IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 85718981
Published in the *Official Gazette* May 21, 2013

Ninkasi Brewery, LLC	(	
	(	
Opposer,	(	**Opposition No.**
	(	
v.	(	**91211662**
Derek. S. T.	(	
	(	
Applicant	(	
	(	

APPLICANT'S ANSWER:
TO NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES AND COUNTERCLAIM

Applicant, Derek S. T., for its answer to the Notice of Opposition filed by Ninkasi Brewery, against application for registration for "Babylonian Hooch" trademark Serial No. 85718981 filed September 1, 2012 and published in the *Official Gazette* on May 21, 2012 (the "Mark") pleads and avers as follows:

Applicant believes that his Mark, BABYLONIAN HOOCH, is significantly different in its entirety from BABYLON DOUBLE IPA and will cause no likelihood of confusion or damage to Ninkasi in either class of beer or wine. Applicant believes that he has "met the standard" and Babylon Double IPA has "Geographic Indication" in its Mark and therefore should not expect to have a monopoly on the word "Babylon."

In the section *of Frequently Asked Questions* of the USPTO website, specifically relating to "Geographic Indication" one question is: "If someone registers the name of my town as a GI, can I still use it to describe where my good/services come

from?" To not quote the entire paragraph, it clearly explains that a " Trademark, Certification or Collective Mark is "not a monopoly right." In further explanation, it states that "the right extends to similar, related or even unrelated goods/services depending on the specific factors of each case." The applicant believes that there are several "specific factors" in this case relating to his Mark, to be further described in his Affirmative Defenses.

ANSWERS TO GROUNDS

1. Agreed
2. Agreed
3. Unknown - applicant does not have sufficient knowledge to know if this declaration of Ninkasi is true.
4. Denied in part. Agreed Ninkasi owns registration # 4293378. Denied in part as Ninkasi cannot exclusively "own" the word "Babylon" as the word is in other similar class trademarks: "Beach Blanket Babylon" #2134576 for class 032 & 033 for wine. "Les Jardin's De Babylone #3882335 and # 3840408 for wine.
5. Unknown. Lacks sufficient knowledge.
6. Unknown. On information and belief, applicant believes based on website information that Babylon Double IPA was "released" in March 2013. Therefore, just "set-free" not "well-known." (*www.ninkasibrewing.com/tag/**babylon-double-ipa**/* Beer of the Week: Ninkasi Brewing Company *Babylon Double IPA* ***Released in March,*** *Babylon Double IPA* is exactly what you'd expect from a Ninkasi beer, **...)...April 14, 2013.**
7. Agreed
8. Agreed
9. Agreed
10. Agreed
11. Denied and Unknown. On information and belief, applicant has only seen website information that Babylon Double IPA was "**born**" in 2012 which could be at any given time in 2012, and has no knowledge of May, 2012. (Same as # 6.)

12. Unknown. To be Determined. (Counterclaim/Petition)

13. Denied. (only first 2 syllables are similar; the entirety of Applicant's Mark is highly distinguishable to be further explained in Affirmative Defenses.)

14. Agreed.

15. Denied. Wine will be sold in a very different location in most stores. Many times, beer is kept in coolers and separated on opposite sides of an entire store. Also, wine is customarily kept on shelves, defining their category, such as Merlot, Resling, Chardonay, etc. whereas, beer usually is not.

16. Agreed in part, and Unknown in part. Applicant did not know Ninkasi even existed until Notice of Opposition was given. Applicant overlooked Ninkasi's new release of Babylon Double IPA and only became aware of it in July, 2013.

17. Denied. There is distinctiveness in Applicant's Mark in various ways, which is very different and distinguishable from Ninkasi's Mark. "Babylonian Hooch" for one example, sounds highly comedic, so people have stated, as <u>is the intention.</u> "Babylon Double IPA" may sound sophisticated; also "low" or "plain" in sound. "Babylonian Hooch" is "sing-songy." Names can cause reactive "triggers" in the brain.

18. Denied. Applicant is entitled to his Mark because it is distinctive and will not cause confusion in the marketplace, as will be further described in his Affirmative Defenses.

