

10/31/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
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Paper No. 18  
EJS

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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Guinness United Distillers & Vintners Amsterdam B.V.,  
substituted for **Twelve Islands Shipping Company Limited**<sup>1</sup>

v.

**John D. Lowe**  
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Opposition No. **111,360**  
to application Serial No. 75/249,470  
filed on **February 28, 1997**  
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**Arnold P. Lutzker and Carl H. Settlemyer of Lutzker & Lutzker LLP for Guinness United Distillers & Vintners Amsterdam B.V., substituted for Twelve Islands Shipping Company Limited.**

**John D. Lowe, pro se.**  
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Before Seeherman, Hohein and Hairston, Administrative Trademark Judges.

Opinion by **Seeherman**, Administrative Trademark Judge:

<sup>1</sup> Although this opposition was brought in the name of Twelve Islands Shipping Company Limited, the evidence of record, and specifically the testimony of opposer's witness, Linda Marjory Hamilton, shows that Guinness United Distillers & Vintners Amsterdam B.V. is the successor in interest to Twelve Islands' rights in the trademark MALIBU. Accordingly, Guinness United Distillers & Vintners Amsterdam B.V. has been substituted for Twelve Islands Shipping Company Limited as the real party in interest.

Guinness United Distillers & Vintners Amsterdam B.V., through its predecessor-in-interest Twelve Islands Shipping Company Limited,<sup>2</sup> has opposed the registration of MALIBU ICE CREAM and design, as shown below, as a trademark for ice cream.<sup>3</sup>

As grounds for opposition, opposer has alleged, inter alia, that it has used the marks MALIBU and MALIBU and design since long prior to the filing date of applicant's intent-to-use application; that opposer is the owner of trademark registrations for these marks for liqueur, and for the mark MALIBU and design for coconut rum; and that applicant's mark so resembles opposer's previously used and registered marks that, if used on applicant's goods, confusion is likely.

Applicant's 16-page answer to the 22 paragraphs in the notice of opposition contains a great deal of

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<sup>2</sup> Hereafter the term "opposer" will be used to refer to either Guinness or Twelve Islands unless they are specifically differentiated in the opinion.

<sup>3</sup> Application Serial No. 75/249,470, filed February 28, 1997, based on an assertion of a bona fide intention to use the mark in commerce. The term ICE CREAM has been disclaimed.

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argument and does not, as the Federal Rules of Civil Procedure require, simply indicate whether applicant admits or denies the allegations of each paragraph. Fed. R. Civ. P. 8(b). It appears that applicant has admitted the existence of opposer's registrations and opposer's prior use of the MALIBU marks for coconut rum, that opposer has the right to use its marks in commerce on alcoholic beverages, and has denied the remaining essential allegations in the notice of opposition. However, even if we were to consider applicant to have denied the allegations of the notice of opposition in their entirety, it would not affect our decision herein because opposer has submitted evidence, as indicated below, as to the existence of two of its registrations and as to its prior use of the subject marks.

The record includes the pleadings; the file of the opposed application; the declaration of opposer's witness Linda Marjory Hamilton;<sup>4</sup> and nine notices of reliance<sup>5</sup> by

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<sup>4</sup> The parties stipulated that this testimony could be submitted by declaration or affidavit. It is noted that the actual declaration bears at the top the legend, "Confidential under Protective Order." However, the document was not filed under seal, nor was a redacted copy containing non-confidential portions submitted. In view thereof, the Board has not treated this declaration as confidential.

