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Applicant	Spirits of New Merced, LLC
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United States Patent & Trademark Office

Trademark Trial & Appeal Board

P.O. Box 1451

Alexandria, VA 22313-1451

RE: YOSEMITE BREWING COMPANY, SERIAL NO.: 78/978475, IC: 032

YOSEMITE BREWING COMPANY, SERIAL NO.: 78/756457, IC: 040

To Whom It May Concern:

Enclosed is the brief on appeal regarding the above-referenced trademark applications for the Spirits of New Merced, LLC.

Respectfully Submitted,

/Kenneth A. Vogel/

Kenneth A. Vogel

Enclosures:

Brief on Appeal

In the Examining Attorney's Final Refusal, the Attorney cited grounds in support of the refusal to which Applicant responded with a Request for Reconsideration and a Notice of Appeal. (The Appeal was suspended pending action on the Request for Reconsideration.) In the Office Action Response to Applicant's Request for Reconsideration on September 5, 2007, the Examining Attorney maintained her earlier Final Refusal. This Appeal brief follows.

COMPANY PROFILE, PRODUCT BACKGROUND

Applicant's establishment is categorized as a "brewpub." A brewpub is a restaurant that brews and serves its own beer. It is located in the City of Merced in Merced County, California, situated in the San Joaquin Valley. It is also located approximately 80 miles away from Yosemite National Park, which is located in Mariposa and Tuolumne Counties. The restaurant formerly operated as Backdraft Brewpub®,² which was a firehouse-themed establishment. (The building was formerly an actual firehouse.) The brewpub has since been remodeled to a cowboy theme, re-named Big Bubba's Bad to the Bone BBQ®,³ and has a cowboy-western motif and BBQ menu items. Some menu items include "Texas Toast," "Texas Tators," "Bad to the Bone Nachos," "Bubba's Caesar Salad," "Bubba's Bad Sauce," and "Bubba's Brownie Bonanza." The entire menu has a similar naming scheme, and all food items are named using either Western themes, Texas themes, incorporation of the name "Bubba," or a combination of the three. The brewpub's beer menu consists of a variety of beers with names of all types, including "Inferno®,"⁴ "El Bombero®,"⁵ "Black Rascal®,"⁶ "FireDrill®,"⁷ and "Golden Bobcat®."⁸

² BACKDRAFT BREWPUB, for restaurant services in Class 43. Registered on August 30, 2005. Reg. No.: 2,990,500

³ BIG BUBBA'S BAD TO THE BONE BBQ, for restaurant services in Class 43. Registered on October 24, 2006. Reg. No.: 3,164,149

⁴ INFERNO, for beer in class 032.

ISSUE ON APPEAL

The issue on appeal is whether or not the Examining Attorney properly applied available evidence and consistently applied precedent in the form of previously registered marks, and whether Examining Attorney gave sufficient weight to Applicant's assertions, which are offered to prove the absence of any likelihood for customer confusion between the Applicant's mark and the geographic area with which the Examining Attorney has associated it.

SUMMARY OF ARGUMENT

There are numerous registered marks on the principal register that are not 2(f)-registrations, but include terms in common with the names of well-known geographic locations. These marks would not have been registered if they were deemed primarily geographically descriptive. There is actually a previously-registered mark on the principal register for YOSEMITE BREWING COMPANY® beer,⁹ which cancelled due to non-renewal. It was not a 2(f)-registration, and neither was YOSEMITE BEER®,¹⁰ also cancelled due to non-renewal.

Registered (non-2(f)) on: February 6, 2007. Reg. No.: 3,206,972.

⁵ EL BOMBERO, for beer in class 032.
Registered (non-2(f)) on: October 3, 2006. Reg. No.: 3,150,905.

⁶ BLACK RASCAL, for beer in class 032.
Registered (non-2(f)) on: September 12, 2006. Reg. No.: 3,142,155.

⁷ FIREDRILL, for beer in class 032.
Registered (non-2(f)) on: December 5, 2006. Reg. No.: 3,180,346.

⁸ GOLDEN BOBCAT, for beer in class 032.
Registered (non-2(f)) on: October 30, 2007. Reg. No.: 3,323,966.

⁹ YOSEMITE BREWING COMPANY, for beer in class 032.
Registered (non-2(f)) on: March 23, 1999. Reg. No.: 2,234,545.

