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

Proceeding	86115113
Applicant	Balencorp Inc.
Applied for Mark	SILVER TRAIL DISTILLERY HARDIN, KENTUCKY
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In re the Application of: Balencorp Inc.

Application Serial No.: 86/115,113

Filed: November 11, 2013

Mark: SILVER TRAIL DISTILLERY HARDIN, KENTUCKY (& Vintage Car Design)

International Classes: 40, 41

The Trademark Trial and Appeal Board P.O. Box 1451, Alexandria, VA 22313-1451

On Appeal from the Trademark Examining Operation

APPLICANT'S APPEAL BRIEF

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I. INTRODUCTION

Applicant has applied for registration of the mark SILVER TRAIL DISTILLERY HARDIN, KENTUCKY (& Vintage Car Design) for “spirits distillery services” in International Class 40 and “education and entertainment services, namely, conducting guided tours of a visitor’s center exhibiting the operation of a distillery” in International Class 41.

The Examining Attorney maintained and made final his refusal to register the mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the grounds that the mark so resembled the mark set forth in U.S. Registration No. 4,406,749, as to be likely to cause confusion, to cause mistake, or to deceive. The Examining Attorney’s Office Action making final this refusal issued on September 5, 2014. On February 26, 2015, Applicant filed a timely Notice of Appeal. The final refusal issued as to International Class 40 only (spirits distillery services).

This Appeal Brief is submitted in support of Applicant’s position that the refusal to register should be reversed on grounds that confusion between the applied for mark and the cited registered mark is not likely and therefore a Notice of Allowance may issue for Applicant’s mark.

II. ISSUE

The issue presented by this appeal is whether Applicant’s SILVER TRAIL DISTILLERY HARDIN, KENTUCKY (& Vintage Car Design) mark, when used on or in connection with the identified spirits distillery services, so resembles the mark set forth in U.S. Registration No. 4,406,749, as to be likely to cause confusion, to cause mistake, or to deceive, within the precepts of Trademark Act, Section 2(d), 15 U.S.C. § 1052(d).

III. BACKGROUND

On November 11, 2013, Applicant filed an application to register the mark SILVER TRAIL DISTILLERY (& Vintage Car Design) for “spirits distillery services” in International Class 40.

On March 5, 2014, the Examining Attorney issued an Office Action refusing registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the basis that SILVER TRAIL DISTILLERY (& Vintage Car Design), as used with the Class 40 services of the application, so resembled the mark SILVER TRAIL of U.S. Registration No. 4,406,749, for alcoholic beverages except beers, as to be likely to cause confusion, to cause mistake, or to deceive pursuant to TMEP § 1207.01, *et seq.* The Examining Attorney also requested a disclaimer of the wording “DISTILLERY” and “HARDIN, KENTUCKY” apart from the mark as shown.

In response to the refusal, Applicant entered a disclaimer of the right to use the wording “DISTILLERY” and “HARDIN, KENTUCKY” apart from the mark as shown, responded to additional technical requirements including submitting an amended drawing, amended description of services, and a new description of the mark, and transversed the Examining Attorney’s finding that the SILVER TRAIL DISTILLERY (& Vintage Car Design) mark should be refused registration in light of the earlier registered SILVER TRAIL mark on grounds that confusion between the two marks was unlikely.

The Examining Attorney maintained the refusal in a final Office Action stating that he was not persuaded by Applicant’s arguments because (1): while the marks are compared in their entirety under a Section 2(d) analysis, word features of the mark should be recognized as more significant in creating a commercial impression and given greater weight in determining that there is a likelihood of confusion in this case, and (2) Internet evidence and USPTO registrations

show that a single commercial source may offer the same or similar goods and services as those of both applicant and registrant in this case.

Applicant filed a timely Notice of Appeal.

IV. ARGUMENT

The refusal of the Examining Attorney is not supported by the evidence of record nor the applicable law and thus the refusal to register should be reversed. Applicant addresses each of the grounds for refusal provided by the Examining Attorney below seriatim.

- (1) The Examining Attorney's Evidence Does Not Show that that Third-Parties Offer Both Distillery Services and Sell Alcoholic Beverages Under the Same Mark

The Applicant's services and the Registrant's goods are not sufficiently similar to support a likelihood of confusion finding.

Applicant has applied to register its mark for distillery services, not retail goods. Applicant's services are distillery services offered to third-parties in commerce who wish to produce distilled spirits bearing their own trademarks.

In contrast, Registrant sells alcoholic beverages, namely wines. Registrant does not offer distillery services, or winery services to third-parties in commerce under the SILVER TRAIL mark.

The Examining Attorney make much of the fact that certain third-party users and third-party registrants offer both Applicant's services and Registrant's goods, permitting a conclusion that consumers are likely to believe that the services of the pending application (spirits distillery services) and the goods of the cited registration (alcoholic beverages, excluding beer) originate from a single source. The Examining Attorney purports to include 78 "attachments" in support of his findings to the final Office Action.

However, a review of the evidence attached to the Examining Attorney's Office Action reveals that the vast majority of the attachments consist of blank pages, illegible text, or irrelevant materials that carry no evidentiary value as prepared. *See, e.g.* Examining Attorney Office Action Attachment Nos. 5, 6, 7, 8, 9, 10, 11, 12, 14, 15, 16, 17. A few legible pages of the materials appear to be web site screen captures from distillery web sites that show owner/operators who distill products under their own name.

