

Mailing:
January 25, 2005

This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Allied Domecq Spirits & Wine USA, Inc. substituted for
Twelve Islands Shipping Company Limited¹

v.

Lattis R. Richards

Opposition No. 91116378
to application Serial No. 75537317
filed on August 14, 1998

Edward T. Colbert, Karen Feisthamel and William M. Merone of
Kenyon & Kenyon for Allied Domecq Spirits & Wine USA, Inc.
and Twelve Islands Shipping Company Limited.

Lattis R. Richards, pro se.

Before Walters, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Lattis R. Richards has applied to register the mark
MALIBU ROCKS for "white chocolate covered walnuts and

¹ Allied Domecq Spirits & Wine USA, Inc. was previously joined as a party plaintiff. Opposer Twelve Islands Shipping Company Limited was retained as a party to facilitate presentation of evidence at trial. In view of the disposition of the notice of opposition by this decision, Allied Domecq may now be substituted. See Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003 (TTAB 1984).

Opposition No. 91116378

pecans" in Class 30. Applicant has submitted a disclaimer of exclusive rights to use MALIBU, apart from the mark as shown. The application asserts that the mark was first used on March 5, 1985 and was first used in commerce in December 1986.

Opposers have opposed issuance of a registration to applicant, pleading as a basis for their opposition prior use of the mark MALIBU, beginning "at least as early as 1983," (i.e., prior to applicant's first use of MALIBU ROCKS, as stated in applicant's application); ownership of Registration No. 1,261,893 for the mark MALIBU for "liqueur" in Class 33 (registration date December 20, 1983);² prior use of a MALIBU and design mark, beginning "at least as early as 1983" (i.e., prior to applicant's asserted first use of MALIBU ROCKS); ownership of Registration No. 1,374,134 for the mark MALIBU and Design for "liqueur" in

² The photocopy of the status and title copy of Registration No. 1261893 made of record by opposers during trial reveals that this registration issued based on a United Kingdom registration, with no assertion of use of the mark in commerce. Reference to the USPTO's PCTRAM computerized database of information on applications and registrations indicates that the mark was registered under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), though this is not indicated on the status and title copy. In addition, the PCTRAM database includes a description of the mark which has no relation to the single typed word MALIBU and does not appear on the status and title copy. Thus, we assume that both the PCTRAM reference to registration under Section 2(f) and the description of the mark as a configuration of goods appear in that database in error. Registration No. 1261893 was renewed in 2003 for a period of 10 years.

Class 33 (registration date December 3, 1985);³ that opposers' "registered MALIBU and Design mark is valid and subsisting, in full force and effect, and its use of the mark has been continuous"; that opposers' "registered MALIBU and MALIBU and Design marks are symbolic of the extensive goodwill and consumer recognition built up through the years" and opposers' use of the marks has resulted in public association of the marks with opposers; that there is a likelihood of confusion or mistake by consumers, or that they will be deceived, as to the source or origin of opposers and applicant's goods; that consumers reasonably could conclude that opposers may have licensed applicant's use of its mark, because applicant's goods are marinated in rum; that consumers of opposers' goods are potential consumers of applicant's goods and the respective goods will overlap; and that consumers of applicant's goods are not likely to exercise care in their purchasing decisions.⁴

³ Registration No. 1374134 issued based on use of the mark in commerce, and the registration states a first use date of September 2, 1980 and first use in commerce date of March 1983. Section 8 and 15 affidavits were filed for this registration and, respectively, accepted and acknowledged by the USPTO.

⁴ Opposers' claim under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) also asserts reliance on United States Registration No. 1780492, but USPTO records show that registration has been cancelled under Section 8 of the Trademark Act; and opposers' claim also relies on a United Kingdom registration, which is irrelevant to the Section 2(d) claim. In their brief, opposers discuss only their United States Registration Nos. 1261893 and 1374134. No consideration has been given to the cancelled United States registration or the United Kingdom registration.

