

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: January 13, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Castaneda and Anderson*  
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Serial No. 85876309  
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Matthew H. Swyers of The Trademark Company, PLLC  
for Onofre Castaneda and Christopher Anderson

In Pyo Lee, Trademark Examining Attorney, Law Office 114,  
K. Margaret Le, Managing Attorney.<sup>1</sup>

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Before Cataldo, Mermelstein and Wolfson,  
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Applicants Onofre Castaneda and Christopher Anderson seek registration on the  
Principal Register of the mark DRINK IT NAKED (in standard characters) for  
Tequila in International Class 33.<sup>2</sup>

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<sup>1</sup> In this proceeding, Mr. Lee represented the Office with respect to the application at briefing. David I is the Examining Attorney that was responsible for the application during prosecution.

<sup>2</sup> Application Serial No. 85876309 was filed on March 14, 2013, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

The Trademark Examining Attorney has refused registration of Applicants' mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicants' mark, when used in connection with tequila, so resembles the previously registered mark DON'T WORRY DRINK NAKED and Design (as depicted below) for goods ultimately identified as "distilled spirits" in International Class 33 as to be likely to cause confusion, mistake, or to deceive prospective purchasers.<sup>3</sup>



After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

### I. Applicable Law

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion

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<sup>3</sup> Reg. No. 4534142, issued May 20, 2014. The identification of goods for which the registration issued was "alcoholic beverages except beers and wines." On June 4, 2015, Registrant submitted a Section 7 Request Form, amending the identification of goods to "distilled spirits" in International Class 33. The amendment was accepted. We consider the refusal to register Applicants' mark with respect to the amended identification of goods.

analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). In this case, we consider the *du Pont* factors for which there are arguments and evidence of record: those relating to the similarity and nature of the goods, the similarity of trade channels, and the similarity of the marks. The other factors we consider to be neutral. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (“Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered.”) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) (“Indeed, any one of the factors may control a particular case.”).

## II. Analysis

### A. *The relatedness of the goods, channels of trade and classes of purchasers.*

The second and third *du Pont* factors consider the relatedness of the goods and the similarity or dissimilarity of “established, likely-to-continue trade channels,” including the classes of purchasers to whom the goods are directed. It is well settled that “the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application.” *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162

(Fed. Cir. 2014) (citing *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *In re Dixie Restaurants*, 41 USPQ2d at 1534; *In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015). In the case at hand, Applicants seek registration of the mark DRINK IT NAKED for “tequila.” The cited mark is registered for “distilled spirits.” A “spirit” is defined as “an alcoholic beverage, especially distilled liquor.”<sup>4</sup> Tequila is one such distilled spirit, being defined as “an alcoholic liquor distilled from the fermented sap of the blue agave.”<sup>5</sup> Accordingly, the “distilled spirits” in the cited registration subsume the more narrowly identified “tequila” in the involved application. The goods thus are legally identical. Applicant does not dispute this finding; Applicant “concede[s] the similarity of the goods or services as recited in the Applicant’s applied-for trademark as well as the registered trademark.”<sup>6</sup>

Because the goods identified in Applicants’ application are legally identical to those listed in the cited registration, we must presume that the goods travel in the same channels of trade and are available to the same potential purchasers of such goods. *See Stone Lion*, 110 USPQ2d at 1162; *In re Smith and Mehaffey*, 31 USPQ2d

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<sup>4</sup> *Id.*, at <https://www.ahdictionary.com>, 6 TTABVUE 10.

<sup>5</sup> At <https://www.ahdictionary.com>; attached to the Examining Attorney’s brief; 6 TTABVUE 10. The Board will ordinarily not consider additional evidence submitted after the appeal is filed, Trademark Rule 2.142(d), but the Board may take judicial notice of dictionary definitions, including definitions or entries from references that are the electronic equivalent of a print reference work. *See University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009). We have taken judicial notice of the definitions of “spirit” and “tequila” submitted with the Examining Attorney’s brief.

<sup>6</sup> Applicants’ Brief, p. 11, 4 TTABVUE 12.

1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”). Moreover, as neither Applicants nor Registrant has limited the identified goods to any particular channels of trade or classes of purchasers, it is further presumed that the goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers of the goods, which in this case are ordinary consumers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Applicants agree, as stated in their brief, that “the majority of the du Pont factors would also favor a finding of a likelihood of confusion (e.g., similarity of goods, trade channels, marketing channels).”<sup>7</sup> Accordingly, we find the second and third *du Pont* factors weigh heavily in favor of finding a likelihood of consumer confusion.

*B. The similarity of the marks.*

We now turn to a consideration of the marks at issue in this case. Where, as here, the goods are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); *see also, In re Mighty Leaf Tea*, 94 USPQ2d at 1260; *In re Dixie Restaurants*, 41 USPQ2d at 1534.

