

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Luc Belaire, LLC
Trademark: BLEU
Serial Number: 88070989
Filing Date: August 8, 2018
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RESPONSE TO OFFICE ACTION DATED NOVEMBER 29, 2018

Applicant submits this response to Office Action dated November 29, 2018 (“Office Action”) for the application for the mark BLEU filed as Serial Number 88070989 in Class 33 for “Wines; Sparkling Wines” (“Applicant's Mark”). The Office Action included three issues: (1) a 2(d) refusal based on a likelihood of confusion with the mark in U.S. Registration No. 3039820 for BLUE (“Cited Mark”) for “Alcoholic brewery beverages, namely beer”; (2) Translation of Foreign Wording and (3) Prior-Filed Application Serial No. 79228100 for Blue. Applicant respectfully addresses all three issues to overcome the 2(d) refusal, and addresses the remaining issues sufficiently to place the application in form to be moved to publication. References in this response to Applicant's Mark and the Cited Mark collectively shall be referred to as the “Marks”.

1. REGISTRATION OF APPLICANT'S MARK WILL NOT RESULT IN A LIKELIHOOD OF CONFUSION WITH THE CITED MARK.

Applicant respectfully submits that Applicant’s Mark if registered for “wines, sparkling wines” using Bleu will not result in a likelihood of confusion with the Cited Mark in U.S. Registration No. 3039820 for BLUE for “Alcoholic brewery beverages, namely beer”. The Office Action’s 2(d) refusal identified two factors of consideration including: 1) similarity of the marks; and 2) relatedness of the goods. Applicant respectfully submits that the registration of Applicant’s Mark will not result in a likelihood of confusion with the Cited Mark under either of the factors cited in the Office Action for the reasons outlined below.

1.1 Applicant's Mark and the Cited Mark Are Not Similar in Appearance, Sound, Connotation or Commercial Impression, and the goods are sufficiently different such that there is not a Likelihood of Confusion between Applicant's Mark and the Cited Mark based on these factors.

The Office Action bases the 2(d) refusal, in part, on a comparison of Applicant's Mark and the Cited Mark for similarities in appearance, sound, connotation and commercial impression. The similarity or dissimilarity of the marks in their entirety is to be considered with respect to appearance, sound, and connotation. *See, In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ at 567; *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 202-03, 22 USPQ2d 1542, 1544-45 (Fed. Cir.1992). All relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar. *See Id.* at 203, 22 USPQ2d at 1545; *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). Applicant respectfully submits that the Marks compared in their entireties are sufficiently different as to appearance, sound, meaning and commercial impression for the following reasons so as to weigh against any finding of a likelihood of confusion. This dissimilarity in appearance, sound, meaning and connotation would prevent consumer confusion.

When viewed side by side, Applicant's Mark BLEU as compared to the Cited Mark BLUE, the Marks are different in appearance, as they look like two different words. The Cited Mark looks like the common English word for the color blue, whereas, Applicant's Mark appears to be a foreign word. Further, when spoken, the Marks also sound different. The Cited Mark sounds like the common English word BLUE, which is pronounced as bl̄oo or blu, whereas Applicant's Mark sounds like a foreign word which is pronounced differently, as bl̄ø.

The phrase, BLEU and the words, BLUE, are dissimilar in appearance, sound, connotation and commercial impression. Additionally, since the Cited Mark, BLUE, consists of a term that is commonly and widely used by third parties for similar goods (See Exhibit A), the scope of the protection afforded to the Cited Mark is weak and should be narrowed.

- BLUE ZIP TIE IPA
Registration Number: 5746543
Registration Date: May 7, 2019
Class 32: Beer
- BIG BLUE VAN
Registration Number: 5570100
Registration Date: September 25, 2018
Class 32: Beer

- BLUE KEY
Registration Number: 5481850
Registration Date: May 29, 2018
Class 32: Beer

- BLUEBEARD
Registration Number: 5212937
Registration Date: May 30, 2017
Class 32: Beer

- BLUE STAR
Registration Number: 4619903
Registration Date: October 14, 2014
Class 32: Beer

With all of the marks using BLUE on a variety of goods and services, no one mark should be given a wide scope of protection either for the similarity of the marks or the similarity of the goods, channels of trade or purchasers/consumers.

