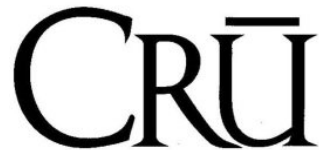


Office Action Response for CRU COLLECTION (U.S. Application Serial No. 88/072,491)

Likelihood of Confusion

The Examining Attorney has refused registration of the Applicant’s mark CRU COLLECTION (“Applicant’s Mark”) for use in connection with wine in Class 33. This refusal is based on an alleged likelihood of confusion under Trademark Act Section 2(d) with two registrations (the “Cited Registrations”) owned by Mariposa Wine Company, LLC (the “Registrant”) for the CRU (Stylized) logo design mark (U.S. Reg. No. 4322360):

The image shows the stylized logo design mark for CRU. The letters 'C', 'R', and 'U' are rendered in a large, bold, serif font. The 'U' has a horizontal bar across its top, which is slightly curved and extends to the left, creating a unique, monogram-like appearance.

and the CRU WINE COMPANY (Stylized) logo design mark (U.S. Reg. No. 4322377):

The image shows the stylized logo design mark for CRU WINE COMPANY. It features the same stylized 'CRU' as above, with the words 'WINE COMPANY' in a smaller, all-caps, sans-serif font centered below the 'CRU'.

The Cited Registrations are for use in connection with “wine.”

The Applicant respectfully disagrees with the Examining Attorney’s assertion that the Applicant’s Mark is likely to cause confusion with the marks in the Cited Registrations. First, the Registrant failed to file the Section 8 Declaration that was due on April 16, 2019, for U.S. Registration No. 4322377, and the Applicant expects that the registration will not be renewed during the grace period.¹ As for U.S. Registration No. 4322360 for the mark CRU (Stylized) (the “Registrant’s Mark”): (i) the Applicant’s Mark and the Registrant’s Mark create different overall commercial impressions; (ii) the parties’ respective goods are offered to sophisticated

¹ Since this registration will likely be cancelled, the Applicant will not discuss it further.

purchasers who can distinguish between the source of such goods; and (iii) as discussed below, the Registrant has already admitted that it does not have exclusive rights to use the word CRU in its correspondence with the Trademark Office.

I. No likelihood of confusion exists between the Applicant’s Mark and the marks in the Cited Registrations.

The court in *E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1973) identified thirteen factors to consider when assessing whether a likelihood of confusion exists. *Id.* at 567. Although there is “no litmus rule which can provide a ready guide to all cases,” it is important to consider the realities of use in the marketplace. *Id.* at 567, 569. The relevant *du Pont* factors to consider in this case are:

- the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression; and
- the sophistication of the purchasers of the respective goods.

Id. at 567; *see also Trademark Manual of Examining Procedure* (“TMEP”) § 1207.01 (October 2018) (discussing the *du Pont* factors). As set forth below, there is no likelihood of confusion between the parties’ respective marks.

A. The Applicant’s Mark and the Registrant’s Mark are dissimilar in their respective appearances, sound, meanings and overall commercial impressions.

The TMEP advises that “[t]he basic principle in determining confusion between marks is that marks must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. . . . [T]he ultimate conclusion rests on consideration of the marks in their entirety.” TMEP § 1207.01(b) (citing *In re Nat’l Data Corp.*, 753 F.2d 1056, 1068, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (emphasis added)).

In analyzing the similarity of the marks, it is not proper to dissect the marks of the parties and to discard or ignore all other non-similar elements. *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992). That is, “marks must be considered in the way they are used and perceived.” *Id.* at 494, 424 USPQ2d at 1239. As the *Hearst* court stated, “marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight” (citing *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847 (Fed. Cir. 1992)). *Id.*

In any event, under the Lanham Act, the mere similarity between two marks can never alone be decisive of a likelihood of confusion. In *Jacobs v. Int’l Multifoods Corp.*, 212 USPQ 641 (CCPA 1982), the Court stated, “[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used” *Id.* at 642 (emphasis added) (footnote omitted). *See also Merritt Foods Co. v. Americana Submarine*, 209 USPQ 591, 599 (TTAB 1980). The marks must be compared for similarities in appearance, sound, meaning or connotation, and commercial impression. *See du Pont*, 476 F.2d at 1361, 177 USPQ at 567; TMEP § 1207.01(b)(vi)(C) (“Appearance, sound, meaning, and overall commercial impression are also factors to be considered when comparing marks.”).

