

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 10, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

E. & J. Gallo Winery

v.

Kinney Family Vintners LLC d/b/a Occasio Winery

Opposition No. 91207656
to Application Serial No. 85519705

Steven M. Weinberg of Holmes Weinberg, PC for E. & J. Gallo Winery.

Daniel W. Celander of Celander Law Firm Ltd. for Kinney Family Vintners LLC
d/b/a Occasio Winery.

Before Zervas, Taylor and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Kinney Family Vintners LLC d/b/a Occasio Winery (“Applicant”) seeks registration of APOTHEOSIS, in standard characters, for “Red wine; Red wines; Table wines; Wine; Wines derived from grapes grown in Livermore AVA, labeled and advertised in compliance with TTB and CA ABC laws for California.”¹ In its

¹ Application Serial No. 85519705, filed January 18, 2012 based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act.

notice of opposition, E. & J. Gallo Winery (“Opposer”) alleges prior use of APOTHIC for wine and that use of Applicant’s mark would be likely to cause confusion with Opposer’s mark.² In its answer, Applicant denies the salient allegations in the notice of opposition and asserts the affirmative defenses of “laches” and “unclean hands,” but failed to explain, pursue or prove these asserted defenses at trial, which are accordingly waived.³ *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

The Record

The record consists of the pleadings, the file of the involved application, and the following:

Opposer’s Notice of Reliance (“Opposer’s NOR,” TTAB Dkt. No. 16) on printouts from Opposer’s website, Applicant’s responses to Opposer’s first set of interrogatories, the discovery deposition of John Kinney, Applicant’s sole member and executive and the exhibits thereto (“Kinney Disc. Tr.”), and dictionary and thesaurus entries.⁴

² Opposer also pleaded ownership of registrations for APOTHIC (Registration No. 4093343) and APOTHIC RED (Reg. No. 3713187), but failed to make these registrations of record. While Applicant’s involved application is automatically of record, a plaintiff must properly introduce its pleaded registration(s). *Compare* Trademark Rule 2.122(d) and TBMP § 704.03(b)(1)(A) (2014), addressing plaintiffs’ registrations *with* Trademark Rule 2.122(b)(1) and TBMP § 704.03(a) addressing defendants’ applications.

³ Applicant also asserted that the parties’ marks are not confusingly similar, which is merely an amplification of its denials of Opposer’s allegations, and that the notice of opposition fails to state a claim upon which relief may be granted, which we need not consider at this stage because it was not supported by a timely motion. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d* 565 Fed. Appx. 900 (Fed. Cir. 2014) (mem.).

⁴ Opposer unnecessarily filed separate notices of reliance on/for each piece of evidence included in TTABVue Dkt. No. 16, but for convenience we will simply cite “Opposer’s NOR” for all materials submitted with that filing.

Applicant's first Notice of Reliance ("Applicant's NOR No. 1," TTABVue Dkt. No. 17) on the April 24, 2012 Office Action issued in connection with the involved application, Opposer's responses to Applicant's first and second sets of interrogatories, dictionary entries, printouts from Opposer's website, the Department of Treasury's Alcohol and Tobacco Tax and Trade Bureau's ("TTB") website and "latinlexicon.org"'s website, and printouts of Google search results.

Applicant's second Notice of Reliance ("Applicant's NOR No. 2," TTABVue Dkt. No. 18) on Urban Dictionary entries and printouts from the "orthodoxwiki.org" and TTB websites.

Opposer's testimony deposition of Katie Griesbeck (TTABVue Dkt. No. 20), its Marketing Manager for APOTHIC wine and the exhibits thereto ("Griesbeck Tr.").

Applicant's testimony deposition of Mr. Kinney (TTABVue Dkt. No. 25) and the exhibits thereto ("Kinney Test. Tr.").

Standing and Priority

Opposer established, and Applicant does not dispute, that it has used APOTHIC for wine since at least as early as 2010. Griesbeck Tr. at 15-16, 27, 29 and Exs. 1-3, 12. This establishes Opposer's standing. *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) ("Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding.") and *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..." where opposer alleged likelihood of confusion). It also establishes that Opposer has priority, because the filing date of Applicant's intent to use application

was January 18, 2012, and Applicant has not claimed or established any use prior to that date. Opposer's Notice of Reliance (Applicant's response to Opposer's Interrogatory No. 11) ("APPLICANT'S MARK has not been used in commerce and ... no goods bearing APPLICANT'S MARK exist ...").

