

In the Office Action, the Examining Attorney cited Application No. 77/624,674 for the mark THE REBEL for “wine” as a potential bar to registration of the instant application. For the following reasons, this potential refusal is respectfully traversed, and reconsideration is requested in view of the following comments.

*In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. 56 (CCPA 1973) stands for the proposition that likelihood of confusion depends upon whether the purchasing public would mistakenly assume that an applicant’s goods originate from, are sponsored by, or are in some way associated with good provided under a cited registration. In *DuPont*, the court enunciated several factors relevant to determining likelihood of confusion. In this case, the similarity or dissimilarity of the marks, especially in view of the weakness of the cited marks, is dispositive.

As an initial matter, the mere similarity or even identity between two marks can never alone be decisive of likelihood of confusion. *McGregor-Doniger, Inc. v. Drizzle Inc.*, 202 U.S.P.Q. 81 (2<sup>d</sup> Cir. 1979). Thus, in holding the mark “DRIZZLE” for women’s overcoats was not likely to cause confusion with “DRIZZLER” for golf jackets, the Court of Appeals for the Second Circuit stated “[f]irst, even close similarity between two marks is not dispositive of the issue of likelihood of confusion. ‘Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question.’” *Id.* at 89 (citations omitted).

The basic principle in determining confusion between marks is that the marks must be compared in their entireties. 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. *In re Nat’l Data Corp.*, 224 U.S.P.Q. 749, 850-51 (Fed. Cir. 1985) (citations omitted); TMEP § 1207.01. For example, the Board in *Hart Schaffner & Marx v. Marks Ltd.*, 229 U.S.P.Q. 544 (TTAB 1986) held that even though the goods of the parties were closely related, the mark “MARKS LTD” was not likely to create confusion with a composite mark “HART SCHAFFNER & MARX” stating that:

[a]lthough “MARKS” and “MARX” might be likely to create confusion if they were used by themselves as marks for the goods and services of the parties, we see no likelihood of confusion in the case presently before us, where these words are only one element of marks which are otherwise not at all alike in meaning, appearance or sound.

*Id.* at 546.

Similarly, the Federal Circuit in *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), in reversing a decision of the Board, found “VARGAS” and “VARGA GIRL,” both for calendars, to be sufficiently different in sound, appearance, connotation and commercial impression to negate any likelihood of confusion. The Board, in analyzing the marks for confusing similarity, had found that “VARGA” was the dominant element of the VARGA GIRL mark, and that “GIRL” was merely

descriptive and thus could not be afforded substantial weight in comparing VARGA GIRL with VARGAS. The Federal Circuit determined that the Board had erred in its analytic approach, stating:

Although undoubtedly “VARGA” and “VARGAS” are similar, the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight. The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component “GIRL”. By stressing the portion “VARGA” and diminishing the portion “GIRL,” the Board inappropriately changed the mark. Although the weight given to the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word “GIRL.” When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.

*Id.* at 1239.

In the instant case, Applicant acknowledges that the parties’ marks share either the term REBEL or RIBELLE, which may be translated as “REBEL.” However, the similarities end there. Even the terms REBEL and RIBELLE, upon which the finding of similarity is based, are not identical. Moreover, the marks are similar only as to this one element. The mere identification of common elements in two marks does not mean that a likelihood of confusion exists. *Sources Services Corp. v. Chicagoland Job Source, Inc.*, 1 U.S.P.Q. 2d 1040 (N.D. Ill 1986). In their entireties, the marks are dissimilar in terms of sight and commercial impression.

TMEP § 1207.01(b)(iv) provides that:

Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, it is proper to give greater force and effect to that dominant feature for purposes of determining likelihood of confusion. **However, the fundamental rule in this situation is that the marks must be considered in their entireties.** (Citations omitted and emphasis added).

In essence, “[n]o element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Laboratories*, 6 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990) (TTAB erred in its dominant focus on the K+ in both marks, to the substantial exclusion of the other elements of both marks); *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 184 U.S.P.Q. 35 (CCPA 1974) (improper to ignore portion of composite mark).

