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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86385603

MARK: SMOKESTACK LIGHTNING



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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: Magnolia Brewing Company, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's refusal to register the trademark SMOKESTACK LIGHTNING on the ground that it is likely to be confused with the mark SMOKESTACK SERIES found at U.S. Registration No. 3509698.

FACTS

On March 25, 2015, the examining attorney issued a Final Refusal based on the likelihood of confusion of applicant's mark with the registered mark.

Applicant filed a request for reconsideration on September 17, 2015, which the examining attorney denied. On September 19, 2015, applicant filed an appeal. On November 25, 2015 applicant filed its appeal brief. The only issue on appeal is the likelihood of confusion with the registered mark, under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant's mark is SMOKESTACK LIGHTNING, for use on:

Beer

The registered mark is SMOKESTACK SERIES, used on:

Beer, ale and malt liquor

Both marks are shown in Standard Characters. Applicant has appealed this refusal.

EVIDENTIARY OBJECTION

Attached with applicant's brief is the Wikipedia entry for "Howlin' Wolf" (the stage name of a Mr. Chester Arthur Burnett). Applicant offers this as evidence in support of its position. The examining attorney objects to this evidence because it has not been properly put in the record before the filing of the 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). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENT

Applicant's mark SMOKESTACK LIGHTNING is similar to the registered mark SMOKESTACK SERIES. Applicant's goods are identical to and competitive with the goods sold under the registered mark SMOKESTACK SERIES. For these reasons, applicant's mark is likely to be confused with the registered mark, under Trademark Act Section 2(d), 15 U.S.C. §1052(d), and the refusal should be affirmed.

Here, the likelihood of confusion analysis is organized in two parts. These are (1) the similarity of the marks, and (2) the similarity or relatedness of the goods. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015) (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); TMEP §1207.01.

(1) Applicant's Mark SMOKESTACK LIGHTNING is Similar to the Registered Mark SMOKESTACK SERIES in Appearance, Sound, Meaning, Connotation and Commercial Impression

In a likelihood of confusion determination, the 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 Fondée 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 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, applicant's mark is similar to the registered mark in appearance, sound, meaning, connotation and commercial impression. Both applicant's mark and the registered mark begin with the word SMOKESTACK. Consumers will see this shared word and believe that both marks identify products from a single source that uses the word SMOKESTACK to identify its products of a certain type, with some additional word to indicate different products from that source. Consumers are likely to believe this because they will encounter other beer brands in the marketplace that use one specific word with other different words to identify different beer products of a particular brewery. Attached with the action of March 25, 2015 is a list of "Top 250 Beers" from the internet website beeradvocate.com.¹ The list includes:

- (1) Two beer brands from Russian River Brewing Company: PLINY THE YOUNGER (number 5 on the list) and PLINY THE OLDER (7),
- (2) Five beers from Founders Brewing Company: FOUNDERS CBS IMPERIAL STOUT (8), FOUNDERS KBS (KENTUCKY BREAKFAST STOUT)(13), FOUNDERS BREAKFAST STOUT (47), FOUNDERS IMPERIAL STOUT (193) and FOUNDERS BACKWOODS BASTARD (231).
- (3) Two beers from Westwood Brewing Co.: DOUBLE BARREL MEXICAN CAKE (59) and MEXICAN CAKE (187).
- (4) Three beers from Alpine Beer Company: HOPPY BIRTHDAY (95), EXPONENTIAL HOPPINESS (144) and PURE HOPPINESS (181)
- (5) Four beers from Goose Island Beer. Co.: BOURBON COUNTY BRAND COFFEE STOUT (3), BOURBON COUNTY VANILLA RYE (10), BOURBON COUNTY BRAND STOUT (18) and BOURBON COUNTY BRAND BARLEYWINE ALE (44).

The evidence shows that consumers will routinely find related beer brands in which one shared element identifies that these beers originate from a single source. Based on this evidence, consumers are likely to see two brands that begin with the word SMOKESTACK and believe that both SMOKESTACK SERIES and SMOKESTACK LIGHTNING come from a single brewery that identifies its beers with the word SMOKESTACK and another element.

¹ TICRS Outgoing 03/25/2015, Pages 2 - 14. The USPTO Trademark Application Records are kept in a software application known by the acronym TICRS. The identical information is available to the public on the USPTO internet web site under the Trademark Status and Document Retrieval system (TSDR).

Additionally, the word SERIES in the mark SMOKESTACK SERIES suggests a naming structure for a series of brands. Applicant acknowledges this in its brief.² This series of brands would certainly need an identifying naming characteristic. In the case of the mark SMOKESTACK SERIES, the identifying characteristic could not be the word SERIES, which indicates the “series” of brands, but would by necessity be the other word in the mark, SMOKESTACK. For this reason, consumers would see the mark SMOKESTACK SERIES, believe that this is a one of a series of brands and also believe that SMOKESTACK LIGHTNING is another brand from the same series of beer brands. In this way the element SERIES in the registered mark makes confusion more likely rather than less likely, and would cause consumers to believe that the marks SMOKESTACK SERIES and SMOKESTACK LIGHTNING identify two products of a series from a single source.