However, none of the materials suggest that a single source sells alcoholic beverages bearing the same mark that it uses as a service mark to offer distillery services to third-parties in commerce.

To qualify as a service mark, a mark must identify and distinguish the services of one person from the services of others and indicate the source of the services TMEP Sec. 1301. The courts have developed legal criteria to determine what constitutes a "service" under the Lanham Act: (1) a service must be a real activity; (2) a service must be performed to the order of, or for the benefit of, someone other than the applicant; and (3) the activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service. *See* TMEP 1301.01(a) citing *In re Canadian Pacific Ltd.*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984); *In re Integrated Resources, Inc.*, 218 USPQ 829 (TTAB 1983); *In re Landmark Communications, Inc.*, 204 USPQ 692 (TTAB 1979).

Applicant has applied to register a mark for use in connection with the offering of distillery services, a real activity, for the benefit of third-parties who wish to use Applicant to distill products. Those products may bear third-party trademarks. This service is fundamentally

different from, and can be easily distinguished from, the finished products sold by the Registrant, namely wine bearing the SILVER TRAIL word mark on its label.

Accordingly, the respective goods and services of the Applicant and Registrant are sufficiently distinct to avoid a likelihood of confusion.

- (2) The Word Portion of Applicant's Mark Should Not Be Considered the Dominant Portion of the Mark for Likelihood of Confusion Purposes under 15 U.S.C. § 1052(d).

The Examining Attorney relies heavily on his conclusion that the word portion of Applicant's mark is dominant and therefore plays a larger role in the comparison of the marks for likelihood of confusion purposes. Applicant's mark is reproduced below:



A simple visual review of the mark is sufficient to show that it is the design element of the mark that is dominant for purpose of determining the mark's overall commercial impression. A particularly prominent design may dominate or at least be a dominant factor in distinguishing between two marks. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (C.C.P.A. 1976).

The findings of the examining attorney notwithstanding, it is well-established that words or portions of words do not always dominate over design features. Rather, the issue turns on the facts of each case. *See Boise Cascade Corporation v. Mississippi Pine Manufacturers Association*, 164 USPQ 364 (TTAB 1969) ("tree in circle" design held dominant); *Tektronics*,

Inc. v. Daktronics, Inc., 189 USPQ 693 (CCPA 1976) (prominent letter “D” must be given weight).

Applicant’s prominent vintage 1950s era design mark sets the mark apart from others in its prominent use of a thick circular border design topped by an open star at its apex. The words “Silver Trail Distillery” are displayed in a stylized font in “wavy” manner suggested by the bumpy road over which an antique style motor car has crested, displayed from an upward angle with exhaust trailing behind.

In the current case, the stark differences between the word mark SILVER TRAIL and the Applicant’s prominent antique car design mark accompanied by the words SILVER TRAIL DISTILLERY HARDIN, KENTUCKY provide consumers ample ground upon which to distinguish between the two marks.

- (3) Whether Comparing the Marks in their Entireties under Section 2(d), or Recognizing a Single Feature of the Marks as More Significant in Creating a Commercial Impression, There is No Likelihood of Confusion.

The overall likelihood of confusion analysis should not be compressed into the similarity factor alone because the question is not whether the marks are merely similar, but whether the similarities are likely to cause confusion. There is no evidence in support of confusion on several of the other relevant *DuPont* factors in this *ex parte* case. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

a. The fame of the prior mark.

There being no evidence of “fame,” this factor must weigh in favor of Applicant based on a presumption that the registered SILVER TRAIL mark is not famous.

b. The nature and extent of any actual confusion.

There is no actual confusion of record even though both parties have been using their mark for a number of years. No such evidence has come to the attention of Applicant, either directly or by way of the Registrant. Therefore, this factor must weigh in favor of Applicant.

c. The junior user's intent in adopting its mark.

There is no evidence that Applicant harbored malicious intent in adopting or filing an application to register its SILVER TRAIL DISTILLERY HARDIN, KENTUCKY (& Vintage Car Design) mark. Thus this factor weighs in Applicant's favor in determining likelihood of confusion.

d. Applicant is entitled to a presumption of no likelihood of confusion where there is no evidence to the contrary.

In view of the statutory structure within which Section 2(d) must be applied, Applicant is entitled to the benefit of presumptions where there is no contrary evidence of record on specific factors. This is due to the well-recognized principle of law that the USPTO has the burden of showing in an ex parte case that the Applicant is not entitled to registration and that one of the Section 2 exceptions to entitlement to registration properly exists. *See, e.g., In re Standard Elektrik Loranz Aktiengesellschaft*, 152 USPQ 563, 566 (CCPA 1967); *In re Maverty Media Group Ltd.*, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994); *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); *In re Crocker National Bank*, 223 USPQ 152, 154 (TTAB 1984); *In re Pierce Fabre S.A.*, 221 USPQ 1210, 1212 (TTAB 1964); *Ex Parte Gemex Co.*, 111 USPQ 443 (Comm'r Pats. 1956).

V. CONCLUSION

Based on the overall differences between the Applicant and the Registrant's respective marks and the relevant goods and services, Applicant's mark is sufficiently different from the cited reference as to make confusion unlikely.

For the foregoing reasons, Applicant requests that the final Office Action issued by the Examining Attorney be overturned and the application be permitted to proceed towards registration.

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