Likelihood of Confusion

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, 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). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 222 F.3d at 943, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which the parties introduced evidence, and treat the remaining factors as neutral.

Goods, Channels of Trade and Classes of Purchasers

Opposer uses its mark for wine. Griesbeck Tr. at 15-16, 27, 29 and Exs. 1-3, 12. Applicant seeks registration for, *inter alia*, "wine." The goods are therefore identical. Furthermore, because the goods are identical, we must presume that the channels of trade and classes of purchasers are as well. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence

regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

To the extent Applicant relies on evidence about its “membership” system and other methods of sale, the pricing of its wine, or the sophistication of its or Opposer’s customers, this evidence is irrelevant. None of these alleged differences are reflected in Applicant’s identification of goods, which includes “wine,” without qualification or limitation. *See, Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014)

The legal identity of Opposer’s and Applicant’s goods and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity of the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

The Fame/Strength of Opposer’s Mark

Opposer argues that its mark is “very well known,” and cites cases concerning and makes references to “fame.” We therefore assume that Opposer is claiming that APOTHIC is a “famous” mark.

Where fame exists, it “plays a ‘dominant role in the process of balancing the *DuPont* factors,’ ... and ‘[f]amous marks thus enjoy a wide latitude of legal

protection.” *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). In fact, it is settled that a strong mark “casts a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

While consumer surveys may provide direct evidence of fame, “fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose*, 293 F.3d at 1367, 63 USPQ2d at 1305. Other relevant factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012). Opposer bears the burden of clearly proving fame. *Id. Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Here, while Opposer has designated most of its evidence of fame/strength as “confidential,” and we therefore only discuss it generally, suffice it to say that APOTHIC wines are popular, apparently increasingly so, have enjoyed significant sales by any measure and Opposer has spent liberally on advertising and promotion. Opposer’s APOTHIC wines have received media attention, including favorable reviews. Furthermore, Opposer has successfully promoted APOTHIC wines via social media, and there are over 150,000 fans of APOTHIC wines on

Facebook. However, “[w]e have no context for opposer’s advertising and sales figures,” or its social media efforts, “such as how the figures for the [APOTHIC wine] compare with that for other brands of” wine. *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1831 (TTAB 2012); *see also, Bose*, 63 USPQ2d at 1309 (“some context in which to place raw statistics is reasonable”).⁵ Moreover, Opposer has only used APOTHIC since 2009 at the earliest.

Accordingly, Opposer has not “clearly proven” that APOTHIC is a “famous” mark. However, Applicant has provided no evidence that Opposer’s mark is commercially or conceptually weak, and Opposer’s evidence is sufficient to establish that APOTHIC is at least a fairly strong mark and entitled to a concomitantly broad scope of protection. This factor also weighs in favor of a finding of likelihood of confusion.⁶

The Marks

Turning to the parties’ marks, we must compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73

⁵ Ms. Griesbeck’s testimony about “brand health data,” tracked online, is insufficient to establish fame, even though the data apparently reveals that a significant number of those surveyed were aware of the APOTHIC brand. Indeed, there is no evidence about the details of these surveys, who exactly was questioned, what the specific questions and responses were, or any other information traditionally required before surveys are accorded evidentiary weight. *See, American Flange & Manufacturing Co., Inc. v. Rieke Corp.*, 80 USPQ2d 1397, 1414 (TTAB 2006), *withdrawn after settlement*, 90 USPQ2d 1127 (TTAB 2009); *Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783, 1786-87 (TTAB 2006); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:187 (4th ed. 2014).

⁶ We hasten to add, however, that even if Opposer had not established that its mark is strong, our ultimate decision on likelihood of confusion would be the same.

USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). That is, we may not dissect the marks into their various components. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981). However, one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant feature of a mark in determining its commercial impression. *In re Nat'l. Data Corp.*, 224 USPQ at 751 (“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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”).

