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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wine B&B Co.

Serial No. 85125544

Matthew H. Swyers of The Trademark Company for Wine B&B Co.

Michelle E. Dubois, Trademark Examining Attorney, Law
Office 107 (J. Leslie Bishop, Managing Attorney).

Before Seeherman, Zervas and Gorowitz, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Wine B&B Co. ("applicant") filed an application to
register the standard character mark SECRET WINE SHOP on
the Principal Register for (i) "wines" in International
Class 33 under Trademark Act Section 1(b), 15 U.S.C.

§ 1051(b); and (ii) "wine bars" in International Class 43
under Trademark Act Section 1(a), 15 U.S.C. § 1051(a).

Applicant claims first use and first use in commerce on
December 21, 2009 for "wine bars." Applicant entered a
disclaimer of "wine shop."

The assigned examining attorney refused registration of applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark used on applicant's goods and services so resembles the following three marks as to be likely to cause confusion or mistake or to deceive:

(i) **SECRET ALE** (standard character form, Registration No. 2063872, ALE disclaimed) for "beverages, namely beer and ale" in International Class 32;



SECRET O

(ii) (Registration No. 3042232) for "wines" in International Class 33;¹ and

¹ The registration contains the following description of the mark:

The mark consists of a stylized depiction of the word "SECRETO" above which is a circular design entered on an aged or worn parchment. The design shown on the parchment is in the nature of a circle within which is wording on the inner perimeter. The innermost portion of the circle shows a human head in profile above which is shown a crown.

The translation statement entered in the registration record provides, "The wording 'SECRETO VINA MAYOR' in the mark translates into English from Spanish as 'SECRET VINEYARD MAJOR' and the word 'RIBERA' translates into English from Spanish as 'BANK' or 'SHORE'."

(iii) **SECRET LABEL** (standard character form, Registration No. 3223374) for "wine" in International Class 33.

The three registrations are owned by three different entities.

Applicant appealed the refusal and briefs have been filed. We reverse the refusal to register.

Our determination under Trademark Act § 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

To evaluate the similarity of the marks, we first consider the strength of SECRET, the common term in applicant's and registrants' marks. In addition to the three registrations cited by the examining attorney, the record includes the following third-party registrations (all owned by different entities) for marks containing the

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term SECRET or SECRETO, which are either for wine or for services that are wine-related:

SECRET CLONE, Registration No. 3297322 for "wine";

SECRET OF PINK, Registration No. 3268644 for goods including "wine";

VALLE SECRETO VINEYARDS WINERY and design, Registration No. 3912044 for "wines";

TIERRA SECRETS, Registration No. 3661713 for "wine";

SECRET DE FAMILLE, Registration No. 3729615 for "wines";

SECRET ACRE, Registration No. 3851169 for "wine";

SECRET D'AMI and design, Registration No. 3405680 for goods including "wine";

SECRETO DE VIU MANENT, Registration No. 4065617 for "wines";

SECRET DE GRAND BATEAU, Registration No. 3818617 for "wines" and "wholesale and retail store services featuring wine; on-line wholesale and retail store services featuring wine";

SECRET DE CARDINALE, Registration No. 3708846 for "wine";

SECRET DE LA COMPTESSSE, Registration No. 3537294 for "wines, wines protected under the Bordeaux appellation of origin";

SECRETO PATAGONICO, Registration No. 3502758 for "wines";

LAKWOOD'S BEST KEPT SECRET, U.S. Registration No. 2890441 for "bar services";

SAAM LITTLE SECRET, U.S. Registration No. 3840507 for "restaurant and bar services"; and

TOP SECRET HOTELS, U.S. Registration No. 3891775
for services including "bar services" and "public
house services."

Although the third-party registrations are not evidence of actual use of the marks, the numerous third-party registrations - as well as the three cited registrations - demonstrate that the addition of various terms to SECRET has been sufficient for the Office to view the registered marks as being sufficiently different from one another such as not to cause confusion, and that the owners of the registrations did not have a problem with the later registration of the other registered marks. See *In re Hartz Hotel Services Inc.*, 102 USPQ2d 1150, 1154 (TTAB 2012) ("It is clear from the third-party registrations that the addition of a geographic location to the word GRAND HOTEL has been sufficient for the Patent and Trademark Office to view these marks as being sufficiently different from the cited registrant's mark, and from each other, such as not to cause confusion. We presume that the owner of the cited registration did not have a problem with the registration of these third-party marks, as they all issued after the registration of the cited registrant's registration without challenge by the registrant."). See also, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair*

Competition § 11:90 (4th ed. 2012) (“[Third-party] registrations ... show that the PTO, by registering several marks with such a common segment, recognizes that portions of such composite marks other than the common segment are sufficient to distinguish the marks as a whole and to make confusion unlikely.”).

With this in mind, we compare applicant’s mark with the three cited marks. In addition to SECRET, applicant’s mark has the wording WINE SHOP, so that the mark as a whole conveys the meaning of a place. In contrast, the SECRET ALE mark refers to an alcoholic beverage, SECRETO is a Spanish language term which gives the mark, used in the context of wine, a South American or Spanish flavor. With regard to the SECRET LABEL mark, the examining attorney submitted with her brief the following definitions of “label” from *The American Heritage Dictionary of the English Language* (4th ed. 2000), accessed at thefreedictionary.com, of which we take judicial notice; “a distinctive name or trademark identifying a product or manufacturer, especially a recording company.”² Based on

² The Board may take judicial notice of dictionaries and encyclopedias, including online dictionaries and encyclopedias which exist in printed format. See *In re Cyber Financial.Net., Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

this definition, consumers will view the phrase SECRET LABEL as the equivalent of "SECRET brand." The connotation of each mark is different. Hence we find the marks are different from one another.

We find that the dissimilarity of the marks outweighs the other *du Pont* factors that would favor a finding of likelihood of confusion, namely, the similarity of the goods and services, overlapping trade channels and purchasers, and purchasers who are not sophisticated or making purchases with particular care. See *Kellogg Co. v. Pack-Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive. ... 'each [of the thirteen elements] may from case to case play a dominant role.'"). Accordingly, we find that applicant's mark SECRET WINE SHOP for wines and wine bars is not likely to cause confusion with each of the cited registrations.

Decision: The refusal to register applicant's mark in both International Classes 33 and 43 is reversed.