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

Proceeding	77858375
Applicant	Mastorogiannakis, Nikolaos
Applied for Mark	MY BIG FAT GREEK WINE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APPEAL BRIEF

Applicant: Nikolaos Mastorogiannakis

Serial No.: 77/858,375

Filed: 10/27/2009

Mark: **MY BIG FAT GREEK WINE**

Attorney Docket No.: 1001.17O.NM

Sir/Ma'am:

Please Find Enclosed Applicant's Main Brief.

INDEX OF CASES

In re E.I. DuPont de Memours & Co., 476 F.2d 1357 (C.C.P.A. 1973) ……4

In re Hearst Corp., 982 F.2d 493,494 (CAFC 1992) …….4

In re H.J. Seiler Co., 289 F.2d 674 (C.C.P.A. 1961) ……7

In Re Electrolyte Laboratories Inc., 929 F.2d 645, 647, 16 USPQ2d, 1240 (Fed. Cir. 1990) …..6

In re Martin's Famous Pastry Shoppe, Inc., 223 U.S.P.Q. 1289, 1289 (Fed. Cir. 1984)……. …..5

I INTRODUCTION

Applicant Nikolaos Mastorogiannakis submitted a trademark application for the mark "MY BIG FAT GREEK WINE" on October 27, 2009. On November 23, 2010, the Examining Attorney issued a final refusal to registration of the above-referenced mark on the Principal Register pursuant to 15 U.S.C. Section 1052(d), holding that the above-referenced mark, when used on or in connection with its identified services, is confusingly similar to registered marks "MY BIG FAT GREEK RESTAURANT," Registration No. 3,202,521 for "restaurant services" in International Class 43. Applicant respectfully appeals this decision, arguing that a likelihood of confusion does not exist because the overall impression of the marks differ as applicant's mark, with additional terms and design, clearly serves a source identifying function.

In determining likelihood of confusion under Section 2(d), a thirteen (13) factor test is employed, specifically: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which, and buyers to whom, sales are made, that is impulse v. sophisticated purchasing; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during, and the conditions under which, there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, that is, whether de minimus or substantial; and (13) any other

established fact probative of the effect of use. *In re E.I. DuPont de Memours & Co.,* 476 F.2d 1357 (C.C.P.A. 1973).

II. ARGUMENT

A. The refusal for likelihood of confusion should be removed as applying the appropriate DuPont factors illustrates an absence of likelihood of confusion as a comparison of applicant's mark and the cited mark illustrates clear differences in sound, appearance, meaning, and connotation.

The common elements of applicant's mark and the cited mark are the words MY BIG FAT GREEK. In determining likelihood of confusion, the examining attorney must compare the marks for similarity in sound, appearance, meaning, and connotation. *In re E. I. du Pont de Nemours & Co*., 476 F.2d 1357, 1361, 177 USPQ 563 (C.C.P.A. 1973); *In re Hearst Corp*., 982 F.2d 493, 494, 25 USPQ2D 1238, 1239 (CAFC 1992). As illustrated herein, a comparison of applicant's mark and registrant's mark illustrates clear differences in sound, appearance, meaning, and connotation of the marks. As such, no determination of likelihood of confusion can exist. The differing element present in the applicant's mark, the term "WINE", which indisputably directs the attention of the purchaser toward, and is highly indicative of applicant's goods, significantly changes the sound, appearance, meaning, and connotation and provides an individual with a clear impression of the goods and source.

Similarity of word marks is found by comparing the appearance, sound, and **meaning** between applicant's mark and the cited registration. TMEP 1207.01(b) (emphasis added). Similarity in appearance for a word mark arises from the overall impression of the word or words composing the mark. *In re Hearst Corp*., 982 F.2d 493, 494, 25 USPQ2D 1238, 1239 (CAFC 1992). The first factor for determining whether a likelihood of confusion exists is to review the applicant's mark in light of the cited registration and analyze the "similarity or

dissimilarity of the marks **in their entireties** as to appearance, sound, connotation, and commercial impression." *In re Martin's Famous Pastry Shoppe, Inc.*, 223 USPQ 1289, 1289 (Fed. Cir. 1984)(emphasis added).

In re Hearst Corp., 982 F.2d 493, 494, 25 USPQ2D 1238, 1239 (CAFC 1992), the Court found that the trademarks VARGAS and VARGA GIRL, which existed in identical goods (calendars) were sufficiently different in sound, appearance, connotation, and commercial impression to negate any likelihood of confusion. A clear correlation can be made between Hearst and the instant situation. The allusion to "wine" in applicant's mark parallels the allusion to "girls," which would be the focal point of the calendar, the photos of the "girls." This allusion, which clearly distinguished the marks in Hearst, should apply herein.

Alleged conflicting marks must be compared by looking at them as a whole, rather than breaking the marks into their component parts for comparison. An addition, subtraction, or substitution of letters or words may be sufficient to make the marks dissimilar in appearance, depending on the overall commercial impression given to the relevant public. T.M.E.P. 1207.01.

