

World Trademark Review *Daily*

TTAB finds that beer and wine are related goods
United States - Leason Ellis LLP

Examination/opposition
National procedures

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In a precedential decision, *In re Kysela Pere et Fils Ltd* (Serial No 77686637, March 24 2011), the Trademark Trial and Appeal Board (TTAB) has affirmed the refusal to register the mark HB for wine over registrations for the mark HB (and crown design) for use with beer.



In applying the *du Pont* factors, the TTAB analysed the relatedness of the goods and the evidence to be considered in such an analysis. The examining attorney had supported the refusal to register HB with third-party registrations covering a single mark for use with both beer and wine. After winnowing out cancelled registrations and registrations that were not based on use in commerce, the evidence consisted of 20 registrations supporting the examining attorney's argument that beer and wine are related. The applicant attempted to counter this evidence by arguing that the number of registrations was not impressive, particularly when considering the number of registrations that identify either wine or beer, but not the other item. The TTAB rejected this argument.

According to the TTAB, third-party registrations are proper evidence to show that goods are related. Moreover, the TTAB rejected the applicant's logic, holding that a registrant may not always include all of its goods in an initial application for a mark. Thus, while inclusion of multiple goods in a registration of a single mark supports the proposition that the included goods emanate from a single source, the inverse is not necessarily true. In other words, the inclusion of one but not the other item in a registration for a single mark does not mean that the goods are not related, because there are other plausible explanations for this situation (there were other flaws with the way in which the applicant had presented its search results that lessened their probative value).

The TTAB also relied on the fact that the examining attorney had introduced internet evidence of stories about companies that make and sell both wine and beer. The additional evidence further tipped the scales on this factor in favour of the refusal.

In discussing the relatedness of the goods factor, the TTAB also drew a distinction with the zone of expansion factor. According to the TTAB, relatedness is important in making an *ex parte* determination of likelihood of confusion, whereas the zone of expansion factor has relevance only in the context of an *inter partes* proceeding. The TTAB faulted both the examining attorney and the applicant for drawing conclusions from the evidence as to whether wine was within the zone of expansion from beer. Rather, the evidence was probative only as to whether consumers are likely to believe that the respective goods emanate from a single source.

The TTAB quickly disposed of the remaining factors, finding that beer and alcohol are sold to adult consumers through similar trade channels, such as liquor stores and supermarkets. More analysis was given to whether the stylised HB and crown design was sufficient to distinguish the marks. The TTAB followed its oft-stated rules that a non-stylised application covers all forms of the mark and that word/letter elements are generally dominant because they are pronounceable, whereas designs are not. Applying these principles, the TTAB found that the marks were similar. The TTAB also rejected the applicant's attempt to rely on extrinsic evidence of the meaning of the registrant's mark, invoking another oft-stated rule, that the marks must be compared as they are in the application/registration and not how they are used.

Considering that each of the factors weighed in favour of a likelihood of confusion, the TTAB affirmed the refusal to register the mark.

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