¹⁰ YOSEMITE BEER, for beer in class 032.
Registered (non-2(f)) on: October 7, 1997. Reg. No.: 2,102,601.

Additionally, “Yosemite” by itself is a word derived from a Native American tribal language, and the word “Yosemite” by itself does not hold any independent significance, geographic or otherwise. The Yosemite National Park (hereinafter also referred to as the “Park”), is located approximately 80 miles away from Applicant’s brewpub. There is no connection between the applicant’s beverages, services or establishment and Yosemite National Park. The National Park Service does not produce any commercial goods or services of any kind in Yosemite National Park, and so there can be no reasonable or likely goods/place association on the part of consumers.

ARGUMENT

In the Examining Attorney’s decision on reconsideration, she adhered to her earlier Final Refusal in which she stated that internet evidence and previous office actions indicate that the Yosemite National Park area is frequently referred to as merely “Yosemite.” The Examining Attorney stated that because of Applicant’s location and the fame of “Yosemite,” consumers are likely to believe that applicant’s services originate in Yosemite National Park. However, she made no reference to the three-part test that must be applied to determine whether a mark is primarily geographically descriptive of its goods. The test is found in TMEP §1210.01(a), which states in a prima facie case for refusal to register:

- (1) the primary significance of the mark is a generally known geographic location (see TMEP §§1210.02 et seq.);
- (2) the goods or services originate in the place identified in the mark (see TMEP §1210.03) ; and (emphasis added)
- (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (see TMEP §§1210.04 et seq.). Note: If the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association (see TMEP §1210.04(c)).

All three prongs of the test must generally be met before a prima facie case for refusal is made.

The Examining Attorney stated that the treatment of “YOSEMITE” as being a geographically descriptive term is consistent with Office practice, but if this was the case, then all marks bearing the term “YOSEMITE” would be deemed geographically descriptive. Examining Attorney has not shown how the primary significance of the term “YOSEMITE,” standing alone, is a generally known geographic location, aside from vacation home searches using that term. Applicant submitted evidence stating that the word “YOSEMITE” translates to “those who kill” in the Native American Miwok language, not a geographic location. Aside from the Examining Attorney’s real estate searches, Applicant asserts that no definition of geographical significance was established for the term “Yosemite” by itself, and thus, the first prong has not been conclusively met.

Regarding the second prong, even if one were to incorrectly presume that “YOSEMITE” signifies “YOSEMITE NATIONAL PARK,” the brewpub is located 80 miles away and could hardly be confused with producing any products using ingredients from the Park. The previous registration of “YOSEMITE BREWING COMPANY®” was to a company 40 miles from the Park and was not confusing on that basis. Thus, Applicant questions why a location twice as far from that could be confused as originating within the Park? Applicant also notes that, hypothetically, even if the first prong were met, the aforementioned distance issue would preclude the second prong from being met as well, as a distance of 80 miles would be well outside of any association of being within the Park. Applicant notes that much of his submitted evidence has shown that the USPTO has granted numerous other applications for marks that

have names in common with geographic regions, but are located as close as 10 miles away from those locations.

Inversely, neither has the Applicant applied for a geographically misdescriptive mark. There is no set definition for what distance is great enough to arbitrarily disqualify a mark for being geographically misdescriptive. The Applicant's mark is neither geographically descriptive nor misdescriptive.

Regarding the third prong of the test, the Examining Attorney stated (but did not offer evidence to support) that purchasers would be likely to believe that the goods or services originated in the geographic place identified in the mark, despite the fact that no goods or industries are in the Park. Furthermore, nothing in the Class 32 beer's ingredients: wheat, barley, hops or yeast, could potentially be confused as originating from the Park, as none of the ingredients are grown in the Park, nor would they be extracted for commercial use even if they were since the Park does not produce any goods. Similarly, none of the company's Class 040 brewing services or activities have anything to do with the Park. All brewing services are performed solely within Merced, far from the Park. Referring back to the three-prong test, none of these prongs have been conclusively proven by the Examining Attorney. At most, Examining Attorney's offered evidence in the form of vacation home searches would be helpful in determining the validity of only the first prong of the three-prong test. The language of the test indicates, with emphasis, that all three must be met for a refusal based on geographic descriptiveness.

