

TRADEMARK

In re Application of: Winestore Holdings, LLC  
Serial No.: 88/282,862  
Filed: January 30, 2019  
Mark: ESCORLADA (Int. Class 33)

Trademark Examining Attorney: Robert N. Guliano  
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Commissioner for Trademarks  
P.O. Box 1451  
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**RESPONSE**

Sir:

In response to the Office Action dated April 11, 2019, Applicant respectfully requests that the Examining Attorney give this matter favorable reconsideration and withdraw the refusal to register Applicant's ESCORLADA mark in view of the remarks provided below.

**REMARKS**

Refusal to Register under Trademark Act § 2(d)

The Office Action initially refuses to register Applicant's mark under Trademark Act § 2(d), 15 U.S.C. § 1052(d), asserting that there is a likelihood of confusion between Applicant's ESCORLADA mark when used in connection with "wine" in Int. Class 33 and the mark ESCARLATA (the "Cited Mark") when used in connection with "wine" in Int. Class 33, which mark is the subject of Registration No. 4,995,076 owned by Global Vineyard Importers, Inc. (the "Cited Registrant").

Applicant respectfully traverses and submits that there is no potential for confusion between Applicant's use and registration of its ESCORLADA mark and the Cited Mark for several

In re Application of:  
Winestore Holdings, LLC  
Serial No.: 88/282,862  
Filed: January 30, 2019  
Mark: ESCORLADA (Int. Class 33)  
Page 2

reasons. First, Applicant's mark can be distinguished from the Cited Mark based upon the narrow scope of protection properly accorded marks beginning with the prefix ESCOR- and ESCAR- in the alcohol industry. Additionally, the differences in the appearance, sound, connotation, and commercial impression between the respective marks are sufficient to distinguish Applicant's mark from the Cited Mark such that no likelihood of confusion exists. These distinctions are the basis for Applicant's contention that its ESCORLADA mark is suitable for registration on the Principal Register.

Applicant respectfully requests that the Examining Attorney reconsider its application based upon the comments contained hereinbelow.

**1. The Cited Mark is entitled to a narrow scope of protection.**

Whether a mark is "strong" or "weak" is an important factor in deciding whether there is a likelihood of confusion. J. Thomas McCarthy, *3 McCarthy on Trademarks & Unfair Competition*, § 23.48 (4th Ed. 2004). Suggestive marks are less distinctive than arbitrary or fanciful marks and are typically afforded a more narrow scope of protection. *Id.* at §§ 11:02 and 11:80; *see, also, Drackett Co. v. H. Kohnstamm & Co.*, 404 F.2d 1399, 1400 (C.C.P.A. 1969) ("The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods."); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334 (Fed. Cir. 2015) (holding that "[m]arks that are descriptive or highly suggestive are entitled to a narrower scope of protection,

In re Application of:  
Winestore Holdings, LLC  
Serial No.: 88/282,862  
Filed: January 30, 2019  
Mark: ESCORLADA (Int. Class 33)  
Page 3

*i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts.”).

As evidence of the weakness of the Cited Mark, Applicant notes that the Cited Registrant amended the application that matured into the Cited Registration to the *Supplemental Register*. The Office required this amendment because the Spanish term ESCARLATA means “scarlet” in English, which the Office determined is commonly used to describe the color of red, rose and pink wines.” (See Office Action dated December 10, 2015, in the file history for Registration No. 4,995,076). Descriptive marks are weak marks that cannot be protected unless secondary meaning is proven. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992) (“When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected.”).

