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Subject: U.S. TRADEMARK APPLICATION NO. 85663894 - CAOS - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85663894

MARK: CAOS



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark CAOS on the ground that it is likely to cause confusion with the registered marks,

CHAOS ON THE ROCKS and CHAOS COCKTAILS, pursuant to §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

FACTS

The applicant applied for the mark CAOS for tequila. The application was suspended pending disposition of earlier-filed applications. On 5/1/2014, registration was refused pursuant to Section 2(d) of the Trademark Act, because the applied-for mark was likely to be confused with Registration No. 4280432 for the mark CHAOS ON THE ROCKS and Registration No. 4335600 for the mark CHAOS COCKTAILS both for alcoholic mixed beverages except beers. Along with the refusal the examining attorney provided evidence that many mixed alcoholic beverages contain tequila as well as evidence regarding the pronunciation of the term CHAOS. In the final refusal dated 11/12/2014, the examining attorney provided copies of third party registrations demonstrating use of the same trademark for the respective goods identified¹. The applicant filed a Request for Reconsideration on 2/16/2015. The Request for Reconsideration was denied on 3/5/2015 and the examining attorney also provided evidence that customers would encounter the respective goods in the same trade channels by attaching a sampling of websites through which customers can purchase various alcoholic beverages. This appeal followed.

ARGUMENT

1. THE PROPOSED MARK, CAOS, FOR TEQUILA IS LIKELY TO CAUSE CONFUSION WITH THE REGISTERED MARKS, CHAOS ON THE ROCKS AND CHAOS COCKTAILS, USED ON ALCOHOLIC MIXED BEVERAGES.

¹ The application was reassigned to the present examining attorney on 7/8/2014.

- A. *The respective marks are highly similar in sight, the applied-for mark is phonetically identical to the dominant portion of the registered marks, and the marks create the same commercial impression.*

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); TMEP §1207.01(b).

In the present case, the applicant's mark is "CAOS" in standard characters; the registrant's marks are "CHAOS ON THE ROCKS" in standard characters and "CHAOS COCKTAILS" in standard characters with a disclaimer of "COCKTAILS". As seen from the dictionary definition attached to the 5/1/2014 office action, the wording "ON THE ROCKS" refers to a way an alcoholic beverage can be served [on ice] and "COCKTAILS" describes any mixed drink with a spirit base. Thus, the portions of registrant's marks after the first word "CHAOS" clearly have specific meaning in relation to the stated goods, which are alcoholic beverages. Matter that is descriptive of or generic for a registrant's goods is

typically less significant or less dominant in relation to other wording in a mark. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009).

Furthermore consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions.)

Thus the dominant portion of registrant’s marks is the first term, “CHAOS”. The term “CHAOS” and the term “CAOS” can both be pronounced “kei,as”. Therefore the applied-for mark and the dominant portion of the registered marks are phonetically identical. The applicant contends the applied-for mark is pronounced as “khaws”. It has been clearly held that there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Because the marks share a term, that is the dominant term in registrant's mark and the only term in applicant's mark, and this term could clearly be pronounced the same, consumers are likely to assume that the goods emanate from a single or related source. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); TMEP §1207.01(b)(ii)-(iii). Thus, a comparison of the marks shows that they are highly similar and create the same commercial impression.

B. *The respective goods are related and are found in the same trade channels.*

The applicant's goods are identified as "tequila". The registrant's goods are "alcoholic mixed beverages except beer". The respective goods are alcoholic beverages. Various alcoholic beverages have been shown to be related goods for purposes of a Trademark Act Section 2(d) analysis. *See In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004) (tequila and beer or ale are inexpensive commodities that consumers would be unlikely to distinguish by manufacturer); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261 (TTAB 2011) (holding wine and beer related because "consumers have been exposed to the concept that wineries also make and sell beer").