The USPTO has also permitted the registration of marks for goods that both are beverages but differ types of beverages and where the marks contain an English word for a color and a foreign word used as a foreign word in the mark that, if translated, contains the same color. For example, U.S. registration number 3695786, owned by Charles Cooper Ltd., for GREEN's is registered for "Gluten free and wheat free beer, ale, lager, stout and porter," while there also exists U.S. registration number 3846791, owned by Jaime Jose Coira Villanueva, for VERDE GREEN, registered for "100% de agave tequila". The first mark and the second mark are both comprised of the term green, and are used on different types of alcohol, both of which were permitted to be registered by the USPTO.

The connotation and commercial impression of each of the Marks are also distinct from the other. The Cited Mark connotes the English word, blue. The English word "blue" can either mean the color blue, or alternatively, "mood: melancholy, sad, or depressed."

(<https://www.dictionary.com/browse/blue?s=twwww.dictionary.com>). When a consumer sees the word BLUE, the consumer may visualize one or other of these meanings. If the consumer visualizes the color, Blue, it is likely to signify a label but not the coloring of the ingredients of the beer as beers are not made from blue ingredients. Whereas Applicant's Mark speaks more to the French language and France, a country known for its wine. When a consumer sees and hears the mark, BLEU, in association with sparkling wines, the consumer is more likely to think of the ingredients of the wine – a dark grape, or of other French terms for similar beverages like champagne, or chardonnay, that are associated with certain regions of France. The consumer when faced with bleu may also think of qualities associated with cheese of the fromage bleu cheese variety, an item that pairs well with wine. If the consumer likes of the meaning of Blue as the mood of melancholy, sad or depressed" they may think of the qualities associated with beer and relaxing or changing mood of consumers as opposed to the color Blue. These differing connotation and commercial impressions further alleviate any

potential consumer confusion from the Cited Mark.

Because of the differences in appearance, sound, connotation and commercial impression between Applicant's Mark and the Cited Mark, and the difference in goods associated with the Marks there is not a likelihood of consumer confusion between the Marks, and therefore, the 2(d) refusal should be removed.

1.2 **The Doctrine of Foreign Equivalents Should Not Be Applied in this Case as a Basis for a 2(d) Refusal.**

The Office Action also cites the doctrine of foreign equivalents as a basis for the 2(d) refusal stating "a mark in a common modern foreign language and a mark that is its English equivalent may be held confusingly similar". (Emphasis Added). It is important to note that the doctrine of foreign equivalents is a standard that is applied on a MAY but MUST basis in any particular application. The doctrine is a guideline, which in this case should not be applied. "Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline. In re N. Paper Mills, 20 C.C.P.A. 1109, 64 F.2d 998, 999 (1933); McCarthy on Trademarks, at § 11:34. The doctrine should be applied only when it is likely that the ordinary American purchaser would 'stop and translate [the word] into its English equivalent.' In re Pan Tex Hotel Corp., 190 U.S.P.Q. 109, 110 (T.T.A.B.1976)." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005).

The doctrine of foreign equivalents does not require an automatic translation of the mark into the English language in order to determine whether the mark is confusingly similar to another mark. "The doctrine of foreign equivalents does not require an unthinking or automatic translation if the setting of the marks makes it improbable that the average American familiar with that language would stop to translate the mark." §23:36. Doctrine of foreign equivalents, 4 McCarthy on Trademarks and Unfair Competition § 23:36 (5th ed.).

In the United States, only 0.4% percent of the population is fluent in French (See <https://statisticalatlas.com/United-States/Languages>) As such there is not a large likelihood of confusion by translation. Ordinary consumers are not going to stop and translate "bleu" into Blue when faced by Applicant's mark. "Bleu" is a term that consumers in the United States are accustomed to seeing and not translating as used with food product names such as cordon blue or bleu cheese products. Plus, ordinary purchasers who speak French and English would appreciate that Applicant has chosen to use the term Bleu, and not to use, Blue, further diminishing any likelihood of confusion with the Cited Mark.

French wines, including sparkling wines such as champagne, have been enormously popular in the United States for significant lengths of time. Because consumers are so familiar seeing wine labels in the French language, it should not be assumed that consumers will automatically translate a French label into its English equivalent. The Federal Circuit for the United States Court of Appeals, held in *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d at 1377, that it "is improbable that the average American purchaser would stop and translate 'VEUVE' into 'widow'." There are many foreign words used in

the wine industry in the United States, including in trademarks that are used in their foreign language wording and accepted without translation by consumers. Pinot noir, a popular type of red wine, is derived from the French terms pine and black, yet, it is unlikely that most consumers, bother to translate these words, when considering purchasing this type of wine.