In addition, “the number and nature of similar marks in use on similar goods” also significantly impacts the strength of a mark. TMEP § 1207.01. In Section 11:85 of *McCarthy on Trademarks & Unfair Competition*, McCarthy explains that “[i]n a ‘crowded’ field of similar marks, each member of the crowd, is relatively ‘weak’ in its ability to prevent use by others in the crowd.” In *Juice Generation*, the Federal Circuit found that “[e]vidence of third-party use bears on the strength or weakness of an opposer’s mark.” 794 F.3d at 1338 (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir.2005)). Evidence of third-party registrations is relevant to “show the sense in which a mark is used in ordinary parlance,” *i.e.*, some segment that is common to both parties’ marks may have “a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that

In re Application of:  
 Winestore Holdings, LLC  
 Serial No.: 88/282,862  
 Filed: January 30, 2019  
 Mark: ESCORLADA (Int. Class 33)  
Page 4

that segment is relatively weak.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015) (quoting *Juice Generation*, 794 F.3d at 1338).

Applicant’s mark shares the prefix ESCAR- with the Cited Mark. Applicant directs the Examining Attorney’s attention to the following seven (7) U.S. registrations and one (1) published U.S. application, all for marks beginning with the prefix ESCOR- or ESCAR-, in each case, in connection with alcoholic beverages, and all of which are registrations on or are approved for registration on the Principal Register.

Mark	Reg. or App. No.	Dates	Goods and/or Services	Owner
ESCORIAL	0,747,017	Filed: October 11, 1961  Registered: March 19, 1963	Class 33: liqueur.	Anton Riemerschmid Weinbrennerei Und Likorfabrik GMBH & CO. KG
ESCORT	3,574,752	Filed: November 28, 2007  Registered: February 17, 2009	Class 33: wine; tables wines; and white wine.	Naked Wines, LLC
ESCARPA	3,632,541	Filed: February 21, 2008  Registered: June 2, 2009	Class 33: red wine; white wine; wine; wines.	Ceritas Wines LLC
ROYAL ESCORT	3,801,708	Filed: October 20, 2008  Registered: June 15, 2010	Class 33: port; port wines.	Prager Winery & Port Works, Inc.
ESCARPMENT	3,651,502	Filed: December 5, 2008  Registered: July 7, 2009	Class 33: wine.	The Escarpment Vineyard Martinborough Limited,; C/ Village Roadshow Limited
ESCORIHUELA 1884	4,462,904	Filed: November 4, 2009	Class 33: wines.	S.A. Establecimientos

In re Application of:  
 Winestore Holdings, LLC  
 Serial No.: 88/282,862  
 Filed: January 30, 2019  
 Mark: ESCORLADA (Int. Class 33)  
Page 5

Disclaimer: "1884".		Registered: January 7, 2014		Vitivincolas Escorihuela
ESCORPION  Translation: The English translation of the word "ESCORPION" in the mark is "SCORPION".	5,120,883	Filed: November 25, 2015  Registered: January 10, 2017	Class 33: alcoholic beverages, namely, mezcal.	Douglas Kohlberg French
ESCARABAJO  Translation: The English translation of "ESCARABAJO" in the mark is "BEETLE".	88/439,589	Filed: May 21, 2019  Published: September 17, 2019	Class 33: alcoholic cocktail mixes; aperitifs; aperitifs with a distilled alcoholic liquor base; distilled spirits; liquor; pre- mixed alcoholic beverages, other than beer-based; schnapps; spirits.	13Thirteen Spirits, LLC.

True and accurate printouts of the status pages from the U.S. Trademark Status & Document Retrieval for the foregoing U.S. registrations and published U.S. application are attached hereto at Exhibit A. The above-referenced marks are peacefully coexisting with each other and with the Cited Mark, all of which are owned by nine (9) different third parties. For the same reasons that these marks beginning with the prefix ESCOR- or ESCAR- peacefully coexist within the alcohol industry, Applicant submits that its ESCORLADA mark is as distinguishable from the above-referenced marks and the Cited Mark, as the above-referenced marks and Cited Mark are different from each other based on the different prefixes and suffixes used by Applicant and the Cited Registrant. For example, none of the third-party marks beginning with the prefix ESCOR- or ESCAR- comprise the suffix -LADA, which has no defined meaning or translation in English. While the Cited Mark comprises the suffix -LATA, this is a common Spanish term

In re Application of:  
Winestore Holdings, LLC  
Serial No.: 88/282,862  
Filed: January 30, 2019  
Mark: ESCORLADA (Int. Class 33)  
Page 6

meaning “can” in English, as evidenced by the true and accurate copy of the translation from the online *SpanishDict* attached hereto at Exhibit B. As such, these two prefixes are easily distinguishable by ordinary purchasers.