I. REGISTRATIONS HAVE BEEN GRANTED FOR “YOSEMITE BREWING COMPANY®,” AS WELL AS OTHER MARKS USING THE WORD “YOSEMITE”

A. **“YOSEMITE BREWING COMPANY®” has already been trademarked and abandoned by a company located even closer to Yosemite National Park than Applicant’s brewpub.**

By way of rebuttal to the Examining Attorney’s declaration that the term is geographically descriptive, Applicant responded by submitting evidence and arguments in support of registerability, including two abandoned registrations for YOSEMITE BEER®¹¹ and one for YOSEMITE BREWING COMPANY®¹²; and the accepted translation of the word “Yosemite,” used to illustrate the variety of meanings for the term.

Two abandoned marks on the principal register are for YOSEMITE BEER®, and a third one was for YOSEMITE BREWING COMPANY®. Both marks were filed in 1995 by Yosemite Beverage Company in Mariposa, California, located approximately 40 miles from Yosemite National Park and in the same county as the Park (but not the same county as the Applicant). Both marks were registered in 1997 and 1998 respectively, and were cancelled at the end of 2004 for non-renewal. Both marks were non-service marks, and neither mark was registered pursuant to Section 2(f)’s provision on subsequently acquired distinctiveness.

¹¹ YOSEMITE BEER, for beer in class 032.
Registered (non-2(f)) on: January 27, 1998. Reg. No.: 2,131,642.

YOSEMITE BEER for beer in class 032.
Registered (non-2(f)) on: October 7, 1997. Reg. No.: 2,102,601.

¹² YOSEMITE BREWING COMPANY for Beer. First use in commerce: 09.01.1995.
Registered on: 03.23.1999. Reg. No.: 2,234,545.

Applicant has used the mark Yosemite Brewing Company in commerce starting in May 2006. More importantly, Applicant's marks are used in Merced, California, located approximately 80 miles from the Park, more than twice the distance from the previous registrant's location. Applicant asserts that "YOSEMITE BREWING COMPANY®" was previously granted to a company based far closer in proximity to the Park than Applicant's establishment, yet no presumption of confusion based on geographic proximity was made for those earlier marks. Applicant points out that although these marks are similar, Applicant is currently applying for marks in both Class 032 and in Class 040. Both applications should be considered separately and distinctly for registration on the Principal Register.

B. Several other marks incorporating the word
"YOSEMITE" have been registered.

Applicant submitted evidence regarding several other registered trademarks that also use the term "YOSEMITE" in their mark. Marks such as "YOSEMITE TECHNOLOGIES®,"¹³ registered to a company in Fresno, California, "YOSEMITE EQUITY STRATEGIES®," registered to a company in Boonville, California, have been granted without regard to Yosemite National Park. An important consideration would be whether or not there is a likely goods-place association in these cases. The fact that no such association is likely makes a mark registerable.

¹³ YOSEMITE TECHNOLOGIES for computer software used in archiving and restoring computer files. Registered (non-2(f)) on: June 3, 2003. Reg. No.: 2,721,476.

YOSEMITE EQUITY STRATEGIES for investment management advisory services. Registered (non-2(f)) on: August 28, 2001. Reg. No.: 2,483,860.

YOSEMITE for computer software used to forecast and display weather data. Registered (non-2(f)) on: October 2, 2004. Reg. No.: 2,890,800.

YOSEMITE for metrology systems using a scanning electron microscope to measure features of semiconductor devices in connection with fabrication of semiconductor wafers. Registered (non-2(f)) on: August 19, 2003. Reg. No.: 2,754,194.

For example, one registered mark for “YOSEMITE®” on the principal register is for metrology systems using a scanning electron microscope. The registration is not the result of 2(f) consideration, and is registered by a company in San Jose, California with similarly no presumed or implied association with Yosemite National Park, but located 180 miles away.

Applicant adds that no such association would be possible with “YOSEMITE BREWING COMPANY” considering Applicant’s location of brewing the product with that name.

