

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Round Hill Cellars dba Rutherford Wine Company

v.

Cape Wine Ventures, LLC

—
Cancellation No. 92057705
to Application Serial No. 85412967
—

J. Scott Gerien of Dickenson Peatman & Fogarty,
for Round Hill Cellars dba Rutherford Wine Company.

Jeffrey A. Sadowski of Howard & Howard Attorneys PLLC,
for Cape Wine Ventures, LLC.

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Before Kuhlke, Taylor and Kuczma,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Round Hill Cellars dba Rutherford Wine Company (Petitioner) filed a petition for cancellation of Registration No. 4265402 for the mark BANDANA registered by Cape Wine Ventures, LLC (Respondent).

As grounds for cancellation, Petitioner alleges ownership of U.S. Trademark Registration No. 4292641 for the mark RED BANDANA¹ in standard characters for “Alcoholic beverages except beers” against Respondent, owner of U.S. Trademark Registration No. 4265402, for the mark BANDANA² in standard characters for “Wine.” The Petition to Cancel is based upon likelihood of confusion under 15 U.S.C. § 1052(d).

In its Answer, Respondent denied the salient allegations in the Petition for Cancellation and also asserted Affirmative Defenses in the nature of lack of likelihood of confusion, laches, priority of use and acquiescence.

I. The Record

A. Petitioner’s Evidence

Petitioner introduced the following evidence via Notice of Reliance:

1. A copy of the TSDR record for U.S. Registration No. 4292641 for the mark RED BANDANA for alcoholic beverages except beers (Exhibit 1).
2. A printout from the website <http://www.thewineconnection.com> showing the RED BANDANA wine advertised for sale (Exhibit 2).
3. A printout from the website <http://foodiefriendsfridaydailydish.com> showing consumer recognition of Petitioner’s RED BANDANA wine (Exhibit 3).

¹ Registration No. 4292641 issued on February 19, 2013, based on Application Serial No. 77882682 filed on November 30, 2009, in which Petitioner alleged a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

² Registration No. 4265402 issued on December 25, 2012, based on Application Serial No. 85412967 filed on September 1, 2011, in which Respondent alleged a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

4. A printout from the website <http://www.rutherfordwine.com> showing Petitioner's advertisement of its RED BANDANA wine (Exhibit 4).
5. A copy of the Certificate of Label Approval, an official government record, issued by the Alcohol and Tobacco Tax and Trade Bureau for the label for Petitioner's RED BANDANA wine (Exhibit 5).

B. Respondent's Evidence

Respondent did not submit any evidence or testimony, nor did it submit a trial brief.

II. Standing

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). To establish standing in a cancellation, a petitioner must show both "a real interest in the proceedings as well as a 'reasonable basis' for his belief of damage." *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Petitioner's standing is established with respect to its likelihood of confusion claim by its registration of the mark RED BANDANA which the record shows to be valid and subsisting and owned by Petitioner.³ *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

III. Priority

To establish priority, Petitioner must show proprietary rights in the mark RED BANDANA that produce a likelihood of confusion. *Otto Roth & Co. v. Universal*

³ Exhibit 1 (9 TTABVUE 6-8).

Foods Corp., 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *Herbko International Inc. v. Kappa Books Inc.*, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) citing *Otto Roth & Co. v. Universal Foods Corp.*, 209 USPQ at 43. Competent evidence also includes a party's application or registration for the relevant mark, for when an application or registration is made of record, the evidence includes its filing date (*i.e.*, its constructive use date). The result is that Petitioner may rely on the filing date of its registration—without further proof—to establish its priority.⁴ *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009); *Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (“petitioner or respondent may rely on its registration for the limited purpose of proving that its mark was in use as of the application filing date”).

Petitioner is the owner of Registration No. 4292641 for the mark RED BANDANA which was filed on November 30, 2009. Inasmuch as the application which matured into Respondent's Registration No. 4265402 was not filed until September 1, 2011, Petitioner has priority.

⁴ While constructive use might seem mainly a benefit to intent-to-use applicants (whose actual use date is usually later than their filing date), it is frequently relied on in Board proceedings regardless of whether the mark was in use when the application was filed. Constructive use is simple and inexpensive to establish. Once the relevant application or registration is of record, the constructive use date is established and—unless priority depends on proving an earlier date—it is not necessary to establish a date of actual use, which usually requires testimony or other evidence.

IV. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of all of the relevant probative evidence in the record related to a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1722*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc., v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

A. Similarity of Goods, Channels of Trade, Classes of Purchasers

Petitioner has registered its mark for “Alcoholic beverages except beers” which includes the “Wine” covered in Respondent’s Registration. Thus, both parties goods are identical to the extent they include “wine.”

Because at least some of Petitioner’s and Respondent’s goods are identical, we can presume that the channels of trade and classes of purchasers for those goods are the same. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). *See also 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).

In view of the foregoing, Respondent's goods are identical to at least some of Petitioner's goods, and travel in at least some of the same trade channels and are sold to some of the same classes of purchasers.

B. Similarity of the Marks

We next consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay*, 73 USPQ2d at 1692. The test is whether the marks are sufficiently similar in their entireties such that confusion is likely to result. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Petitioner's RED BANDANA mark completely encompasses Respondent's BANDANA mark. Despite the fact that Petitioner's mark begins with the word RED, the marks otherwise look and sound the same as they both contain the dominant term BANDANA.

It is significant that Respondent's mark is contained in its entirety within Petitioner's mark. Likelihood of confusion has frequently been found where the entirety of one mark is incorporated within another. *See The Wella Corp, v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT similar to CONCEPT); *Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188

USPQ 105 (CCPA 1975) (BENGAL LANCER similar to BENGAL); *Henry Siegel Co. v. M&R International Mfg.*, 4 USPQ2d 1154 (TTAB 1987) (CHIC confusingly similar to LA CHIC when both for women's clothing; customers seeing the junior user's mark could mistakenly think that it designated a particular line of clothing made by the senior user); *La Maur, Inc. v. Matney*, 167 USPQ 559 (TTAB 1970) (applicant's "ITALIAN STYLE" mark similar to registered "STYLE" mark).

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather, whether they are sufficiently similar in terms of their overall commercial impression. While we have placed the parties' marks together for purposes of our discussion, consumers may not encounter the marks in such proximity and must rely upon their recollections thereof. Viewing the marks in their entireties, we find that consumers will perceive the marks RED BANDANA and BANDANA as having the same meaning and engendering the same commercial impression.

In comparing the marks, we are mindful that where, as here, Respondent's goods are legally identical to Petitioner's goods, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

C. Conclusion

Respondent's mark BANDANA is similar to Opposer's mark RED BANDANA. Additionally, based on the in-part identical and otherwise related nature of the goods set forth in Respondent's and Petitioner's registrations, and the presumed in-part identical trade channels and classes of customers, the *du Pont* factors of the similarity of the goods, trade channels and customers also favor a finding of likelihood of confusion. Accordingly, we find that Respondent's mark BANDANA for wine is likely to cause confusion with Petitioner's registered mark RED BANDANA for alcoholic beverages except beers. To the extent that any other *du Pont* factors for which no evidence or argument were presented may nonetheless be applicable, we treat them as neutral.

Decision: The Petition for Cancellation of Registration No. 4265402 is granted.