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RFC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 17, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Brauerei Beck, GmbH & Co.
v.
Warsteiner Brauerei, Haus Cramer, GmbH & Co.

Opposition No. 98,695
to application Serial No. 74/504,134
filed on March 22, 1994

David Toren of Anderson Kill and Olick, P.C. for Brauerei
Beck, GmbH & Co.

Mark H. Jay for Warsteiner Brauerei, Haus Cramer GmbH & Co.

Before Simms, Cissel and Hohein, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 22, 1994, applicant, a corporation organized
under the laws of Germany, filed an application with the
United States Patent and Trademark Office to register the
mark "ISENBECK" on the Principal Register for beer.
Applicant claimed priority based on an application it had
filed on November 25, 1993 in Germany, and asserted that it

possessed a bona fide intention to use the mark in commerce here.

Following publication of the mark in the Official Gazette, a timely notice of opposition was filed on August 31, 1995 by Brauerei Beck GmbH & Co., a limited partnership under German law. As grounds for opposition, opposer asserted that it possessed prior rights in the marks "BECK" and "BECK'S" for goods which are identical to those on which applicant intended to use the mark it seeks to register; that opposer owned the following marks, all of which were registered for beer:

1



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BECK'S

¹ Reg. No. 1,683,146, issued April 14, 1992, claiming first use in 1976 and first use in commerce on February 17, 1987. On Oct. 19, 1998, this registration was canceled under Section 8 of the Act.

² Reg. No. 600,471, issued Jan. 4, 1955, claiming first use and first use in commerce on Jan. 26, 1910; renewed on March 15, 1995 for ten years.

"BECK'S BEER"³

4

and

5



; that

opposer's marks, also including the mark "BECK'S DARK" and design, for which registration had then only recently been applied, constitute a family of trademarks; that as a result of extensive use and promotion, opposer's marks are highly distinctive and extremely strong marks; and that applicant's

³ Reg. No. 1,028,855, issued Dec. 30, 1975, claiming first use and first use in commerce in 1910; This registration subsequently expired.

⁴ Reg. No. 1,030,970, issued on Jan. 20, 1976, claiming first use and first use in commerce since 1949; This registration also subsequently expired.

⁵ Reg. No. 1,734,134, issued on Nov. 17, 1992, claiming first use and first use in commerce since 1989. Combined affidavit under Sections 8 and 15 accepted and acknowledged on Sept. 16, 1998.

mark, if it were to be used in connection with beer in this country, would so resemble opposer's marks that it would be mistaken for another in opposer's family of marks, and thus that confusion would be likely.

While the first four of the pleaded registrations identify the goods as simply "beer," the registration for "HAAKE BECK" along with the other words and the design shown in that registration identifies the goods as "non-alcoholic beer." Further, as indicated in the footnotes referencing those registrations, the first, third and fourth of them are not currently subsisting. Each of those registrations has either been canceled or has expired.

In its answer, applicant denied that opposer owns a family of marks based on the mark "BECK"; denied that confusion would likely result from applicant's use of its mark in view of opposer's marks; and asserted as affirmative defenses that applicant's mark had coexisted with opposer's marks for at least eighty-five years without consumer confusion; that, in light of opposer's acquiescence in applicant's use during that period, opposer is estopped from opposing registration of applicant's mark now; and that because opposer adopted its "BECK'S" mark in 1910, whereas applicant's predecessor first sold beer under the "ISENBECK" mark in 1897, "any consumer confusion between BECK'S beer

and ISENBECK beer results from conduct by Opposer and not from conduct of Applicant's predecessor."

Both parties took testimony and introduced evidence in support of their respective positions. Both parties filed briefs, and both argued at the oral hearing which was conducted before the Board on February 11, 1998.

The record consists of the following: the testimony and associated exhibits of Virgil Abbatiello, the president of opposer's wholly-owned importing subsidiary, of Gregory Hardman, president of applicant's exclusive importer, and of Paul Rehor, the owner of a restaurant in Chicago which sells both applicant's and opposer's beer; applicant's answers to four of opposer's interrogatories; copies of published articles about opposer's business activities; and label approval certificates issued by the Bureau of Alcohol, Tobacco and Firearms for "BECK'S BEER," "BECK'S LIGHT," and "BECK'S OKTOBERFEST."

Based on careful consideration of the record and the arguments of the parties, we hold that Section 2(d) of the Act bars registration of the mark applicant seeks to register. Even though opposer has not adequately demonstrated that it is the owner of a family of marks, the marks opposer is using and for which there are subsisting registrations are extensively used and promoted, and applicant's use of the mark sought to be registered on

identical goods, in the case of beer, and closely related goods, in the case of non-alcoholic beer, both of which move through identical channels of trade to the same class of purchasers, is likely to cause confusion.

To begin with, irrespective of the expired or canceled registrations, by virtue of the subsisting registrations owned by opposer, opposer is entitled to priority as to the marks "BECK'S" and "HAAKE BECK" and design for beer and non-alcoholic beer, respectively. It is upon those two marks, as applied to those goods, that our decision is based.