In its brief, applicant discusses how the marks are “distinguishable” based on sight, referencing 6th Circuit decisions that require viewing the marks “alone.” The Federal Circuit uses a different standard for determining likelihood of confusion. In the Federal Circuit, 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 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). Accordingly, while applicant discusses whether the marks are “distinguishable” when “viewed alone,” the proper standard to apply is to consider whether the marks are similar. “Viewed alone” is not part of the standard.

Applicant also discusses how the marks must be considered “in their entirety” but proceeds with a discussion of the individual elements of the mark, focusing on the words SERIES and LIGHTNING in

² Applicant’s brief, applicant’s page number 7

the marks, which applicant argues make them “distinguishable” from each other. If it were sufficient to identify the ways in which the marks can be distinguished from each other to overcome the likelihood of confusion, then only marks that are letter-for-letter identical would be confusingly similar. However, when applying the proper standard of review, the marks SMOKESTACK SERIES and SMOKESTACK LIGHTNING are similar, in part because of the shared word SMOKESTACK found in both marks, notwithstanding identifiable difference between the marks. The standard is similarity of the marks, and in this case the marks are similar in sight and sound.³

Regarding the meaning of the marks, applicant asks the Board to interpret the mark SMOKESTACK SERIES as a visual representation of smokestacks lined up in a row. Applicant has also argued that the registered mark would be understood as being “purely industrial,” because of the presence of the word SMOKESTACK in it.⁴ Based on this premise, the word SMOKESTACK in applicant’s mark would also render its mark to be “purely industrial,” and suggest a visual representation of smokestack. Ultimately, whether one looks at the words in the marks or their meaning, the marks are identical in part and as to that identical part they would have an identical meaning.

Applicant has also argued that its mark SMOKESTACK LIGHTNING is a reference to a classic blues song.⁵ However, there is no evidence to show that beer drinkers will know the title of a song that was released in 1956 and was never popular with the public at large. Absent some evidence that beer drinkers are also uniformly blues fans and would be aware of blues song titles from over 50 years ago, the fact that applicant named its beer after an old blues song is merely interesting background. This

³ While applicant discusses the marks in three sections, “sight,” “sound” and “meaning,” the discussions within the “sight” and “sound” sections are essentially a repeat of the other section. Accordingly, the examining attorney will not discuss these separately here.

⁴ Applicant’s brief, applicant’s numbered page 6.

⁵ Applicant’s brief discusses this in reference to its Exhibit C, to which the examining attorney has objected. However, applicant’s response of 03/09/2015, TICRS Pages 6 – 8 includes the Wikipedia entry for the song “Smokestack Lightning.” The examining attorney addresses this discussion only to the extent that it coincides with the evidence provided on 03/09/2015.

background suggests that applicant came about the name without malice or intent to infringe on SMOKESTACK SERIES, but this is of no significance in determining the similarity of the marks. Intent is not an element of likelihood of confusion.

In its discussion, applicant identifies the sixth *DuPont* factor as weighing against this refusal. This factor requires looking at the field of other marks in use to determine whether consumers are accustomed to seeing an element of a trademark so frequently as to require greater discrimination between these similar marks. As applicant correctly states, the “number and nature of similar marks in use on similar goods” can be considered. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Unfortunately for applicant, none of the registered trademarks applicant has discussed are used on **similar goods**.⁶ Applicant has provided no evidence of any registered marks that are used on similar goods.⁷ While applicant has provided internet evidence of five other webpages referencing the word SMOKESTACK,⁸ the evidence does not show such widespread use of this element in trademarks on similar goods to make the mark “relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

Finally, applicant argues that the absence of actual confusion shows that confusion is not likely between its mark and the registered mark. However, in an *ex parte* proceeding the owner of the registered mark is not available to provide necessary testimony. For this reason, applicant's assertion

⁶ The marks are used on retail furniture stores (reg. no. 4617228), prepared food (reg. no. 4518184), wood chips for barbecue grilling (reg. no. 3330165), optical lenses (reg. no. 2478662), restaurant services (reg. no. 2110643) and promotional services (reg. no. 1880159). Two of the applications applicant discussed never matured into registrations. Accordingly, these cannot be considered evidence of trademarks that were in use on goods. However, these too were for use on unrelated goods (sandwiches and furniture).

⁷ It is difficult to prove the negative. However, the examining attorney asserts that applicant's failure to show other beer trademarks containing the word SMOKESTACK is because there are none in the Office's records.

⁸ One of these pages appears to be for a restaurant, and another for a liquor store. The remaining three identify beers that may no longer be in production. The evidence contains no information about how to purchase the goods, and specifically the page for Vertigo Brewing indicates specifically that the beers are “(usually) available.”

and affidavit as to actual confusion are incomplete at best, and arguably are merely self-serving. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). Also, there is no requirement for a showing of actual confusion to prove that there is 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).

For these reasons, applicant's mark is similar to the registered mark.

(2) Applicant's Goods are Identical to and Competitive with the Goods on which the Registered Mark is used.

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); TMEP §1207.01(a)(i).

However, in this case, applicant's beer is identical to and competitive with the beer on which the registered mark is used. This exceeds the required showing for a goods similarity.

Applicant has not argued that the goods are not similar.

CONCLUSION

Because applicant's mark SMOKESTACK LIGHTNING is similar to the registered mark SMOKESTACK SERIES and because applicant's beer is identical to the beer on which the registered mark is used, applicant's mark is likely to be confused with the registered mark and the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), should be affirmed.

Respectfully submitted,

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