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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AGE, Bodegas Unidas, S.A.

Serial No. 78/074,052

Jane F. Cullen of Cullen IP for AGE, Bodegas Unidas, S.A.

Florentina Blandu, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Hanak, Hohein and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 16, 2001, AGE, Bodegas Unidas, S.A.
(applicant) applied to register the mark SIGLO, in typed
form, on the Principal Register for goods identified as
"wines" in International Class 33.¹ The applicant has
indicated the Spanish word "Siglo" is translated as
"Century."

¹ Serial No. 78/074,052. The application contains an allegation
of a bona fide intention to use the mark in commerce.

The examining attorney has refused to register the mark under Section 2(d) of the Trademark Act because of a prior registration for the mark SIGLO DE ORO shown below for goods identified as "rum" in International Class 33.² 15 U.S.C. § 1052(d).



The mark is lined for the color gold and the words "Siglo de Oro" are translated as "Golden Century."

After the examining attorney made the refusal final, this appeal followed.

The examining attorney's position is that the term SIGLO in the registrant's mark is prominently displayed and the term "ORO is translated as gold and the term gold is one of the colors that rum comes in." Examining Attorney's Brief at 3. The examining attorney held that the points of similarities are greater than the differences between the marks because they share a common dominant element. In addition, the examining attorney found that the goods are related. She cited a prior case, apparently involving applicant, in which the Board found that wine and whiskey

² Registration No. 2,270,857, issued August 17, 1999.

were related goods. In re AGE Bodegas Unidas, S.A., 192 USPQ 326 (TTAB 1976). The examining attorney determined that the goods in this case (rum and wine) "are marketed to the same consumers and are sold through the same channels of trade." Examining Attorney's Brief at 6. The examining attorney also submitted copies of nine use-based registrations as evidence that wine and rum have been registered by the same party under a common mark.

Applicant, on the other hand, maintains that the registered mark is translated as "golden century" while applicant's mark is translated simply as "century." The registered mark, applicant argues, "suggests entirely different meanings than the Applicant's mark" (Applicant's Brief at 5) and the fact that both marks contain a common term does not mean the marks are confusingly similar. Applicant also disputes that the registrations that the examining attorney has placed in evidence demonstrate that the goods travel in the same channels of trade. Finally, applicant argues that wine purchases are not impulse purchases, "consumers of fine wines are a group of sophisticated purchasers," and the "sophistication of the average wine consumer is world renowned." Applicant's Brief at 11. Applicant concludes by arguing that the

differences in the marks and the goods support the reversal of the refusal to register.

We affirm.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that “[t]he fundamental inquiry mandated by § 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).

We start with a comparison of the applicant’s mark SIGLO and registrant’s mark SIGLO DE ORO (stylized). First, regarding applicant’s arguments regarding the stylization of the registered mark, since applicant’s mark is shown in typed form, no difference can be asserted with the stylization of the registered mark. Squirtco v. Tomy Corp., 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type

style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party. Tomy asserts rights in SQUIRT SQUAD regardless of type styles, proportions, or other possible variations. Thus, apart from the background, the displays must be considered the same").

Next, we compare the words in the marks and, having done so, we find that they are similar. Both marks contain the same word SIGLO. Indeed, it is the only word in applicant's mark and it is the first word in the registered mark. Registrant's mark also contains the additional Spanish words DE ORO, which are translated as "golden." Despite the presence of these words in the registration, we find that the marks still look and sound very similar inasmuch as they begin with the same word "Siglo."

Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000) ("[B]ecause both marks begin with "laser," they have consequent similarities in appearance and pronunciation") (quotation marks in original omitted). In addition, the presence of the words DE ORO would not significantly change the meaning and commercial impression of the marks. Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105, 106

(CCPA 1975) ("When one incorporates the entire arbitrary registered mark of another into a composite mark, inclusion in the composite mark of a significant nonsuggestive element does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion"). Even to those familiar with the Spanish language, the difference in meaning and commercial impression between "century" and "golden century" is not substantial. To those not fluent in Spanish, the differences would be even less prominent. In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ 1531, 1534 (Fed. Cir. 1997) (more weight given to common dominant word DELTA); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). We find that the differences between the marks are not enough to avoid confusion if the goods are related.