Applicant's "affirmative defense" that its predecessor established priority constitutes a collateral attack on opposer's pleaded registrations, which, in the absence of a counterclaim for cancellation, is not permissible. In any event, opposer's registration of "BECK'S" is more than five years old, so it could not be canceled on the ground of priority and likelihood of confusion. Moreover, as to applicant's contention that it could establish priority through its predecessor in Germany, this record clearly establishes that opposer has priority of use of its marks in the United States. The question of which party had prior rights in Germany is irrelevant to the issue of who has the right to register in this country.

Similarly, applicant's assertion that opposer is estopped from opposing the registration of applicant's mark

because it acquiesced to decades of applicant's use is also without merit. Laches or acquiescence in an opposition proceeding must be determined based on delay in taking action, not from when the party plaintiff first had knowledge of defendant's use of the mark, but rather, based on delay in taking action from the time when plaintiff first had the opportunity to oppose the defendant's attempt to register the mark. *National Cable Television Association, Inc. v. American Cinema Editors Inc.*, 437 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). In the instant case, opposer timely filed its notice of opposition following publication of applicant's mark in the Official Gazette. No unreasonable delay, much less detrimental reliance on such delay, took place.

As another matter which is also introductory in nature, we note for the record that our decision is not predicated upon a finding that opposer has established a family of "BECK" marks. Although opposer argues strenuously to the contrary, and notwithstanding that the record clearly shows that opposer has used the marks which it asserts to be its family of marks, there is little persuasive evidence that opposer has promoted all, or even a substantial number, of the marks it claims as its family together, as a family, to prospective purchasers of the goods in such a way that a significant number of people outside of opposer's

organization recognize opposer's individual marks as members of a family of marks which all indicate source in a single entity.

For example, Mr. Abbatiello, the president of opposer's wholly-owned subsidiary, testified that Exhibit 16 is a copy of a printer's proof of an advertisement. The advertisement pictures bottles of "BECK'S," "BECK'S DARK," "BECK'S LIGHT," "HAAKE BECK," and "BECK'S OKTOBERFEST BIER," beer. Above the bottles is the heading "BECK'S FAMILY OF BRANDS." Below the bottles is the caption "The Number One Imported German Beer." Although the witness testified that this advertisement did appear in print, he specifically stated that it was only in trade journals, and that the ad appeared only in 1991, after which it was changed. When questioned further, he said that the exhibit was one of the types of print ads that opposer used in different trade journals. Interestingly, the testimony then turned to a discussion of who created opposer's advertising and promotion materials. The witness stated that an advertising agency worked with the importer to finalize whatever the agency came up with. He went on to say that the ad shown in Exhibit 16 was distributed to sports journals and to trade journals that go to restaurants and retailers such as grocery stores or chain outlets. Although he continued by stating that opposer also advertised in NBA basketball programs and arenas, the

particular ad shown in the exhibit was said to be used only in trade journals. It was not linked to advertisements like the ones appearing in basketball programs, which were presumably directed to ordinary consumers of beer.

Exhibit 16 is the only advertisement of record, a single 1991 ad, which shows several different types of "BECK'S" beers and "HAAKE BECK" non-alcoholic beer promoted as a family together. The testimony is not at all clear that the target audience for the ad, the readers of sports journals, which are apparently one kind of trade journal, and the readers of journals sent to restaurants and retailers such as grocery stores or chain outlets, represent a significant portion of the beer consuming-public.

Moreover, even if the testimony were clear that this one 1991 advertisement had been directed to beer consumers or to a segment of the wholesale market for such products, it would be difficult for us to find that it provides a basis upon which to conclude that a significant number of beer purchasers at any level understand that all of opposer's marks with either "BECK" or "BECK'S" in them belong to the same family of marks used by one entity, opposer, to identify the source of its different kinds of beer.

The other exhibits asserted by opposer to establish that a family of marks exists fall shorter still. These

other exhibits either do not show the asserted members of the family together, or they are simply printer's proofs of artwork, designed to be cut up, with particular appropriate parts to be used in ads where illustrations of the various types of beer opposer sells are necessary, and/or print-ready presentations of the various labels or trademarks are needed for particular print advertisements.

Exhibits 20 and 21 are examples of this. We have no evidence or testimony that these sheets, labeled "binding sample for b/w art-paper printing," were ever used to create advertisements which promoted together to beer purchasers, whether retail or wholesale, the various marks opposer asserts to constitute its family of marks.

There is a problem with opposer's family of marks theory which is even more fundamental. The marks combining "BECK'S" with generic terms for beer such as "BEER," "LIGHT," "DARK," or "OKTOBERFEST" would not necessarily be considered to be a family of marks in the usual trademark sense. Rather, these combinations are likely to be perceived as examples of the famous "BECK'S" trademark used on a full line of products which all come from the same brewer.

