

Recent Developments in Trademark Law

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In recent months, the Trademark Trial and Appeal Board (TTAB) of the United States Patent and Trademark Office has issued several opinions relating to the registration of trademarks for beer, wine, and other adult beverages. These opinions are summarized below.

First, the TTAB issued two opinions refusing registration of a mark for one type of alcoholic beverage on the basis that a confusingly similar mark was already registered for another type of alcoholic beverage:

In re Kysela Pere et Fils, Ltd., Trademark Trial and Appeal Board, Serial No. 77686637, March 24, 2011

The TTAB affirmed an examining attorney's final refusal of a registration of the word mark HB for wine on the grounds that a similar mark had already been registered for beer. Applicant sought to register HB, in standard characters, for wine. The examining attorney refused registration on the ground that the mark was likely to cause confusion in light of two existing registrations for stylized marks for beer containing the initials "HB." In determining that beer and wine were related for purposes of demonstrating a likelihood of confusion, the TTAB remarked that "there is an intrinsic connection between food and beverage products." In addition, "[t]hird party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source." As evidence on this point, the examining attorney submitted more than twenty third-party registrations in which both wine and beer were included in class identifications. Based in large part on this evidence, the examining attorney found that beer and wine are related products for purposes of determining likelihood of confusion, and the TTAB agreed in its affirmance.

Miguel Torres, S.A. v. Complejo Industrial RM, S.A. de C.V., Trademark Trial and Appeal Board, Opposition No. 91188401 to application Serial No. 77525448, May 17, 2011

The TTAB sustained an opposition to a mark for tequila on the grounds that a similar mark had been registered for wine. Complejo Industrial RM, the applicant, sought to register the word (and design) mark GRAN SOL for tequila. Miguel Torres S.A. opposed opposition on the basis that the mark created a likelihood of confusion with its registered mark GRAN VIÑA SOL (registered in standard character form, VIÑA disclaimed), for wine. Among other points, the TTAB noted the applicant's admission that "wine and tequila have similar channels of trade," and further relied on case law from the Federal Circuit Court of Appeals standing for the proposition that "different types of alcoholic beverages are related goods...." Moreover, Miguel Torres S.A. submitted thirteen use-based third-party registrations which included in their

identifications of goods both tequila and wine. After comparing the marks in light of the similarity of the goods and the channels of their distribution, the TTAB sustained the opposition.

Another recent case issued by the TTAB demonstrates that meaning of a word mark, apart from similarity in written form or sound, is a substantial consideration in determining likelihood of confusion.

Fast Forward Brands, LLC v. Houdini, Inc., Trademark Trial and Appeal Board, Opposition 91188001 to application Serial No. 77504664, April 22, 2011

The TTAB sustained an opposition to registration where the word mark for which registration was sought for wine was confusingly similar in meaning and impression to the opposer's previously registered and used mark for wine. Applicant Houdini filed an intent-to-use application for the mark CLOUDBANKS (in standard characters) for wine. Fast Forward opposed the registration on the grounds that the mark was confusingly similar to its previously registered and used mark FOGBANK (in standard characters), also for wine. The parties submitted dictionary definitions as part of the record. The TTAB determined that the meanings of "fog" and "cloud" (and consequently, FOGBANKS and CLOUDBANKS) were so similar as to create a likelihood of confusion. The ordinary meaning and usage of the two words are so close as to render the marks similar in the minds of ordinary consumers, who are not likely to be experts in meteorological terms. . . .We find that the substantially similar meaning between fog and cloud, and fogbank and cloudbanks, outweighs any differences in appearance and sound. Thus, the TTAB found that the similarity in "overall commercial impressions" between the marks weighed in favor of a finding of likelihood of confusion.

Finally, in another case, the TTAB affirmed a denial of mark registration where the applicant proffered no evidence demonstrating an intent to use the mark in commerce. This decision is especially notable because it seems to indicate that not having documents evidencing an intent to use a mark could create a presumptive obligation to the contrary.

Spirits International, B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarm Satis Kooperatifleri Birligi, Trademark Trial and Appeal Board, Opposition No. 91163779 to application Serial No. 78253641, July 6, 2011

Applicant S.S. Taris sought to register the mark MOSKONISI in stylized form for a wide variety of food and drink products, including beer, wine, and other alcoholic drinks. Spirits International, B.V., which owned an intent to use application for the mark MOSKOVSKAYA for vodka, opposed the registration of the mark on the ground, inter alia, that the applicant did not have a bona fide intent to use the mark for the identified product classes, including beer and wine. The TTAB sustained the opposition, noting that the applicant did not produce any documentation demonstrating that it had based on the ground asserted by the opposer an intent to use the mark for those classes, and therefore could not demonstrate a bona fide intent to use the mark. The TTAB relied heavily on the fact that the applicants entire product line using the mark was limited to olive oil produced in Turkey, and applicant had taken no steps to obtain the proper permits and licenses to import alcoholic beverages into the United States.

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