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EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85744747

MARK: DARK OF THE COVENANT



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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>

APPLICANT: Congregation Ale House (AZUSA Chapter) L
ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

1061.01

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark attorney's FINAL refusal to register the mark DARK OF THE COVENANT in standard characters for "beer" in International Class 32. Registration was refused pursuant to Section (d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground of likelihood of

confusion with the registered mark , Registration No. 3077476, for use on “wine” in International Class 25.

I. STATEMENT OF THE CASE

On October 3, 2012, the applicant applied to register the mark DARK OF THE COVENANT in standard characters for “beer.” In an office action mailed on February 3, 2013, the examining attorney refused registration pursuant to Section 2(d) on the ground that the mark sought to be registered is likely to be confused with Registration No. 3077476 for the mark COVENANT for use on wine in International Class 33. Additionally, applicant was required to disclaim the descriptive wording “DARK” apart from the mark as shown because it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods. See 15 U.S.C. §§1052(e)(1), 1056(a).

On August 2, 2013, the applicant responded by arguing against the refusal based on Section 2(d). The applicant’s response failed to disclaim the wording DARK. On August 26, 2013, the examining attorney found the applicant’s arguments unpersuasive and made the Section 2(d) refusal FINAL.

On January 14, 2014, the applicant filed an appeal and submitted its appeal brief on March 13, 2014. The only issue on appeal is whether the applicant’s proposed mark DARK OF THE COVENANT in standard characters for “beer” is confusingly similar to Registration No. 3077476 for the registered mark COVENANT in standard character, primarily for use on wine.

II OBJECTION TO UNTIMELY EVIDENCE

As a preliminary matter, the undersigned attorney objects to the admission of all of the evidence submitted with the applicant's brief at pages 3 to 8 as untimely filed. The record in an application must be complete prior to the filing of an appeal. Because the proposed evidence was submitted with the appeal brief, the undersigned attorney respectfully requests that this evidence not be considered. 37 CFR 2.142(d); *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058-9 n. 2 (TTAB 2002); *In re Trans Cont'l. Records, Inc.*, 62 USPQ2d 1541 n. 2 (TTAB 2002); TBMP 1203.02(e), 1207.01; TMEP 710.01(c).

III ARGUMENT

THE APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH THE REGISTRANT'S MARK.

a) SIMILARITY OF THE MARKS

As a general rule, Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). In In

re *E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the Court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. Any of these elements may cause likelihood of confusion.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 et seq.

Additionally, in the determination of likelihood of confusion in this case, the issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. See, e.g., *Paula Payne Prods. Co. v. Johnson's Pub'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) (“[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source.”); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

The examining attorney asserts that the applicant's mark is likely to cause confusion with the registrant's mark because the applicant's mark incorporates the entire registrant's mark, then added the descriptive wording DARK to the registrant's arbitrary mark.

In analyzing likelihood of confusion, the Examining Attorney must compare the marks for similarities as to sound, appearance, meaning, connotation or commercial impression. *E.I DuPont*, at 1357. Similarity of any of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP Section 1207.01(b)

In the instant case, the applicant has applied to register the proposed mark DARK OF THE COVENANT and the registrant's mark is COVENANT. The marks of the parties are confusingly similar because likelihood of confusion may be based on appearance, sound, connotation, and commercial impression. *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *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)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks 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). Here, the most dominant component of the parties' marks is the term COVENANT. It is the arbitrary term COVENANT that relevant consumers will always remember in the course of purchasing because it is the identifying source, thus the examining attorney asserts the marks are confusingly similar as to commercial impression. Although, applicant added the term DARK, it is apparent that the term has no strong significant distinguishing factor or Trademark value because it is descriptive of characteristic or feature of the identified goods and nothing else. Several alcoholic beverages are usually light or dark in color, thus the addition of DARK is insufficient to distinguish the parties' marks.

The applicant argues marks are not to be dissected. The examining attorney disagrees with the applicant's analysis because the mark is not being dissected. Although, marks must be compared in their

entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark”); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011). Here, it is appropriate to weigh the term COVENANT more heavily in the analysis of likelihood of confusion because it is an arbitrary term.