<sup>5</sup> Opposer submitted an additional notice of reliance (Opposer's seventh notice of reliance) in which it has attempted to rely on excerpts taken from various websites. However, Internet

which opposer submitted copies of two of its own abandoned MALIBU applications and its cancelled MALIBU registration, as well as copies of various third-party applications and registrations; applicant's responses to opposer's interrogatories;<sup>6</sup> certain printed publications; copies of third-party applications which have been opposed, and papers taken from those opposition proceedings;<sup>7</sup> and status and title copies of two of the three registrations pleaded in its notice of opposition, for MALIBU per se<sup>8</sup> and for MALIBU and design, as shown below,<sup>9</sup> both of which are for liqueur.<sup>10</sup>

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excerpts may not be made of record by notice of reliance. See **Raccioppi v. Apogee Inc.**, 47 USPQ2d 1368 (TTAB 1998).

<sup>6</sup> Opposer also submitted applicant's responses to opposer's document production request; however, documents submitted in response to such requests may not be made of record pursuant to a notice of reliance. Trademark Rule 2.120(j)(3)(ii). Accordingly, only those documents which were submitted as part of applicant's responses to interrogatories have been considered.

<sup>7</sup> The papers submitted are from three opposition proceedings brought by opposer. Opposer has also submitted a PTO status report on a fourth application for MALIBU which was abandoned, along with correspondence between that applicant's attorneys and opposer's attorney's. The correspondence, which does not constitute official records and therefore may not be made of record by notice of reliance, has not been considered.

<sup>8</sup> Registration No. 1,261,893, issued December 20, 1983; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

<sup>9</sup> Registration No. 1,374,134, issued December 3, 1985; Section 8 affidavit accepted; Section 15 affidavit received. The lining and/or stippling shown in the mark on the drawing is a feature of the mark and does not indicate color.

<sup>10</sup> These registrations show that they were originally issued to Twelve Islands Shipping Company Limited, and that ownership is now in UDV Amsterdam BV. Opposer has explained that subsequent to the assignment of the marks from Twelve Islands Shipping

Among the evidence opposer has submitted under notice of reliance are more than 100 articles taken from various periodicals. It should be noted that these articles cannot be used as evidence of the truth of the statements made in the articles, as that would be hearsay. However, the articles can be used to show that the public has been exposed to those statements. Moreover, we have given no consideration to the articles appearing in foreign publications or those which are from newswire services, since we have no indication that the U.S. public has seen such articles. Furthermore, to the extent that the articles are used, as opposer's notices of reliance state, to show the fame of opposer's marks, those articles taken from trade journals have little

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Company Limited, UDV Amsterdam BV changed its name to Guinness United Distillers & Vintners Amsterdam B.V., and ownership in Guinness has been confirm by Ms. Hamilton's testimony. With its notice of reliance opposer also submitted four additional registrations because "they show the use of Opposer's MALIBU mark and/or palm tree and sun design elements in connection with its goods and services." Brief, p. 5. Because opposer neither pleaded nor has it relied on these registrations as a basis for its ground of likelihood of confusion, we do not deem the pleadings to have been amended to assert likelihood of confusion with respect to these registrations.

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probative value because it is unclear whether they would ever have been seen by the general consumer.

Applicant did not submit any evidence.

Both opposer and applicant have filed briefs; an oral hearing was not requested.

The testimony of Linda Marjory Hamilton states that Guinness United Distillers & Vintners Amsterdam B.V. (hereafter Guinness) is the successor in interest to opposer Twelve Islands Shipping Company Limited's trademark rights in the MALIBU brand. Guinness and its predecessors in interest in MALIBU sold in excess of 48 million bottles of MALIBU flavored rum beverage in the United States between 1993 and 2000, with more than 17 million bottles sold between 1993 and 1996. Each bottle has a retail price of between \$12 and \$14. Since the early 1990's MALIBU coconut flavored rum drink has been the best-selling such drink in the United States, and is the third most popular imported liqueur brand in the United States. Guinness and its predecessors-in-interest have spent, between 1991 and 2000, in excess of \$70 million promoting the MALIBU rum drink in the United States, advertising in national magazines such as "People," "Entertainment Weekly," "Cosmopolitan" and

"Playboy," on radio, billboards, and signage and promotional materials in bars and restaurants.

