

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: 8/30/06

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Domecq, Baxley, Resch and Niermeyer

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Serial No. 76585314

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Peter H. Smith, Esq. for Raymond Domecq, Glenn Baxley,  
Jackie Resch and Lawrence T. Niermeyer.

Howard Smiga, Trademark Examining Attorney, Law Office 102  
(Thomas V. Shaw, Managing Attorney).

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Before Quinn, Walters and Cataldo, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Raymond Domecq, Glenn  
Baxley, Jackie Resch and Lawrence T. Niermeyer, as joint  
applicants (hereinafter referred to as "applicant"), to  
register the mark RODEO COLD ("COLD" disclaimed) for "malt  
beverages, namely beer."<sup>1</sup>

The trademark examining attorney refused registration  
under Section 2(d) of the Trademark Act, 15 U.S.C.

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<sup>1</sup> Application Serial No. 76585314, filed April 6, 2004, based on  
an allegation of a bona fide intention to use the mark in  
commerce.

§1052(d), on the ground that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark RODEO STOUT ("STOUT" disclaimed) for "malt liquors, namely, stout" as to be likely to cause confusion.<sup>2</sup>

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant contends that there is no likelihood of confusion in view of the differences between the marks and the goods. In addition, applicant argues, its prior ownership of a registration, now canceled, of the same mark it seeks to register herein tips the scales in its favor.

The examining attorney maintains that the marks are dominated by the same, arbitrary term "RODEO," and that beer and stout are closely related products. The examining attorney submitted a dictionary definition of the term "stout," and, in connection with the comparison of the goods, copies of several third-party use-based registrations showing that each entity has registered a single mark for beer and stout. The examining attorney was not persuaded by applicant's claim that it previously owned a registration, indicating that he is not bound by the prior decisions of other examining attorneys.

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<sup>2</sup> Registration No. 1865390, issued November 29, 1994; renewed.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to compare the goods, namely beer and stout. It is not necessary that the respective goods be identical or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods 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 originated from the same producer. *In re Melville Corp.*,

18 USPQ2d 1386 (TTAB 1991). Further, although applicant draws several distinctions in the characteristics between beer and stout, the issue is not whether purchasers would confuse beer and stout, but rather whether there is a likelihood of confusion as to the source of the goods. In re Rexel Inc., 223 USPQ 830 (TTAB 1984).

It hardly need be stated that beer and stout are closely related malt beverages. As shown by the dictionary definition, "stout" is a type of strong, dark beer. In connection with this du Pont factor, the examining attorney introduced several third-party use-based registrations showing that each entity adopted a single mark for a variety of malt beverages, including beer and stout. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Further, beer and stout travel in the same trade channels, and the same classes of purchasers, including ordinary consumers, buy these beverages. Applicant would have us find that consumers of stout are sophisticated and, thus, less likely to be confused. More specifically, applicant contends that "stout consumers are a limited

class of consumers with a refined taste for their product, which has small appeal compared with the mass marketing appeal of beer," and that "stout consumers are apt to be more perceptive than the average consumer." (Appeal Brief, p. 7). Applicant has failed to support its proposition with any evidence. Moreover, its identification of goods contains no restrictions as to classes of purchasers, and it is presumed that stout would be purchased by all potential buyers thereof. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Accordingly, we have no reason to assume that potential purchasers could not include ordinary individuals interested in consuming a malt beverage, including those who drink beer. In any event, even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving very similar marks and closely related goods. See In re Research Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."]. See also In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

We next turn to consider the marks. In determining the similarity or dissimilarity of the marks, we must

compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper, for rational reasons, to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In comparing the marks *RODEO COLD* and *RODEO STOUT*, we first note that both begin with the same arbitrary term. We also note that applicant has disclaimed the descriptive word "COLD" and registrant has disclaimed the generic word "STOUT." Such descriptive or generic terms are often given little weight in likelihood of confusion determinations.

Ser No. 76585314

"Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 224 USPQ at 752. See also In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ["With respect to GOLD, the Board determined that the term denotes a premium quality, a descriptive term offering little to alter the commercial impression of the mark." Court found that as a result the Board had good reason to discount the term's significance]; and In re Code Consultants Inc., 60 USPQ2d 1699, 1702 [TTAB 2001) [Disclaimed matter is often "less significant in creating the mark's commercial impression"]].