To predicate a finding of similarity based solely on the shared formative “THE REBEL” or “LA RIBELLE,” to the exclusion of the other, integral formatives in Applicant’s mark, would employ the same reasoning the Board employed in *In re Hearst Corp.*, for which it was reversed. *See also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, § 23:47 n.1. (4<sup>th</sup> ed. 1996) (“Because marks are to be compared in their entireties, even if the ‘dominant’ parts of the conflicting word-design marks are the identical words, the marks as a whole are not confusingly similar”).

In the instant case, Applicant’s mark consists not only of the term “LA RIBELLE,” but also of eight other words, which both precede “LA RIBELLE” and appear above it. As stated by the Board in *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895 (TTAB 1988), “[i]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.” As in *Presto Products*, “BARBERA D’ASTI DENOMINAZIONE DI ORIGINE CONTROLLATA E GARANTITA” will make the most immediate impression on consumers, and will be remembered by consumers. While Applicant has agreed to disclaim the exclusive right to use “BARBERA D’ASTI DENOMINAZIONE DI ORIGINE CONTROLLATA E GARANTITA,” this phrase nonetheless forms an integral part of Applicant’s mark as a whole, due to its prominence within the mark and appearance at the forefront of the mark. The cited marks contain no elements similar any of these terms, and these terms clearly distinguish Applicant’s mark from the cited marks. The words “BARBERA D’ASTI DENOMINAZIONE DI ORIGINE CONTROLLATA E GARANTITA,” render Applicant’s mark dissimilar to the cited marks in terms of appearance, sound and commercial impression. In their entirety, Applicant’s mark and the cited marks are dissimilar. Moreover, when these differences are considered in view of the weakness of the cited marks, the marks in their entirety are dissimilar.

**The Strength of the Cited Marks**

TMEP § 1207.01(d)(x) regarding conflicting marks owned by different parties provides “[i]f the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.”

In the instant case, several active registrations for marks incorporating “REBEL” (and foreign translations of this term) owned by different entities, for wine coexist on the federal register. Applicant has attached, to the instant response, full records for such registrations. As the Examining Attorney will note, the following registrations coexist:

<b>TM/SN/RN/Disclaimer</b>	<b>Status/Status Date</b>	<b>Full Goods/Services</b>	<b>Owner</b>
THE REBEL SN:77-624674 RN:3,691,632	Registered October 6, 2009	(Int'l Class: 33) Wine	Darryn Travis Enterprises LLC (Washington Limited Liability Company) 808 Industry Dr. Tukwila, Washington 98188
 SN:78-939085 RN:3,400,070	Registered March 18, 2008	(Int'l Class: 33) Wines, bottled table wines	Lenbridge Forge Pty. LTD. (Australia Corp.) 10 St. Huberts Road Coldstream Australia

TM/SN/RN/Disclaimer	Status/Status Date	Full Goods/Services	Owner
REBEL RED SN:78-303514 RN:2,903,375	Registered November 16, 2004	(Int'l Class: 33) Bottled wine	V V Wines, Inc. (California Corp.) 7672 Alhambra Drive Huntington Beach, California 92647
AVIESO SN:77-291247 RN:3,532,096  Translation: twisted, rebel	Registered November 11, 2008	(Int'l Class: 33) Wines	Carbe LLC (Florida Limited Liability Company) 1368 Seagrape Cr. Weston, Florida 33326

Applicant submits that these coexisting registrations demonstrate that dilution of “REBEL” marks exists on the register for wine. Applicant submits that these registrations demonstrate that the Office has already determined that no one entity has exclusive rights in the term “REBEL” for these goods.

