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

Proceeding	85699749
Applicant	TOP BRAND SPÃ#LKA Z OGRANICZONA ODPOWIEDZ
Applied for Mark	ORIGINAL PREMIUM BLACK ENERGY DRINK
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Submission	Appeal Brief
Attachments	Ex Parte Appeal Brief - Original Premium black Energy.pdf(131164 bytes)
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Date	08/12/2016

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In re:	)
	)
Serial No. 85699749	)
	)
Applicant: TOP BRAND SPÓLKA Z OGRANICZONA ODPOWIEDZIALNOSCIA W ZABIERZOWIE	)
	)
Filed: August 9, 2012	)
	)
Mark: ORIGINAL PREMIUM BLACK ENERGY DRINK	)
	)

APPLICANT'S APPEAL BRIEF

Applicant, Top Brand, a company of Poland, hereby appeals to the Trademark Trial and Appeal Board from the Examining Attorney's Final refusal of registration dated February 17, 2016.

FACTS OF THE CASE

On August 9, 2012, Applicant filed a trademark application for the mark below in classes 032 and 033.

("Applicant's Mark").

The Examining Attorney issued a likelihood of confusion refusal of classes 032 and 033 on December 12, 2012 based on registration no. 3326953, and indicated there was a prior pending application serial no. 85222757 that may bar registration.

A response was filed on June 12, 2013, and on July 8, 2013, the Examining Attorney suspended the present application.

On August 12, 2015, the Examining Attorney issued a second non-final office action because cited registration no. 3326953 had been cancelled and prior pending application serial no. 85222757 matured into registration no. 4680427. A likelihood of confusion refusal was issued based on registration no. 4680427, but only in connection with class 032. Registration no. 4680427 identifies "energy drinks," and is depicted below:

("Registrant's Mark").

On January 19, 2016, applicant filed a response arguing that the marks were not similar in their entireties, especially given the weakness of the word BLACK in connection with "energy drinks."

On February 17, 2016, the Examining Attorney issued a final refusal, but appearing to limiting the refusal to certain goods in class 032 containing the wording "energy drinks."

On August 12, 2016, applicant filed a Notice of Appeal for only certain goods in class 032 referencing "energy drinks." On the same day, applicant filed an amended Notice of Appeal, believing it was possible the Examining Attorney issued a final refusal regarding all goods in class 032. The final list of refused goods was identified as follows:

> Fizzy non-alcoholic drinks containing tannins, namely, **energy drinks;** Non-alcoholic beverages being fruit based; Non-alcoholic beverages having a fruit juice base; Non-alcoholic beverages with tea flavor; Non-alcoholic beverages, namely, soft drinks that are cherry flavored and contain cola extract; **Non-alcoholic cherry flavored beverages, namely, energy drinks,** soft drinks, bottled water, sparkling water, colas; Non-alcoholic beverages consisting of mixtures of fruit juices; Soft drinks consisting of non-fermented fruit juices; Non-alcoholic drinks made from water from the ground, namely, sparkling water, flavored mineral water, isotonic drinks, sports drinks; vitamin enriched non-alcoholic beverages vitamins not predominating, namely, drinking water with vitamins, **energy drinks enhanced with vitamins**, sports drinks enhanced with vitamins; Non-alcoholic soft drinks made from natural extracts; Non-alcoholic soft drinks made from artificial extracts; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages containing mineral water, namely, fruit drinks, isotonic drinks, **energy drinks;** Soft drinks; non-alcoholic sparkling drinks, namely, sparkling water, sparkling fruit juices; Colas being soft drinks; Non-fizzy **non-alcoholic drinks containing tannins, namely, energy drinks, energy shots,** sports drinks, soft drinks; Fruit-based soft drinks flavored with tea; non-alcoholic Cordials; isotonic non-alcoholic drinks containing caffeine; Mineral and aerated waters; Non-alcoholic drinks containing pineapple, namely, juices and pineapple juice based beverages; Soya bean based

carbonated non-alcoholic beverages not being milk substitutes; Peanut milk being a soft drink; Non-alcoholic beverages made from syrups, namely, soft drinks, fruit drinks, **energy drinks,** sports drinks; Non-alcoholic beverages, namely, soft drinks, sports drinks, isotonic drinks, **energy drinks containing milk ferments;** Squashes being non-alcoholic soft drinks; Soya bean based non-carbonated non-alcoholic drinks not being milk substitutes; Mineral waters

ISSUE TO BE DECIDED

1. Whether Applicant's mark, "ORIGINAL PREMIUM BLACK ENERGY DRINK (and design)," in connection with its goods in class 032, is likely to be confused with Registrant's mark, a two-dimensional illustration of a black and red can with the wording BLACK COLA ENERGY DRINK, in connection with "energy drinks," in class 032, under Trademark Act Section 2(d).