Ms. Hamilton also testified that Guinness and its predecessors licensed the sale of HAAGEN-DAZS ice cream co-branded with the MALIBU mark overseas for several years, ending in 1999. Applicant, apparently relying on statements made in some of the newspaper articles submitted by opposer,<sup>11</sup> calls into question the accuracy of this testimony. As noted, the articles are not evidence of the truth of the statements made in the articles, so as far as the evidence of record is concerned, there is nothing to call Ms. Hamilton's testimony into question. Applicant had the opportunity to cross-examine Ms. Hamilton as to her declaration testimony, but chose not to. In any event, we would not consider the difference between two year's use and "several years" to be meaningful in the context of this evidence; the fact that MALIBU liqueur was used in ice cream, and that the liqueur mark appeared on the ice cream for even two years indicates a relationship between the goods.

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<sup>11</sup> For example, the "Frozen and Chilled Foods" article, dated April 1997, states that "Haagen Dazs is launching another new flavour this spring: Malibu, a combination of coconut and rum."

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Although applicant did not submit any evidence, his responses to interrogatories which were submitted by opposer show that he has not yet used his mark, but intends to use it on "super-premium American ice cream" in pint containers, 500 ml. containers, 118 ml. containers and novelty ice cream bars. The purchasers of these products would encompass all those who consume ice cream in the United States, from young children to the elderly, with the target market being teenagers and families with young children. Applicant has used the mark in advertising to store buyers, airlines and small businesses, and it was advertised on the Internet in January 1997.

Priority is not in issue in view of opposer's registrations, submitted under a notice of reliance. See **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the record shows that opposer has used the mark MALIBU since at least 1993, which is prior to the February 2, 1997 filing date of applicant's intent-to-use application, which is his constructive use date.

The determination of likelihood of confusion must be made based on all of the probative evidence that is relevant to the factors set forth in **In re E.I. du**

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**Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although we have considered all relevant factors, we will concentrate our discussion on the factors argued by the parties.

Turning first to the parties' goods, they are obviously different. We agree with applicant that no one would mistake a liqueur with ice cream, or buy one product when they wanted to buy the other. However, the question we must decide is not whether consumers are likely to confuse the products, but whether they are likely to confuse the source of the products. The fact that opposer's liqueur is classified in one class, and applicant' ice cream in a different class, does not necessarily mean that such confusion is not likely to result. The classification system is for the convenience of the Patent and Trademark Office, and does not serve as evidence of the relatedness of goods or services. See **National Football League v. Jasper Alliance Corp.**, 16 USPQ2d 1212, 1216 n. 5 (TTAB 1990).

It is well established that, in order to support a holding of likelihood of confusion, it not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade. It is sufficient that the respective goods of the parties are

related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

The record demonstrates that such a relationship exists between liqueur and ice cream. The evidence submitted by opposer shows that liqueur can be used as an ingredient in ice cream. In particular, opposer has provided evidence as to the co-branding of opposer's own MALIBU liqueur with Haagen Dazs ice cream. Moreover, the newspaper articles refer to the use of liqueur in ice cream, as well as an ingredient in sorbet (including a sorbet called MALIBU BAY BREEZE SORBET) and cakes, and to the use of ice cream in alcoholic beverages. Although the articles are not evidence that liqueur has in fact been used in such a manner, they show that the public has been exposed to reports of such use. Thus, consumers are likely to assume that liqueur and ice cream emanate from or are sponsored by the same source if the goods were sold under confusingly similar marks.

Opposer has also submitted third-party registrations which show that liqueur and ice cream are related. Third-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. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).<sup>12</sup> The third-party registration evidence shows that BAILEYS has been registered for, inter alia, ice cream (Reg. No. 2,023,042) and liqueurs (Reg. No. 1,224,459); GRAND MARNIER has been registered for, inter alia, ice creams (Reg. No. 1,731,364) and cordials (Reg. No. 1,013,041); and SEREGO ALIGHIERI has been registered for, inter alia, frozen confections and liqueurs (Reg. No. 2,273,272); while BLEND'S and design has been registered for "prepared alcoholic blend containing distilled spirits and ice cream" (Reg. No. 2,240,700).

