona fide intent to use its mark in connection with the identified goods [in the pleaded application]." Brief, p. 7. However, this argument was not pleaded as an affirmative defense or otherwise

⁹ Applicant's response to Interrogatory No. 13.

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raised in applicant's answer as required by FRCP 8(c), and it cannot be deemed to have been placed in issue and tried by the parties by express or implied consent, as provided for in FRCP 15(b). See TBMP § 311.02(c) (2d ed. rev. 2004) and authorities cited therein; also, *Cf. Salacuse v. Ginger Spirits Inc.*, 44 USPQ2d 1415 (TTAB 1997) (respondent, in response to a summary judgment motion, was able to challenge petitioner's bona fide intent to use its pleaded applications "in view respondent's pleaded challenge to the validity of petitioner's applications.") As a result, applicant's argument regarding opposer's alleged lack of a bona fide intent to use the mark in its pleaded application has not been considered.

Even if we were to consider applicant's challenge to opposer's pleaded application, it is not clear that applicant has satisfied the initial burden of establishing a prima facie case that opposer's pleaded application is invalid for lack of the requisite bona fide intention to use its mark. See *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351 (TTAB 1994); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). Applicant's argument is essentially based on opposer's ownership of several other intent-to-use applications for the same mark in connection with various goods and opposer's inability to identify (in response to an interrogatory

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request) any person or entity to who opposer intends to offer for sale goods under its mark. Brief, pp. 7-8. As previously decided, the record before us does not include copies of these applications and the registration. Yet the record does contain an admission from opposer that, in addition to its pleaded application, it is the owner of five applications for the same mark, WINE OH!, for goods that range from "computer hardware and computer software for use in the selection and purchasing of wines"¹⁰ to "bottled water"¹¹ to "wines"¹² to various food products¹³ to clothing¹⁴, in addition to opposer's ownership of the registration. Taken together, opposer's ownership of these applications and the registration does not necessarily indicate that opposer lacks the requisite bona fide intent to use its mark on the goods identified in the pleaded application. Many of the goods identified in several of the applications are related to opposer's restaurant and bar services inasmuch as they involve wine or food. The pleaded application's identification of goods begins with "printed matter and paper goods, namely, books[,] [a] magazine and newspapers in the field of food, wine, restaurants, health

¹⁰ Application Serial No. 78352657, filed on January 15, 2004.

¹¹ Application Serial No. 78393523, filed on March 30, 2004. Abandoned on June 10, 2008.

¹² Application Serial No. 78445588, filed on July 2, 2004.

¹³ Application Serial No. 78491270, filed on September 29, 2004.

¹⁴ Application Serial No. 78265979, filed on June 23, 2003.

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and nutrition." Thus, the connection between the goods in opposer's applications and its restaurant services may actually indicate that opposer does indeed have a bona fide intent to use the mark in commerce with respect to those goods. And opposer's inability to identify "any person or entity to who opposer intends to offer for sale goods under its mark" is not necessarily dispositive of a lack of intent to use the mark in commerce.

Ultimately, we find that opposer may rely on its constructive use (filing) date of its pleaded application in establishing its priority over the subject application. We turn now to whether there is a likelihood of confusion.

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) 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 and 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 considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

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We first consider the *du Pont* factor regarding the similarity of the goods. In this regard, we find that opposer's pleaded application and the opposed application both cover greeting cards. In addition, opposer's pleaded application identifies "stationery," which is broad enough to encompass several of applicant's identified goods, namely, blank note cards, cards bearing universal greetings, greeting cards, note cards, and social note cards.¹⁵ Many other goods identified in opposer's pleaded application, e.g., "party supplies, namely, paper party decorations, paper party invitations, ...paper cake decorations, paper party bags; paper party hats, gift wrapping paper, paper gift tags, paper gift bags, paper cardboard gift boxes" are closely related to applicant's coasters made of paper and greeting cards.

Accordingly, the respective goods are identical, in part, and otherwise they are closely related. This factor therefore weighs strongly in favor of finding a likelihood of confusion.

¹⁵ In this regard, we rely on the following defined meanings of the term "stationery": "1. Writing paper and envelopes. 2. Writing materials and office supplies.." The American Heritage Dictionary of the English Language: Fourth Edition. 2000. It is well settled that the Board may take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n.7 (TTAB 1981).