Given that the United States has persons living here from around the world, ordinary purchasers are accustomed to being presented with goods, particularly food and beverages which use trademarks that include terms that may have a foreign language origin. Consumers regularly accept the word without translation and often without awareness of the meaning having an English translation. For example, Mexican foods routinely have a sauce referred to as “salsa verde”. A range of such consumers accept and order using verde without translating it into green. Similarly, a consumer ordering Coq au vin, at a restaurant will simply order this French dish without considering its English translation. In this case, ordinary purchasers would accept Applicant’s Mark as Bleu for wines without translating the mark into Blue. As such there would not be a likelihood of confusion with registration of Bleu for wines with the Cited Mark.

In this case when presented with Blue vs. Bleu, the doctrine should not be applied because an ordinary purchaser would not stop and translate Bleu. Even though one use of the word Bleu is a French word, Bleu is commonly used without being translated into the color blue in the United States, such as when used in connection with chicken cordon bleu and bleu cheese or bleu cheese dressing.

1.3 The Goods between the Cited Marks are sufficiently different so as to not result in a likelihood of Confusion with registration for Applicant’s Mark.

While Applicant’s Mark, is likely to be viewed as BLEU and not translated into BLUE by ordinary purchasers for the reasons stated above, Blue for beer and Bleu for wine would also be treated differently by ordinary purchasers. The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. *See, e.g., In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men’s underwear held not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color, and durability adapted to outdoor activities when applied to shoes, but “implies something else, primarily indoors in nature” when applied to men’s underwear). Unlike the marks *In re British Bulldog, Ltd.*, the Marks are not identical in their totalities such that less difference in their goods would be needed to distinguish them than the marks in *In re British Bulldog, Ltd.*

In comparing the goods of the Marks, the Cited Mark is used with “Alcoholic brewery beverages, namely, beer.” By contrast, the goods provided under Applicant’s Mark, are very different: “Wines; Sparkling Wines.” While both are alcoholic in nature, wine is distinct from beer.

The Examining Attorney asserts the relevant goods of the Cited Mark for the 2(d) refusal are “Alcoholic brewery beverages, namely, beer” in class 32. By contrast, Applicant’s goods under Applicant’s Mark, include “Wines; Sparkling Wines” in class 33. The vast majority of alcohol consumers today, know the difference between wine, beer and spirits. If a consumer were to order a glass of wine at a bar, and instead received a beer, that would know right away, not only based on the look of the beverage, but the glassware used as well.

Consumers exercise a sufficient degree of care and sophistication when purchasing wine, beer and spirits at the liquor store and grocery store as well, that decreases the likelihood of confusion occurring. The difference in packaging between a case of beer, is starkly different from a bottle of wine. The likelihood of a consumer confusing the two is slim. The court in *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 390 (2d Cir. 2005), discussed the sophistication that consumers exhibit in liquor stores, that decreases the likelihood of confusion. “Unhurried consumers in the relaxed environment of the liquor store, making decisions about \$12 to \$24 purchases, may be expected to exhibit sufficient sophistication to distinguish between Star’s and Bacardi’s products, which are differently labeled,” holding Bacardi’s orange rum, not confusingly similar to Georgi’s orange vodka.

Labatt’s is a brewery known for selling beer and not wine. (See <https://www.labattusa.com/beer/labatt-blue/>). The Cited Mark is used on beer as BLUE and is not translated as a trademark into BLEU for sales in the United States nor to Applicant’s knowledge in French-speaking regions such as Quebec. If Labatt’s extended its Blue mark in the United States from beer into wines Labatt’s would have no motivation to do so with BLEU. Labatt’s has not chosen register BLUE in wines in the United States and should not be granted an extension of its trademark rights by a refusal of registration of Applicant’s BLEU for wines.

1.4 Effect of Descriptiveness and Dilution

Determining whether there is a likelihood of confusion requires careful consideration of the nature of the common elements of the marks at issue, as well as the overall commercial impression created by each mark. *Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.* (Emphasis added). TMEP 1207.01(b)(iii).