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<sup>12</sup> In accordance with the principle set out in Trostel, we have given no consideration to the third-party applications submitted by opposer, as they do not carry the same presumptions as registrations. Nor have we considered the registrations based on Section 44 of the Act, since those registrations would not show use of the marks in the United States, unless a Section 8 affidavit or renewal application has been accepted for those registrations which would evidence such use. We are also unclear as to why certain of the registrations have been submitted, e.g., the various registrations for STARBUCKS are not for alcoholic beverages at all.

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Applicant has asserted that the goods travel in different channels of trade because opposer's product is a controlled alcoholic beverage. Although applicant has not submitted any evidence on this point, we can take judicial notice that most, if not all, states have restrictions as to the sale of alcoholic beverages. Many states require that they be sold in special stores, or in separate sections of grocery stores. We have no information, however, as to whether all states prohibit the sale of bottled alcoholic beverages in the same stores where food is sold, and we certainly cannot take judicial notice that stores which sell liquor are prohibited from selling ice cream.

Even if we were to assume that liqueurs and ice cream are sold in different retail outlets, they are sold to at least some of the same classes of customers. Applicant acknowledges that his ice cream may be purchased by "all those who consume ice cream in the United States from young children to the elderly." Response to Interrogatory No. 16. The adult members of this purchasing audience would include the same class of purchasers of liqueurs. Certainly there is no evidence to indicate that adults who purchase and consume liqueurs would not also purchase and consume ice cream. On the

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contrary, the third-party registration for "prepared alcoholic blend containing distilled spirits and ice cream," (No. 2,240,700) and the articles reporting on cocktails which contain ice cream suggest the opposite conclusion.

Turning to the marks, it is well established that it is permissible, when comparing marks, to accord more weight to particular features of the marks, as long as the marks are considered in their entireties. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In applicant's mark the word MALIBU is clearly the dominant element. The word ICE CREAM, which is the generic term for applicant's goods, has no source-indicating value. As for the palm frond design, visually the leaves simply form a decorative background which frames and emphasizes the words in the mark. Moreover, when a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods. **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987). Comparing opposer's mark MALIBU with applicant's mark, they are identical in sound in terms of the source-identifying elements; and similar in appearance in that opposer's mark, being registered as a typed drawing, could

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certainly be used in the script form employed in applicant's mark, while, as previously noted, the palm frond background design of applicant's mark does not have a strong source-indicating capacity. As for the connotation of the marks, applicant states that MALIBU is the name of a famous place in California and suggests palm trees, sun and beaches. Such a connotation would be equally applicable if the term were used with ice cream or with liqueur, particularly the coconut flavored rum liqueur with which opposer's marks are used. Thus, the connotations of the marks are identical. Accordingly, we find that the marks convey the same commercial impression.

Comparing opposer's mark MALIBU and design with applicant's mark, the same reasoning applies. If anything, the similarity in appearance of the marks is even greater because opposer's MALIBU and design mark contains a design of palm trees.

Applicant argues that opposer's marks are weak because the word portion is the name of a geographic place, Malibu, California. There is nothing in the record to show that MALIBU is being used or has been registered by third parties, such that we should deem the scope of protection for opposer's mark to be

circumscribed.<sup>13</sup> On the contrary, opposer has shown that when third parties have attempted to register marks containing the word MALIBU it has successfully opposed their registration. Given the lack of evidence of third-party use, and the evidence opposer has submitted as to its sales and promotion of its marks, we cannot find that opposer's marks are so weak that their scope of protection would not extend to the use of MALIBU on ice cream, a product which the record shows to be related to liqueurs.<sup>14</sup>

Although we do not find opposer's MALIBU marks to be weak, neither can we accept opposer's position that its marks are famous. Opposer's evidence shows that it has sold 48 million bottles of its liqueur in the United States between 1993 and 2000, but we have no indication

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<sup>13</sup> In its brief applicant has referred to a the MALIBU automobile, and in its interrogatory responses also has mentioned a "teenage television show MALIBU, CA on the internet at malibu-ca.com." Response to Interrogatory No. 20. However, applicant has not submitted any evidence regarding such usages.

