

Applicant E. & J. Gallo Winery (“Applicant”) hereby responds to the office action issued February 23, 2019 for OCCASIONS WINE CO., Serial No. 88202855, for alcoholic beverages except beers (“Applicant’s Mark”). The office action refuses registration on the grounds that a registration for OCCASIO, Reg. No. 3907950, translated as “occasion or opportunity, “ and prior-filed pending application for OCCASIONALE, Serial No. 88202539 (the “Cited Marks”) may bar registration. Applicant respectfully submits that there is no likelihood of confusion with either of the Cited Marks, and therefore, Applicant’s Mark should be allowed to proceed to publication.

In order to determine whether there is a likelihood of confusion, the typical analysis reviews the factors set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973). The factors that are the most relevant to the instant analysis include the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, and the number and nature of similar marks in use on similar goods. *See* TMEP 1207.01. If the marks are dissimilar enough, if they differ so substantially in appearance, sound, connotation or commercial impression that there can be no likelihood of confusion, then that is enough to sustain a finding of no likelihood of confusion. *See Kellogg v. Pack’em Enterprises*, 21 USPQ2d 1142 (Fed. Cir. 1991) (FROOTIE ICE not likely to be confused with FROOT LOOPS ); *Citigroup v. Capital City Bank Group, Inc.*, 98 USPQ2d 1253 (Fed. Cir. 2011 (CAPITAL CITY BANK and other variants not likely to be confused with CITIBANK). Such is the case here, as the differences in appearance, sound and commercial impression between Applicant’s Mark and the Cited Marks are significant. In

addition, evidence of third party use of similar marks on similar goods is relevant to demonstrate that the Cited Marks are weak and entitled only to narrow protection. See TMEP 1207.01(d)(iii); see also *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). Here, there is evidence of third party allowed applications and registrations of marks that include the word “OCCASION” in the field of alcoholic beverages. The dissimilarity of the marks and the third party use of the common element OCCASION means there is no likelihood of confusion.

#### 1. The Differences Between the Cited Marks and Applicant’s Mark Render Confusion Unlikely.

A basic principle in any likelihood of confusion analysis is that the marks must be compared in their entireties. Here, the comparison is between Applicant’s Mark OCCASIONS WINE CO., on the one hand, and the Cited Marks OCCASIO and OCCASIONALE.

#### Commercial Impression, Connotation, Appearance and Sound

##### A. OCCASIO

Applicant’s Mark and the cited mark OCCASIO convey distinct commercial impressions upon the consumer, and the marks’ sound and appearance are quite distinct.

First, “the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline.” *In re Spirits Intern. N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009) (vacating and remanding TTAB decision finding that

MOSKOVSKAYA translated means of or pertaining to Moscow, and thus this mark was geographically misdescriptive). “Whether an examining attorney should apply the doctrine of foreign equivalents turns upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record, including, for example, dictionary, Internet, and LexisNexis® evidence. If the evidence shows that the relevant English translation is literal and direct, and no contradictory evidence of shades of meaning or other relevant meanings exists, the doctrine generally should be applied by the examining attorney.” TMEP 1207(b)(vi).

Here, the Examining Attorney states that the record shows that OCCASIO means OCCASION. Actually, the trademark record for OCCASIO indicates that OCCASIO means OCCASION or OPPORTUNITY. Moreover, Latin dictionaries define OCCASIO as chance; opportunity; or pretext/occasion. See <https://latin-dictionary.net/definition/28450/occasio-occasionis>; <https://www.wordhippo.com/what-is/the-meaning-of/latin-word-6007ef4a1c15ad121741009aad403efa9f3c724c.html>; <https://glosbe.com/la/en/occasio>. (See attached pages from these dictionaries as Exhibit A.) In addition to OCCASIO being defined as “occasion,” all three of these Latin/English dictionaries define OCCASIO as chance or opportunity.

Thus dictionary evidence demonstrates that there are shades of meaning to the word OCCASIO, which means chance or opportunity in addition to occasion, so that the translation is not literal or direct and the doctrine of foreign equivalents should not be applied.