It is well recognized that evidence of third-party registrations in the marketplace strongly suggests that consumers are conditioned by the number of similar marks to differentiate between the marks and the sources from which the marks emanate based upon other distinctions, including the differences between the marks and/or the goods/services offered by the respective parties. *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 U.S.P.Q.2d 1477 (T.T.A.B. 1987) (concluding that the numerous third-party uses of STEVE-formative marks for restaurants and food stores demonstrate that the purchasing public has become conditioned to recognize that many businesses in the restaurant and food store businesses use the term and that the purchasing public is able to distinguish between these businesses based on small distinctions among the marks). Given the narrow scope of protection properly accorded the Cited Mark, Applicant respectfully submits that its ESCORLADA mark is equally capable of distinction from the Cited Mark based on the differences between the respective marks discussed below.

**2. Applicant’s mark is different in terms of appearance, sound, connotation, and commercial impression when compared to the Cited Mark.**

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Whether the subject marks are similar in appearance, sound, and meaning are material considerations in determining likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The Examining Attorney must compare

In re Application of:  
Winestore Holdings, LLC  
Serial No.: 88/282,862  
Filed: January 30, 2019  
Mark: ESCORLADA (Int. Class 33)  
Page 7

the allegedly conflicting marks as a whole, rather than breaking up marks into their component parts for comparison. *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) (“[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.”). This is the “anti-dissection” rule. *Id.* The rationale for the rule is that the commercial impression of a composite mark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. *See McCarthy on Trademarks and Unfair Competition*, § 23:41:

The anti-dissection rule is based upon a common sense observation of customer behavior: the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole.

Similarity as to one aspect of the sight, sound, and meaning trilogy does not itself automatically create a likelihood of confusion between two marks. *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.4 (T.T.A.B. 1988). As shown by the following cases, courts have rejected the contention that there was likelihood of confusion even when one mark has contained, in part, the whole of another mark:

- “**PERKS**” (volume discount buying services) v. “**PERKSPOT**” (volume discount buying services) – *Coach/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 U.S.P.Q.2d 1458 (T.T.A.B. 2014);
- “**DOMAINE PINNACLE & Design**” (apple-based beverages) v. “**PINNACLES**” (wine) – *Franciscan Vineyards, Inc. v. Domaines Pinnacle, Inc.*, 2013 TTAB LEXIS 553 (T.T.A.B. 2013);
- “**DISRUPT**” (prophylactic and desiccant powder to prevent growth of microorganisms) v. “**DISRUPT MICRO-FLAKE**” (insecticide and pesticide) – *In re DGR Associate LLC*, 2013 TTAB LEXIS 297 (T.T.A.B. 2013);

In re Application of:  
Winestore Holdings, LLC  
Serial No.: 88/282,862  
Filed: January 30, 2019  
Mark: ESCORLADA (Int. Class 33)  
Page 8

- “**QUICK-KILL**” (mousetrap) v. “**AMDRO QUICK KILL**” (insecticide) – *In re Woodstream Corp.*, 2013 TTAB LEXIS 16 (T.T.A.B. 2013);
- “**PARENTS**” (magazine) v. “**PARENT’S DIGEST**” (publication of magazines) – *Gruner + Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 26 U.S.P.Q.2d 1583 (2d Cir. 1993);
- “**VARGA GIRL**” (calendars) v. “**VARGAS**” (calendars) – *In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992);
- “**FINAL**” (pesticide) v. “**FINAL FLIP**” (pesticide) – *Bell Laboratories, Inc. v. Colonial Products, Inc.*, 644 F. Supp. 542, 231 U.S.P.Q. 569 (S.D. Fla. 1986); and
- “**ROMAN**” (cereal breakfast food, bread) v. “**ROMANBURGER**” (specially prepared carry out foods-namely, sandwiches sold for consumption on or off the premises) – *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 U.S.P.Q. 364 (Fed. Cir. 1986).

