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Sent: 4/15/2015 11:04:25 AM

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86263566

MARK: PUZZLE BREWING COMPANY



CORRESPONDENT ADDRESS:

DANIEL MAFFEO

PUZZLE BREWING COMPANY

45 SEVILLA

RANCHO SANTA MARGARITA, CA 92688-2940

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Puzzle Brewing Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

PZ-1401

CORRESPONDENT E-MAIL ADDRESS:

nikolas.isely@gmail.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Puzzle Brewing Company, has appealed the final refusal to register the mark "PUZZLE BREWING COMPANY" for use on beer. Registration is refused pursuant to Trademark Act Section 2(d),

15 U.S.C. Section 1052(d), on the ground that the mark, when used on the identified goods, is likely to be confused with the mark in U.S. Registration No. 2196017 for the mark "THE PUZZLE" for use on wine.

FACTS

On April 25, 2014, Applicant, Puzzle Brewing Company, filed an application to register the mark "PUZZLE BREWING COMPANY" for use on beer.

On August 14, 2014, the examining attorney issued an Office action, refusing registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), because the applicant's mark is likely to be confused with Reg. No. 2196017 for the mark "THE PUZZLE" for wine. A requirement for a disclaimer of the descriptive wording "BREWING COMPANY" was also included.

The applicant submitted a response to the Office action on September 4, 2014, providing the required disclaimer, and arguing against the Section 2(d) refusal to register.

On September 17, 2014, the examining attorney issues a final refusal to register the mark. This appeal followed.

EVIDENTIARY OBJECTION

As a preliminary matter, the evidence included with applicant's brief identified as "Exhibits A-M" comprising references to 45 pairs of marks, articles from Internet web sites, and data in various graphs and tables should not be considered, as it was submitted for the first time on appeal. The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e),

1207.01; TMEP §710.01(c). The examining attorney requests that the Board disregard the evidence attached to applicant's appeal brief. See *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely 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). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or services. *Syndicat Des Proprietaires Viticulteurs De Chateaufneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared

in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra 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). Additionally, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

Applicant's Mark "PUZZLE BREWING COMPANY" Is Confusingly Similar To Registrant's Mark "THE PUZZLE."

In this case, Applicant seeks to register "PUZZLE BREWING COMPANY. The dominant feature of Applicant's mark is the word "PUZZLE" because the wording "BREWING COMPANY" is descriptive wording that has been disclaimed, and therefore, is less significant in creating a commercial impression. 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). Matter that is descriptive of or generic for a party'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).

The dominant portion of the registrant's mark is also the term "PUZZLE" because the article "THE" is insignificant. When comparing similar marks, the Trademark Trial and Appeal Board has found that inclusion of the term "the" at the beginning of one of the marks will generally not affect or otherwise diminish the overall similarity between the marks. See *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE "virtually identical" marks; "[t]he addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS "virtually identical" marks; the inclusion of the definite article "the" is "insignificant in determining likelihood of confusion").

Applicant's mark "PUZZLE BREWING COMPANY" is confusingly similar to the registered mark "THE PUZZLE" because the marks contain the identical term "PUZZLE" as the dominant feature of each 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).

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/or 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). Use of the identical term “PUZZLE” in Applicant’s mark and Registrant’s mark is confusingly similar, because purchasers, who retain only a general impression of trademarks, are not likely to focus upon the term “THE” or the descriptive wording “BREWING COMPANY” neither of which adds anything significant to the commercial impression of the marks. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE “virtually identical” marks; “[t]he addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance.”); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS “virtually identical” marks; the inclusion of the definite article “the” is “insignificant in determining likelihood of confusion”).

The additional wording “BREWING COMPANY” added to the applicant’s mark is devoid of trademark significance, as it only identifies the provider of the goods, and therefore is generic of the product. *See In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2025 (TTAB 2010) (holding ELECTRIC CANDLE COMPANY generic for lighting fixtures); *In re The Paint Prods. Co.*, 8 USPQ2d 1863, 1865 (TTAB 1988) (holding PAINT PRODUCTS CO. generic for paint). Thus, it is not significant to distinguish the marks.

Applicant’s argument that the examining attorney has improperly dissected the marks and ignored the additional elements of the marks is without merit. The overall impression of the marks is confusingly

similar because the dominant element of each mark is the identical term “PUZZLE.” In arriving at the conclusion that the marks are confusingly similar, the examining attorney did not overlook the additional words in each mark, namely, the term “THE” preceding “PUZZLE” in the registrant’s mark, or the wording “BREWING COMPANY” following “PUZZLE” in the applicant’s mark, but rather, determined that these differences are not sufficient to obviate the likelihood of confusion of the dominant term PUZZLE in each mark.