As noted in *Amstar Corporation v. Domino’s Pizza, Inc. et al*, 205 U.S.P.Q. 969, 975 (5<sup>th</sup> Cir. 1980), “the strength and distinctiveness of plaintiff’s mark is a vital consideration in determining the scope of protection it should be accorded.” Moreover, “[t]he strength of a given mark rests on its distinctiveness. The scope of protection afforded a strong mark is greater than that afforded a weak one. In determining the distinctiveness of a mark one looks to the degree to which the public associates the mark with a particular source.” *Miss World (UK) Ltd. v. Mrs. America Pageants Inc.*, 8 U.S.P.Q.2d 1237, 1240 (9<sup>th</sup> Cir. 1988)

Stated another way, “[a] strong trademark is one that is rarely used by parties other than the owner of the trademark, while a weak trademark is one that is often used by other parties.” *Universal Money Universal Money Centers Inc. v. American Telephone & Telegraph Co.*, 30 U.S.P.Q.2d 1930, 1935 (10<sup>th</sup> Cir. 1994) quoting *Exxon Corp. v. Texas Motor Exch.*, 208 U.S.P.Q. 384, 387 (5<sup>th</sup> Cir. 1980).

Applicant acknowledges that, pursuant to TMEP § 1207.01, in *ex parte* examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in *DuPont* may be considered if relevant evidence is contained in the record. However, as stated in 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11.88 (3<sup>rd</sup> Ed. 1995):

Evidence of third party use of similar marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to only a narrow scope of protection. The purpose of a defendant introducing third party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers “have been educated to distinguish between different [such] marks on the basis of minute distinctions” (citations omitted).

For example, in *General Mills, Inc. v. Health Valley Foods*, 24 U.S.P.Q.2d 1270, 1277 (TTAB 1992) the Board found that the field of “FIBER” composite marks for foods is crowded, such that there is

no likely confusion between FIBER ONE and FIBER 7 FLAKES both for breakfast cereals high in fiber. Similarly, in *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559 (TTAB 1996), the Board found that “[e]vidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field.” *Id.* at 1566-7.

While the existence of third-party registrations generally cannot justify the registration of another mark, in *Petro Stopping Centers L.P. v. James River Petroleum Inc.*, 44 U.S.P.Q.2d 1921 (4<sup>th</sup> Cir. 1997) citing *Pizzeria Uno Corp. v. Temple*, 224 U.S.P.Q. 185, 190 (4<sup>th</sup> Cir. 1984), the court found that third party registrations are relevant to the distinctiveness inquiry, stating:

Petro Stopping argues, however, that evidence of third-party registrations alone is insufficient to conclude that a mark is weak. The company maintains that only proof that third parties actually use the term PETRO would be relevant. We disagree. The frequency with which a term is used in other trademark registrations is indeed relevant to the distinctiveness inquiry under the first likelihood of confusion factor.

The frequency with which “REBEL” is used in other trademark registrations is indeed relevant to the distinctiveness inquiry. The coexistence of these many registrations and applications for marks incorporating “REBEL” for identical goods demonstrates that the Office has already determined that no one entity has exclusive rights to the term “REBEL” for wine.

Inasmuch as the Federal Circuit found the evidence of four entities concurrently using marks incorporating “OLD TIME” and variations thereof for food and beverage products to be sufficient to demonstrate that the cited mark was weak, Applicant submits that the foregoing clearly demonstrates that the cited mark is weak in its ability to prevent registration of Applicant’s mark.

#### **Confusion Must Be Likely**

Finally, under the Lanham Act, a refusal to register under likelihood of confusion requires that such confusion as to the source of the goods must be not merely *possible*, but likely. A mere possibility of confusion is an insufficient basis for rejection under § 2(d). *In re Massey-Ferguson, Inc.*, 222 U.S.P.Q. 367, 368; *Witco Chem. Corp. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43 (CCPA 1969). “We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world with which trademark laws deal.” *Witco* at 44.

Inasmuch as all outstanding issues have been resolved, Applicant submits that the mark is in condition for publication. Please direct any questions regarding this response to the undersigned attorneys for Applicant.