Opposition No. 91116378

Also in opposers' notice of opposition is a claim under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), that applicant's mark will "seriously impair the uniqueness of," and "dilute the strength of" opposers' "famous MALIBU marks." Under applicable Board case law, opposers' pleading of dilution is insufficient. In addition, opposers have not discussed the claim in their brief and therefore we have not considered it.

Applicant expressly denied many of the allegations of the notice of opposition; the others were effectively denied when applicant asserted she was without sufficient information to admit or deny those allegations.

At trial, opposer filed three notices of reliance and the declaration testimony of Byron R. Jacobson, "Intellectual Property Counsel for Opposer" Allied Domecq Spirits & Wine USA, Inc.⁵ The record created through these submissions includes applicant's responses to certain of opposers' interrogatories, numerous third-party registrations, numerous printed publications or excerpts therefrom, a photocopy of a non-precedential Board decision, and the Jacobson testimony and accompanying exhibits.

⁵ Opposers state that the Jacobson testimony has been submitted in declaration form in accordance with "Trademark Rule 2.123(b) and the parties' earlier-filed stipulation." Applicant has not contested the statement that the parties entered into such a stipulation and we therefore accept opposers' statement as true.

As to opposers' notice of reliance on a previous non-precedential Board decision, we note that opposers may not rely on the decision for its statements of law. See General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, 1275, n. 9 (TTAB 1992). Also, as applicant was not a party to the prior Board proceeding, opposers may not rely on it for any claim or issue preclusive effect in this case.⁶ Thus, contrary to opposers' assertion, the decision submitted by notice of reliance cannot stand as evidence of the strength of opposers' marks, the relatedness of the involved goods, or the similarities in channels of trade; however, we agree with opposers that the decision is relevant evidence of opposers' efforts to protect their marks.

Applicant did not take any testimony or file any notices of reliance. In her brief, applicant asserts that there is evidence she could provide but was unable to provide during her assigned testimony period, for various reasons. To the extent applicant is requesting a reopening of the time to present evidence, she has not made a sufficient showing of excusable neglect, and we therefore deny the request. See Fed. R. Civ. P. 6(b)(2) and TBMP Section 509.01(b) (2d ed. rev. 2004) and authorities

⁶ Opposer Twelve Islands Shipping Company Limited was a plaintiff in the case, as was a predecessor-in-interest of opposer Allied Domecq Spirits & Wine USA, Inc.

discussed therein.⁷ Applicant also asserts that she provided evidence of her initial use of her mark in response to opposers' document request no. 13, and applicant has attached to her brief what she asserts is a copy of the document provided in response to the document request. A party's evidence generally must be submitted during its assigned testimony period, as originally set, as extended, or as reset following grant of a motion to reopen.⁸ See the general discussion in Section 702 of the TBMP. In regard to applicant's submission with her brief of a document produced to opposers during discovery, we note that we have not considered the document. We also note that applicant's submission of this document to the examining attorney during prosecution of applicant's application does not render it admissible or competent evidence merely because the application is automatically part of the record. Compare Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b) and the discussion in TBMP Section 704.04.

⁷ All references to the TBMP in this decision are to the second edition, revision 2004.

⁸ One exception is that a party may file with its pleading copies of any registration it owns, if such copies are prepared by the USPTO to show current status and title. In addition, the parties to a Board case can stipulate that evidence be admitted outside an assigned testimony period. Neither of these exceptions applies to applicant's submission of the exhibit with her brief.

Priority

Applicant states in her brief that "MALIBU ROCKS was first created in 1982-83" and "[t]he name was derived from the city of Malibu and because the product resembled little rocks strewn about the beach." Statements in a brief, however, are not evidence on a party's behalf. As explained in TBMP Section 704.06(b), "Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest."