Nonetheless, the Examining Attorney disregarded these prior decisions and supported the refusal to register the Applicant’s Mark by focusing on only the shared element – the word “CRU” – rather than comparing the marks in their entirety and considering the overall commercial impression that each creates. The additional word “COLLECTION” in the Applicant’s Mark, as well as the distinguishing design element in the Registrant’s Mark, cannot be ignored.

Indeed, courts have found no likelihood of confusion created by marks with more significant similarities in sound, appearance, connotation, and commercial impression than the Applicant's Mark and the Registrant's Mark. For example, the Trademark Trial and Appeal Board found that ISLANDER for various non-alcoholic beverages and bases was not confusingly similar to ISLANDER COFFEE HOUSE, as used with restaurant services. See *In re Island Oasis Frozen Cocktail Co.*, 64 USPQ2d 1158 (2002). The TTAB noted in this decision that "the words 'COFFEE HOUSE' lend a different significance and commercial impression to the registered mark than any meaning or impression conveyed by applicant's mark." *Id.* at 1160. Applied to the instant case, the additional terms and design component in the Registrant's Mark combine to create a mark with a significantly different commercial impression than that of the Applicant's Mark.

Moreover, in *National Distillers and Chemical Corp. v. William Grant & Sons*, 505 F.2d 719, 184 USPQ 34 (CCPA 1974), the Court of Customs and Patent Appeals held that obvious dissimilarities of marks are important and should be considered when evaluating a likelihood of confusion. As such, the differences between the respective marks should be considered and should not be ignored. See also *The Sea Island Company v. Kroehler Corporation and American Signature, Inc.*, 2005 TTAB LEXIS 158 (TTAB 2005) (no confusion between the marks SEA ISLAND COLLECTION and AMERICAN SIGNATURE SEA ISLAND COLLECTION both for furniture); *NBC Fourth Realty Corp. v. Martin Industries, Inc.*, 1999 TTAB LEXIS 507 (TTAB 1999) (no confusion between GRILL MAXX for barbecue grills and T.J. MAXX, GET THE MAXX FOR THE MINIMUM, THE MAXIMUM FOR THE MINIMUM, and THE MAXX FOR THE MINIMUM for retail department store services, clothing and other goods); *In re International Home Furnishings Marketing Association*, 1997 TTAB LEXIS 380 (TTAB

1997) (no confusion between INTERNATIONAL HOME FURNISHINGS MARKET for arranging and conducting exhibitions in the field of furniture and INTERNATIONAL HOME FURNISHINGS CENTER for providing showroom and related facilities to manufacturers in the field of furniture and home furnishings); *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.* 393 F.3d 1238, 2d 1350 (Fed. Cir. 2004) (PUTTING ON THE RITZ for use in connection with bath towels was held to have a different meaning from RITZ for use in connection with shower curtains); *ConAgra, Inc. v. George A. Hormel & Co.*, 990 F.2d 368, 26 U.S.P.Q.2d 1316 (8th Cir. 1993) (HEALTHY CHOICE and HEALTH SELECTIONS for use in connection with food products were held to not be confusingly similar); *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 U.S.P.Q.2d 1715, 2007 WL 1431084 (TTAB 2007) (the difference in connotation between opposer's marks GULP and BIG GULP and defendant's mark GULPY "outweigh any similarities in the appearance and sound of the marks").