BACKGROUND INFORMATION

Sometimes background information may be relevant and important. Considering the upcoming settlement discussions set forth in the Schedule of this Opposition by the Honorable Board, Applicant ("he") has tried to settle with the Ninkasi CEOs and their attorney. Once Applicant discovered the Mark in question, Babylon Double IPA, he conferred with outside Patent and Trademark counsel regarding his interest in settling and reached out to the Principals in a very amicable manner, requesting if there was some sort of resolution. Applicant stated "in considering and respecting each other's interests as entrepreneurs" he hoped for an amicable resolution, as there were many alternatives. He immediately proposed co-ownership, and also narrowing the scope of the Trademark (not to an extreme) and perhaps being able to "co-exist" in the marketplace, without "one affecting the other." He also emphasized that although it was conveyed to him that he may have recourse to the Opposition, in a Petition to Cancel, that in no way wanted take that route "with respect to each other's interests." Afterward, in the midst of amicable conversation, applicant's correspondence

to both CEOs seemed to be "blocked" and the return e-mails read "access denied." Initially, Applicant's e-mails did successfully reach the CEOs email address. This problem was addressed to Ninkasi's attorney each time, as he received e-mails, but questioned why he could not reply; there was no feedback.

Applicant hired a Patent and Trademark attorney [not of record] in an attempt to resolve. Further extension of time would have been consented to, if there were "substantive" settlement discussions to take place. Unfortunately, no suggestions came forth. Applicant also noticed that "Bell's Brewery" filed a Notice of Opposition on Ninkasi's Mark "Helles Belles." The long-time senior "user" and owner since 1983 could have contested the junior's Mark, but did not. On information and belief, there appeared to be some grace extended to Ninkasi, the junior. Applicant then requested that in turn, could Ninkasi give the Applicant, the junior, the same consideration Ninkasi's CEOs received from "Bell's Brewery?" This was not accepted. One CEO's reply to the Applicant was that Bell's position was "weak." (Debatable, nor an amenable response.)

Therefore, Applicant still expresses interest in resolving this matter the best way possible. Now, unfortunately, that both parties are forced to defend their marks, and since settlement discussions are required before the Honorable Board, perhaps there may a new perspective for an amicable resolution.

APPLICANT'S AFFIRMATIVE DEFENSES AND COUNTERCLAIM/ PETITION TO CANCEL

First Affirmative Defense:

1. The mark is significantly different in its entirety.

The Applicant's mark, and the Opposer's mark, (Ninkasi) when considered in their entirety are significantly different in sound, appearance, and meaning. Babylon Double IPA (Ninkasi) vs. Babylonian Hooch (Applicant). Sound and appearance as previously mentioned in the answers, and also in Affirmative Defenses to follow. (Ref: Recent Board Decision: # 85587596 SweetPeaToad; addition of the word "toad" to significantly distinguish applicant's mark.")

Second Affirmative Defense

2. Opposer (Ninkasi) does not have monopoly right to the word "Babylon."

In the section of "Frequently Asked Questions" of the USPTO website, specifically relating to "Geographic Indication" one question is: "If someone registers the name of my town as a GI, can I still use it to describe where my good/services come from?" To not quote the entire paragraph, it clearly explains that a " Trademark, Certification or Collective Mark is "not a monopoly right." In further explanation, it states that "the right extends to similar, related or even unrelated goods/services depending on the specific factors of each case." The applicant believes that there are several "specific factors" in this case relating to his Mark, to be further described in his Affirmative Defenses.

Third Affirmative Defense

3. The common portion of Babylon Double IPA, and Babylonian Hooch is weak. The source modifier in Applicant's mark make it distinctive.

"If the common portion is weak, (perhaps having a descriptive connotation), then addition of the source modifyer may suffice to avoid conflict, as in the case of HEATHERNKIT VS. HEATHERNIT BY ROOSTER." (Richard Kirkpatrick Treatise Sec. 4:10.8 Liklihood of Confusion.) Babylonian Hooch has a source modifier. The source is "Babylonian." The modifier, which also ***creates the change***, is "Hooch." Only two syllables are common in the names "Babylon Double IPA" and "Babylonian Hooch," Those syllabels being: "Ba-bl." Many people may think or say: "Bab-lon" instead of "Ba-by-lon." "Babylonian" as a whole sounds very different.

Fourth Affirmative Defense

4. Remaining portion is not confusingly similar. The common element is weak or "recessive." Overall combination of the words have no "commonality."

