Oral Hearing:
October 20, 1999

Paper No. 18
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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 28, 00

U.S. PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

IDV North America, Inc.
v.
R.C. (SHONUFF) Enterprises, Inc.

Opposition No. 107,234 to application Serial No. 75/133,141
filed on July 12, 1996

Albert Robin and Howard B. Barnaby of Robin, Blecker & Daley for IDV North America, Inc.

Donald R. Murphy, Esq. for R.C. (SHONUFF) Enterprises, Inc.

Before Hohein, Bottorff and Holtzman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

R.C. (SHONUFF) Enterprises, Inc. has filed an application to register the mark "SHONUFF" for "prepared alcoholic cocktails".[1]

IDV North America, Inc. has opposed registration on the ground that, since prior to the July 12, 1996 filing date of applicant's application, opposer "has been and now is engaged,

[1] Ser. No. 75/133,141, filed on July 12, 1996, which alleges a bona fide intention to use the mark in commerce.

inter alia, in the business of importing, producing, bottling, advertising, offering for sale and selling alcoholic and non-alcoholic beverages"; that since prior to such date, opposer "has been using SMIRNOFF as a trademark for vodka, vodka with natural flavors, prepared low alcohol cocktails and non-alcoholic cocktail mixes"; that opposer "is the owner of a number of registrations of its SMIRNOFF trademark," including those for the following marks and goods:

(1) "SMIRNOFF," in the stylized format reproduced below,

for "vodka";[2]

(2) "SMIRNOFF LEAVES YOU BREATHLESS!," in the stylized manner shown below,

for "vodka";[3]

(3) "SMIRNOFF SILVER" for "vodka";[4]

(4) "SMIRNOFF DE CZAR" for "vodka based prepared alcoholic cocktails";[5]

(5) "SMIRNOFF DE CZAR" for "vodka";[6]

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[2] Reg. No. 513,428, issued on August 9, 1949, which sets forth dates of first use of 1914; second renewal.

[3] Reg. No. 862,846, issued on December 31, 1968, which sets forth dates of first use of May 12, 1967; first renewal.

[4] Reg. No. 907,665 (erroneously listed as Reg. No. 907,655 in the notice of opposition), issued on February 9, 1971, which sets forth dates of first use of August 14, 1969; first renewal.

[5] Reg. No. 1,118,403, issued on May 15, 1979, which sets forth dates of first use of February 2, 1978; combined affidavit §§8 and 15. It appears, however, that such registration has now expired and, thus, it will not be given further consideration. See TBMP §703.02(a).

(6) "SMIRNOFF SINGLES" for "prepared low-alcohol cocktails";[7]

(7) "SMIRNOFF" for "non-alcoholic cocktail mixers";[8]

(8) "EXTREME SMIRNOFF" for both "non-alcoholic cocktail mixers" and "vodka";[9]

(9) "SMIRNOFF" and design, as illustrated below,

for "vodka";[10] and

(10) "SMIRNOFF" and design, as depicted below, illustrated below,

for "vodka";[11] and

that "[a]pplicant's designation SHONUFF so resembles the trademark SMIRNOFF, as previously registered and used by Opposer,

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[6] Reg. No. 1,199,801 (erroneously listed as Reg. No. 1,119,801 in the notice of opposition), issued on June 29, 1982, which sets forth dates of first use of August 28, 1979; combined affidavit §§8 and 15.

[7] Reg. No. 1,877,880, issued on February 7, 1995, which sets forth dates of first use of June 22, 1993.

[8] Reg. No. 1,887,385, issued on April 4, 1995, which sets forth a date of first use anywhere of October 1993 and a date of first use in commerce of January 17, 1994.

[9] Reg. No. 1,932,292, issued on October 31, 1995, which sets forth dates of first use of January 1995.

[10] Reg. No. 2,045,650, issued on March 18, 1997, which sets forth dates of first use of 1958. The mark is lined for the colors red and gold.

[11] Reg. No. 2,047,345, issued on March 25, 1997, which sets forth dates of first use of 1958.

as to be likely, when applied to the goods of Applicant, to cause confusion, or to cause mistake or to deceive."

Applicant, in its answer, has denied the salient allegations of the notice of opposition.

The record includes the pleadings; the file of the opposed application; and, as opposer's case-in-chief, the affidavit, with exhibits, of its Director of Smirnoff Marketing, Jonathan G. Stordy, which was submitted pursuant to a stipulation by the parties. Applicant, however, did not take testimony or otherwise offer any evidence. Only opposer submitted a brief and attended the oral hearing held on this matter.

