

From: Carl, Fred

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Subject: U.S. TRADEMARK APPLICATION NO. 86385603 - SMOKESTACK LIGHTNING - N/A - Request for
Reconsideration Denied - Return to TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86385603

MARK: SMOKESTACK LIGHTNING



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: Magnolia Brewing Company, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 9/29/2015

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d) made final in the Office action dated March 25, 2015 is maintained and continues to be final. TMEP §§715.03(a)(ii)(B), 715.04(a).

Applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Regarding applicant's arguments, applicant states that the marks should not be dissected but should be viewed in their entirety. Applicant points to the different words LIGHTNING and SERIES in each mark as being "distinctly different." Applicant is correct on both points. However, it is only relevant that the marks have these different words if one dissects them to make this comparison. When compared as a whole, the marks SMOKESTACK LIGHTNING and SMOKESTACK SERIES are similar because the shared element SMOKESTACK, found in both marks.

Also, applicant incorrectly indicates that there is no emphasis on the SMOKESTACK element in each mark. SMOKESTACK is the first word in both marks. Consumers are generally more inclined to focus on the first word in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee 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). Because this word comes first in each mark, the word SMOKESTACK naturally receives emphasis in each mark.

Applicant then discusses the sound of the marks, using a detailed counting of the letters and syllables of the marks to conclude that the marks are dissimilar as to sound. While the marks have differences in sound, regardless of the number of letters in the marks, the marks are similar overall because of the shared word SMOKESTACK in both marks.

Applicant briefly discusses the nature of the goods in the marks, pointing to the fact that its specimen shows use of the mark on kegs of beer, while the registered mark is shown on bottles of beer in the specimens provided to register that mark. There can be little doubt that applicant uses its mark on kegs of beer, but there is no reason to conclude that applicant does not also use the mark on bottles of beer. Applicant may sell its beer in cans or on growlers in addition to the sales shown on the specimen of record. The owner of the registered mark may also sell its goods in various ways. Simply because the specimen shows use in one way does not limit a trademark owner to sell its goods only in the way shown on the specimens. For this reason, applicant's discussion regarding the use of the mark on the goods is not convincing.

Applicant then returns to arguing about the marks and proposes that the wide use of the element SMOKESTACK in trademarks of others requires consumers to exercise greater care when faced with this element in a trademark. This argument fails because applicant provided as evidence examples of use of other marks on a wide range of goods and services like wood chips and lenses that are completely unrelated to beer, on which applicant's mark and the registered mark are used. These trademarks are not relevant because the goods or services on which they are used are wholly unrelated to the goods at issue, not because the element SMOKESTACK is part of the mark.

Applicant's final argument is that there has been no actual confusion between the marks and because of this confusion is not likely. 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).

For the foregoing reasons, applicant's request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any

outstanding final refusal, and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Fred Carl III/

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