“Where the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find the marks confusingly similar.” See TMEP 1207.01(b)(vi)(B), citing *In Re Sarkli Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed Cir. 1983) (REPECHAGE and SECOND CHANCE not equivalents because REPECHAGE has several potential meanings), and *In re Buckner Enters.*, 6 USPQ2d 1316 (TTAB 1987) (DOVE and PALOMA not likely to cause confusion because PALOMA could be translated into dove or pigeon).

OCCASIO and OCCASIONS WINE CO. are not direct foreign equivalents and thus should not be compared as such. The doctrine is simply inapplicable to the examination of OCCASIONS WINE CO.

In terms of sound and appearance of the marks, the Examining Attorney argues that Applicant has just added the letters NS to the registered mark OCCASIO. Applicant’s mark is OCCASIONS WINE CO., so that statement is not accurate, when the mark is viewed as a whole. OCCASIO is a different word than OCCASIONS WINE CO. It is pronounced differently – O-KAY-SEE-O. There is a hard S, and the I and the O are actually pronounced. This is very different than OCCASIONS – O-KAY-ZHUNS, where there is a soft S, no pronunciation of the I and O, and the mark includes the additional words WINE CO. Consumers are not likely to be confused into thinking that goods marked with the trademark OCCASIO come from the same source as those marked with the trademark OCCASIONS WINE CO.

#### B. OCCASIONALE

The Examining Attorney does not offer arguments regarding why Applicant's Mark is likely to be confusing with this pending application. However, Applicant offers some arguments here regarding why its mark is distinct from this cited mark.

Dictionary.com defines the adjective "occasional" as "1) occurring or appearing at irregular or infrequent intervals;" "2) intended for supplementary use when needed;" "3) pertaining to, arising out of, or intended for the occasion; acting or serving for the occasion or only on particular occasions;" "4) serving as the occasion or incidental cause."

<https://www.dictionary.com/browse/occasional>. (See Exhibit B.) The word occasional modifies a noun. One can have an occasional headache, or an occasional alcoholic beverage. Mostly, the word "occasional" says something about time, and indicates that something is happening every once in a while.

Occasion, on the other hand, is a noun, and is defined as a particular, important or convenient time, or the immediate cause for some action or result. <https://www.dictionary.com/browse/occasion>. (See Exhibit C.) OCCASIONS, as used in Applicant's Mark, suggests "events" to the consumer, and OCCASIONS WINE CO. suggests that the goods can be used to celebrate special occasions.

These two marks have different commercial impressions and connotations, given the differences referenced above, and consumers are not likely to be confused into thinking the goods are from the same source. This is especially true given the differences in the appearances and sound of the marks: when one says the mark OCCASIONALE, the emphasis is on the last syllable, as if there is no "E"; in

Applicant's Mark, OCCASIONS WINE CO., the emphasis is on the "A" in OCCASIONS. Admittedly the words begin the same, but their overall appearance and pronunciation is distinct.

C. OCCASIO and OCCASIONALE

The fact that Applicant's Mark and the Cited Marks share the beginning letters OCCASIO does not by itself demonstrate that the marks are likely to be confused. "The use of identical, even dominant, words in common, does not automatically mean that the two marks are similar." *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987) (OATMEAL RAISIN CRISP & Design distinct from APPLE RAISIN CRISP & Design). Rather, when comparing Applicant's Mark and the Cited Mark in any likelihood of confusion analysis, the marks must be viewed in their entireties. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) ("likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of mark"); *Murray Corp. of America v. Red Spot Paint & Varnish Co.*, 47 CCPA 1152, 280 F.2d 158 (CCPA 1960) (EASYTINT not likely to be confused with EASY for paint); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (CCPA 1970) (PEAK PERIOD for deodorant not likely to be confused with PEAK for a dentifrice). Here, the Examining Attorney bases the likelihood of confusion finding on that the marks begin with OCCASIO. But, when the marks are viewed as a whole, Applicant's Mark is distinct.

A recent Federal Circuit case is instructive. In *Juice Generation, Inc. v. GS Enterprises LLC*, 115 USPQ2d 1671 (Fed Cir. 2015), the Court held that the

TTAB failed to consider the mark PEACE LOVE AND JUICE as a whole while comparing it to PEACE & LOVE for similar goods. The Court stated:

“The Board declared that ‘PEACE LOVE’ is the ‘dominant’ portion of that combination, compared that portion to GS’s ‘PEACE & LOVE’ phrase, found that they are ‘virtually identical,’ and then simply added that ‘the additional disclaimed word ‘JUICE’...do[es] not service to sufficiently distinguish’ Juice Generation’s mark from GS’s marks...That analysis is inadequate. It does not display any consideration of how the three-word phrase in Juice Generation’s mark may convey a distinct meaning – including by having different connotations in consumers’ minds – from the two word phrase used by GS.”