ARGUMENTS

A. <u>The Similar Feature of the Marks is a Weak Indicator of Source</u>

The dominant feature of Registrant's mark is the two-dimensional illustration of a black can and the wording "BLACK." The remainder of Registrant's mark (i.e., COLA ENERGY DRINK) is generic because the goods consist of an energy drink, which is also a cola (i.e., a carbonated soft drink containing an extract made from kola nuts, together with sweeteners and other flavorings). "cola." Dictionary.com Unabridged. Random House, Inc. 11 Oct. 2015. <Dictionary.com http://dictionary.reference.com/browse/cola>.

When compared to Applicant's mark, ORIGINAL PREMIUM BLACK ENERGY DRINK (and design), the only common features are the words BLACK

and ENERGY. Since the wording "energy" is generic and not part of the mark, the only issue remaining is whether or not confusion is likely to arise because of the common wording "BLACK."

The wording "BLACK," however, is weak in connection with "energy drinks." This is evidenced by at least 12 third-party registrations owned by 12 different companies. See attachments of January 19, 2016. As found in BAF Industries v. Pro-Specialties, Inc., 206 USPQ 166 at 175 (TTAB 1980), third party registrations are "relevant to show that a particular mark has been adopted and registered by so many individuals in a particular field for different products embraced by such field that a registration of the mark in that trade is entitled to but a narrow or restricted scope of protection."

Applicant also attaches third-party webpages showing common use of the wording "BLACK" in connection with energy drinks. See attachments of January 19, 2016.

In instances like the present where a mark or a portion of a mark is so commonly used, the importance of additional elements (such as or words or designs) included in the mark are significantly increased because the public will look to such other elements to distinguish the source of the goods or services. See, e.g., AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); Plus Products v. Star-Kist Foods, Inc., 220 USPQ 541, 544 (TTAB 1983).

Here, the wording "ORIGINAL PREMIUM," the design features, and the predominantly grey background, minimize confusion with Registrant's mark,

which consists of a two-dimensional illustration of a black can with the wording BLACK COLA ENERGY DRINK in different fonts on a predominantly red background.

Also, as a general rule, consumers are more inclined to focus on the first word, prefix or syllable in any trademark. See Palm Bay Imps., Inc. v. Veueve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also 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). Since the first two words are different, confusion is even further minimized.

B. Applicant's mark must be view in its Entirety

Finally, the Examining Attorney must consider the trademarks in their entirety to determine whether or not there may be a likelihood of confusion. General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 3 USPQ2d 1442, 1445 (8th Cir. 1987). A likelihood of confusion may not be predicated on only part of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). See Opryland USA Inc. v. Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992)(stating that marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight).

When comparing conflicting marks, a mark should not be dissected into its component parts and each part then compared with corresponding parts of the conflicting mark to determine a likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538 (U.S. 1920). As the Supreme Court noted, "[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value." Id. at 546-547.

The registrant applied for an image of a cylindrical black CAN with a red banner comprising the words wording "BLACK COLA" and the wording "ENERGY DRINK" below. Applicant's mark consists of a gray BANNER with a red bottom lining and the dominant wording BLACK, a black star, with the wording ORIGINAL PREMIUM at the top and the wording ENERGY DRINK at the bottom. Taken as a whole, prospective consumers would not believe that the two applied-for marks are similar (especially in light of the fact that the word "BLACK" is commonly used in connection with energy drinks, as argued above).

CONCLUSION

When viewed in its entirety, applicant's mark is not likely to be confused with registrant's mark because the overall appearance and sound are different, and the common wording are generic or weak.

WHEREFORE, Applicant prays that the Examining Attorney's refusal of registration be reversed and that registration be granted.

Submitted: August 12, 2016

By:_____/john Alumit/_____

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