While we have considered the marks as a whole, the term "STOUT" in registrant's mark and the term "COLD" in applicant's mark do not have much trademark significance. Each mark is clearly dominated by the identical, arbitrary portion "RODEO." "If the dominant portion of both marks is the same, the confusion may be likely notwithstanding peripheral differences." TMEP § 1207.01 (b)(iii) (4<sup>th</sup> ed. 2005). See, e.g., Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)

[HEWLETT PACKARD and PACKARD TECHNOLOGIES]; In re El Torito Restaurants Inc., 9 USPQ2d 2002 (TTAB 1988) [MACHO and MACHO COMBOS]; In re Equitable Bancorporation, 229 USPQ 709 (TTAB 1986) [RESPONSE and RESPONSE CARD]; and In re Corning Glass Works, 229 USPQ 65 (TTAB 1985) [CONFIRM and CONFIRMCELLS].

We find that the marks RODEO COLD and RODEO STOUT, when considered in their entirety, are substantially similar in sound, appearance, meaning and commercial impression. This factor favors a conclusion that there is a likelihood of confusion.

The only point raised by applicant that merits further discussion is its prior ownership of a now-canceled registration. Applicant explains that two of the four current joint applicants owned Registration No. 2149620, issued April 7, 1998, for the mark RODEO COLD covering "malt beverages, namely, beer." Applicant further explains that its prior registration, identical in all respects to the registration sought herein, lapsed on January 8, 2005 due to its failure to file an affidavit of continued use:

The registrants were not able to keep the 1998 RODEO COLD registration in effect because they had a significant gap in their use of the mark RODEO COLD for malt beverages, having lost their brewer, and they did not believe that it was appropriate to file a continuing

use affidavit. At this time, however, the applicants are still actively pursuing new brewers and intend to recommence use of the mark in interstate commerce. Therefore, they are still very interested in obtaining a notice of allowance in connection with their pending application. (Appeal Brief, p. 2).

Applicant contends that its now-canceled registration was examined without any citation to previously issued Registration No. 1865390 as a statutory bar under Section 2(d). Applicant goes on to argue that the coexistence on the register of its registration and the cited registration is probative in showing that there is no likelihood of confusion between the two marks. In the words of applicant, "RODEO COLD for beer was not deemed by the Patent and Trademark Office to be confusingly similar to RODEO STOUT for stout in 1996, and it should not be deemed to be confusingly similar to that mark in 2005 or 2006." (Appeal Brief, p. 8).

The situation in which applicant finds itself is not unprecedented. We fully recognize that applicant owned a prior registration, now canceled, for RODEO COLD for "malt beverages, namely, beer," and that the Office allowed that registration to issue over the now-cited registration for RODEO STOUT. However, there is longstanding, well-settled precedent holding that the Board is not bound by prior

decisions of examining attorneys, and that each case must be decided on its own merits and on the basis of its own record, in accordance with relevant statutory, regulatory and decisional authority. See, e.g., *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999). More specifically, we are not bound by the previous examining attorney's determination that applicant's mark was registrable, and we will not compound the problem of the registration of a confusingly similar mark by permitting such a mark to register again. *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991); and *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

The fact that the cited mark and applicant's mark at one time coexisted on the register does not prove that they coexisted during that time without confusion in the marketplace. Without evidence of the nature and extent of both applicant's and registrant's use of their respective marks, we cannot determine whether a meaningful opportunity for actual confusion ever existed. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). We cannot conclude that registrant had no objection to applicant's earlier registration simply because registrant failed to object to it. We are not privy to registrant's reasons for

**Ser No.** 76585314

not challenging the registration and we will not speculate about them. Further, any objections registrant may have had to applicant's earlier registration were eliminated once the registration was canceled. In re Thomas, 79 USPQ2d at 1028. See Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ["[A] canceled registration does not provide constructive notice of anything."].

We conclude that consumers familiar with registrant's stout sold under the mark RODEO STOUT would be likely to believe, upon encountering applicant's mark RODEO COLD for beer, that the malt beverages originate from or are associated with or sponsored by the same source.

**Decision:** The refusal to register is affirmed.