Here, although WINE CO. is now disclaimed in Applicant’s Mark, consumers will still see the words, understand their meaning, and include them in the commercial impression the mark makes. Even if a portion of the mark is disclaimed, the mark must be considered in the way it will be perceived by the consuming public. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993). When the consuming public actually views a mark, the public is not aware of whether a portion of the mark is disclaimed or not. *In re Nat’l Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985). What should be compared here is OCCASIO and OCCASIONALE to OCCASIONS WINE CO. Just as in the *Juice Generation* case cited above, when the marks are compared as a whole, they are distinct.

As the Court in *Juice Generation* stated, a mark must be considered as a whole in determining likelihood of confusion because “the message of a whole phrase may well not be adequately captured by a dissection and recombination.” *Juice Generation*, 115 USPQ2d 1671. This is exactly the case here. See also *Shen Mfg. Co. Inc. v. Ritz Hotel, Ltd.*, 73 USPQ2d 1350 (Fed Cir. 2004) (the whole mark must be viewed to determine its commercial impression).

By not comparing the entirety of Applicant's Mark to the Cited Mark, the Examining Attorney is essentially changing the meaning of the marks. Applicant's Mark "derives[s] significant contribution from" every word in the mark. See *In re Hearst Corp.*, 25 USPQ2d 1238 (Fed Cir. 1992) (finding no likelihood of confusion between VARGA GIRL and VARGAS, the Court stated that "[b]y stressing the portion 'varga' and diminishing the portion 'girl' the Board inappropriately changed the mark"); see also *In Re KW Intellectual Properties, Inc.*, 2013 TTAB LEXIS 149 (TTAB 2013) (refusal of registration reversed; SPIRIT OF LINDY differs in sound, appearance and commercial impression from LINDI); *In re The West Retail Group Limited*, 2015 TTAB LEXIS 540 (TTAB 2015) (refusal of registration reversed; CABOT WREN and WRENN distinct) . All the words in Applicant's Mark are integral to its meaning. By ignoring the importance of the whole mark, the Examining Attorney misses the connotation of Applicant's Mark as compared to that of the Cited Marks, and the differences in their appearance, and thus misses the significant differences between them.

2. The Scope of Rights Enjoyed by the Cited Marks is Weak.

An initial question in every analysis regarding the likelihood of confusion between marks is the degree of protection afforded a registered mark. See TMEP 1207.01(d)(iii). If the evidence demonstrates that consumers are exposed to significant third party use of similar marks on similar goods, then that "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Id.*; *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); see also *Juice Generation, Inc. v. GS Enterprises LLC*, 115 USPQ2d 1671 (Fed Cir. 2015) (“The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.”).

Here, active third party registrations containing the word OCCASION show that these marks can co-exist without causing confusion, and that consumers look to additional elements of the mark to determine the source of the goods.

A search of the USPTO’s database reveals there are several allowed and registered OCCASION-formative marks used in connection with alcoholic beverages that currently coexist, as follows:

<b>TM/AN/RN/Di sclaimer</b>	<b>Status/Stat us Date</b>	<b>Brief Goods/Services</b>	<b>Owner Information</b>
<b><u>NOW OCCASIONS DON'T HAVE TO BE SO OCCASIONAL!</u></b> RN: 3278422 SN: 76671179	<b>Renewed August 14, 2017</b>	<b>(Int'l Class: 33) champagne</b>	<b>F. Korbel &amp; Bros. (California Corp.) 13250 River Road Guerneville California 95446</b>
<b><u>OCCASIO</u></b> RN: 3907950 SN: 85058716	<b>Registered 8 &amp; 15 March 30, 2016</b>	<b>(Int'l Class: 33) wine</b>	<b>Kinney Family Vintners LLC (California Limited Liability Company) Suite S-186 2954 Deer Meadow Drive 9000 Crow Canyon Danville California 94506</b>

