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Subject: U.S. TRADEMARK APPLICATION NO. 86115113 - SILVER TRAIL DISTILLERY HARDIN, - SI117 - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 86115113

**MARK:** SILVER TRAIL DISTILLERY HARDIN,



**CORRESPONDENT ADDRESS:**

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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:** Balencorp Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

SI117

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the trademark examining attorney's final refusal to register the service mark SILVER TRAIL DISTILLERY HARDIN, KENTUCKY with a design element. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the grounds that the applicant's

mark, when used in connection with the identified services in International Class 040, so resembles the mark in U.S. Registration No. 4406749 as to be likely to cause confusion, to cause mistake, or to deceive.

### **FACTS**

On November 11, 2013, applicant Balencorp Inc. filed an intent-to-use service mark application seeking registration on the Principal Register of the mark SILVER TRAIL DISTILLERY HARDIN, KENTUCKY with a design element for “distillery services” and “Education and entertainment services, namely, operating a visitor center exhibiting the operation of a distillery.” In an Office Action mailed March 5, 2014, the examining attorney refused registration under Trademark Act Section 2(d) for International Class 040 based on U.S. Registration No. 4406749. The examining attorney also noted that there was a prior-filed application (U.S. Application Serial No. 86020444) that may be a potential bar to registration. Finally, the examining attorney required that the applicant amend the identification of services in both classes, submit a disclaimer of the descriptive wording DISTILLERY and HARDIN, KENTUCKY, submit a new drawing, and amend the description of the mark.

On September 4, 2014, the applicant responded to the Office Action and argued against the refusal under Section 2(d). The applicant also submitted a new drawing, amended the identification of services, submitted the required disclaimer, and amended the description of the mark. The applicant also noted that the cited prior-filed application had been abandoned.

On September 5, 2014, the examining attorney issued a Final Office Action. The examining attorney made final the refusal under Section 2(d) with respect to International Class 040. The examining attorney also noted that the prior-filed application had been abandoned and therefore no longer presented a potential bar to registration and that the applicant had satisfied all of the outstanding procedural requirements.

The applicant noted the instant appeal on February 26, 2015. On April 27, 2015, the applicant filed its appeal brief. The file was forwarded to the examining attorney for statement on April 29, 2015.

### **ISSUE**

Whether the applicant's mark, when used in connection with the identified services in International Class 040, so resembles the mark shown in U.S. Registration No. 4406749 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

### **ARGUMENT**

**THE MARKS OF THE APPLICANT AND THE REGISTRANT ARE CONFUSINGLY SIMILAR IN APPEARANCE, SOUND, MEANING AND OVERALL COMMERCIAL IMPRESSION AND THE GOODS AND SERVICES OF BOTH ARE CLOSELY RELATED CREATING A LIKELIHOOD OF CONFUSION OR MISTAKE UNDER SECTION 2(d) OF THE TRADEMARK ACT.**

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods. TMEP §1207.01. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182

USPQ 368 (C.C.P.A. 1974). Here, the marks of the parties are confusingly similar and the goods are closely related and are sold in the same channels of trade.

**A. The Marks Are Confusingly Similar**

In the present case, the applicant seeks registration of SILVER TRAIL DISTILLERY HARDIN, KENTUCKY with a design element for “spirits distillery services.” The registered mark is SILVER TRAIL in standard character form for “Alcoholic beverages except beers.”

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser’s memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been

disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Furthermore, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). Here, the applicant has disclaimed the descriptive term DISTILLERY and the geographically descriptive term HARDIN, KENTUCKY apart from the mark as shown. Thus, the examining attorney must closely examine the dominant portion of the applicant's mark against the registrant's mark.

The dominant portion of the applicant's mark is the wording SILVER TRAIL, which is the only wording in the registrant's mark. Therefore, the dominant portion of the applicant's mark is identical to the registrant's mark with respect to sound, appearance, and commercial impression. The dominant portion of the applicant's mark is identical to the entirety of the registrant's mark. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In*

*re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

Moreover, the wording SILVER TRAIL appears first in the applicant's mark. 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).

