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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86413027
LAW OFFICE ASSIGNED	LAW OFFICE 117
<b>MARK SECTION</b>	
MARK	<a href="http://tmng-al.uspto.gov/resting2/api/img/86413027/large">http://tmng-al.uspto.gov/resting2/api/img/86413027/large</a>
LITERAL ELEMENT	STONE HOUSE RYE WHISKEY
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
<p>Registration has been refused under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on the cited registration in Registration No. 4,388,540 and a second cited registration in Registration No. 2,497,019 and Applicant amends its specification today in light thereof.</p> <p>Applicant again notes that the examining attorney's basis for the cited refusals under Section 2(d) is that the Applicant's mark STONE HOUSE RYE WHISKEY is for spirits of various types in Class 33 while the Registrant of the mark STONEHOUSE CELLARS, Et Al. Wines, Inc. of Pacifica, California, holds Registration No. 4,388,540 for "wines" in Class 33 and the Registrant of the mark STONE HOUSE, Mildara Blass, Inc. dba Windsor Vineyards Corporation of Santa Rosa, California holds Registration No. 2,497,019 for "wine" in Class 33 and Applicant's mark and the two Registrants marks are similar in components and particularly the first wording and "spirits" are related to wine.</p> <p>Essentially, this refusal appears to be based upon the shared component of these three marks, i.e., STONE HOUSE and STONEHOUSE, and a determination that this similarity is not affected by the inclusion of the additional text elements in the Applicant's mark STONE HOUSE RYE WHISKEY.</p> <p>Obviously "wines" are directly related to "wine" (of course, actually identical) and STONEHOUSE CELLARS is sharing components as a mark in its first wording with STONE HOUSE, yet those marks coexist. Since this weakness in the mark is apparently tolerated to the extent that two marks STONEHOUSE CELLARS and STONE HOUSE can coexist together on wine, the argument that a far less related set of goods in the form of spirits (i.e., goods that are not identical to each other in being wine) could be confused with wines that already coexist under a set of marks that is nearly</p>	

identical fails to hold significant logic or merit.

It should be noted that in this response today, as stated previously, contingent to its ability to eliminate the basis of the refusal, Applicant also makes adjustment of its specification of goods in the functionality for that purpose in TEAS as well.

#### GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	033
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#### DESCRIPTION

Alcoholic beverages, namely, distilled spirits, and excluding wines; Alcoholic beverages, namely, spirits, and excluding wines; Alcoholic beverages, namely, whiskey, rye whiskey, rye malt whiskey, malt whiskey, wheat whiskey, bourbon whiskey, corn whiskey, blended whiskey, light whiskey, spirit whiskey, straight whiskey and flavor-infused whiskey, and excluding wines

FILING BASIS	Section 1(b)
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#### GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	033
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#### TRACKED TEXT DESCRIPTION

~~Alcoholic beverages, namely, distilled spirits, and excluding wines;~~ Alcoholic beverages, namely, distilled spirits, and, as stated, excluding wines; ~~Alcoholic beverages, namely, spirits, and excluding wines;~~ Alcoholic beverages, namely, spirits, and, as stated, excluding wines; ~~Alcoholic beverages, namely, whiskey, rye whiskey, rye malt whiskey, malt whiskey, wheat whiskey, bourbon whiskey, corn whiskey, blended whiskey, light whiskey, spirit whiskey, straight whiskey and flavor-infused whiskey, and excluding wines;~~ Alcoholic beverages, namely, whiskey, rye whiskey, rye malt whiskey, malt whiskey, wheat whiskey, bourbon whiskey, corn whiskey, blended whiskey, light whiskey, spirit whiskey, straight whiskey and flavor-infused whiskey, and, as stated, all of the above, excluding all wines

#### FINAL DESCRIPTION

Alcoholic beverages, namely, distilled spirits, and, as stated, excluding wines; Alcoholic beverages, namely, spirits, and, as stated, excluding wines; Alcoholic beverages, namely, whiskey, rye whiskey, rye malt whiskey, malt whiskey, wheat whiskey, bourbon whiskey, corn whiskey, blended whiskey, light whiskey, spirit whiskey, straight whiskey and flavor-infused whiskey, and, as stated, all of the above, excluding all wines

FILING BASIS	Section 1(b)
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#### SIGNATURE SECTION

RESPONSE SIGNATURE	/Kevin Oliveira/
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SIGNATORY'S NAME	Kevin Oliveira
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SIGNATORY'S POSITION	Attorney of record, Virginia bar member
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SIGNATORY'S PHONE NUMBER	(703) 218-2138
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DATE SIGNED	01/08/2016
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<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Jan 08 12:43:37 EST 2016
<b>TEAS STAMP</b>	USPTO/RFR-XX.XXX.XX.XX-20 160108124337146932-864130 27-5507b9d784b99303055a91 68aebdb943257c1d383357ae6 8174031e01be6ec2172-N/A-N /A-20160108122435281489