Opposer's priority of its various "SMIRNOFF" marks is not in issue inasmuch as the affidavit testimony regarding its extant pleaded registrations for its marks and the certified copies of such registrations[12] establish that the registrations are subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). The only real issue to be determined, therefore, is whether applicant's "SHONUFF" mark, when used in connection with prepared alcoholic cocktails, so resembles one or more of opposer's "SMIRNOFF" marks for vodka, prepared low-alcohol

[12] Although the certified copies of Reg. Nos. 1,887,880, 1,932,292, 2,045,650 and 2,047,345 show that such registrations are subsisting and owned by opposer, IDV North America, Inc. ("IDV"), the certified copies of Reg. Nos. 513,428, 862,846, 907,665, 1,199,801 and 1,877,880 indicate that those registrations, while subsisting, are owned by Heublein, Inc. rather than opposer. Nevertheless, in light of Mr. Stordy's testimony, stipulated to by applicant, that "IDV is the owner of ... registrations of its SMIRNOFF trademark, and ... copies of the ... registrations are attached to this affidavit as Opposer's Exhibits ...," the latter registrations are considered to be owned by opposer.

cocktails and/or non-alcoholic cocktail mixers that confusion is likely as to the source or sponsorship of the parties' goods.

According to the record, opposer is engaged in the business of importing, producing, bottling, advertising, offering for sale and selling alcoholic and non-alcoholic beverages. For over 60 years, opposer and its predecessors have been selling vodka under the mark "SMIRNOFF" and, for many years, such brand "has been the largest selling vodka in the United States and the first or second largest selling brand of distilled spirits." (Stordy aff. ¶4.) For a number of years, opposer and its predecessors have also used the mark "SMIRNOFF" in connection with vodka with natural flavors, prepared low-alcohol cocktails and non-alcoholic cocktail mixes.

Annual sales in the United States of vodka bearing the mark "SMIRNOFF" have been as follows over the past ten fiscal years:

Year	Case Sales	Dollar Amount
1988	5,883,000	$314,400,000
1989	6,009,000	$326,000,000
1990	5,814,000	$324,700,000
1991	5,427,000	$327,200,000
1992	5,253,000	$327,700,000
1993	5,353,000	$334,900,000
1994	4,905,000	$305,000,000
1995	5,233,000	$325,900,000
1996	5,200,000	$326,201,000
1997	5,046,000	$327,600,000

Opposer "has heavily advertised and promoted SMIRNOFF vodka." (Id. ¶8.) For the past ten fiscal years, annual expenditures in the United States with respect to advertising, merchandising and promoting its "SMIRNOFF" marks have run as follows:

Year	Dollar Amount
1988	$25,048,000
1989	$25,102,000
1990	$28,208,000
1991	$23,214,000
1992	$23,654,000
1993	$23,664,000
1994	$24,595,000
1995	$33,438,000
1996	$35,467,000
1997	$37,614,000

Turning to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), that confusion as to source or affiliation is not likely to occur.[13] In so finding, however, we agree with opposer that, as pointed out in its brief, the respective goods of the parties are identical in part, with respect to prepared low-alcohol cocktails, and it is plain from the nature of the products that applicant's prepared alcoholic cocktails are closely related to both opposer's vodka and its non-alcoholic cocktail mixers. The respective goods, in view thereof, would clearly be sold to the same classes of purchasers through identical channels of trade and under identical conditions of sale.

Opposer argues, in light of the above *du Pont* factors weighing in its favor, that confusion is likely because the respective marks are sufficiently similar in their overall sound

[13] While opposer states in its brief that the pertinent factors in this case "are (1) similarity of the marks; (2) similarity of the goods; (3) similarity of the trade channels; and (4) conditions under which sales are made," its brief also contains a passing mention of fifth *du*

and appearance. Specifically, as to its "SMIRNOFF" mark, which along with its "SMIRNOFF" and design marks are the ones which most closely resemble applicant's "SHONUFF" mark, opposer maintains that:

> Here, the marks at issue share similarities that make them confusingly similar. Both marks are two-syllable terms, both beginning with the letter "S", both having almost the same number of letters (eight vs. seven) and both ending with a vowel/double "N-FF" combination ("NOFF vs. NUFF).

Opposer consequently contends that:

> Given the similarities between the marks, ... likelihood of confusion seems particularly acute in the noisy atmosphere of a bar where ... the sales of the parties' alcoholic beverages must be presumed to occur. Indeed, because of the phonetic similarities in the marks, as well as the frequent ordering of alcoholic beverages in bars by brand name (e.g., SMIRNOFF vodka and tonic), it is likely that both bartenders and patrons are likely to be confused. ....

We find, however, that even in the noisy atmosphere of a bar or, to take other examples, either a crowded restaurant or busy liquor store, the respective marks are distinguishable not only in sound and appearance but, most importantly, in connotation and commercial impression. When considered in their entireties, the first syllable in the term "SMIRNOFF" sounds nothing like that of the mark "SHONUFF," nor do such portions look substantially alike. The mere fact that such designations begin with the letter "S" and have similar suffixes is not enough

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Pont factor which we find relevant, namely, the fame of its "SMIRNOFF" mark.

to give rise to a likelihood of confusion. This is particularly so inasmuch as the term "SMIRNOFF" would appear to have no meaning, other than possibly that--as shown by the references on the labels of record for opposer's vodka to a "Pierre Smirnoff"--of a surname, while the term "SHONUFF" is an expression which, we judicially notice,[14] signifies that something is genuine, true or sure enough. For instance, The Slang Thesaurus (1896) at 49 includes, under the heading for "**Accuracy; Truth**," the expressions "sure enough, sho' 'nuff" as connoting "*genuine, true*," while The Oxford Dictionary of Modern Slang (1993) at 251 lists "**sure** adverb **sure 'nuff** US, mainly Black English" as meaning "[s]ure enough; used for emphasis, esp. in demonstrating a point. Also **sho' nuff**."[15]

As a result of the distinct differences in sound and appearance, and the substantial difference in connotation, applicant's "SHONUFF" mark for prepared alcoholic cocktails is, as a whole, so disparate in commercial impression from opposer's

[14] It is settled that judicial notice may be taken of dictionary definitions and other standard reference works. See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); and In re Hartop & Brandes, 311 F.2d 249, 135 USPQ 419, 423 (CCPA 1962) at n. 6.