Applicant’s “YOSEMITE BREWING COMPANY” beer is brewed on-site at the Applicant’s brewpub, and is consumed exclusively at the brewpub. No bottling, canning, or keg-filling of the beer is done at the establishment or elsewhere. Applicant asserts that no relation to the Yosemite National Park is presumed, as proven by the name of the establishment (“Big Bubba’s Bad Barbeque” brewpub), the décor, other menu items served there, or even in the context of other named beers that are brewed or consumed at the brewpub. Some of these other beers (all with either currently registered or pending trademarks), previously mentioned, include “Inferno®,” “El Bombero®,” “Black Rascal®,” “FireDrill®,” and “Golden Bobcat®.”

Furthermore, the Park does not conduct or permit any commercial manufacturing or industrial activities of any kind. No goods are produced at all within the Park, and Applicant’s product does not use any components or ingredients or anything Park-related in the production or consumption of its beer. National parks do not produce beer, nor are national parks known for beer or for brewpubs. The rest of Applicant’s menu items do not use or imply any relation to the Park’s components or inhabitants, nor does the rest of Applicant’s establishment presume any relation to the Park. Applicant asserts that his company should not be penalized for its relative proximity to the Yosemite National Park, as there are several other registered marks that use the term “YOSEMITE,” including past registrations for “YOSEMITE BEER®” and “YOSEMITE

BREWING COMPANY®” that were located even closer to the Park than Applicant’s brewpub. Even still, the City of Merced, where Applicant’s brewpub is located, does not bring in or use any type of water that is associated with the Park, but instead uses as municipal water its own underground wells.

Applicant questions three points. First, why are some marks utilizing the term “YOSEMITE” registerable while “YOSEMITE BREWING COMPANY” would not be registerable? Applicant asserts that here is no logical differentiation between Yosemite Brewing Company and, for example, “YOSEMITE INSURANCE COMPANY®.”¹⁴ Based on the practice of the USPTO, the Applicant’s mark should be registered.

Second, how can one logically differentiate between Yosemite Brewing Company beer and other beers by other brewing companies, such as “CHESAPEAKE BAY BREWING COMPANY,” in which the latter mark is registered to a company located almost directly adjacent to the Chesapeake Bay? These questions are even more confusing considering that there is a farther distance between the Applicant’s brewpub and the Park, than there is between Chesapeake Bay Brewing Company Corporation and the Chesapeake Bay.

Third, does the USPTO use an unpublished or arbitrary distance to judge whether or not the consumers would be confused with the products of that region? Applicant asserts that if the USPTO selectively denies registrations for some marks containing terms in common with geographic locations, but not others, then this would be unequal protection and treatment under the law. That policy would, in effect, state that a California company is not receiving the same benefit (registration on the Principal Register) that a company domiciled in a different state might receive. Had the brewpub been located in a different region of the country, would the

¹⁴ YOSEMITE INSURANCE COMPANY for insurance underwriting in property and casualty insurance. Registered (non-2(f)) on: August 28, 2007. Reg. No.: 3,285,990.

mark be considered registerable? Applicant questions if there is some sort of arbitrary mileage-distance rule that would warrant such a registration, however. Looking at the previous registration for “YOSEMITE BREWING COMPANY®,” the mark was granted for a company located 40 miles away from Yosemite National Park. That would indicate that such a distance would be far enough to avoid being confused with originating from the Park. But, an arbitrarily farther distance of say, 300-400 miles, might be deemed far enough to be considered deceptively misdescriptive. Applicant respectfully asserts that these practices should not be upheld in the interest of fairness to all trademark applicants, since this sort of arbitrary choice between various distances is an unfair judgment to make, and in this case, should not preclude registration.

II. EXAMINING ATTORNEY’S EVIDENCE, CONCLUDING THE TERM “YOSEMITE” BY ITSELF IS GEOGRAPHICALLY DESCRIPTIVE, IS NOT PERSUASIVE.

A. **The Term “YOSEMITE” by itself has no primarily significant meaning, geographic or otherwise, and further, its only known translation does not relate to Yosemite National Park, but to a term in a Native American language.**

In the Examining Attorney’s Final Refusal, she stated that because of the Applicant’s location and the “fame of Yosemite,” consumers are likely to believe that the Applicant’s services originate in Yosemite National Park. The fact that a term may have other meanings in other contexts does not necessarily negate the basis for refusal as long as the most prominent meaning or significance is geographic for the identified goods and/or services.