Like in the above cases, in the case at hand, the prefix ESCOR- and ESCAR- are relatively weak in connection with alcoholic beverages, as described in greater detail in Section 1. Considering the narrow scope of protection afforded to the Cited Mark and considering the Cited Mark in their entirety, Applicant’s ESCORLADA mark is distinctly different in appearance, sound, connotation, and commercial impression from the Cited Mark. As an initial matter, Applicant’s mark begins with the prefix ESCOR-, while the Cited Mark begins with the prefix ESCAR-. Additionally, Applicant’s mark ends with the suffix -LATA, while the Cited Mark ends with the suffix -LADA. These prefixes and suffixes are different in appearance and pronunciation. Additionally, as discussed above in Section 1, the suffix -LADA has no defined meaning or translation in English, while the suffix -LATA is a common Spanish term meaning “can” in English.



In re Application of:  
Winestore Holdings, LLC  
Serial No.: 88/282,862  
Filed: January 30, 2019  
Mark: ESCORLADA (Int. Class 33)  
Page 9

Applicant's mark consists of the single term ESCORLADA that has no defined meaning or translation in English. Accordingly, Applicant's mark is 'fanciful' on the spectrum of distinctiveness. TMEP § 1209.01(a) ("Fanciful marks comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (e.g., PEPSI, KODAK, and EXXON) or are completely out of common usage (e.g., FLIVVER)."). In Section 11:6 of *McCarthy on Trademarks & Unfair Competition*, McCarthy explains that "[l]ooking to the conceptual strength of a mark, coined and fanciful words are referred to as **conceptually the 'strongest' of all marks**, in that their originality and uniqueness is **likely to create a substantial impact on the buyer's mind**." (citing *Aveda Corp. v. Evita Marketing, Inc.*, 706 F. Supp. 1419, 1428 (D. Minn. 1989)). (Emphasis added).

In contrast, the Cited Mark consists of the single Spanish term ESCARLATA meaning "scarlet" in English, as submitted by the Cited Registrant in Cited Registration No. 4,995,076. In this regard and as noted above, the Cited Registrant amended the application that matured into the Cited Registration to the Supplemental Register in response to the Office's assertion that this mark is merely descriptive, since "the word SCARLET is commonly used to describe the color of red, rose and pink wines." (See Office Action dated December 10, 2015, in the file history for Registration No. 4,995,076). Descriptive marks are weak marks that cannot be protected unless secondary meaning is proven. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992) ("When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected."). As such, the Cited Mark is not likely to be identified as a particular source by a buyer and is distinguishable from Applicant's fanciful ESCORLADA mark.

In re Application of:  
Winestore Holdings, LLC  
Serial No.: 88/282,862  
Filed: January 30, 2019  
Mark: ESCORLADA (Int. Class 33)  
Page 10

For these reasons, Applicant respectfully submits that the differences in the appearance, sound, connotation, and commercial impression created by the Cited Mark and Applicant's ESCORLADA mark makes clear that consumer confusion as to source is very unlikely.

**3. The totality of the evidence demonstrates the complete absence of any danger of purchaser confusion in this matter.**

When making a final determination as to likelihood of confusion, the Examining Attorney must consider *all* of the evidence bearing on the question of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Applicant submits that in light of the narrow scope of protection properly accorded the Cited Mark and the differences in appearance, sound, connotation, and commercial impression of the respective marks, there is **no** danger of consumer confusion as to source under these circumstances.

\* \* \* \* \*

Applicant respectfully requests that the Examining Attorney give favorable reconsideration to its application in light of the remarks submitted herewith directed to the issues of likelihood of confusion. Applicant submits that its mark is not likely to cause confusion with the Cited Mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw this rejection and pass its application to publication at the earliest possible date. Such favorable action on the part of the Examining Attorney is respectfully solicited.