The office action dated 5/1/14 contained evidence demonstrating that many mixed alcoholic beverages contain tequila. Secondly, as evidenced by the sampling of third party registrations attached to the final refusal dated 11/12/2014, the applicant's tequila is related to the alcoholic beverages identified by the registrant. For example, note the following third-party registrations: Registration No. 4070482 for the mark TUKYS for alcoholic beverages including alcoholic beverages except beer and tequila [see pages 2 - 3 of final refusal dated 11/12/2014]; Registration No. 4306560 for the mark BACKSTAGE PASS for goods including alcoholic beverages except beer and tequila [see pages 6 – 8]; Registration No. 4473402 for the mark THE PROOF IS IN THE COCKTAIL for products including alcoholic mixed beverages of gin, vodka, rum or tequila and alcoholic beverages except beer [see pages 12 – 14]. These third-party registrations demonstrate there are entities that are the source of tequila and alcoholic beverages except beer as well as alcoholic beverages that contain tequila.

In addition to providing evidence the respective goods are related because they may emanate from a single source under the same mark, the examining attorney provided further evidence of the overlapping trade channels in the denial of the Request for Reconsideration dated 3/5/15. This evidence consisted of a sampling of websites in which customers can purchase tequila from retailers in addition to purchasing other alcoholic beverages such as prepared cocktails and cocktails containing tequila. This trade channel evidence clearly shows the respective goods are related products that will be encountered by the same consumers in the same stores. Therefore applicant's and registrant's goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

The applicant contends their tequila is sold in retail stores and in bulk to restaurants and hotels and that the cited marks are offered through its website or in some retail stores. [Applicant's brief at page 13.] However, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods recited in applicant's application and the cited registrations, rather than on extrinsic evidence of use. *See In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1USPQ2d 1813 (Fed. Cir. 1987). Because there are no restrictions in the descriptions of goods in either applicant's application or registrant's registrations, the identified goods are considered to include tequila and alcoholic beverages at all price points, and to move in all the normal and usual channels of trade and methods of distribution to all potential purchasers. *Octocom Systems, Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Thus, based on the evidence, both applicant's "tequila" and the "alcoholic beverages except beer" identified in the cited registrations would be sold in some of the same channels of trade, such as liquor stores, and to the same classes of purchasers, including the general public.

The applicant makes the conclusive statements the target audience for the applicant's CAOS "consists of tequila enthusiasts specifically, and social drinkers ages 21 and older, as well as restaurant and hotel owners and/or managers" and the "target audience of the cited marks' are women aged 21 and older, who are health and figure conscious." [Applicant's brief pages 13 - 14.] However the applicant has failed to provide any evidence that the respective consumers and trade channels are distinct. On the other hand, the examining attorney provided evidence of the overlapping trade channels in the final refusal dated 11/12/14. This evidence consisted of a

sampling of registrations taken from the U.S. Trademark Office X-search 1.1 database. This sampling clearly evidences that purchasers are accustomed to viewing the same trademark on the respective goods. In addition, the examining attorney provided evidence that the respective goods are found in the same stores in the 3/5/15 action. The trade channel evidence clearly shows the respective goods are related alcoholic beverage products and the respective goods would be encountered by the same consumers in the same stores. Furthermore these consumers are accustomed to viewing the goods to be proffered by the applicant and the goods provided by the registrants offered under the same mark by a single entity.

CONCLUSION

Applicant's and registrant's marks are highly similar. The applicant's mark CAOS can be pronounced the same as the dominant portion of the registrant's marks, CHAOS. The "ON THE ROCKS" in registrant's mark has a specific meaning in relation to alcoholic beverages and the "COCKTAILS" in the cited mark of registrant is descriptive. Thus, when considering the marks in their entireties, they are similar in appearance, pronunciation and connotation, and have a similar overall commercial impression. The marks are used for tequila and alcoholic beverages except beer which are related products that are purchased by members of the general public. Given the close similarity of the CAOS mark on tequila and CHAOS ON THE ROCKS and CHAOS COCKTAILS marks used on

alcoholic beverages except beer, the refusal to register on the basis of §2(d) of the Trademark Act, 15 U.S.C. §1052(d), should be affirmed.

Respectfully submitted,

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