The only evidence introduced at trial bearing on the question of applicant's first use is her response to opposers' interrogatory no. 6, wherein she references "adoption of MALIBU ROCKS in 1983." While such evidence is not without weight, "in 1983" is very vague, and even apart from the vagueness of this evidence, a party's response to an interrogatory may not be entitled to significant weight, for it is generally viewed as "self-serving." General Electric Co. v. Graham Magnetics Inc., 197 USPQ 690, 692 n.5 (TTAB 1977) *citing* Grace & Co. v. City of Los Angeles, 278 F.2d 771, 776 (9th Cir. 1960), and Beecham Inc. v. Helene Curtis Industries, Inc., 189 USPQ 647 (TTAB 1976). The trier of fact has discretion to decide what weight to give

to an interrogatory response. Fidelity & Deposit Co. of Maryland v. Hudson United Bank, 653 F.2d 766, 777 (3d Cir. 1981); and Freed v. Erie Lackawanna Railway Co., 445 F.2d 619, 621 (6th Cir. 1971).

In this instance, given the lack of corroborating evidence of any type—not even testimony from applicant—we do not accord this interrogatory response much value. Moreover, as noted above, statements in a brief can serve as admissions against interest and applicant explains in her brief that after she created her product and mark ("in 1983"), "the product was tested and given to friends throughout the southern California region at first, but then customers started purchasing it in bags, after which I (Applicant) decided to seek a trademark ... with the Secretary of States office in California since it had not been sold in interstate commerce at that time." Elsewhere in the brief, applicant explains that the state trademark registration was sought March 5, 1985. In sum, even if we knew precisely when in 1983 applicant first adopted her mark, we have no evidence when applicant transitioned from giving the product to friends to selling it "in bags."

In any event, priority is not an issue in this case, because opposer Allied Domecq has established, by the declaration testimony and exhibits of Byron R. Jacobson, both its ownership of the two relevant pleaded

registrations, Registration Nos. 1261893 and 1374134, and that they are in full force and effect. King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995).⁹

Likelihood of Confusion

Having determined that priority is not an issue in this case and, even if it were, based on the evidence of record opposers would prevail on that issue, we turn to the issue of whether there is a likelihood of confusion among consumers. In deciding this issue, we consider a range of factors. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods and services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d

⁹ If priority were an issue in this case, the preponderance of the evidence dictates that we would have to find for opposers on the issue. Even without evidence of actual use of their marks, they would be entitled to rely on the filing dates of their pleaded and proved registrations. The filing dates, respectively are August 30, 1982 for the MALIBU mark and April 28, 1983 for the MALIBU and design mark. In contrast, given the vague and uncorroborated evidence of applicant's asserted first use, the earliest date on which applicant can rely is the filing date of her involved application, August 14, 1998. Thus, based on filing dates, opposers would prevail on the question of priority.

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 services] and differences in the marks").

In comparing marks, we consider "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." Giant Food, Inc. v. Nation's Foodservice, Inc., 218 USPQ 390, 395 (Fed. Cir. 1983). Opposers' MALIBU mark is registered in typed form. Applicant seeks to register her mark in typed form. When marks are registered, or sought to be registered, in typed form, we must assess their similarity in terms of appearance based on the assumption that they can be presented in any reasonable forms of display, including the same type face or font. See Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). As to opposers' MALIBU and design mark, though this mark presents MALIBU in a particular font and in a slight arc (above the design element), because we must assume that applicant's mark can be set forth in any reasonable form of display, we must assume that applicant's mark can be displayed in this font and in a slight arc. Moreover, the MALIBU portion of the MALIBU and design mark would be the visually dominant portion, because it appears in large, upper-case letters above the palm trees and sunset

Opposition No. 91116378

design. Likewise, MALIBU would be the visually dominant portion of applicant's mark, as it is the first and longer word of the two.