When comparing the two marks, equal weight must be given to each element and the fact that the applicant's mark contains different elements cannot be ignored. In comparing the two opposing marks in their entireties, they are clearly different and engender different commercial impressions. As illustrated above, applicant's differing element, WINE, changes the overall commercial impression of the mark, by invoking in the minds of the relevant consumer the actual type of goods to which applicant's mark is identified.

B. The refusal for likelihood of confusion should be removed as the overall impression of applicant's mark differs from that of the cited mark as the dominant terms and focal points of the marks differ.

An addition . . . of words, may . . . be sufficient to make the marks dissimilar in appearance, depending on the overall commercial impression given to the relevant public TMEP 1207.01(b). Thus, applicant must show that the differences between two marks significantly change the commercial impression made by the applicant's mark. *In re Electrolyte Labs, Inc.*, 16 USPQ2D 1239, 1240 (Fed. Cir. 1990) ("**more dominant features will, of course, weigh heavier in the overall impression of a mark**")(emphasis added). As illustrated herein, the overall impression of the marks MY BIG FAT GREEK RESTAURANT and MY BIG FAT GREEK WINE clearly differ as the dominant terms of the respective marks differ.

Investigating the language of the marks for their dominant portion or features, WINE qualifies as the dominant portion of applicant's mark in MY BIG FAT GREEK WINE, which clearly defines applicant's good and thus source identifying. WINE also serves as the focal point of applicant's mark because it provides a descriptive element that distinguishes it from the registrants mark. Whereas the dominant portion or feature of registrants mark is RESTAURANT in MY BIG FAT GREEK RESTAURANT. RESTAURANT also serves as the focal point of registrant's mark because it provides a descriptive element that distinguishes it from the applicant's mark.

C. The refusal for likelihood of confusion should be removed as the two marks are different goods and services that are sold in different channels of trade, making it unlikely that two consumers would be confronted with both marks at the same time.

The third DuPont factor addresses the similarity or dissimilarity of established, like-to-continue trade channels. Trade channels represent an important aspect of the marketing environment in which marks are used. Likelihood of confusion is enhanced in cases where the goods or services of the parties are related and sold through channels of trade that are the same or overlapping. In the case at hand, the two marks are not sold in the same or relevant channels of trade and in no way would ever be encountered together at the time of purchasing. The registrant's mark is for restaurant services, as they operate only ten (10) stores in Arizona, while applicant produces wine which is to be sold nationally.

The applicant produces its products in Massachusetts's and is starting a nationwide campaign for their sale and distribution. While some of these products may funnel into Arizona, they will not be encountered together. It seems rather unlikely that someone looking for the registrant's restaurant will mistakenly purchase the applicant's wine, especially if the consumer is outside the small, geographical area the registrant caters to. It also seems highly unlikely that someone in the same geographical area will mistake applicant's product with the registrant's product due to the different marks and the difference in goods. The examining attorney claims that because the applicant's goods are related to the registrant's restaurant services, it could be concluded that they are provided together by the same manufacturer/restaurateur, citing *In re H.J. Seiler Co*., 289 F.2d 674, 129 USPQ 37 (C.C.P.A. 1961) (holding SEILER'S catering services likely to be confused with SEILER'S smoked and cured meats; In re Opus One Inc., 60

USPQ2D 1812 (TTAB 2001)(holding OPUS ONE for restaurant services likely to be confused with the identical mark for wine).

In re H.J. Seiler Co., 289 F.2d 674, 675, 129 USPQ 347 (C.C.P.A. 1961), the Court held that "[t]he fact that catering firms do market food can hardly be disputed by this appellant in view of its solicitation, on menus used by it in its catering business, of customers for the retail sale of its food products, and the difference between a service for the catering of food and the actual sale of food is rather a fine legal distinction not likely to be drawn by laymen." Here, both companies were in the business of food. One was in the business of going places to serve customers; the other was in business of serving customers on the spot. The difference here is that both the applicant and the registrant are in different services. The registrant is in the business of serving food and having interaction with the customers. The applicant, however, is in the business of serving the nation with wine that they can buy and take home. A person buying a bottle of wine in MA will not think that it is purchasing wine from a restaurant that is Arizona. Similarly, a purchaser who is buying wine in a store in Arizona will not be confused and think its buying wine from the restaurant.

Moreover, it does not qualify as a stretch to state that a person shopping for a wine, in a local alcohol proprietor, would find confusion with a restaurant, or a person looking for a restaurant would peruse a list of wine stores. Therefore, for the reasons stated above, no likelihood of confusion should exist and thus, applicant requests that the refusal be removed and that the Examiner forward the mark for publishing.

III. CONCLUSION

Applicant asserts Examining Attorney has erred in refusing registration for applicant's mark "MY BIG FAT GREEK WINE" and distinctive orchard storefront design for likelihood of confusion with the cited reference mark "MY BIG FAT GREEK RESTAURANT" (U.S. Registration No. 3,202,521) because the marks encompass disparate focal points and meanings.

Therefore, applicants respectfully requests that this Honorable Board reverse the decision of the Examining Attorney, and direct that the mark be published for opposition by the public.

Dated: July 22, 2011

Respectfully submitted,

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