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

Proceeding	85656671
Applicant	The Bruery, LLC
Applied for Mark	5 GOLDEN RINGS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re The Bruery, LLC

Serial No.: 85/656671

Mark: 5 GOLDEN RINGS

Examining Attorney: Natalie M. Polzer
Law Office 108

APPLICANT'S / APPELLANT'S MAIN BRIEF

I. Introduction

Five Golden Rings is a phrase that is so intrinsically associated with Christmas that it is difficult to read it without elongating vowels.¹ Yet, the Examining Attorney contends that there is a likelihood of confusion between Applicant's use of 5 GOLDEN RINGS (the "Mark") as part of its 12 Days of Christmas seasonal beers series, and two registered marks: GOLD RING and GOLD RING VINEYARDS (the "Registered Marks"). Ultimately, even ignoring the indisputable connotation of the Mark, the Examining Attorney's assertion that there is a likelihood of confusion between the Mark and the Registered Marks is flawed at best; taking the unique commercial and cultural impact of the Mark into account, her position is insupportable. Since there is no likelihood of confusion between the Mark and the Registered Marks, The Board should grant Applicant's Appeal and permit the Application to move forward toward registration.

¹ "The Twelve Days of Christmas" is an English Christmas Carol, first published in 1780, that enumerates a series of increasingly grand gifts. http://en.wikipedia.org/wiki/Twelve_Days_of_Christmas Arguably, the only gift that is more iconic and readily associated with the song that 5 Golden Rings is A Partridge in a Pear Tree.

II. Procedural History

Applicant, The Bruery, LLC, is a premiere American craft brewery. On June 20, 2012, it filed a federal trademark application pursuant to Section 2(b) citing its intent to use the Mark in connection with beer and malt liquor in international class 032. Applicant filed an amendment alleging use on November 1, 2013. The Examining Attorney issued an office action that included a refusal based on likelihood of confusion under Section 2(d). The Examining Attorney issued a final refusal in response to Applicant's timely filed response to the office action. Therefore, the Board has jurisdiction to hear this appeal. (Trademark Act §20, 15 U.S.C. 1070; 37 C.F.R. §2.141) Applicant appealed and submits this brief after an extension graciously granted by the Board.

III. STATEMENT OF THE ISSUE

1. Is there a likelihood of confusion between Applicant's 5 GOLDEN RINGS mark in connection with beer and malt liquor in international class 032, and the registered marks GOLD RING for wines and GOLD RING VINEYARDS for alcoholic beverages except beers.

IV. Standard of Review

The Board reviews the Examining Attorney's appealed decisions to determine if they were made correctly. (T.B.M.P. §1217) "... the question is whether or not, based on the record before the examiner, the examiner's action was correct." (In Re Bose Corp., 227 U.S.P.Q. 1, 4 (Fed. Cir. 1985)) Applicant is confident the Board will find that the Examiner failed to meet that standard.

V. Argument

There is no likelihood of confusion between the Mark and the Registered Marks. The Examining Attorney's analysis is flawed, and if allowed to stand, would lead to an unjust refusal to register a mark in which Applicant has established substantial good will.

A. The Marks Must be Compared as a Whole

Potentially conflicting marks must be compared by looking at them as a whole, rather than breaking them up into their component parts for comparison. (*Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 345-46 (1920)) This "anti-dissection rule" ensures that the commercial impression of a trademark on an ordinary prospective buyer as a whole is considered, not merely their component parts. "It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue." (*China Healthways Institute, Inc. v. Wang*, 83 U.S.P.Q. 2d 1123 (Fed. Cir. 2007), cert. denied.) Unfortunately, that is precisely the type of analysis the Examining Attorney undertook in refusing Applicant's registration pursuant to §2(d). This is a classic case where the parts, while similar, create a dramatically different commercial impression.

Specifically, the Examining Attorney argues that because both the Mark and the Registered Marks contain some derivation of the word "gold" and the word "ring", there would be a likelihood of confusion. This ignores the starkly different commercial impression of 5 GOLDEN RINGS – a reference to a classic Christmas song, and that of GOLD RING and GOLD RING VINEYARDS – presumably a reference to luxury, exclusivity and/or excellence. To reach this conclusion, the Examining Attorney also had to ignore or discount the fact that the words themselves are different – the inclusion of the number 5 in the Mark, "golden" vs. "gold" and "rings" vs "ring". When the composite parts of the Mark and Registered Marks are

dismantled and compared, the analysis seems credible. However, when the Supreme Court's anti-dissection rule is applied, the analysis fails entirely.

There is simply no likelihood of confusion between the Mark and Registered Marks when they are compared in their entirety.

B. The Dupont Factors Favor Applicant

Application of the relevant Dupont factors² establish that there is no likelihood of confusion between the Mark and Registered Marks. The relevant Dupont factors, discussed in turn, are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;

This is primary factor, and it is critical to consider it in its entirety. Unfortunately, the Examining Attorney's analysis ignored much of this factor's requirements, namely, comparing the marks in their entireties as to connotation and commercial impression. The Mark and Registered Marks, taken in their entireties, simply do not look or sound confusingly similar. More importantly, as discussed above, while 5 GOLDEN RINGS and GOLD RING/GOLD RING VINEYARDS all contain the root words "gold" and "ring", not only are the words not the same, but the marks as a whole have starkly different connotations and commercial impressions. If one mentions a "gold ring", several things may come to mind – an engagement, wealth, exclusivity, opulence, etc., whereas if one mentions "5 golden rings", the mind almost invariably moves to Christmas, and the 12 days thereof.

- (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;

² In Re E. I. Du Pont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973)

Applicant is a craft brewery selling beer and malt liquor, whereas the owner of the Registered Marks is a vineyard selling wine and alcoholic beverages not including beer. These goods are likely somewhat related in the mind of consumers (alcoholic beverages), but not to the extent that they are easily confused. Applicant's counsel is unaware of any producers of both beers and wines.

- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;

The trade channels for Applicant's and the owner of the Registered Marks goods, while not the same, are likely similar and/or related.

- (4) The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; and

Fine wines and craft beers are rarely impulse purchases. The consumers of such goods are usually highly educated about the products, and are sensitive to brand and source.

- (5) The extent of potential confusion, i.e., whether de minimus or substantial.

Again, based on the commercial impression and connotation of the Mark as compared to the Registered Marks, likelihood of confusion, if any existed at all, would be de minimus.

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VI. Conclusion

Based upon the foregoing facts, law and arguments, and upon the record, Applicant respectfully requests its appeal be granted and that its application be approved for publication.

Respectfully submitted,

Dated: February 14, 2014

_____/Arash Samadani/
Arash Samadani
SAMADANI LAW, APC
Attorney for Applicant