<p><b><u>MAKE ANY OCCASION SPARKLE</u></b>  <b>RN: 4318662</b>  <b>SN: 85581268</b></p>	<p><b>Registered -  8 Accepted  May 8, 2019</b></p>	<p><b>(Int'l Class: 33)  alcoholic  beverages  except beers</b></p>	<p><b>E. &amp; J. Gallo  Winery  (California Corp.)  600 Yosemite  Boulevard  Modesto  California 95354</b></p>
<p><b><u>BEACH HAUS BREWERY, A BEER FOR EVERY OCCASION</u></b>  <b>SN: 86771820</b>  <b>Disclaimer:  "BEER" AND  "BREWERY"</b></p>	<p><b>Allowed -  Intent to  Use 2nd  Extension  of Time  Granted  January 23,  2019</b></p>	<p><b>(Int'l Class: 32)  beer, ale, lager,  stout and  porter</b></p>	<p><b>East Coast  Brewing  Company, LLC  (New Jersey  Limited Liability  Company)  801 Main Street  Belmar New  Jersey 07719</b></p>
<p><b><u>BEACH HAUS BREWERY, EVERY BEER HAS AN OCCASION</u></b>  <b>SN: 86771826</b>  <b>Disclaimer:  "BEER" AND  "BREWERY"</b></p>	<p><b>Allowed -  Intent to  Use 2nd  Extension  of Time  Granted  February 6,  2019</b></p>	<p><b>(Int'l Class: 32)  beer, ale, lager,  stout and  porter</b></p>	<p><b>East Coast  Brewing  Company, LLC  (New Jersey  Limited Liability  Company)  801 Main Street  Belmar New  Jersey 07719</b></p>
<p><b><u>WHEN THE OCCASION CALLS FOR GREAT TASTE</u></b>  <b>RN: 5252182</b>  <b>SN: 87035469</b></p>	<p><b>Registered  July 25,  2017</b></p>	<p><b>(Int'l Class: 32)  beer</b></p>	<p><b>Koehler Brewing  Company, LLC  (Pennsylvania  Limited Liability  Company)  20436 Us-19 #620  Cranberry  Township  Pennsylvania  16066</b></p>

<p><b><u>SPECIAL OCCASION</u></b>  <b>RN: 5507954</b>  <b>SN: 87697611</b></p>	<p><b>Registered</b>  <b>July 3, 2018</b></p>	<p><b>(Int'l Class: 32)</b>  <b>sour mash beer</b></p>	<p><b>Bull and Goat</b>  <b>Brewery</b>  <b>(Maryland</b>  <b>Limited Liability</b>  <b>Company)</b>  <b>Suite E 204 Banjo</b>  <b>Lane Centreville</b>  <b>Maryland 21617</b></p>
<p><b><u>WINE ON OCCASION</u></b>  <b>SN: 88007891</b>  <b>Disclaimer:</b>  <b>"WINE"</b></p>	<p><b>Allowed -</b>  <b>Intent to</b>  <b>Use</b>  <b>Statement</b>  <b>of Use -</b>  <b>Non-Final</b>  <b>Refusal</b>  <b>Mailed</b>  <b>March 14,</b>  <b>2019</b></p>	<p><b>(Int'l Class: 33)</b>  <b>Wine</b></p>	<p><b>Hardin, Joseph</b>  <b>(United States</b>  <b>Citizen)</b>  <b>2145 3rd Creek</b>  <b>Church Rd.</b>  <b>Cleveland North</b>  <b>Carolina 27013</b></p>

Records from the USPTO's TESS database for these registrations and applications are attached as Exhibit D.

The USPTO has permitted these OCCASION-formative marks to co-exist on the register. By allowing all these marks to co-exist, the USPTO has determined that consumers can distinguish among them, and will be able to distinguish between the Cited Marks and Applicant's Mark, especially given their differences in appearance and commercial impression.

C. Conclusion

For the foregoing reasons, Applicant respectfully requests that the Examining Attorney find there is no likelihood of confusion between Applicant's Mark and the Cited Marks, and pass Applicant's Mark to publication.

Respectfully submitted,

E. & J. Gallo Winery

By: \_\_\_\_\_/s/\_\_\_\_\_

Kristi W. Whalen  
Associate General Counsel  
Senior Director of  
Intellectual Property