Here, the parties’ marks not only share, but begin with, the same five letters: “APOTH.” Consumers are likely to focus on the first part of the parties’ marks. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *see also Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009) (PALOMITA likely to be confused with PALOMA). The marks look and sound similar as a result of sharing the same five initial letters.

As for the marks’ connotations, Applicant’s mark APOTHEOSIS is a word which means “the perfect form or example of something,” “the highest or best part of something,” “elevation to divine status” and “the perfect example.” Applicant’s NOR No. 1 (definitions from Free Merriam-Webster Dictionary); *see also*, Griesbeck Tr. at 78 (“Some of the definitions that I’ve seen are the highest pinnacle, the culmination,

the ultimate point.”); Kinney Test. Tr. at 11 (“It means to raise to a higher standard. It means pinnacle. The top of one’s work. And it means to achieve or to almost make devine (sic) in status.”).

Opposer’s bottle labels and website indicate that Opposer’s mark is derived from the word “Apotheca”: “More than 800 years ago, vintners blended and stored their most coveted concoctions in a mysterious place called *Apotheca*. In late 2005, a Master Winemaker envisioned an epic red wine that would combine Old World blending traditions with a markedly New World Style.” Opposer’s NOR (printouts from Opposer’s website “apothic.com”); *see also*, Applicant’s NOR No. 1 (printout from TTB website including label for Apothic Red). In a “Brand Overview” document created in 2011, prior to Applicant’s filing date, Opposer explained “The Origin of the Name” APOTHIC as follows: “Apotheca + Epic = Apothic.” Griesbeck Tr. at 11-14 and Ex. 1. The same document defines the word “epic,” as used in this equation, as “Surpassing the usual or ordinary. Heroic and impressive in quality.” *Id.*

While Opposer apparently intends for its mark to be perceived as “Apotheca + Epic,” there is no evidence that consumers will understand APOTHIC to include the word “epic” or its meaning; we cannot presume that consumers will perceive this meaning from the mere inclusion of the letters “ic” at the end of Opposer’s mark, or otherwise. Therefore, we cannot find that the marks convey similar meanings. At the same time, however, we agree with Opposer that because “apotheosis” is not a commonly-used word, to many consumers Applicant’s mark would not connote

anything, and its meaning would therefore not necessarily be a basis to distinguish it from Opposer's mark, especially where both marks begin with the letters "APOTH."

The evidence reveals that Opposer has expanded its use of APOTHIC to several different types of wine, including APOTHIC RED, APOTHIC WHITE, APOTHIC ROSE and APOTHIC DARK. Griesbeck Tr. at 20-21, 37, 48-52, 57-58 and 74 and Exs. 1, 2, 8, 14 and 28. Consumers familiar with Opposer's expanding use of the APOTHIC mark may be likely to assume that APOTHEOSIS is another expansion, or variation, of Opposer's use of APOTHIC.

Considering the marks in their entirety, we find that they are more similar than dissimilar, especially because where, as here, trademarks would appear on identical goods, the degree of similarity necessary to support a finding 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). The marks' similarities in appearance and sound are more significant than any perceived differences in connotation, especially because they both begin with the letters "APOTH" and consumers are familiar with Opposer's expanding use of its mark. This factor therefore also weighs in favor of a finding of likelihood of confusion.⁷

Conclusion

⁷ Applicant's focus on Opposer's use of its "A" design mark is misplaced. The issue is whether there is a likelihood of confusion between Applicant's mark and Opposer's pleaded APOTHIC mark. In any event Opposer at times uses APOTHIC alone, apart from the "A" design mark, and the media often refers to Opposer's mark APOTHIC alone, apart from the "A" design. Griesbeck Tr. at 79 and 93 and Exs. 10-12.

The parties' goods, channels of trade and classes of purchasers are identical, their marks are more similar than dissimilar and Opposer's mark is somewhat strong. Opposer has therefore established its claim of priority and likelihood of confusion by a preponderance of the evidence.

Decision: The opposition is sustained and registration of Applicant's mark is refused under Section 2(d) of the Trademark Act.