The applicant argues that the marks are not confusingly similar because the design portion of the registrant's mark is the dominant portion of the applicant's mark. However, the Court of Appeals for the Federal Circuit and the Board have held that although marks must be compared in their entireties, the word portion generally may be the dominant and most significant feature of a mark because consumers will request the goods and/or services using the wording. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 1366, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014). For this reason, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii).

Furthermore, the registrant's mark is presented in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized

characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Given the fact that the marks are highly similar with respect to sound, appearance, and commercial impression and that the dominant portion of the applicant’s mark is the wording SILVER TRAIL, which is the only wording in the registrant’s mark, the marks are sufficiently similar to cause a likelihood of confusion in the marketplace under Trademark Act Section 2(d).

**B. The Goods And Services Of The Parties Are Closely Related And Are Found In The Same Channels Of Trade**

The goods and 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).

The respective goods and services 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 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)); TMEP §1207.01(a)(i).

The trademark examining attorney, in the Final Office Action dated September 5, 2014, attached evidence from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and services as those of both applicant and registrant in this case. This evidence shows that the goods and services listed therein, namely alcoholic beverages and distillery services, are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). The following are examples of this evidence:

- GEORGE WASHINGTON’S DISTILLERY (U.S. Registration No. 3738327) for “whiskey” and “distillery services.”
- NEW HOLLAND ARTISAN SPIRITS (U.S. Registration No. 4111584) for “distilled spirits” and “spirits distillery services.”

- FILIBUSTER (U.S. Registration No. 4314461) for “Blended whisky; Bourbon; Bourbon whisky; Malt whisky; Whiskey; Whisky” and “Whisky distillery services.”
- HERITAGE DISTILLERY COMPANY, INC. (U.S. Registration No. 4351244) for “Alcoholic beverages except beers, wines and tequilas; Alcoholic beverages, namely, flavor-infused whiskey” and “Alcohol distillery services.”
- MY BATCH (U.S. Registration No. 4292470) for “Alcoholic beverage produced from a brewed malt base with natural flavors; Alcoholic beverages containing fruit; Alcoholic beverages except beers; Alcoholic beverages of fruit; Alcoholic beverages, namely, digestifs; Alcoholic beverages, namely, flavor-infused whiskey; Alcoholic bitters; Alcoholic cocktail mixes; Alcoholic extracts; Alcoholic fruit cocktail drinks; Alcoholic mixed beverages except beers; Rum” and “Alcohol distillery services.”

Further, in the Final Office Action dated September 5, 2014, the examining attorney attached Internet evidence consisting of the websites of entities that provide the applicant’s services and the registrant’s goods. This evidence establishes that the same entity commonly manufactures/produces/provides the relevant goods and services and markets the goods and services under the same mark and that the relevant goods and services 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 and services 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). This evidence included the following examples:

- The examining attorney provided evidence from the website for Catoctin Creek Distilling Company. Catoctin Creek provides alcoholic beverages and spirits and distillery services to consumers.
- The examining attorney provided evidence from the website for Green Hat Gin. Green Hat provides distilled gin and alcoholic beverages made with gin. Green Hat also provides distillery services.
- The examining attorney provided evidence from the website for A. Smith Bowman Distillery. This entity provides distillery services and produces and sells hand-crafted spirits to consumers.
- The examining attorney provided evidence from the website for Copper Fox Distillery. This entity provides distillery services and alcoholic beverages.

Moreover, consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men's, boys', girls' and women's clothing likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and clothing likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office

furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion).

The applicant argues that a likelihood of confusion does not exist because the evidence does not show that the applicant's services and the registrant's services commonly originate from the same source. However, the examining attorney has provided both third-party registrations and Internet evidence that shows that many entities that spirits distillery services also provide alcoholic beverages and spirits. 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).

The applicant also argues that a likelihood of confusion does not exist because of the lack of actual confusion between the marks in the marketplace. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. The Court of Appeals for the Federal Circuit has held that 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).

Finally, the overriding concern is not only to prevent buyer confusion as to the source of the goods and services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

## **CONCLUSION**

For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the grounds that the applicant's mark, when used in connection with the

identified services in International Class 040, so resembles the mark shown in U.S. Registration No. 4406749, as to be likely to cause confusion, to cause mistake, or to deceive, should be affirmed.

Respectfully submitted,

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