However, the term “YOSEMITE,” standing alone, is not defined as a well known geographic location, and has no independent significance aside from being included in the term “YOSEMITE NATIONAL PARK.” There is no Yosemite, California. The Examining Attorney attached numerous prior registrations for marks that incorporated “Yosemite,” most of which were design marks. She also attached screenshots of searches for rental properties near the Yosemite National Park that were referred to as “Yosemite,” but as Applicant noted earlier in evidence, by way of a search via the United States Postal Service, no city, state, or region called “Yosemite” exists. It’s clear that by the context of the web search that the real estate hyperbole is designed to infer a proximity to the Park for vacation rentals, but no such assumption should exist for beer, a totally different product which is independent of geography.

By contrast, Applicant’s submitted evidence consisted overwhelmingly of word marks, rather than design or image marks, that did not disclaim “Yosemite” from being claimed along with the mark and used “Yosemite” repeatedly in their construction. Applicant asserts that the mere existence of a lazily-written shorthand term for Yosemite National Park does not change the fact that there is no place named “Yosemite,” nor does it change the name of the Park to merely “Yosemite.” Applicant submitted evidence of other registrations having been granted which also use the term “YOSEMITE,” including recently abandoned registrations for the exact same mark as Applicant’s. Applicant asserts that the term “YOSEMITE,” by itself, cannot be associated exclusively with “YOSEMITE NATIONAL PARK,” as there are several other marks that use the term “YOSEMITE” but whose owners are not even remotely near the “YOSEMITE” geographic region. If analyzed under the same framework, these marks would have to be deemed deceptively misdescriptive or geographically misdescriptive depending on the subject matter. Applicant also submitted evidence stating that the term “YOSEMITE” translates to a

word that does not even describe the region itself, but actually means “those who kill,” or “the killers” in the Native American Miwok tribal language. Applicant asserts that the Examining Attorney has submitted no persuasive evidence as to how the “primary” significance of the term “YOSEMITE” relates to the Park, or any other known definition of the term “YOSEMITE.”

B. No evidence has been presented concluding that consumers would likely presume that YOSEMITE BREWING COMPANY consists of either beer or brewing services relating to Yosemite National Park.

Applicant also asserts that although the brewpub is located 80 miles away from the Park, the Park is not the origin of its beer or brewing services and should not be construed as the origin in light of that distance.

There is no commercially available product produced in the Park, or manufacturing services conducted in the Park. Thus, Applicant asserts that there is nothing from which a consumer could presume would come from the Park which is used in the production of “YOSEMITE BREWING COMPANY” beer. Past registrations for “YOSEMITE BEER®” and “YOSEMITE BREWING COMPANY®” have been granted for a company even closer to the Park than Applicant’s brewpub, in which case even if such a presumption existed, that notion would be even stronger due to the closer proximity to the Park than Applicant’s brewpub. Nonetheless, the prior registrations for “YOSEMITE BEER®” and “YOSEMITE BREWING COMPANY®” were granted notwithstanding that possibility, and thus, Applicant respectfully requests registration for the same mark now that it has been abandoned.

C. There have been numerous other registered marks on record that use common terms with geographic regions, but have not been denied on the grounds of either geographic descriptiveness or misdescriptiveness.

Applicant asserts that he is not being treated consistently with other approved registrations, both past registrations for Yosemite Brewing Company, with other registrations using the word “Yosemite” and, if Yosemite is a geographic name, with other registrations using other geographic names. Throughout the examination process, Applicant submitted a number of exhibits, many of which contained registered marks that used words in common with geographic places. These include Sierra Nevada, El Capitan, Denali, Adirondack, Saranac, Snake River, Mt. Shasta, etc. Some of these, such as Sierra Nevada and Adirondack, have registered marks (which were also non-2(f) registrations) for beer or alcoholic beverages. Applicant submitted exhibits of numerous marks containing the names of widely recognizable geographic regions. The majority of these marks were non-2(f) registrations, and many were for beer and other consumable food products. In particular, some of the marks related to and were registered to companies near the Chesapeake Bay near Maryland,¹⁵ Roslyn in Washington State,¹⁶ Rio Chama in New Mexico,¹⁷ Mobjack Bay near Virginia,¹⁸ Fox River in Wisconsin,¹⁹ Key Bridge in the

¹⁵ CHESAPEAKE BAY BREWING COMPANY for beer and/or ale, in class 032. Registered (non-2(f)) on: June 18, 2002. Reg. No.: 2,582,971.