The Applicant's Mark and the Registrant's Mark, when viewed in their entirety, are different in appearance, sound, meaning, and commercial impression. Because of these distinctions between the parties' respective marks, no likelihood of confusion exists.

B. The respective goods covered by the Applicant's Mark and the Registrant's Mark are offered to purchasers who are knowledgeable enough to distinguish the respective sources of the parties' goods.

The nature of the parties' respective customers, and the conditions under which those customers would seek and obtain the relevant goods, further support the Applicant's contention that no likelihood of confusion exists between the parties' respective marks. Consumers who have expertise or who are otherwise more sophisticated and careful with respect to certain goods and services can be expected to exercise greater care in their purchases of those goods and services. *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 718, 21

U.S.P.Q.2d 1388 (Fed. Cir. 1992) (“[Consumer] sophistication is important and often dispositive because ‘[s]ophisticated consumers may be expected to exercise greater care.’ ”) (citations omitted). *See also Daddy’s Junky Music Stores v. Big Daddy’s Fam.*, 109 F.3d 275, 285 (6th Cir. 1997). As consumers exercise a higher degree of care in making their purchasing decisions, the likelihood of confusion as to the source of the goods sold under similar marks decreases. *See du Pont*, 476 F.2d at 1361. The TMEP also explains that “circumstances suggesting care in purchasing may tend to minimize likelihood of confusion.” TMEP § 1207.01(d)(vii) (citing *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, “even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily”); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006)).

Here, because of the highly specialized nature of the Applicant’s and the Registrant’s goods (wine), the sophistication of consumers who will purchase these products is elevated. For example, common sense and ordinary caution dictate that, before purchasing any of the parties’ respective goods to drink, a consumer would take the time to read the product label and identify the source. Accordingly, consumers are sophisticated when it comes to purchasing such items and would diligently distinguish between the Applicant’s wine and the Registrant’s wine and their respective sources, further supporting that there is no likelihood of confusion between the Applicant’s Mark and the Registrant’s Mark.

C. The Registrant admitted that it does not have exclusive rights in the word CRU.

Perhaps most important is the prior correspondence the Registrant had during the examination of the applications that matured into the Cited Registrations. For example, in an office action response dated February 7, 2013, for the Cited Registration for CRU (Stylized), the Registrant explained that “allowing the term ‘CRU’ on the Supplemental Register will hardly allow ‘monopolization’ of the term as feared. Even if the term were placed on the register, it would lack most trademark registration benefits until secondary meaning was demonstrated and it were allowed on the principal register.” (See attached Exhibit 1) We have no evidence that the Registrant tried to file a new application for the CRU (Stylized) mark, claiming acquired distinctiveness, nor is there any other evidence that the Registrant has developed secondary meaning in the mark.

II. Allegations of potential confusion are theoretical and not grounds for refusing to register the Applicant’s Mark.

The possibility, either theoretical or *de minimis*, that confusion may occur is not a sufficient basis for refusal to register the Applicant’s Mark. *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969). Rather a likelihood of confusion must exist. *Id.* In *Witco*, the court stated, “We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with the *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.” As such, a finding of likelihood of confusion must be based on the confusion of “some relevant person,” such as a consumer. *Astra Pharm. Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206, 220 USPQ 786 (1st Cir. 1983).

In the present case, however, any possibility of confusion as to the source of the Applicant's Mark and the Cited Registration is merely theoretical or, at most, *de minimis*. There is no proof that consumers will be actually confused by the respective uses of the marks, especially in light of the foregoing differences noted about the appearance, sound, meaning, and commercial impressions of the marks, and the sophistication of the purchasers of those goods. Under these circumstances, no confusion as to the source of the goods is likely to occur, further supporting that there is no likelihood of confusion between the Applicant's Mark and the Registrant's Mark.

For all of the above reasons, the Applicant respectfully disagrees with the Examining Attorney's assertion that the Applicant's Mark is likely to cause confusion with the marks in the Cited Registrations. Accordingly, the Applicant requests that the Examining Attorney withdraw the refusal to register the Applicant's Mark.