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

## **Request for Reconsideration after Final Action**

### **To the Commissioner for Trademarks:**

Application serial no. **86413027** STONE HOUSE RYE WHISKEY(Standard Characters, see <http://tmngl.uspto.gov/resting2/api/img/86413027/large>) has been amended as follows:

#### **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

Registration has been refused under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on the cited registration in Registration No. 4,388,540 and a second cited registration in Registration No. 2,497,019 and Applicant amends its specification today in light thereof.

Applicant again notes that the examining attorney's basis for the cited refusals under Section 2(d) is that the Applicant's mark STONE HOUSE RYE WHISKEY is for spirits of various types in Class 33 while the Registrant of the mark STONEHOUSE CELLARS, Et Al. Wines, Inc. of Pacifica, California, holds Registration No. 4,388,540 for "wines" in Class 33 and the Registrant of the mark STONE HOUSE, Mildara Blass, Inc. dba Windsor Vineyards Corporation of Santa Rosa, California holds Registration No. 2,497,019 for "wine" in Class 33 and Applicant's mark and the two Registrants marks are similar in components and particularly the first wording and "spirits" are related to wine.

Essentially, this refusal appears to be based upon the shared component of these three marks, i.e., STONE HOUSE and STONEHOUSE, and a determination that this similarity is not affected by the inclusion of the additional text elements in the Applicant's mark STONE HOUSE RYE WHISKEY.

Obviously "wines" are directly related to "wine" (of course, actually identical) and

STONEHOUSE CELLARS is sharing components as a mark in its first wording with STONE HOUSE, yet those marks coexist. Since this weakness in the mark is apparently tolerated to the extent that two marks STONEHOUSE CELLARS and STONE HOUSE can coexist together on wine, the argument that a far less related set of goods in the form of spirits (i.e., goods that are not identical to each other in being wine) could be confused with wines that already coexist under a set of marks that is nearly identical fails to hold significant logic or merit.

It should be noted that in this response today, as stated previously, contingent to its ability to eliminate the basis of the refusal, Applicant also makes adjustment of its specification of goods in the functionality for that purpose in TEAS as well.

## **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 033 for Alcoholic beverages, namely, distilled spirits, and excluding wines; Alcoholic beverages, namely, spirits, and excluding wines; Alcoholic beverages, namely, whiskey, rye whiskey, rye malt whiskey, malt whiskey, wheat whiskey, bourbon whiskey, corn whiskey, blended whiskey, light whiskey, spirit whiskey, straight whiskey and flavor-infused whiskey, and excluding wines

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

### **Proposed:**

**Tracked Text Description:** ~~Alcoholic beverages, namely, distilled spirits, and excluding wines;~~ Alcoholic beverages, namely, distilled spirits, and, as stated, excluding wines; ~~Alcoholic beverages, namely, spirits, and excluding wines;~~ Alcoholic beverages, namely, spirits, and, as stated, excluding wines; ~~Alcoholic beverages, namely, whiskey, rye whiskey, rye malt whiskey, malt whiskey, wheat whiskey, bourbon whiskey, corn whiskey, blended whiskey, light whiskey, spirit whiskey, straight whiskey and flavor-infused whiskey, and excluding wines;~~ Alcoholic beverages, namely, whiskey, rye whiskey, rye malt whiskey, malt whiskey, wheat whiskey, bourbon whiskey, corn whiskey, blended whiskey, light whiskey, spirit whiskey, straight whiskey and flavor-infused whiskey, and, as stated, all of the above, excluding all wines

Class 033 for Alcoholic beverages, namely, distilled spirits, and, as stated, excluding wines; Alcoholic beverages, namely, spirits, and, as stated, excluding wines; Alcoholic beverages, namely, whiskey, rye whiskey, rye malt whiskey, malt whiskey, wheat whiskey, bourbon whiskey, corn whiskey, blended whiskey, light whiskey, spirit whiskey, straight whiskey and flavor-infused whiskey, and, as stated, all of the above, excluding all wines

**Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /Kevin Oliveira/ Date: 01/08/2016

Signatory's Name: Kevin Oliveira

Signatory's Position: Attorney of record, Virginia bar member

Signatory's Phone Number: (703) 218-2138

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86413027

Internet Transmission Date: Fri Jan 08 12:43:37 EST 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XX-20160108124337146

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