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Given that some of the goods are identical and others are closely related, and there is no limitation in the identifications thereof in opposer's and applicant's applications, we must presume that the identical goods will be sold in the same channels of trade and will be bought by the same classes of purchasers, while the related goods will be sold in some of the same channels of trade, and will be bought by some of the same purchasers. 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) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). Thus, the *du Pont* factors involving trade channels and classes of purchasers also favor a finding of likelihood of confusion.

We now turn our attention to the level of similarity or dissimilarity in the parties' marks. In considering the marks, we initially note that when they are used in connection with identical goods, as they are here, "the degree of similarity [between the marks] 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).

Under this *du Pont* factor, we look to the similarity or dissimilarity of the marks in their entireties as to

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appearance, sound, connotation and commercial impression. 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 overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the perception and recollection of the average purchaser of the involved goods, who normally retains a general rather than specific impression of trademarks. See *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). In this case, the average purchaser would include members of the general public inasmuch as greeting cards, party supplies, stationery, and other writing supplies are widely available in various retail outlets.

In comparing the marks, we first find that the literal portion of applicant's mark is phonetically identical to opposer's mark. There is no real discernible difference in the manner in which each mark will be pronounced by consumers. Applicant argues that opposer's use of the exclamatory expression OH!, with the exclamation point, creates a more pronounced impression. To the extent that the term OH! is enhanced in opposer's mark, we find this to have little consequence for purposes of distinguishing the

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two marks, visually or when spoken. In this regard, with respect to applicant's mark, the literal portion WINE-O is accorded greater weight than the design element because it is the word portion of the mark that consumers use to request and to identify applicant's products. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461, 462 (TTAB 1985). In other words, consumers will likely describe, refer and/or recall both marks in the same manner by verbalizing the literal portions of the marks and, as a result, there may be confusion as to which of the two marks is being referenced.

As to connotation or commercial impression, we also find the marks to be similar in that they have a wine connotation and play on the term "wino," a common expression used pejoratively to describe someone who drinks wine in excess.¹⁶ Both parties' marks, when considered in connection with the respective goods, will conjure images of wine. Indeed, the term wine is descriptive with respect to opposer's goods and a disclaimer of the term has been

¹⁶ Exhibit A to applicant's notice of reliance contains copies of two definitions for the term "wino." The first definition provided is "*Slang* An indigent wine-drinking alcoholic" .." The American Heritage Dictionary of the English Language: Fourth Edition. 2000. The second definition provided is "one who is chronically addicted to drinking wine." Merriam-Webster Online Dictionary.

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entered in the pleaded application. Likewise, applicant acknowledges that its goods are used in connection with wine bottles, i.e., the goods can be placed around the neck of the wine bottles, and the design of a wine bottle underscores this connection.

The addition of a stylized red wine bottle design, along with the letter "O" circling the neck of the wine bottle, are features that obviously are not present in opposer's pleaded mark. Despite this difference, when the marks are considered in their entirety, we find that the similarities outweigh the differences. Again, the marks are essentially phonetic equivalents and they engender highly similar overall commercial impressions. Thus, we conclude that the relevant *du Pont* factor involving the similarity or dissimilarity of the marks supports a finding of a likelihood of confusion.

Applicant argues that there have been no reported instances of confusion and that this *du Pont* factor therefore favors a finding of no likelihood of confusion. Applicant's argument, however, is belied by the fact that in order to determine whether the absence of actual confusion is relevant, we must consider the length of time and conditions under which the parties have concurrently used their marks without any reported instances of confusion. Here, there has been virtually no opportunity for actual

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confusion because opposer has not used its mark and applicant only began using his mark in mid-2006. Thus, this factor remains neutral in our analysis.

Upon consideration and balancing of all of the relevant *du Pont* factors, we are convinced that there is a likelihood of confusion as between applicant's WINE-O (stylized with design of a red wine bottle) mark and opposer's WINE OH! mark, such that registration of applicant's mark is barred under Trademark Act Section 2(d).

Decision: The opposition is sustained contingent upon opposer's registration of the mark in application Serial No. 78463007. The time for filing an appeal or for commencing a civil action will run from the date of the present decision. See Trademark Rules 2.129(d) and 2.145. When opposer's mark has been registered or its application therefor becomes abandoned, opposer should promptly inform the Board, so that appropriate action may be taken to terminate this proceeding.

* * *