In comparing the marks at issue, we focus on “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial

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<sup>7</sup> Applicant’s Brief, p. 10, 4 TTABVUE 11.

impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citing *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); see also *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

Our comparison of the marks is determined based on the marks in their entireties and is not predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). The “touchstone of this factor is consideration of the marks in total.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH KGAA v. New Millennium Sports, S.L.U.*, 707 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015). Nonetheless, “in articulating reasons for reaching a conclusion on the issue of

confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat’l Data*, 224 USPQ at 751. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Applicants’ mark DRINK IT NAKED creates an overall commercial impression



that is similar to Registrant’s composite mark: . The fact that the registered mark includes a design feature of circular patterns, stars and crossed sugarcanes does not obviate the likely confusion between the marks.<sup>8</sup> The circular patterns and stars in Registrant’s mark form an ordinary and familiar geometric background design that serves as a carrier for the literal portion. The crossed sugarcanes inside the mark at least tangentially reinforce the wording; sugarcane is a chief source of sugar, and sugar is a common ingredient in some distilled liquors.<sup>9</sup>

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<sup>8</sup> The description of the mark reads: “The mark consists of the design of a concentric circular design comprised of two circles, where the outermost circle features the words ‘DON’T WORRY DRINK NAKED’ with two star shapes appearing on either side of the circle [sic] and the innermost circle features the design of two crossed sugarcane leaves overlapping in the center.” The description is slightly inaccurate as only one star shape appears on either side of the circle.

<sup>9</sup> That sugarcane is a chief source of sugar is referenced at Dictionary.com, where “sugarcane” is defined as “a tall grass, *Saccharum officinarum*, of tropical and warm regions, having a stout, jointed stalk, and constituting the chief source of sugar.” The same on-line dictionary identifies “sugar” as “used extensively as an ingredient and flavoring of

Accordingly, the design features of the cited mark do not offer sufficient distinctiveness to create an overall commercial impression that is more dissimilar than similar to Applicants' mark. Moreover, the literal portion of Registrant's mark is far more likely to be impressed upon a purchaser's memory and to be used when requesting the goods than is the sugarcane design (the background design features, being unpronounceable, are even less likely to be used to request the goods). *See Joel Gott Wines*, 107 USPQ2d at 1431 (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); *In re Viterra*, 101 USPQ2d at 1908 ("In the case of a composite mark containing both words and a design, 'the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.'") (quoting *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)).

Applicants argue that the marks are sufficiently different in connotation to avoid confusion, reasoning that while consumers would perceive the term "naked" in Applicants' mark as referring to a tequila beverage that did not contain any drink mixers or added juices, they would perceive the term "naked" in the registered mark as referring to the state of being unclothed. Applicants' argument is unpersuasive. While the phrase "drink naked" may suggest an image of someone consuming an alcoholic beverage unclothed, we see no reason why the phrase "drink it naked" could not also evoke such an image, and there is nothing in the record to support Applicants' contention that "drink it naked" refers to their goods rather than the

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certain foods and as a fermenting agent in the manufacture of certain alcoholic beverages." At [dictionary.reference.com/browse/sugarcane?s=t](http://dictionary.reference.com/browse/sugarcane?s=t); [dictionary.reference.com/browse/sugar](http://dictionary.reference.com/browse/sugar).



consumers thereof. The addition of the word “it” in Applicants’ mark does not change the overall similarity between the connotations of the two marks. While “drink it naked” may to some consumers be perceived as an exhortation to refrain from adding mixers or juice, an equally compelling exhortation suggested by the mark would be the tongue-in-cheek suggestion to undress and imbibe. As for the argument that in general, consumers typically recall the first portion of a mark rather than the last, in Registrant’s mark there is no true “first” portion, given the circular nature of the mark. Moreover, even if the tendency is to recall the mark as “DON’T WORRY DRINK NAKED,” rather than “DRINK NAKED DON’T WORRY,” the wording “drink naked” stands on its own, both because it is visually set apart from the other wording and as a catchy and slightly risqué proposition.

Overall, the marks are similar in their connotations and commercial impressions and more similar than dissimilar in their entirety as to appearance and pronunciation. The first *du Pont* factor favors a finding of likely confusion among relevant purchasers of Applicants’ tequila and Registrant’s distilled spirits.

### III. Conclusion

The marks form overall similar commercial impressions. The goods are legally identical. The goods are presumed to travel through the same trade channels and be purchased by the same classes of consumers, which includes ordinary consumers. Taking into account all arguments and evidence pertinent to the relevant *du Pont* factors, we find that use of Applicant’s mark DRINK IT NAKED would be likely to



cause confusion with Registrant's cited mark for the goods listed with respect to Applicants' application and Registrant's registration.

**Decision:** The refusal to register Applicant's mark DRINK IT NAKED under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is affirmed.