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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Treana Winery LLC

Serial No. 76532863

Scott W. Petersen of Holland & Knight for Treana Winery LLC.

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Before Hanak, Walters and Bucher, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Treana Winery LLC (applicant) seeks to register in typed drawing form WESTSIDE RED for "wine." The application was filed on July 28, 2003 with a claimed first use date of July 2003. The Examining Attorney noted at page 2 of the first Office Action that "the applicant must disclaim RED in the mark because it is merely descriptive of the color of the wine." Thereafter, applicant submitted a disclaimer of RED apart from its mark in its entirety.

Citing Section 2(d) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant's mark as applied to wine is likely to cause confusion with the mark WESTSIDE BLUE previously registered in typed drawing form for "wine." Registration No. 2,801,202.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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.").

Considering first the goods, they are legally identical. Both are described as simply "wine."

Without providing evidentiary support, applicant argues at page 2 of its brief that the wines are different in that "applicant's mark is used on a red wine which is produced in the Napa Valley, California. The cited

registrant has a single function for its wine products -- special low-alcohol served in a blue bottle for the Jewish holidays." Not only does applicant offer no evidence in support of this proposition, but moreover, even if this proposition were true, it is legally irrelevant. It is well settled that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the marks as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the cited registration], rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Because both the application and the cited registration listed the goods as simply "wine," then for our likelihood of confusion analysis, we must consider the goods to be legally identical.

Turning to a consideration of the marks, we note at the outset that when the goods of the parties are legally identical as is the case here, "the degree of similarity [of 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).

In this case both marks consist of two words, and both marks begin with the same arbitrary word WESTSIDE. As noted earlier, applicant has disclaimed the exclusive right to use the word RED in its mark acknowledging that red is merely descriptive of the color of its wine. In addition, as just noted, applicant, besides reiterating that its wine is a red wine, also argues that registrant's wine comes in a blue bottle. When used on wine marketed in a blue bottle, the BLUE portion of the registered mark would be viewed as merely indicating the color of the bottle.

Obviously, in comparing applicant's mark and registrant's mark we are obligated to compare the marks "in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, in comparing the marks in their entirety, it is completely appropriate to give less weight to a portion of a mark that is merely descriptive of the relevant goods or services. National Data, 224 USPQ at 751 ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.").

Not only is WESTSIDE the only arbitrary portion of both marks, but in addition, it is "the first word" in both marks, a factor which makes "the marks similar." Palm Bay

Imports, Inc. v. Veuve Clicquot, 396 F.3d 1369, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005). See also Presto Products v. Nice-Pak Products, 9 USPQ2d 1825, 1897 (TTAB 1998)(The fact that two marks share the same first word is generally "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

In sum, given the fact that the goods of applicant and registrant are legally identical and the additional fact that the two marks are very similar in that they both begin with the arbitrary word WESTSIDE and then end with mere descriptive wording causes us to find that the contemporaneous use of the two marks would result in a likelihood of confusion. This is particularly true because both applicant's mark and the registered mark are depicted in typed drawing form. This means that the two marks are not limited to being "depicted in any special form," and hence we are mandated to "visualize what other forms the mark[s] might appear in." Phillips Petroleum Co. v. C. J. Webb Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992). One reasonable manner of presentation for both marks would be to depict the arbitrary portion WESTSIDE in large lettering on one line, and then depict

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the subordinate elements (RED or BLUE) in decidedly smaller lettering on a second line. When so depicted, the two trademarks would be extremely similar, and their use on identical goods would result in not a mere likelihood of confusion, but rather in an extremely high probability of confusion.

Decision: The refusal to register is affirmed.