Turning, then, to the central issue in this opposition proceeding, i.e., whether confusion is likely, we note that the applicable test for resolving this question is not

seriously disputed. It is well settled that our analysis must focus on all of the thirteen factors identified by the Court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), which are relevant to the case at hand. The ones which are applicable to the facts in the instant case include the similarity of the marks and the goods, the trade channels, the conditions under which and the buyers to whom sales are made; the market interface of the parties and their products; any fame of the prior marks; the number and nature of similar marks in use on similar goods; and the occurrence of incidents of actual confusion because of the marks at issue in the relevant marketplace, in view of the potential for actual confusion to have taken place.

We find that applicant's mark, "ISENBECK," is similar to opposer's "BECK'S" and "HAAKE BECK" marks. While plainly not identical, these marks create similar commercial impressions. Especially in view of the fame of opposer's "BECK'S" mark for beer, beer purchasers in the United States are likely to assume, mistakenly, as it turns out, that "ISENBECK" beer emanates from, or is in some way associated with, the source of "BECK'S" beer.

Any of the thirteen factors which may be considered in resolving the issue of likelihood of confusion may play a more dominant role in a particular case, depending on the

facts at hand. Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), cert. denied, 506 U.S. 862 (1992). However, as emphasized therein: "The fifth du Pont factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark." Id. at 352. Famous marks are to be accorded a wide latitude of legal protection, in view of the lower standard of care purchasers are likely to exercise in purchasing a product under a famous mark, as well as the fact that a newcomer has an obvious incentive to try to exploit the goodwill symbolized by a mark which is already famous in its field.

The record in the case before us establishes that "BECK'S" is a famous mark for beer. The mark has been extensively used and promoted by opposer, and as a result, the product on which it is used has been extremely successful in the marketplace. "BECK'S" beer is the largest selling German beer in this country. Opposer's "HAAKE BECK" mark for non-alcoholic beer is stronger than it would otherwise be because the word "BECK" is a clear reference to "BECK'S" beer. The record does not establish that any other mark consisting of or containing the name "BECK" is used or registered for beer of any kind.

Although "ISENBECK" is not identical to the famous "BECK'S" mark for beer, these marks create similar

commercial impressions because of their common component, the name "BECK." This is so even if purchasers do not assume, as opposer argues they will, that "ISENBECK" is an ice beer made by the makers of "BECK'S" beer. The fame of opposer's "BECK'S" beer and the identity of the goods accounts for this. The record does not establish that the "ISEN" component of applicant's mark has any known meaning in the German language.

That this record does not contain any evidence of incidents of actual confusion is not determinative of a contrary result. The record clearly establishes that applicant has used the mark it seeks to register, "ISENBECK," in the same channels of trade—indeed, in the very same restaurant, in one case—wherein opposer's "BECK'S" beer is also sold, without any actual confusion being reported, but the evidence of such market interface does not show that there has otherwise been sufficient opportunity for confusion to have occurred. Moreover, even if there had been such opportunity without confusion resulting, the question before the Board is whether confusion is likely, and in order for us to resolve this issue in the affirmative, we do not need to have evidence that confusion has actually occurred. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

In summary, applicant's use of "ISENBECK" on goods which are identical to those on which the famous "BECK'S" mark is used is plainly likely to cause confusion. The likelihood that confusion will take place is increased by the fact that beer is an inexpensive consumer product that is often casually purchased without a lot of thought and consideration.

We reach the same conclusion with respect to the "HAKKE BECK" mark for non-alcoholic beer. For the purposes of our analysis, beer and non-alcoholic beer, although distinguishable, are very closely related. Although applicant argues to the contrary, these products move through the same channels of trade to the same purchasers, ordinary consumers, and the conditions under which they are sold are essentially the same. Although opposer's "HAAKE BECK" and design mark for beer does not resemble applicant's mark as closely as opposer's "BECK'S" mark does, and the goods on which "HAAKE BECK" is used are closely related, rather than identical, confusion is nonetheless likely. "HAAKE BECK" and "ISENBECK" create similar commercial impressions, especially in view of the fame of opposer's "BECK'S" mark, and regular beer is closely related to non-alcoholic beer. Potential purchasers, when confronted with the mark "ISENBECK" on a container of beer, are likely to assume that the mark indicates another type of beer made by

the makers of "BECK'S" beer, in the same sense that "HAAKE BECK" beer is the brand name under which another type of opposer's beer is sold.

This case presents the Board with a famous mark for beer and a related mark for non-alcoholic beer, on the one hand, and on the other, a beer trademark which, while not identical, creates a similar commercial impression. Under these circumstances, confusion is likely. Were there any doubts concerning this result, such doubt would necessarily be resolved in favor of the prior user of the famous mark, and against the newcomer, who had a duty to avoid selecting a mark which would create the likelihood of confusion with the mark already in use by its leading competitor. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

For the reasons set forth above, the opposition is sustained and registration to applicant is refused.

R. L. Simms

R. F. Cissel

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board

Opposition No. 98,695