

This Opinion is not a  
Precedent of the TTAB

Mailed: September 28, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—————  
Trademark Trial and Appeal Board

—————  
*In re Balencorp Inc.*

—————  
Serial No. 86115113

—————  
Amy Sullivan Cahill of Stites & Harbison PLLC  
for Balencorp Inc.

Seth A. Rappaport, Trademark Examining Attorney, Law Office 103,  
Michael Hamilton, Managing Attorney.

—————  
Before Quinn, Taylor and Lykos,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On November 11, 2013, Balencorp Inc. (“Applicant”) filed an application to register on the Principal Register the mark displayed below for services ultimately identified as “spirits distillery services” in International Class 40 and “[e]ducation and entertainment services, namely, conducting guided tours of a visitor's center exhibiting the operation of a distillery” in International Class 41.<sup>1</sup>

---

<sup>1</sup> Application Serial No. 86115113, filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce. The description of the mark is as follows: “The mark consists of the wording ‘SILVER TRAIL DISTILLERY’ above the wording ‘HARDIN, KENTUCKY,’ which appears inside a shaded rectangle. The wording appears above a design of a vintage automobile driving down a road. There are



Applicant has disclaimed the words “DISTILLERY” and “HARDIN, KENTUCKY” apart from the mark as shown.

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark **SILVER TRAIL** (standard characters) for “Alcoholic beverages except beers” in International Class 33,<sup>2</sup> that, when used on or in connection with Applicant’s Class 40 services,<sup>3</sup> it is likely to cause confusion or mistake or to deceive.

Applicant has appealed the final refusal to register the mark for the Class 40 services. The appeal is fully briefed. For the reasons set forth below, we affirm the Section 2(d) refusal.

---

bushes on the side of the road. The wording and the design element appear inside an oval with an open star at the top and center of the oval.” Color is not claimed as a feature of the mark.

<sup>2</sup> Registration No. 4406749, registered on September 24, 2013, alleging March 24, 2009 as the date of first use anywhere and in commerce.

<sup>3</sup> The refusal does not apply to the Class 41 services.

### ***Likelihood of Confusion Analysis***

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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 and/or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and others are discussed below. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (even within *du Pont* list, only factors that are “relevant and of record” need be considered).

### ***The Marks***

We commence with the first *du Pont* likelihood of confusion factor which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph*

*Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d, 1901, 1905 (TTAB 2007)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

That being said, our analysis cannot be predicated on dissection of the involved marks. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Rather, we are obliged to consider the marks in their entireties. *Id.* See also, *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161.

Applicant argues that the design element, not the word portion, of Applicant’s mark is dominant in terms of the mark’s overall commercial impression. Applicant focuses on the vintage automobile with exhaust trailing behind on a bumpy road, the thick circular border, and star apex as presenting “stark differences” with Registrant’s word mark.

We acknowledge the differences in the marks pointed out by Applicant in terms of graphics and wording. Nonetheless, we agree with the Examining Attorney's determination that the literal element SILVER TRAIL is the dominant feature of Applicant's mark, given the lesser significance we may attribute to the disclaimed matter DISTILLERY and HARDIN, KENTUCKY and design elements. It is well established that disclaimed matter generally will not constitute the dominant part of a mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). It is equally well established that when a mark consists of a literal portion and a design portion, the literal portion is usually more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011).

Thus, comparing Applicant's mark as a whole to the registered mark we find that consumers encountering Applicant's and Registrant's marks are more likely to

focus on the wording SILVER TRAIL as the first literal portion. *See Palm Bay*, 73 USPQ2d at 1692. Because the marks are similar in connotation and commercial impression, the first *du Pont* factor weighs in favor of finding a likelihood of confusion.

### ***The Goods and Services***

The next step in our analysis is a comparison of the Class 40 services identified in Applicant's application vis-à-vis the goods identified in the cited registration. *See Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also, Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). The goods and services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). The respective goods and services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *Coach Servs., Inc.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). *See also On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). The issue here is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the

source of these goods and services. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Applicant argues that the Examining Attorney has failed to meet the Office's burden of proving that Applicant's "spirits distillery services" are related to Registrant's "alcoholic beverages except beers." Applicant contends that whereas its distillery services are offered to third parties who wish to produce distilled spirits bearing their own trademarks, Registrant is selling alcoholic beverages, mainly wine.