Applicant argues in its brief that many tribunals analyze word marks structurally in terms of format and position, number and similarity of the letters, syllables or words comprising the marks, citing *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 1147, 227 U.S.P.Q. 541, 542. The cited case does not contain any discussion relating to structural analysis of word marks, other than the well settled comparison of the sound of the marks, which the Court noted rhyme in that case. However, no discussion was made, as alleged by Applicant, regarding position, number and similarity of the letters or words comprising the mark. Moreover, the instant case is distinguishable from the cited case, because the marks at issue contain the identical term “PUZZLE” while the marks in the cited case contained no identical wording. Furthermore, the fame of the registered mark was strongly considered by the Court in that case, who ruled that “there is no excuse for even approaching the well-known trademark of a competitor.” *Id.*

Applicant also argues that there are other marks which contain the term “PUZZLE” for wine which were allowed after “THE PUZZLE” was registered. This argument is unpersuasive for multiple reasons. First, Applicant has never made any of these applications or registrations (such as “MONKEY PUZZLE” and “PUZZLE TREE”) of record, having attached only a printout of a TESS search listing some marks

containing the term “PUZZLE” to the September 4, 2014 Office action. Notably, the three marks referred to by applicant in both its initial response and in its brief are not on the TESS printout, nor were copies of the registrations made of record. Therefore, the registrations are not part of the evidentiary record before the Board. Nonetheless, prior decisions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). In spite of Applicant’s failure to make the evidence of record for proper consideration by the Board, the examining attorney has previously considered and discussed the other “PUZZLE” marks having advised Applicant that this case will be decided on its own facts.

Applicant’s argument that “THE PUZZLE” has a different connotation from “PUZZLE BREWING COMPANY” is noted, but is not persuasive. In both marks, the identical term “PUZZLE” has the exact same connotation, because the meaning, sound and appearance of the term is identical. Adding the generic wording “BREWING COMPANY” to “PUZZLE” does not alter the connotation of “PUZZLE” in any way.

Applicant’s argument that the terms “brewer,” “brewery” and “brewing” are never associated with wine making is not supported by the evidence. What’s more, as shown in the evidence attached to the first and final Office actions, combined winery and brewing companies are becoming increasingly popular

and utilize references to both terms in connection with their goods to identify the type of entity that is providing the goods. For example, a printout from the VON JAKOB WINERY BREWERY web site shows use of both “winery” and “brewery” to identify this Illinois company that makes both beer and wine. VALLEY VINEYARDS is another vineyard that uses the term “BREWERY” in connection with its name to identify itself as a source of both fine wines and craft beers.

The Respective Parties’ Goods are Closely Related.

The goods 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 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] 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).

Applicant’s goods are beer. Registrant’s goods are wine. Various alcoholic beverages have been shown to be related goods for purposes of a Trademark Act Section 2(d) analysis. *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; *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069 (TTAB 1989) (holding BRAS D'OR for brandy likely to be confused with BRADOR for beer). Specifically, in a recent precedential decision of the Board, beer and wine were found to be related goods that purchasers have come to expect to emanate from the same source. *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”).

Evidence of the relatedness of beer and wine was attached to the first Office action and supplemented in the final Office action. This evidence consists of both representative third party registrations from the USPTO'S X-Search database showing that beer and wine emanate from a single source under a single mark, and also, representative Internet evidence showing that beer and wine often emanate from the same source, and articles showing the popularity of hybrid alcoholic beverages containing both beer and wine.

Applicant attempts to discount the evidence, by using statistical analysis to arrive at a number of vineyards that also have microbreweries. This argument is extremely flawed, because it incorrectly presumes that the number of examples cited by the examining attorney is the number of vineyards that also have microbreweries. As the examining attorney clearly stated when attaching this evidence, the evidence consisted of *representative printouts* from web sites for combined vineyard/microbreweries. In no way, should any conclusions be drawn, as applicant suggests, as to the number of such companies that exist in the United States based on those examples. Moreover, a similar argument was considered and in the *Kysela* case, in which that applicant's methodology for viewing attached evidence was

rejected, noting that “the Board would be very critical if the examining attorney were to submit an inordinate number of registrations.”