[15] Although counsel for opposer, at the oral hearing, contended that, even if there were dictionary definitions as to the connotation of applicant's mark, it could not be assumed that all purchasers would know the meaning of the term "SHONUFF," we think that a significant portion of the purchasing public would perceive or regard applicant's mark as either a concatenated form of the expression "sho' 'nuff" or simply the equivalent of the familiar term "sure-enough," which, for instance, Webster's Third New International Dictionary (1993) at 2299 defines as an adjective meaning " ACTUAL, GENUINE, REAL <the life for a *sure-enough* man ....>".

"SMIRNOFF" marks for vodka, prepared low-alcohol cocktails and/or non-alcoholic cocktail mixers that the contemporaneous use thereof is not likely to cause confusion as to origin or affiliation. See, e.g., Laboratories du Dr. N.G. Payot Establissement v. Southwestern Classics Collection Ltd., 3 USPQ2d 1600, 1606 (TTAB 1987) [marks "PEYOTE" and "PAYOT," when used in connection with toiletries and cosmetics, would not be likely to cause confusion as to source or sponsorship since "PEYOTE" is ordinary word with dictionary definition while "PAYOT," being surname of creator of opposing party's cosmetic line, is unfamiliar term with no ordinary meaning].

Lastly, however, opposer casually refers, as previously noted, to the asserted fame of its "SMIRNOFF" mark by mentioning, in its brief, that the record (*emphasis added)* "demonstrates widescale [sic] advertising, promotion and use of its *famous* SMIRNOFF mark in connection with its products, including prepared alcoholic cocktails." As our principal reviewing court in Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 113 S.Ct. 181 (1992), has pointed out:

> The fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection. ....

That the "fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *du Pont* factors" was recently reaffirmed by such court in Recot Inc. v. M.C. Becton, No. 99-1291, slip op. at 5, ___ F.3d ___, ___ USPQ2d ___

(Fed. Cir. June 7, 2000). Nevertheless, as set forth in Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142, 1146 (Fed. Cir. 1991), the dissimilarity of the marks alone may be dispositive of the issue of likelihood of confusion inasmuch as, while the prior mark of an opposer may indeed be famous, each case must be decided on its own facts. A single *du Pont* factor other than fame may, therefore, play a dominant role since, according to the Court, "[w]e know of no reason why, in a particular case, a single duPont factor may not be dispositive." Id.

The record herein is sufficient to establish that opposer's "SMIRNOFF" mark is at least widely known, if not famous, for vodka. Opposer and its predecessors have sold vodka under the "SMIRNOFF" mark for over 60 years and, in addition to being the first or second largest selling brand of distilled spirits, it is the largest selling brand of vodka in the United States. Sales thereof for the ten-year period beginning in 1988 have exceeded 54 million cases, representing a dollar value of over $3.2 billion, and the "SMIRNOFF" brand, during the same period, has been heavily advertised and promoted, with expenditures therefor totaling just over $280 million.

However, notwithstanding the demonstrated renown or recognition of the mark "SMIRNOFF" for vodka, the substantial overall disparities in pronunciation, appearance and, especially, connotation and commercial impression, as between applicant's "SHONUFF" mark for prepared alcoholic cocktails and opposer's various "SMIRNOFF" marks for vodka, prepared low-alcohol

cocktails and/or non-alcoholic cocktail mixers, are sufficient to preclude there being any likelihood of confusion in the marketplace for the parties' goods. The dissimilarity in the respective marks is simply so great that, on the facts of this case, it plays the dominant and decisive role among the *du Pont* factors, outweighing even the fame of opposer's "SMIRNOFF" marks. See, e.g., Kellogg Co. v. Pack'em Enterprises Inc., supra at 1144-46 [no likelihood of confusion between mark "FROOTIE ICE" and elephant design for packages of flavored liquid frozen into bars and mark "FROOT LOOPS" for, inter alia, cereal breakfast foods and fruit-flavored frozen confections since, while such goods are very closely related, move through the same channels of trade to the same classes of purchasers, are purchased casually rather than with care and the mark "FROOT LOOPS" is a very strong, well known and, indeed, famous, mark, the respective marks differ so substantially in appearance, sound, connotation and commercial impression].

Decision: The opposition is dismissed.

G. D. Hohein

C. M. Bottorff

T. E. Holtzman
Administrative Trademark Judges,
Trademark Trial and Appeal Board