¹⁶ ROSLYN BEER, for beer in class 032. Registered (non-2(f)) on August 12, 2003. Reg. No.: 2,750,110.

ROSLYN BREWING COMPANY for beer in class 032. Registered (non-2(f)) on August 12, 2003. Reg. No.: 2,750,111.

¹⁷ CHAMA RIVER BREWING CO., for providing food and drink to guests, in class 043. Registered (non-2(f)) on: September 26, 2006. Reg. No.: 3,149,250.

RIO CHAMA STEAKHOUSE for restaurant services, in class 042. Registered (non-2(f)) on: May 29, 2001. Reg. No.: 2,455,063.

District of Columbia,²⁰ Salado Creek in Texas,²¹ Woodstock in Georgia,²² Cold Spring in Minnesota,²³ Mauna Loa in Hawaii,²⁴ Rocky Mountain in Colorado,²⁵ and Bear Mountain in New York.²⁶ Marks such as “KEY BRIDGE ALE®,” “ROSLYN BEER®,” and “CHESAPEAKE BAY BREWING COMPANY®” clearly demonstrate a willingness for marks to be granted when they share terms in common with geographic regions. Applicant asserts these marks are indistinguishable to his own, except perhaps that Applicant’s is more compelling since there is no region titled “Yosemite,” unlike the existence of actual locations in the other marks identified by Applicant. There are certainly geographic places and regions such as “Roslyn” and the “Chesapeake Bay,” yet these regions have been used in marks for both beer and restaurant services. Applicant asserts that his mark should also be on the Principal Register

¹⁸ MOBJACK BAY BREWING COMPANY, for beer and soft drinks in class 032. Registered (non-2(f)) on: November 9, 1999. Reg. No.: 2,291,433.

¹⁹ FOX RIVER BREWING COMPANY, for restaurant services, namely providing food and beverages in class 042. Registered (non-2(f)) on: February 24, 1998. Reg. No.: 2,139,104.

²⁰ KEY BRIDGE ALE, for beer in class 032. Registered (non-2(f)) on: December 28, 2004. Reg. No.: 2,915,129.

²¹ SALADO CREEK BREWING COMPANY, for malt beverages, namely beer, in class 032. Registered (non-2(f)) on: August 26, 1997. Reg. No.: 2,091,998.

²² WOODSTOCK BREWING COMPANY, for beer in class 032. Registered (non-2(f)) on: June 13, 2006. Reg. No.: 3,104,947.

²³ COLD SPRING, for beer and soft drinks, in class 032. Registered (non-2(f)) on July 4, 2006. Reg. No.: 3,111,175.

²⁴ MAUNA LOA, for macadamia nut oil for food, in class 029. Registered (non-2(f)) on May 10, 2005. Reg. No.: 2,948,119.

²⁵ ROCKY MOUNTAIN CHOCOLATE FACTORY, for food and beverages in class 030. Registered (non-2(f)) on November 12, 1996. Reg. No.: 2,015,284.

ROCKY MOUNTAIN BATH WORKS, for personal care products in class 003. Registered (non-2(f)) on October 10, 2006. Reg. No.: 3,153,592.

²⁶ BEAR MOUNTAIN, for clothing in class 025. Registered (non-2(f)) on September 12, 2000. Reg. No.: 2,384,568.

as these marks clearly cannot be distinguished on any viable grounds for geographic descriptiveness. Applicant does concede that some geographic regions may be obscure and remote enough to the eyes of the Examining Attorney to justify granting a mark using similar or shared terms, since there may not be customer confusion. However, Applicant's submitted evidence shows that many of these marks are in fact being registered to companies in geographic areas so close to the areas that they are apparently named after, that a presumption of geographic descriptiveness would almost certainly be warranted for those other marks.