The term “BLUE” is commonly used as an element of trademarks in a range of services and goods. A simple search of the USPTO trademark database for marks containing the term “BLUE” and in Class 32 on May 8, 2019 at 1:08 PM reveals 885 trademarks (both live and dead) alone (see Exhibit B for examples). As shown by this search, the word, BLUE, is commonly used and has become diluted as to scope for any one mark.

A mark incorporating a common English word is inherently weaker than a mark consisting of fanciful and fictitious terms. *See Dieter v. B&H Indus. of Sw Fla, Inc.*, 880 F.2d 322 at 327; *Sun Banks of Fla. v. Sun Fed. Sav. & Loan*, 651 F.2d 311, 316 (5th Cir.1981). The Cited Mark consists of a common English word, thus the Cited Mark should not be granted such broad protection outside of its beer/brewery goods. Labatt’s has not chosen register BLUE in wines in the United States and should not be granted an extension of its trademark rights by a refusal of registration of Applicant’s BLEU for wines. The rationale underlying this principle is that courts should not grant the holder of a mark that consists of a common English word a monopoly on that term outside the user’s field. *See Major League Baseball Props., Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F.Supp. 1103, 1119 (S.D.N.Y.1993). In *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 260 (5th Cir.1980), the Court observed that although a common term’s “application ... may be arbitrary, it is still not to be accorded the same degree of protection given such coined and fanciful terms as ‘Kodak’ or ‘Xerox.’” As noted above

The Cited Mark is further weakened, and confusion lessened, by the extensive third party use of the term “BLUE.” *See Sun Banks*, 651 F.2d at 315–16 (finding term “sun” a weak mark in light of extensive third party use); *Amstar Corp.*, 615 F.2d at 260 (finding term “domino” of weak trademark significance because of third party use); *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 505 (5th Cir.1979) (holding that wide use of mark “World” resulted in little likelihood of confusion); *El Chico, Inc. v. El Chico Cafe*, 214 F.2d 721, 725 (5th Cir.1954)(holding that 27 trademark registrations of ‘El Chico,’ made term weak trade name deserving limited protection).

The Trademark Office has registered numerous trademarks that include the term BLUE in combination with other terms in Class 32 with beer listed as the goods including, but not limited to the registrations listed in Section 1.1 above. These third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012) *see* TMEP 1207.01(d)(iii). Evidence of third-party use falls under the sixth du Pont factor – the “number and nature of similar marks in use on similar goods. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d

1689, 1693 (Fed. Cir. 2005).

The marks listed above, are representative of the extensive use of the term BLUE by third parties on a multitude of similar goods and services. The consuming public is exposed to numerous companies using BLUE in their marks, thereby weakening the source identifying significance. Thus, the term BLUE as used in the Cited Mark is weak and is entitled to only a narrow scope of protection. Further, the Owner of the Cited Mark chose to file in Class 32 and failed to register in Class 33. The Owner of the Cited Mark chose not to include any type of wines in their registration. As such, the Cited Mark's rights should be limited and not given an expanded scope of protection to extend to "Wines."

2. Foreign Wording.

The Examining Attorney requested that Applicant submit an English translation of Applicant's Mark. In accordance with the Examining Attorney's suggestion, Applicant submits the following English translation:

The English translation of "BLEU" is "BLUE".

3. Advisory on the Pending Cited Prior Application.

Applicant acknowledges that the Examining Attorney has also issued an advisory regarding a pending application, U.S. Application Serial No. 79228100, for BLUE for "Wine; sparkling wines; wine-based beverage, namely, prepared wine cocktails, spritzers, aperitifs with a wine base, wine coolers, wine punches, wine-based drinks, piquette" in class 33 ("Cited Application") noting that if the Cited Application registers, Applicant's Mark may be refused registration under 2(d) for a likelihood of confusion with the Cited Application. However, Applicant chooses to wait and retain Applicant's rights to address a potential 2(d) until such time that the Cited Application issues as a registration, if ever.

4. **Conclusion.**

Applicant respectfully submits that based on the arguments and evidence submitted, Applicant has overcome the assertion of a Section 2(d) refusal based on the Cited Mark, has entered the required translation and has chosen to not address or offer arguments related to the Cited Application until such time as it matures into a registration.

Applicant respectfully requests that the 2(d) refusal based on the Cited Mark be removed with respect to the BLEU mark and the translation be entered.

Respectfully submitted,

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