It is also the applicant's contention that the parties' marks are not confusingly similar because the phrase DARK OF THE CONVENANT is intended to be a satirical play on biblical phrase “ARK OF THE COVENANT.” The examining attorney disagrees because the applicant's assumed tongue in cheek reference will not offset or dilute the similarity in commercial impression because the wording DARK describes the nature of the identified alcoholic beverages. Relevant consumers will assume the addition of the term DARK merely indicates the style or color of the parties' goods. The examiner's evidence of 08/26/13 supports the fact that the term DARK is highly associated with beer. Further, marks are usually analyzed in the context of the identified goods and services and not in abstract as proposed or preferred by the applicant. Here, relevant consumers will assume that the wording DARK is nothing but a color or style variation of the CONVENANT labeled alcoholic beverages.

Furthermore, likelihood of confusion has frequently been found where one mark incorporates or absorbs the entirety of another for related products as we have in the instant case. See *Coca-Cola Bottling Co. of Memphis Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ

105, 106 (CCPA 1975) (BENGAL for gin and BENGAL LANCER for nonalcoholic club soda, quinine water and ginger ale); *Helga, Inc. v. Helga Howie, Inc.*, 182 USPQ 629, (TTAB 1974) (HELGA for women's clothing and HELGA HOWIE for women's clothing). Here, the applicant has incorporated the registrant's mark COVENANT by simply adding the descriptive term DARK. The applicant's mark is therefore confusingly similar as to connotation and commercial impression and nothing else.

Moreover, on page 8 of the applicant's brief, the applicant argues the term COVENANT is strong or arbitrary for alcoholic beverages. The examining attorney agrees. CONVENANT is a strong and arbitrary mark that should be accorded a strong protection. The examining attorney asserts that the marks in their entireties are similar in appearance, sound, 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)-(b)(v). In addition, the connotation and commercial impression of the marks do not differ when considered in connection with the respective goods. Therefore, the marks are confusingly similar and the refusal be affirmed.

The applicant again argues that there is no evidence supporting the fact that applicant was aware of the registrant's marks "thus there was no malicious or deceitful intent" in the use of the term COVENANT. This argument is misdirected because the applicant should have conducted a relevant research as to the possibility of a conflicting mark. Ignorance should not be an excuse for applying for a confusingly similar mark. The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18

USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii).

The applicant further argues that there is no evidence of actual confusion. The examining attorney disagrees because the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

B) SIMILARITY OF THE GOODS

In a likelihood of confusion, the similarity of the goods and/or services of the parties are analyzed as the second prong. In this analysis or comparison, the goods and/or services of the parties need not be

identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

Also, the respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

In the instant case, the goods of the parties are related because both parties specialize in alcoholic beverages. Various alcoholic beverages have been shown to be related goods for purposes of a Trademark Act Section 2(d) analysis. *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (holding GASPAR’S ALE for beer and ale likely to be confused with JOSE GASPAR GOLD for tequila); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (holding RED BULL for tequila likely to be confused with RED BULL for malt liquor); *In re Salierbrau Franz Sailer*, 23 USPQ2d 1719 (TTAB 1992) (holding CHRISTOPHER COLUMBUS for beer likely to be confused with CRISTOBAL COLON & design for sweet wine); *Somerset Distilling, Inc. v. Speymalt Whiskey Distribs. Ltd.*, 14 USPQ2d 1539 (TTAB 1989) (holding JAS. GORDON and design for scotch whiskey likely to be confused with GORDON’S for distilled gin and vodka); *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069 (TTAB 1989)

(holding BRAS D'OR for brandy likely to be confused with BRADOR for beer); *Bureau Nat'l*

Interprofessionnel Du Cognac v. Int'l Better Drinks Corp., 6 USPQ2d 1610 (TTAB 1988) (holding trademark COLAGNAC for cola flavored liqueur likely to be confused with certification mark COGNAC for brandy).

The applicant did not emphatically dispute the relatedness of the parties' goods.

Nevertheless, the examining attorney argues that the parties' goods are related and they travel through common trade channels. This assertion is supported by the evidence from page 21 to 33 attached to the office action of February 3, 2013. The attached Internet evidence of February 03, 2013 consisted of several websites producing or marketing wine and beer under the same roof. Notable evidence in the attachment to the applicant were, a) Fenwick Beer and Wine with its webpage <http://fenwickbeerandwine.com/> that provides and displays both wine and beer; b) Capital Beer and Wine enterprise's online advertisement for wines and beers at <https://www.capitalbeerwine.com/>; and c) CORK57 company that claims to be the largest supplier or provider of wine and beer in the metropolitan District of Columbia <http://www.cork57.com/>. This evidence establishes that the same entity commonly provides the relevant goods and markets the goods under the same mark or the goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. 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).