For example, both "ROSLYN BEER®" and "ROSLYN BREWING COMPANY®" are trademarked by a corporation located in Roslyn, Washington. "CHESAPEAKE BAY BREWING COMPANY®" is trademarked by a corporation located 30 miles from the Chesapeake Bay, Maryland. "CHAMA RIVER BREWING COMPANY®" and "RIO CHAMA STEAKHOUSE®" are trademarked by a corporation located 90 miles from Rio (River) Chama, New Mexico. "MOBJACK BAY BREWING COMPANY®" is trademarked by a corporation located 60 miles from Mobjack Bay, Virginia. "FOX RIVER BREWING COMPANY®" is trademarked by a corporation alongside the Fox River, Wisconsin. "KEY BRIDGE ALE®" is trademarked by a corporation with an office located 10 miles from the Key Bridge between Washington, D.C. and Roslyn, Virginia. "WOODSTOCK BREWING COMPANY®" is trademarked by a corporation in Woodstock, Georgia. "COLD SPRING®" beer is trademarked by a corporation located in Cold Spring, Minnesota. "MAUNA LOA MOUNTAIN®" is trademarked by a corporation located 30 miles from Mauna Loa Mountain in Hawaii. "BEAR MOUNTAIN®" is trademarked by a corporation located 40 miles from Bear Mountain in Palisades National Park, New York. Applicant respectfully asserts that there can be no reasonable distinction between many of these marks and Applicant's mark, being used 80 miles

away from Yosemite National Park, and without any connection whatsoever to the Park. Further, unlike the rest of these names, the word “Yosemite” has no officially-recognized independent significance relating to the Park by itself, but only when describing “Yosemite National Park.” Applicant asserts that consumers could not reasonably believe that there is a brewing company of any type located within a U.S. National Park, nor would there be beer manufactured from ingredients originating in or from a National Park.

III. YOSEMITE BREWING COMPANY IS A SINGLE MARK WHEN VIEWED IN ITS TOTALITY

Applicant seeks to register the mark “Yosemite Brewing Company” for Yosemite Brewing Company beer in Class 32 and for Yosemite Brewing Company for brewing services in Class 40. Even if “Yosemite” or even “Yosemite Beer” is primarily geographically descriptive or generic, nonetheless, “Yosemite Brewing Company” is not a generic substitute name for Yosemite Beer. It should be read as an independent word mark. The three words are a unified whole which identify a distinct product and a distinct service. The name does not mention the Park or imply an association with the Park.

Applicant therefore requests that the TTAB denial of its earlier application for Yosemite Beer not taint the instant application for Yosemite Brewing Company beer or Yosemite Brewing Company brewing services.

ENHANCED DISCLAIMER ACCEPTABLE

Applicant offers the following suggestion to further make clear its non-affiliation with the Park. For its application in IC 32, Applicant proposes modifying its product description to: Beer not produced from materials originating in Yosemite National Park. For its application in IC 40, Application proposes modifying its product description to: Brewing Services, NAMELY custom manufacture of alcoholic malt beverages and beer not manufactured in Yosemite National Park. Alternative similar disclaimer language acceptable to the Examining Attorney would also be acceptable to the Applicant.

CONCLUSION

In summary, the Examining Attorney erred in maintaining her Final Refusal, particularly in light of past registrations for “YOSEMITE BREWING COMPANY®,” registrations for other marks containing the term “Yosemite,” translations for the word “YOSEMITE,” a host of other registrations for arguably geographically descriptive or misdescriptive marks, an explanation of the Applicant’s brewpub services and products, and a lack of conclusive evidence supporting Examining Attorney’s two main assertions, which, even if supported by evidence, would still fall short of the three-prong test provided for by the Trademark Manual of Examining Procedure. As such, Applicant respectfully requests that Examining Attorney’s Final Refusal be reversed and Applicant’s marks for “YOSEMITE BREWING COMPANY®” in both Class 32 and Class 40 be registered on the Principal Register.

The TTAB analysis for each of the two Yosemite Brewing Company marks should not be identical. Applicant requests that the arguments herein be considered separately for each of the

marks, as appropriate. Applicant requests that even if Yosemite Brewing Company beer is construed as potentially being geographically descriptive of the Applicant's beer in Class 032, it need not be similarly construed as being geographically descriptive of the Applicant's brewing services in Class 040, and vice versa.

In the alternative, if either or both marks are refused, Applicant respectfully requests that "YOSEMITE BREWING COMPANY®" be registered on the Supplemental Register for whichever marks are thereby refused for registration on the Principal Register.

For Spirits of New Merced, LLC

BY: /Kenneth A. Vogel/

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BY: /Koorosh K. Orandi/

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