Therefore, we next examine the relationship of the goods, wine and rum. There is certainly no rule that the use of similar marks on different alcoholic beverages always results in a likelihood of confusion.³ However, it

³ See, e.g., G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635, (Fed. Cir. 1990) (RED STRIPE and design for beer not confusingly similar to a design of a red stripe for wines and sparkling wines); National Distillers and Chemical Corp. v. William Grant & Sons, Inc., 505 F.2d 719, 184 USPQ 34

is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association or connection between the producers of the respective goods. See In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

The question of whether specific alcoholic beverages are related to other beverages has been the subject of numerous cases. See, e.g., AGE Bodegas Unidas, 192 USPQ at 326 ("[T]here is clearly a relationship between wine and whiskey, both of which alcoholic beverages are sold through the same specialized retail outlets to the same purchasers, and are frequently bought at the same time"); In re Rola Weinbrennerei Und Likorfabrik GmbH & Co., 223 USPQ 57, 58 n.1 (TTAB 1984) ("Nevertheless, it is fair to say that

(CCPA 1974) (DUET on prepared alcoholic cocktails and DUVET for French brandy and liqueurs not confusingly similar).

adults who consume alcoholic beverages can and do consume soft drinks as well. There are no limitations as to channels of trade in the descriptions of goods before us and there can be little question that alcoholic beverages and soft drinks, travelling in their respective channels of trade (and, quite likely, overlapping in many respects) can and would come to the attention of the millions of adults who drink the former").

In a specific case involving rum and other distilled alcoholic beverages and wine, the Board found that there was a relationship between these alcoholic beverages.

In the case before us there is no doubt but that purchasers could readily distinguish the products of opposer from those of applicant. However, the products of both parties are alcoholic beverages which flow through the same channels of trade to the same class of purchasers, and we believe that a prospective purchaser of an alcoholic beverage upon entering and browsing through the various alcoholic products located or displayed on the various shelves or counters in retail liquor establishments would, upon encountering a whiskey, rum, brandy or vodka identified by the term "MONARCH", and then continuing on his jaunt to another counter or section of the same store and seeing a wine or champagne sold under the identical mark "MONARCH", be likely to believe that both products originated with the same producer.

Monarch Wines Co., Inc. v. Hood River Distillers, Inc., 196

USPQ 855, 857 (TTAB 1977).

Recently, the Federal Circuit has also addressed the issue of the relationship between various alcoholic beverages.

The PTO responds, and we agree, that malt liquor and tequila are similar by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers. Although the PTO apparently found no evidence of any manufacturer who both brews malt liquor and distills tequila, Majestic has not shown that the PTO's lack of evidence in that regard is relevant. Unless consumers are aware of the fact, if it is one, that no brewer also manufactures distilled spirits, that fact is not dispositive. The DuPont factors require us to consider only "trade channels," which may be, but are by no means necessarily, synonymous with manufacturing channels. In this case, Majestic has not demonstrated that consumers distinguish alcoholic beverages by manufacturer rather than brand name.

Majestic Distilling, 65 USPQ2d at 1204.⁴

Regarding the issue of whether the goods are related, the examining attorney has placed in the record nine use-based registrations that show that the same party has registered the same mark for wine and rum. See Registration Nos. 2,528,250; 2,215,583; 2,505,385; 2,402,053; 2,404,673; 2,000,976; 1,910,791; 1,747,347; and 1,550,458. See In re Mucky Duck Mustard Co., 6 USPQ2d

⁴ We are also aware of the case of In re National Distillers & Chemical Corp., 297 F.2d 941, 132 USPQ 271 (CCPA 1962) in which the CCPA noted there were differences in the marks and goods (MERITO for rum and MARQUES DEL MERITO for wines). These factors, along with a consent to register by the registrant, resulted in the CCPA concluding that there was no likelihood of confusion. There is no consent to register in the instant case.

