

# Trademark Review

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## JOTS for Gelatin Shots Found Confusingly Similar to TOTT'S for Sparkling Wine

E.&J. Gallo Winery successfully opposed registration of JOTS for gelatin shots mixed with distilled spirits or wine, on the grounds that there would be a likelihood of confusion with E.&J.'s mark TOTT'S for sparkling wine.

The Trademark Trial and Appeal Board ("Board") considered the two marks to be highly similar, noting the rhyming nature of the marks and the fact both were short monosyllabic words.

The Board found that the relatedness of the goods weighed slightly in the opposer's favor. Because alcoholic beverages are not necessarily related, the Board analyzed the particular "somewhat out of the ordinary" goods at issue in this case. The Board noted the differences between applicant's alcoholic gelatin shots and opposer's sparkling wine, but still found their similarities to be convincing because both goods may contain wine and are a means of "seeking the pleasures of intoxication."

In considering the channels of trade, the Board found the following highly persuasive: both products had low price points, both shared an overlap of young adult consumers likely to be relatively unsophisticated, and venues such as bars and restaurants encouraged impulse buying, leaving little opportunity for close inspection.

The Board also considered the strength of the TOTT'S mark. Although the Board found the opposer presented insufficient evidence to support a finding that the TOTT'S mark is famous, the evidence was still entitled some weight in the analysis, and made it more likely that applicant's mark would cause confusion.

*E.J. Gallo Winery v. Christopher M. Malek*, Opposition No. 91199089 (September 14, 2012).

## Likelihood of Confusion Between DUB for Nutritional Supplements and DUB for Non-Alcoholic Energy Drinks

The Board affirmed the final refusal of an application to register DUB for dietary supplements on the ground of likelihood of confusion with a prior registration for DUB for non-alcoholic energy drinks. The Board treated the existing DUB registration as a strong mark, finding that it is arbitrary as applied to energy drinks and that there was no evidence of similar third party marks on the Register.

Because the marks are identical, the Board noted there only need be a "viable relationship between the respective goods" to find a likelihood of confusion. The Board found a viable relationship between nutritional supplements and energy drinks based on

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numerous third party registrations which included both types of goods, suggesting that the goods are of a type that may emanate from a single source. Applicant's attempt to distinguish the goods by claiming that dietary supplements are healthy and that energy drinks are not was unsuccessful amidst evidence on the record describing some energy drinks as healthy.

Because the application did not include any restriction on the applicant's sales channels, the Board presumed that the goods were to be marketed in all channels, including ones overlapping with the channels for the registrant's goods. The Board also found dietary supplements to be ubiquitous products, not purchased with the degree of care that would help eliminate a likelihood of confusion. Moreover, because the trademarks are identical, even a cautious consumer could not distinguish them as emanating from separate sources.

*In re Dub Nutrition, LLC*, Serial No. 77752113 (October 3, 2012).

## **The Applicant Cannot Rely on the Fashion Designer's Place of Origin in the Context of Geographic Misdeshriptiveness for the Sale of Fashion Accessories**

The Federal Circuit affirmed the Board's refusal to register the mark:



for sunglasses, handbags and other fashion accessories on the ground that it is primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Lanham Act. The court found that the goods had no direct relationship with Paris and that given the famed relationship between fashion and Paris, consumers would be deceived into thinking that the goods came from Paris.

The manager and designer of the JPK PARIS 75 fashion line is a French citizen who had previously lived in Paris for 22 years. The applicant argued that this attenuated connection to the fashionably acclaimed city of Paris was sufficient to establish that the goods "originated" from Paris and, thus, the mark was not deceptively misdescriptive.

Origin can be predicated on essentially any circumstances that justify a *current* connection between the goods and the place and may even include the company's headquarters. Applicant sought to expand the meaning of "originate" to include the designer's connection to the city, arguing that in the fashion industry, consumers care more about the designer's origin than that of the goods. The Federal Circuit did not agree and found that the statute is clear and requires a direct connection between the actual goods and the place. Here, the company resided outside of Paris, the designer lived and worked outside of Paris, and the products were ultimately designed and manufactured outside of Paris (and outside of France altogether).

*In re Miracle Tuesday, LLC*, 104 U.S.P.Q.2d 1330 (Fed Cir. 2012).

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