Evidence obtained from the internet may be used to support a determination under trademark act section 2(d) that goods and/or services are related. *see, e.g., in re g.b.i. tile & stone, inc.*, 92 uspq2d 1366, 1371 (ttab 2009); *in re paper doll promotions, inc.*, 84 uspq2d 1660, 1668 (ttab 2007).

The applicant further contends that “there is reason to think that the degree of care exercised by a purchaser of CONENANT wine would be more than the degree of care exercised by ordinary wine purchase” and that the consumers are sophisticated. This argument is unpersuasive because the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, ___ F.3d. ___, ___, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). There is no evidence from the applicant that relevant consumers exercise this degree of care.

Another argument by the applicant is that there is no likelihood of confusion between “a grain product like beer and registrant’s wine” because of the inherent religious connection with the registrant’s products. The examining attorney argues that this assertion is misdirected because of the identifications of the parties’ goods. Here, there are no restrictions or limitations embedded in the parties’ identifications of goods. With respect to applicant’s and registrant’s goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified goods and/or services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration(s) has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application and registration use broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in applicant’s/registrant(s)’s more narrow identification. Here, there is no religious limitation or description of KOSHER for PASSOVER wine in the registrant’s identification of goods. Additionally, applicant failed to include any limitation in its identification of goods as to description or channel of trade. Accordingly, it is the Examining attorney’s assertion that relevant consumers will be confused as to the source of the parties’ goods.

IV APPLICANT MUST DISCLAIM THE WORDING “DARK”

Although, the applicant did not present any argument against the requirement to disclaim the term DARK in the submitted brief, the examining attorney asserts this wording must be disclaimed. The term is descriptive of the goods and it will not sufficiently serve as a distinguishing factor when analyzing the parties' marks as to likelihood of confusion. If a mark comprised in part of a matter that is descriptive of the identified goods it must be disclaimed. Here, applicant must disclaim the wording "DARK" because it merely describes the style, color, characteristic, or feature of the applicant's goods. The wording is an unregistrable component of the mark. See 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a). Also the wording DARK is highly associated with the identified goods.

The attached evidence from page 2 to 20 of the office action of February, 3 2013 and page 4 to 31 OF August 26, 2014 support the fact that the wording DARK is unregistrable on the Principal register because it is commonly used in connection with the applicant's identified alcoholic beverages. Good examples from the provided evidence included a) GREAT BREWERS'S website <http://greatbrewers.com/list/90431> that discusses dark beer as a beer style in its DARK BEER LIST; b) Food & Wine webpage <http://www.foodandwine.com/blogs/2013/10/28/10-dark-beers-for-people-who-dont-like-dark-beer> that advises fans on stereotypes associated with DARK BEER; and c) Paste magazine website <http://www.pastemagazine.com/blogs/lists/2010/05/10-great-malty-dark-beers.html> that discusses 10 Great Malty Dark Beers. These entities' websites confirm the descriptive use of the term DARK as applied to the applicant's goods.

Material obtained from the Internet is generally accepted as competent evidence. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (accepting Internet evidence to show false suggestion of a connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (accepting Internet evidence to show geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b). Therefore, the wording merely describes the nature of the identified goods and nothing else and should be given a little or no weight as a distinguishing factor in the analysis of likelihood of confusion.

V. CONCLUSION

The applicant's proposed mark is confusingly similar to the registered mark, and the parties' goods are closely related. Therefore, relevant consumers who encounter DARK OF THE COVENANT in standard characters for "beer" and confusingly similar to Registration No. 3077476 for the registered mark COVENANT primarily for use on wine are likely to be confused as to the source of goods. It is also respectfully submitted that the evidence supporting requirement for the disclaimer of DARK under 15 U.S.C. §§1052(e)(1), 1056(a) be found sufficient and the requirement for the disclaimer be affirmed. For

the foregoing reasons, the refusal of the applicant's mark under Section 2(d) of the Trademark Act and the requirement for a disclaimer of DARK be affirmed.

Respectfully submitted,

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