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**Vodka and wine are unrelated, says TTAB
United States - Silverberg Goldman & Bikoff**

**Examination/opposition
National procedures**

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In *In re White Rock Distilleries Inc* (Case 77093221, October 5 2009), in a precedential decision, the Trademark Trial and Appeal Board (TTAB) has reversed a refusal to register the word mark VOLTA, finding that confusion was unlikely with the registered figurative mark TERZA VOLTA.

White Rock Distilleries applied to register the mark VOLTA for “energy vodka infused with caffeine” in Class 33 of the *Nice Classification*. The examining attorney rejected the application under Section 2(d) of the *Lanham Act* on the grounds that the mark was confusingly similar to the earlier registered mark TERZA VOLTA for “sparkling fruit wine; sparkling grape wine; sparkling wine; wines”.

In its likelihood of confusion analysis, the TTAB concluded that the marks were dissimilar - in sound, appearance, connotation and overall commercial impression - and that the goods were unrelated. Specifically, the TTAB found that the examining attorney had failed to establish that energy vodka and wine are complementary products or emanate from a single source.

Before the TTAB, White Rock argued that the marks were dissimilar on the following grounds:

- The TERZA VOLTA mark prominently depicts a “large vine shoot design”. Moreover, the dominant word ‘terza’ is spelt “in much larger point type and in a darker colour” than the word ‘volta’.
- The phrase ‘terza volta’ (meaning ‘third party’ in Italian) creates a distinct connotation closely linked to both “vineyards and the number three”, while the VOLTA mark is a “play on the word ‘volt’” and refers to the “sudden caffeine ‘rush’ associated with its unusual ‘energy vodka’ product”.
- A far different commercial impression was conveyed in light of White Rock’s “highly unconventional market niche of ‘energy vodka’”.

The TTAB essentially adopted these positions wholesale, adding only that “[a]s to sound, because the literal portion of the registered mark begins with the term ‘terza’, this mark sounds somewhat different from [White Rock]’s mark”.

As to the degree to which the goods were related, the TTAB explained that “[t]here is no *per se* rule that holds that all alcoholic beverages are related” (citing the *Trademark Manual of Examining Procedure*, §1207.01(a)(iv): “there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto”).

The TTAB then summarized the examining attorney’s evidence on relatedness as “excerpts from several internet websites showing that (1) vodka and wine are offered on the same website to the same consumers, and (2) there are several vodkas which are made with wine grapes”. The examining attorney had further argued that “the TTAB has repeatedly found that alcoholic beverages are related” and that given “the common trade channels established for alcoholic beverages, consumers will encounter both marks” (citing *In re Chatam Int’l Inc* (380 F3d 1340 (2004)), in which it was held that GASPAR’S ALE for beer was likely to be confused with JOSE GASPAR GOLD for tequila, and *In re Majestic Distilling Co* (65 USPQ2d 1201 (2003)), in which it was held that RED BULL for tequila was likely to be confused with RED BULL for malt liquor).

The examiner’s argument followed a trend of TTAB decisions finding alcoholic goods related. In fact, the TTAB has found confusing similarity between alcoholic beverages so frequently that it appeared to have established a virtual *per se* rule, despite the Trademark Manual’s admonition.

The TTAB, however, rejected this broad-brush interpretation, which glossed over the proof of relatedness between alcoholic beverages adduced in prior cases. For example, in *Chatam*, the TTAB and the Federal Circuit had found that third parties owned registrations for both beer and tequila, which showed that the two beverages could emanate from the same source. In *Majestic*, the TTAB and the Federal Circuit had relied on “(1) articles demonstrating that malt liquor and tequila are occasionally found in some of the same places, and (2) articles relating to Anheuser-Busch’s Tequiza, a tequila-flavoured beer”.

The TTAB concluded that “there is no evidence that vodka, much less [White Rock]’s specific type of vodka, and wine emanate from a single source under a single mark”. Moreover, the TTAB stated that “there is no evidence that energy vodka infused with caffeine and wine are ingredients for any particular cocktails such that we could consider them complementary products that would be bought and used together”.

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Ultimately, this decision is instructive for trademark practitioners and their clients in the beverage industry, who must decide whether to press forward through adverse examination and appeal to the TTAB. It shows that even though there are a great number of decisions finding certain alcoholic goods related, the [US Patent and Trademark Office](#) still may not treat them as related *per se*, and must adduce independent evidence of relatedness in order to satisfy the TTAB.

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