ESTTA Tracking number: **ESTTA607464**
Filing date: **06/02/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77080324
Applicant	POWER BEVERAGES, LLC
Applied for Mark	YING YANG VODKA
Correspondence Address	Timothy J. Monahan MONAHAN &COMPANY, LLC 201 E Park Ave GREENVILLE, SC 29601 UNITED STATES tmonahan@monahanip.com, tanderson@monahanip.com
Submission	Appeal Brief
Attachments	Appeal Brief - Final Signed Version.pdf(639906 bytes) black and white side by side specimens.pdf(518542 bytes)
Filer's Name	Timothy J. Monahan
Filer's e-mail	agrondski@monahanip.com, tmonahan@monahanip.com
Signature	/Timothy J. Monahan/
Date	06/02/2014

Ex parte Power Beverages, LLC

Serial No. 77/080,324

Filing Date: January 10, 2007

Trademark: YING YANG VODKA

APPEAL BRIEF

CASE CITATIONS

Ex parte Black & Decker Mfg. Co., 136 USPQ 379 (Comm'r Pats. 1963).

In re Guitar Straps Online, LLC, 103 USPQ2d 1745 (TTAB 2012) citing In re Who? Visions Systems, Inc., 57 USPQ2d at 1218.

Paris Glove of Canada, Ltd. v. SBC/Sportco Corp., 84 USPQ2d 1856, 1862 (TTAB 2007).

Ex parte Petersen & Pegau Baking Co., 100 USPQ 20 (Comm'r Pats. 1953).

In re Umax Data System, Inc., 40 USPQ2d 1539 (Comm'r Pats. 1996).

Procedural Background

The following entries in the record are being brought to the Board's attention:

An amended drawing was submitted in the present application on October 10, 2007. The amending drawing was accepted and an Examiner's Amendment to the description of the mark was entered on November 9, 2007. The amended description reads as follows:

"The mark consists of the yin-yang symbol with dripping water coming off the design. The wording YING YANG VODKA is in the shape of a wave."

On May 25, 2012, Applicant filed a Statement of Use and submitted a specimen showing use of the mark. In an Office Action dated August 10, 2012, the Statement of Use was refused on the ground that the mark on the specimen disagrees with the mark on the drawing.

On February 11, 2013, Applicant submitted a replacement specimen, which is essentially a better photograph of the earlier filed specimen. Applicant also requested that the description of the mark be amended to read as follows:

"The mark consists of a large yin/yang symbol above wavy "ying yang" text, incorporating a small yin/yang symbol."

The Examiner has refused to enter the amendment and has maintained refusal of the specimen. A Final Rejection was entered in the present application on November 3, 2013.

Issue on Appeal

The issue for the Board's consideration is whether the mark sought to be registered and the specimen submitted in support of the Statement of Use "create the impression of being essentially the same mark."

Argument

The Examiner found that the omission of the stylized dripping water element from the specimen, in addition to other variations in the layout of the words "ying" and "yang", constitute a material alteration of the mark, such that the specimen does not create the same commercial impression as the drawing.

Applicant submits the following observations for the Board's consideration.

1. The mark is YING YANG VODKA.
2. The words "ying" and "yang" and a small yin/yang symbol appear in substantially the same position and relationship in both the drawing and the specimen – the differences are subtle and are unlikely to be noticed by a reasonably prudent consumer.
3. A large yin/yang symbol appears at the top of both the drawing and the specimen.
4. The stylized dripping water element appears in the drawing, but not the specimen.

For the Board's reference, a copy of the drawing and the specimen in black and white are juxtaposed in Exhibit A, attached hereto.

"[T]he primary question is whether the proposed amendment contains 'the essence of the original mark' and whether it creates 'the impression of being essentially the same mark.' *In re Who? Visions Systems, Inc.,* 57 USPQ2d at 1218. In other words, 'the new and old forms of the mark must create essentially the same commercial impression.' *Id., quoting In re Nationwide Industries Inc.,* 6 USPQ2d 1882, 1885 (TTAB 1988)" cited by *In re Guitar Straps Online, LLC* , 103 USPQ2d 1745 (TTAB 2012).

Applicant submits that the slight variation in the relative positions of the words "ying" and "yang" and the small yin/yang symbol between the drawing and specimen are not material. The differences are consistent with the AQUA STOP case. *Paris Glove of Canada, Ltd. v. SBC/Sportco Corp.*, 84 USPQ2d 1856, 1862 (TTAB 2007) ("AQUASTOP" depicted on one line in semicircular form not material alteration of "AQUA STOP" depicted on two lines in rectangular form; the Board found that "the commercial impression of the mark is dependent upon the literal terms AQUA STOP and not on the rectangular, semicircular or linear forms of display"). TMEP § 807.14(f).

The Examiner has set forth the differences in the positioning of the words "ying" and "yang" and the small yin/yang symbol between the drawing and the specimen in exacting detail. Applicant submits, however, that the level of scrutiny brought to bear by the Examiner goes well beyond the standard of a "commercial impression." In fact, the similarities between the drawing and specimen are substantial. In both depictions the phrase "ying yang" appears in a wave, along with a small yin/yang symbol. In both the drawing and the specimen, the word "ying" appears on the left and word "yang" appears on the right. In both the drawing and the specimen, the small yin/yang symbol is integrated into the wave and is positioned between the words "ying" and "yang." Thus, the wavy "ying yang" and small yin/yang symbol convey the same commercial impression in both depictions.

The large yin/yang symbol appears at the top of both the drawing and the specimen, although the symbol is rotated 90° in the specimen. Applicant submits that the yin/yang symbol is a distinct design element and conveys essentially the same commercial impression in both the drawing and the specimen.

It may be arguable whether the words "ying" and "yang" or the yin/yang symbols form the dominant portion of the mark. In general, "words tend to dominate in forming a commercial impression." TMEP§1604.13. Nevertheless, the large yin/yang symbol in particular, as well as the small yin/yang symbol, are both distinct and contribute to the play on words between "ying yang" and the philosophical concept of yin and yang.

The stylized dripping water element of the drawing suggests superficial condensation on the outside of a bottle. It is not the dominant portion of the mark, and the dripping water element is not integrated into the mark in any meaningful way. The removal of a design element that is not integrated into the mark in any significant way is not a material alteration of the mark. *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996); and *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953).

"Material alteration" is the standard for evaluating amendments to marks at all relevant stages of processing, both during examination of the application and after registration." A test for whether the new form (specimen) creates the same commercial impression as the original mark (drawing) is "whether the form as altered would be likely to be recognized as the same mark." TMEP§1609.02(a). *See Ex parte Black & Decker Mfg. Co.,* 136 USPQ 379 (Comm'r Pats.

1963). Applicant respectfully submits that the specimen would be recognized as the same mark as the drawing in the application, by the relevant consumers.

Applicant requests that the refusal to accept the Statement of Use and the specimen filed in support thereof be reversed and the registration be granted.

Respectfully Submitted,

Timothy J. Monahan
MONAHAN & COMPANY, LLC

ying yang
VODKA

ying yang
PREMIUM
VODKA