1467, 1470 n.6 (TTAB 1988) (Although use-based, third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). This evidence and the case law leads us to conclude that rum and wine are not so dissimilar that the goods would not be considered related by the relevant purchasers.

Another factor we consider is the channels of trade. "[S]ince there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages." Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989). There are no restrictions on the goods in this case, so we must presume that applicant's wines and registrant's rum are likely to be sold through at least some of the same channels, i.e., stores that sell various alcoholic beverages.

We also believe that applicant's malt liquor is sufficiently related to opposer's Cognac brandy that, when sold under similar marks in the same channels of

trade, such as bars, restaurants and liquor stores, confusion is likely. While we have no doubt that purchasers are not likely to consume a malt liquor thinking that it is Cognac brandy, in view of the similarities of the mark it is reasonable to assume that purchasers may believe that BRADOR malt liquor is another premium imported alcoholic beverage sold by the same company which sells expensive BRAS D'OR Cognac Brandy.

Id. See also Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 136 USPQ 508, 514 (9th Cir. 1963) (BLACK & WHITE scotch whiskey confusingly similar to BLACK & WHITE beer; purchasers may believe that beer may be produced under the supervision of the scotch whiskey distiller or pursuant to some other arrangement with them).

In response to applicant's argument that "consumers of fine wine are a group of sophisticated purchasers" (Applicant's Brief at 11), we note that applicant's identification is not limited to fine wines.

Applicant does not dispute the identity of the goods but, rather, argues that its wine and the wine sold under the cited "PETRUS" trademark are expensive, high-quality wine sold to a small group of extremely sophisticated wine connoisseurs through high-quality wine and spirits stores and that these well-informed consumers are cognizant of the vineyard naming conventions in France and are sensitized to the vineyard naming practices whereby no connection between vineyards is presumed due to the inclusion of part of one vineyard's name in the name of another nearby, albeit unrelated, vineyard. The problem with this argument is that applicant is attempting to restrict the scope of its goods in its application and the scope of the goods covered in the cited registration by extrinsic argument and evidence while neither the recitation of goods in applicant's

application nor the recitation of goods in the cited registration is so restricted. It is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined by an analysis of the marks as applied to the goods identified in the application vis-a-vis the goods recited in the registration, rather than what extrinsic evidence shows those goods to be.

In re Bercut-Vandervoort & Co., 229 USPQ 763, 764-65 (TTAB 1986). See also Opus One, 60 USPQ2d at 1817 ("'[W]ine' must be presumed to encompass inexpensive or moderately-priced wine").

Inasmuch as applicant's goods are simply identified as "wines," we must not read limitations into the identification of goods. Applicant's goods are considered to include all types of wines sold through all normal channels of trade. Obviously, purchasers of wine in general are not necessarily sophisticated and this factor does not indicate that confusion is unlikely. In addition, "[o]ne can concede an enormous growth in recent years of buyer sophistication in wine purchasing without conclusion that this would obviate likelihood of confusion or transform all buyers into discriminating purchasers immune from source confusion." In re Jakob Demmer KG, 219 USPQ 1199, 1201 (TTAB 1983). There is also no evidence that wine and rum would not be impulse purchases as applicant suggests. Accord Majestic Distilling, 65 USPQ2d at 1207

("[M]alt liquor and tequila are both fairly inexpensive and likely to be purchased on impulse").

Finally, having considered the record in the case, we find that the marks SIGLO and SIGLO DE ORO (stylized) are similar and that the goods are related. When potential customers who are familiar with SIGLO DE ORO rum would encounter SIGLO wine, they are likely to believe that there would be some relationship or association between the sources of these products. Therefore, we conclude that there is a likelihood of confusion. Even if we had any doubts about whether there is a likelihood of confusion, it has long been the law that we must resolve those doubts in favor of the prior registrant and against the newcomer. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988)

Decision: The refusal to register is affirmed.