In terms of the connotation of the marks, the parties disagree as to the likely perception of consumers of the ROCKS portion of applicant's mark. They do not, however, disagree about the likely perception of the common term MALIBU, i.e., there is no disagreement about this term being perceived as identifying a place in California. Applicant contends that the ROCKS portion of her mark will be perceived as referring to pebbles strewn on the beaches of MALIBU, while opposers contend that the term ROCKS will be perceived as meaning "ice," as when the phrase "on the rocks" is used to refer to the preparation of an alcoholic drink. We disagree with opposers insofar as it is highly unlikely that any consumer of applicant's goods would think of ice cubes when contemplating the mark MALIBU ROCKS used on or in conjunction with chocolate covered nuts. Focusing on the term MALIBU, this is the entirety of opposers' MALIBU mark and the only word in their MALIBU and design mark; and the palm tree and setting sun design in the latter would reinforce the connotation of MALIBU beaches, rather than alter the connotation otherwise attributable to MALIBU. As for applicant's mark, though applicant has disclaimed rights in the term MALIBU, consumers may not be aware of

disclaimers that are printed on registration certificates and disclaimers may not, in any event, help avoid confusion. See discussion in J. T. McCarthy, 3 McCarthy on Trademarks and Unfair Competition § 23:51 (4th ed. 2001). Thus, at a minimum, MALIBU is a significant part of applicant's mark in terms of its connotation. Further, MALIBU is the first term in applicant's mark and its connotation is more obvious than the connotation of ROCKS and therefore would be more likely to be the term relied on by consumers calling for applicant's goods.¹⁰ In short, the connotation or meaning of both of opposers' marks is the place in California known as "Malibu." Applicant's mark has a very similar connotation.

This dominant portion of the involved marks would be pronounced the same. Applicant does not dispute the point.

Overall, the commercial impressions of the marks are very similar, i.e., they both are evocative of a particular place in California. While applicant has argued in her brief that there are other parties that use "Malibu" as a term in marks identifying various products or services,

¹⁰ We note that the term "rock" has been used in a descriptive manner with confections, as in the term "rock candy," defined as "sugar in the form of large, hard, clear crystals." The American Heritage Dictionary of the English Language 1123 (New College Edition 1976)). While we cannot know whether consumers of applicant's goods would, when confronted with the mark MALIBU ROCKS for chocolate covered nuts, think of pebbles on the beach or some sort of rock hard confection, we believe they would be less likely to rely on the ROCKS term than on the MALIBU term, to remember and call for applicant's goods.

there is no evidence of record to establish this. Thus, we have no basis on which to find that the scope of protection for opposers' marks should be circumscribed, or on which to find that consumers would be accustomed to differentiating various marks containing the term "Malibu" based on other word or design elements.

We also note that the record establishes that opposers' MALIBU liqueur has been extensively advertised, widely sold and often specified as an ingredient for cocktails in numerous articles or printed publications. Jacobson declaration, paragraphs 5-7; opposers' notice of reliance on printed publications. Accordingly, the strength that we attribute to opposers' mark based on its apparent exclusivity is heightened by widespread promotion and references in articles and printed publications. While we do not find this record sufficient to prove that opposers' mark is famous, we do find it more than sufficient to prove the mark to be strong and distinctive.

Turning to the relatedness of the involved products, it is clear that liqueurs and chocolate covered nuts are not competitive products. Nonetheless, they are related. Liqueurs and chocolate covered nuts would not be viewed as complementary in the way that, for example, bread and butter would be, but they are products that could be served during the course of a single meal. Moreover, opposers have shown

Opposition No. 91116378

by many of the printed publications and third party registrations submitted by notice of reliance that it is not uncommon for liqueurs to be used as ingredients in confectionery products, or for the same marks to be registered for liqueurs and confectionery products. Finally, an exhibit to the Jacobson declaration shows that opposer Allied Domecq has, on one occasion, licensed use of its MALIBU marks for use in conjunction with a frozen dessert that utilizes opposers' liqueur as an ingredient.