Applicant also incorrectly states that the examining attorney “failed to provide any evidence of third party registrations that identify both “beer” and “wine” as goods.” This argument contradicts Applicant’s original acknowledgment of third party registrations at the beginning of the “Relatedness of Goods” discussion, and more importantly, is not correct. Below is a partial listing of some of the third party registrations that were attached to the first Office action:

- BINNY’S BEVERAGE DEPOT (Reg. No. 2350261) for **beer** and distilled liquor, liqueurs, spirits and **wines**
- WORK TRUCK (Reg. No. 3522339) for **beer** and alcoholic beverages, namely, **wine**
- SWEET JESUS (Reg. No. 3994422) for **beer** and **wine**
- MOTOR CITY BREWING WORKS DETROIT (Reg. No. 3875505) for **beer** and **wine**
- YO NO CARE (Reg. No. 3771079) for **beer**, ale, lager, stout, porter, **wines** and sparkling wines
- TIGHT ASS (Reg. No. 3962914) for **beer**, distilled spirits and **wine**
- SCHILLINGBRIDGE (Reg. No. 3099373) for **beer** and **wine**
- EWING YOUNG (Reg. No. 3975642) for **beer**, distilled spirits, **wines** and liqueurs
- UNCLE SAM (Reg. No. 3396347) for **beer**, **wine** and wine coolers
- SALTY DOG (Reg. No. 4136155) for **beer**, ale, lager, port, stout and **wine**
- LAND RUN (Reg. No. 4464912) for **beer**, **wines** and spirits.

Given the large number of third party registrations attached to the Office action, Applicant's statement that the examining attorney did not attach any evidence of third-party registrations for both beer and wine is simply incorrect. As in the *Kyselá* case, the examining attorney submitted a representative number of third party registrations listing beer and wine. Applicant subsequently indicated an awareness of the existence of registrations for both types of goods, and attempted to extrapolate data for the number of registrations for both goods. Again, these numbers are unsubstantiated and inconclusive, not having been made of record, and cannot be considered.

Moreover, the diagrams for beer and wine marks that are part of Applicant's brief contain evidence that has not been properly made of record, and, therefore, cannot be considered. Similarly, Table 1 and almost all of the attachments that follow Applicant's brief contain evidence that is being submitted for the first time, and should be disregarded by the Board. The exception is the printout from the registrant's web site, which was previously submitted with Applicant's response to the first Office action.

The examining attorney has submitted timely extrinsic evidence from a variety of sources that shows that beer and wine are related goods for purpose of Section 2(d) analysis. In addition to the third party registrations previously referenced in this brief, printouts from representative web sites were attached to show that more and more vineyards also house microbreweries, and vice versa. For example, Charlevill Vineyard (www.charlevillvineyard.com) is a winery and microbrewery that offers "distinctive hand-crafted wines and microbrewed beers." In addition, numerous articles are of record showing the increasing popularity of beer-wine hybrids, which further evidences the similarity of beer and wine.

Articles, such as the one entitled “5 New Beer-Wine Hybrids” from the Wine Mag website (www.winemag.com), discuss how some of the pressed and fermented grapes will take a detour to a beer bottle, rather than being used for wine making. This evidence vitiates Applicant’s lack of awareness of any wine producers that also produce beers and its corresponding assumption that the goods are unrelated due to an alleged inability to find any concoction that includes both wine and beer. (September 4, 2014 Response at page 7.)

Applicant further notes that beer and wine are in different International Classes. However, it is well settled that the fact that the Office classifies goods in different classes does not establish that the goods are unrelated under Trademark Act Section 2(d). See TMEP §1207.01(d)(v). The determination concerning the proper classification of goods is a purely administrative determination unrelated to the determination of likelihood of confusion. *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *Nat’l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990). In this case, beer is in Class 32 with some beverages, while wine is in Class 33 with other types of beverages. However, the classes are considered highly related for purposes of likelihood of confusion.

In view of the similarity of the marks “THE PUZZLE” and “PUZZLE BREWING COMPANY” for use on similar goods beer and wine, confusion is likely to occur.

CONCLUSION

Applicant has a legal duty to select a mark that is totally dissimilar to marks that are already in use. *Burroughs Welcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979). In light of that duty, and for

the foregoing reasons, the examining attorney respectfully requests that the Board resolve the likelihood of confusion issue in favor of the registrant and affirm the refusal to register under Trademark Act Section 2(d).

Respectfully submitted,

/Patty Evanko/

Law Office 119

(571) 272-9404

patty.evanko@uspto.gov (informal questions only)

Brett J. Golden

Managing Attorney

Law Office 119