<sup>14</sup> We note applicant's assertion throughout its brief that MALIBU is not a commercially distinctive term because of its geographic connotation. Such an assertion is at odds with applicant's position in seeking to register MALIBU and design as its mark. If applicant, by this assertion, wishes to claim that opposer's marks are geographically descriptive or geographically deceptively misdescriptive, applicant is advised that, because opposer's two registrations issued in 1983 and 1985, they cannot be attacked on such grounds. Further, there is no evidence in the record that would indicate that MALIBU is either geographically descriptive or geographically deceptively misdescriptive for liqueurs.

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of how this compares with other liquor sales. In this connection, we note from the articles submitted by opposer that company sales of alcoholic beverages are normally reported as number of cases, not individual bottles. Further, as applicant has pointed out, the fact that opposer's beverage is "the best-selling coconut flavoured rum drink in the United States" (Hamilton aff., ¶ 6) is not meaningful if it is the only coconut-flavored rum drink sold in the United States. Similarly, the fact that it may be the third most popular imported liqueur in the United States does not indicate its market share as compared to all liqueurs sold in the United States.

Nor is opposer's evidence as to its promotional activities sufficient to demonstrate that its MALIBU marks are famous. Opposer has not broken down the amounts spent on the various kinds of advertising or promotion it does, nor has opposer provided any examples of its advertising. Thus, we do not know whether the advertisements in "widely circulated magazines" consist of a mere listing of opposer's marks along with opposer's other product marks, or whether they are full-page ads featuring the MALIBU marks alone. As for the various newspaper and magazine articles taken from the NEXIS database, most, as indicated previously, are from trade

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journals, foreign publications or wire service reports. Of the 38 articles that are from general circulation newspapers and magazines, and thus would be seen by the general public, many of the references to opposer's MALIBU liqueur simply list "Malibu liqueur" as an ingredient in the context of a cocktail recipe. Although the articles do show that the public has been exposed to these references, we cannot say that this exposure is enough to make a strong impression on consumers. Accordingly, we cannot conclude, on the evidence of record, that opposer's MALIBU marks are famous.

We reiterate, however, that even if opposer's marks are not famous, they are still strong marks. Because of this, and because of the relationship which has been shown between liqueurs and ice cream, the fact that both products are sold to the general public and the similarities of the parties' marks, we find that confusion is likely if applicant's mark MALIBU and design were to be used on ice cream.

In reaching this conclusion, we have considered applicant's argument that the cost of opposer's product would avoid confusion. We cannot say that a retail price of between \$12 and \$14 a bottle ensures that a great deal of care would be exercised by the purchasers of opposer's

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goods. More importantly, however, ice cream, as acknowledged by applicant, is an "inexpensive 'impulse buy' ". Brief, p. 4. Thus, consumers who are familiar with opposer's MALIBU branded liqueurs are not likely, upon seeing the very similar MALIBU and design mark on ice cream, to undertake any investigation as to whether the goods come from the same source. Rather, because ice creams can be flavored with alcoholic beverages, they are simply likely to assume that the ice cream is licensed or sponsored by the source of MALIBU branded liqueur.

Thus, although some of the duPont factors favor applicant, when we consider all of the duPont factors for which evidence is of record, we find that the evidence in its totality supports a finding of likelihood of confusion.

Decision: The opposition is sustained and registration to applicant is refused.