Applicant argues that much of the evidence that shows use of liqueurs in confectionery centers on use of liqueurs in connection with chocolate products and that her product is a nut product coated with chocolate, not a chocolate product that happens to have nuts. We do not find this a significant distinction. As applicant has admitted in a response to one of opposers' interrogatories, her product "contains a rum flavor [but no rum per se] in a wonderful orange marinade." Opposers' notice of reliance on interrogatory responses, response no. 17. Thus, while applicant's product may be considered more a nut product than a chocolate product, it is still a product made by combining various ingredients and flavorings, as with confectionery products that do include a liqueur as an ingredient.

Applicant also argues that consumers of her product would not be aware of the licensing of liqueurs for use in other products. This Board, however, has observed in other decisions that licensing is a rather commonplace occurrence and we believe that even general consumers would be aware of the phenomenon. See, e.g., Turner Entertainment Co. v. Nelson, 38 USPQ2d 1942, 1945-46 (TTAB 1996) ("licensing of commercial trademarks for use on 'collateral' products... has become a common practice in recent years").

As to classes of consumers for opposers' and applicant's respective products, it is clear that opposers' class of consumers must be considered limited to those who can legally purchase alcoholic beverages. Such consumers, however, would be within the broader class of prospective consumers of applicant's product.

Applicant contends that her product, as a gourmet or gift item, generally would be sold in stores different from those in which opposers' liqueur would be sold. She admits, however, in her response to opposers' interrogatory no. 17, that her product may be sold in liquor stores. Further, we are constrained in our analysis to consider the parties' respective products as capable of being sold in all normal channels of trade for such products. See Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion

that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

While it can be presumed that opposers' liqueur can only be sold in stores authorized to sell alcoholic beverages, applicant acknowledges in her brief that this could include high-end grocery stores or stores specializing in gourmet and gift items; and applicant acknowledges that these are potential outlets for her product, too.

A likelihood of confusion among consumers may exist even when parties are not direct competitors and the rights of the owner of a mark extend to those goods or services which potential consumers might mistakenly conclude are related or have some common sponsorship. See In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001); In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

Applicant argues that potential consumers would understand that the MALIBU ROCKS product had no connection with opposers because "MALIBU ROCKS is always used in conjunction with SWEETREATS BY LATTISTM." We, however, cannot consider this as ameliorating any possible confusion, because

Opposition No. 91116378

applicant has not applied to register the composite mark "MALIBU ROCKS SWEETREATS BY LATTIS," and if MALIBU ROCKS alone were registered, then applicant would be free to use it with or without the legend SWEETREATS BY LATTIS. See Frances Denney v. Elizabeth Arden Sales Corp., 263 F.2d 347, 120 USPQ 480, 481 (CCPA 1959); and Blue Cross and Blue Shield Association v. Harvard Community Health Plan Inc., 17 USPQ2d 1075, 1077 (TTAB 1990).

Applicant also argues that there have been no instances of actual confusion. Such evidence is usually difficult to discover, however, and does not mean there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983) (Absence of significant evidence of actual confusion does not mean that there is no likelihood of confusion). For example, if consumers of applicant's product mistakenly thought it was made with opposers' product and enjoyed applicant's product after purchase, they might have no reason to complain.

Under the circumstances of this case, i.e., where the opposers' MALIBU mark and applicant's MALIBU ROCKS mark are very similar in terms of appearance, sound, connotation and overall commercial impression, and where there is an overlap of prospective purchasers and channels of trade, and where the goods are such that consumers would likely assume some

relationship as by licensing, common sponsorship or authorization by opposers for applicant to use opposers' mark, we find there to be a likelihood of confusion. Further, we note that were there any doubt about the possibility of confusion among consumers, we would have to resolve that doubt in favor of opposers.¹¹ See, e.g., Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd., 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985).

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

¹¹ In her brief, applicant asserts that doubt should not be resolved in favor of opposers because applicant has "established use of the MALIBU ROCKS mark for 22 years." As already noted, applicant has not introduced any evidence and has not established use of her mark for 22 years. Even if applicant had established long use of her mark, that would not establish, per se, that the rule requiring resolution of doubt in favor of a registrant be ignored.