Applicant is correct that it is the Examining Attorney's burden to establish that the involved goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods). Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based third-party registrations of marks listing both goods/services of the type identified in the applicant's application and the cited registration. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). We find that in this case, the

Examining Attorney has met the Office's burden by making of record the following used-based third-party registrations identifying both Applicant's Class 40 services and Registrant's goods which are identified as "alcoholic beverages except beers":

- Reg. No. 3738327 for the mark GEORGE WASHINGTON'S DISTILLERY for "whiskey" and "distillery services."
- Reg. No. 4111584 for the mark NEW HOLLAND ARTISAN SPIRITS for "distilled spirits" and "spirits distillery services."
- Reg. No. 4314461 for the mark FILIBUSTER for "whisky distillery services" and "blended whisky; bourbon; bourbon whisky; malt whisky; whiskey; whisky."
- Reg. No. 4351244 for the mark HERITAGE DISTILLING COMPANY, INC. for "alcohol distillery services" and "alcoholic beverages except beers, wines and tequilas; alcoholic beverages, namely, flavor-infused whiskey."
- Reg. No. 4292470 for the mark MY BATCH for "alcohol distillery services" and "alcoholic beverage produced from a brewed malt base with natural flavors; alcoholic beverages containing fruit; alcoholic beverages except beers; alcoholic beverages of fruit; alcoholic beverages, namely, digestifs; alcoholic beverages, namely, flavor-infused whiskey; alcoholic bitters; alcoholic cocktail mixes; alcoholic extracts; alcoholic fruit cocktail drinks; alcoholic mixed beverages except beers; Rum."

See Final Office Action dated June 11, 2015. As a general proposition, although third-party registrations alone are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have probative value to the extent they are based on use in commerce and may serve to suggest that the goods are of a kind that emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6

USPQ2d 1467, 1470 n.6 (TTAB 1988).<sup>4</sup> With regard to the third-party registrations, the term “alcoholic beverages” in Registrant’s mark is sufficiently broad to encompass other more specific types of alcoholic beverages such as bourbon and whisky. Accordingly, the second *du Pont* factor also weighs in favor of finding a likelihood of confusion.

### ***Fame of the Prior Mark***

We now turn to the fifth *du Pont* factor, the fame of the cited mark, as argued by Applicant. Applicant erroneously states that because the record is devoid of fame of the registered mark, this *du Pont* factor weighs in favor of finding no likelihood of confusion. The absence of such evidence has minimal significance in an *ex parte*

---

<sup>4</sup> The Examining Attorney also provided website evidence showing alcoholic distilleries selling alcoholic beverages (excluding beer). See Final Office Action dated June 11, 2015, Green Hat (<http://greenhatgin.com>), A. Smith Bowman Distillery (<http://asmithbowman.com>), Copper Fox Distillery (<http://copperfox.biz>). As Applicant correctly points out, it appears that none of the aforementioned entities are providing alcohol distilling services to third parties. Rather, it appears from the materials that each entity distills its own products for retail sale. For this reason, we have not relied on this evidence in reaching our determination.

In addition we agree with Applicant’s objection that the majority of evidence submitted by the Examining Attorney from the Catocin Creek Distilling Company website (<http://catocincreekdistilling.com>) is illegible because it consists of blank pages in the color black. While the evidentiary requirements in an *ex parte* appeal are less stringent, both examining attorneys and applicants have a duty to ensure that their submissions are legible. Cf. *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (“It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible ...,” finding that applicant's objections, raised for the first time in its trial brief, to illegible exhibits submitted with opposer's notice of reliance, to be timely). Nonetheless, we decline to strike the documents in their entirety because some portions are legible. That being said, the Board can only review evidence that is clear and unobstructed so we have considered only the legible portions for whatever value they may have. See *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013), *aff'd*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.).

appeal. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). This factor is therefore neutral.

### ***Actual Confusion and Contemporaneous Use***

Applicant points to contemporaneous use of its mark for a number of years with Registrant's mark and the absence of evidence of actual confusion. Applicant asserts this argument, despite the fact that its application was filed under Trademark Act Section 1(b) ("intent to use"). We acknowledge that Applicant may in fact be using its applied-for mark in commerce. Nonetheless, a showing of actual confusion would of course be highly probative, if not conclusive, of a likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). The issue before us is the likelihood of confusion, not actual confusion. *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (actual confusion not required). Further, any suggestion that there has been no actual confusion between the marks based on the coexistence of Applicant's mark and the cited registration is entitled to little probative value in the context of an *ex parte* appeal. *In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205. The seventh and eighth *du Pont* factors are therefore neutral.

### ***Applicant's Intent in Adopting Its Mark***

Lastly we note that Applicant argues that because the record does not show that Applicant harbored malicious intent in adopting or filing its application, this favors a finding of no likelihood of confusion. "[I]ntent in adopting a mark is not decisive

on the issue of confusing similarity...” *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 643 (TTAB 1984). Moreover, in the context of an *ex parte* appeal where no discovery or testimony can be presented or taken, we cannot place any probative value to the absence of bad intent on the part of an applicant. As such, we deem this neutral in our analysis.

### ***Conclusion***

In the present case, the critical first and second *du Pont* factors each favor a finding of likelihood of confusion. The other *du Pont* factors are neutral.

After considering all of the evidence properly of record and arguments pertaining to the *du Pont* likelihood of confusion factors, we find that there is a likelihood of confusion between Applicant’s applied-for and Registrant’s registered mark as to Applicant’s services identified in Class 40.

*Decision:* The Section 2(d) refusal to register Applicant’s mark for the Class 40 services is affirmed. The applied-for mark will be forwarded for publication in the *Official Gazette* for the services in Class 41.