Descriptiveness

Registration of the CRU COLLECTION mark has also been refused on the ground that the mark is merely descriptive of the Applicant's goods. For the reasons that follow, the Applicant disagrees with the refusal and requests that the mark be passed to publication.

The standard for determining whether CRU COLLECTION is descriptive is whether "it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the services." *In re The Stroh Brewery Co.*, 34 U.S.P.Q.2d (BNA) 1796, 1797 (T.T.A.B. 1995)(emphasis added) quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 U.S.P.Q. (BNA) 215, 218 (C.C.P.A. 1978). Suggestive marks, by contrast, require the purchaser to exercise some

“imagination, thought or perception to reach a conclusion as to the nature of the goods or services.” TMEP §1209.01(a); see also *In re Southern Nat'l Bank*, 219 U.S.P.Q. (BNA) 1231 (T.T.A.B. 1983). The Board takes the position that the “distinctive” threshold is relatively low. *See In re Southern Nat'l Bank*, 219 U.S.P.Q. (BNA) 1231 (T.T.A.B. 1983) (test requires only “some degree of imagination or perception”; finding MONEY 24 sufficiently distinctive for “automated teller services”; refusal of registration reversed). A suggestive mark “may shed some light on the characteristics of the goods.” *Erma Corp. v. Superclips Ltd.*, 218 U.S.P.Q. 124, 130 (E.D. Mich. 1983).

If there is any doubt as to whether a mark is descriptive, the Board resolves doubt in favor of the applicant and passes the mark to publication. *Stroh Brewery*, 34 U.S.P.Q.2d at 1797 (“[w]hen doubts exist as to whether a term is descriptive . . . (the) Board resolve[s] doubts in favor of the applicant and pass[es] the mark to publication”); *In re Grand Metro. Foodservice*, 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994) (“any doubt with respect to the issue of descriptiveness should be resolved in applicant’s behalf,” finding MUFFUNS not merely descriptive of muffins).

When refusing registration under Section 2(e)(1), the Examining Attorney has the burden of establishing a prima facie case that the mark is descriptive. *See In re American Standard Inc.*, 223 U.S.P.Q. (BNA) 353, 355 (T.T.A.B. 1984) (“the Board must conclude that the Patent and Trademark Office has failed to carry its burden of establishing a threshold or prima facie case for the ‘merely descriptive’ determination.”). Moreover, to refuse registration on the ground that a mark is merely descriptive, the Examining Attorney must make a substantial showing based on clear evidence of descriptive use. *In re Kopy Kat, Inc.*, 182 USPQ 372, 373 (CCPA 1974); *see also In re Intelligent Med. Sys., Inc.*, 5 USPQ2d at 1675. In support of her claim that CRU is

descriptive of the goods listed in the application, the Examining Attorney explained that “[t]he wording ‘cru’ is defined as ‘a grade or class of wine: premier cru.’ The term ‘cru’ is a designation used to denote wine that has met a certain premier qualification.” To support this, the Examining Attorney referenced only a single webpage from a website called “winefrog.com,” which is not a recognized dictionary and does not appear to be a well-known, legitimate website with trustworthy information about wine. The Examining Attorney provides no other bases for rejecting the Applicant’s mark as descriptive. In short, the Examining Attorney has taken the position that “cru” formative marks which have wine-related goods or services will always be descriptive but has not provided evidence to support this point. The Applicant respectfully submits that the Examining Attorney has made neither a prima facie case of descriptiveness nor a substantial showing based on clear evidence of descriptiveness. Accordingly, the descriptiveness rejection should be withdrawn for these reasons alone.