If the common element in the mark is "weak" in that it is generic, descriptive or highly suggestive of the named good or services, ***consumers typically will be able to***

avoid confusion unless the overall combinations have other commonalities." (T.M.E.P Sec.1207.01 Likelihood of Confusion.)"Where the common portion is weak, otherwise minor differences in the remaining portions could make for marks, which, overall, are not confusingly similar." (Richard Kirkpatrick Treatise Sec. 410.3) "Hooch" has no commonality with "Double IPA." "Babylonian" different from "Babylon." as is: "Boston" and "Bostonian."

Fifth Affirmative Defense

5. The non-common matter, verbal or pictoral is equally suggestive to avoid confusion.

Taking away the common portion of the two marks (2 syllables) that being "Ba-bl" from the rest of the word, leaves a distinct impression. What remains is: "**lonian Hooch**" which is distinctive and memorable. Babylon Douple IPA sounds remarkably different than Babylonian Hooch.

Sixth Afirmative Defense

6. The word "Babylon" of Ninkaski, the Opposer, is geographic and not distinctive. It is not arbitrary as in "Babylonian." "Typically, geographic indications are registered as certification marks or collective marks in the United States." Sec. 2(e)(2) Lanham Act. To overcome, it has to become distinctive. However, Opposer's mark was "released in March " 2013, (web info cited in Answers 6 & 11).

Seventh Affirmative Defense

7. The root of alledged having some portion in common, does not compel a conclusion of likely confusion. In this case, only the first two syllables are most common. (Richard Kirpatrick Treatise, Similarity of the Mark, pli.edu) and No likelihood of confusion.

Eight Affirmative Defense

8. **Visual appearance and characteristics.** Not only is Applicant's mark visually distinctive, but has characteristics with a greater potential for a secondary meaning than the Plaintiff's (Ninkasi) mark. (Richard Kirkpatrick Treatise, Similarity of the Marks, pli.edu.) **Disclaimed portions should also be considered.**

Ninth Affirmative Defense

9. **Differences in "parody."** A successful parody actually avoids or decreases likelihood of confusion because the effect is to create or highlight a clear distinction between the parody and the true mark." (Pli.edu, Kirkpatrick Treatise. Ch. 4), also See (TTAB recent decision, Pr. No. # 85404979.) "Addition of Blues Band and the visual distinction presented by replacement of the "TO" with "2" to be sufficient to distinguish the marks." (Coast 2 Coast/Coast to Coast Blues Band.) Also see Decision # 85587596 addition of "toad" to "SweetPeaToad."

Tenth Affirmative Defense

10. **Common usage of the word "Babylon."** Others in the same class as 032 and 033 are using the word "Babylon." "Beach Blanket Babylon" #2134576 for class 032 & 033 for wine. "Les Jardin's De Babylone # 3840408 class 033 for wine. "Babylonstoren" has also been applied for in wine class 033.

Opposer wants to cancel Applicant's mark for "Babylonian Hooch." Referring to "common usage" Babylon has 91 records in the USPTO trademark search.. "Babylonian Hooch" has only 2, both belonging to Applicant. Therefore, "Babylon" appears to be common in Trademark usage, whereas the applicant's is more unique.

Supportive Issues

Other beer classes appear to live in harmony, such as the Double Bocks: "Trogenator", "Celebrator", "Dominator." If anything sounds like confusion, these likely would be to the general public. It appears that many times people are smarter than what they're given credit for, as least in this beer category. It would be desirable to live in harmony with the Opposer, as in the Double Bock category of beer, as well as with previous registrants: "Beach Blanket Babylon," class 032, 033. Les Jardin's De Babylone.

Note: The reason Applicant (Defendant) has included some pleadings in this answer is due to the "intent to use" application, whereas there is little in the way of Discovery. Therefore, perhaps may file a motion for an early decision based on the pleadings, if or when appropriate.

For all the foregoing reasons and defenses, and any other reasons deemed appropriate, the Applicant (Defendant) prays that the Honorable Board dismiss the Opposition, and find in favor of the Applicant in allowing registration to continue.

Respectfully submitted,

Derek Scott T.

Derek Scott T.

Applicant/Owner # 85718981

* A copy of this Petition has been mailed certified to Defendant's attorney, Jane Yates.