In addition, the Applicant’s mark does not describe the goods listed in the application for CRU COLLECTION with the degree of particularity required for unregistrable descriptive marks. The definition of “cru” cited by the Examining Attorney refers to a designation. As a result, it is unlikely that that consumers would automatically associate the Applicant’s CRU mark with wine. At best, CRU COLLECTION may suggest goods or services relating to wine, which could be almost anything – bottles, restaurants, cafes, vineyards, etc., just to name a few. As such, the Applicant’s mark does not convey anything about the specific goods listed in the application. Thus, the CRU COLLECTION mark is similar to the term “DESIGNERS” which was found to be suggestive rather than descriptive in the context of the mark “DESIGNERS PLUS+.” *In re Hampshire-Designers, Inc.*, 199 U.S.P.Q. 383 (T.T.A.B. 1978). CRU represents an idea that requires some operation of the imagination to connect it with the goods, creating a

single and distinct commercial impression. *Platinum Home Mortg. Corp. v. Platinum Financial Group, Inc.*, 149 F.3d 722, 727 (7th Cir. 1998). Moreover, in *In re Zico Beverage LLC*, Serial No. 85284093 (May 9, 2013) [not precedential], the word NATURALLY, in NATURALLY POWERED for use in connection with “all-natural coconut-based beverages” was allowed without a disclaimer because it clearly modified the term POWERED to “create a unitary phrase that only suggests a feature of applicant’s goods.”

Courts have consistently held that general or vague terms that only broadly or tenuously describe the relevant goods or services cannot be considered “merely descriptive” marks. *See Physicians Formula Cosmetics, Inc. v. West Cabot Cosmetics, Inc.*, 857 F.2d 80, 81, 8 U.S.P.Q.2d 1136 (2d Cir. 1988) (PHYSICIANS FORMULA not descriptive of skin creams and lotions because “the mark does little to identify the product other than to locate it in the realm of medicine”); *see also Polaroid Corp. v. Anken Chemical & Film Corp.*, 343 F.2d 771, 145 U.S.P.Q. 191 (C.C.P.A. 1965) (POLYCOPY held suggestive for photocopying machines); *In re Hutchison Technology, Inc.*, 852 F.2d 552, 554, 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988) (TECHNOLOGY is not descriptive of electronic and mechanical computer components because “technology is such a very broad term which includes many categories of goods . . . and does not convey an immediate idea of the ‘ingredients, qualities, or characteristics’ of [applicant’s] goods”).

“The more imagination that is required on the potential customer’s part to get some direct description of the product from the designation, the more likely the term is suggestive, not descriptive. . . . If the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.” See J. Thomas McCarthy, *Trademarks and Unfair Competition*, § 11:67, 68 (4th Ed.) (emphasis added.)

Here, the mark does not describe the goods offered in connection with it; there is much imagination required to determine the “direct description” of the goods listed in the CRU COLLECTION application. In particular, a consumer would have to use a multi-step reasoning process to determine the identity of these goods. There is certainly not an “almost instantaneous” mental leap between the CRU COLLECTION mark and the goods listed in the application. For example, a consumer encountering this mark might believe that the CRU COLLECTION mark refers to services relating to a vineyard, a wine café, an organization of sommeliers, or a wine club. Accordingly, the mental leap between the CRU COLLECTION mark and the goods listed in the application for CRU COLLECTION is not almost instantaneous, and thus the CRU COLLECTION mark is at most suggestive, not merely descriptive, for use in connection with the goods listed in the Application.

For the above-stated reasons, CRU COLLECTION cannot reasonably be said to forthwith convey an immediate idea of the qualities or characteristics of the Applicant’s goods. When encountering the CRU COLLECTION mark, a consumer must exercise a high degree of imagination, thought or perception to conclude that the Applicant’s goods are related to wine. As such, the Applicant respectfully suggests that the CRU COLLECTION mark is at best suggestive of the Applicant’s goods.

Request for Information

In response to the Examining Attorney’s Request for Information, the Applicant submits that CRU COLLECTION will identify select wine brands associated with a certain division of the Applicant’s business. The Applicant can provide more information as use of the mark starts.

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