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Subject: TRADEMARK APPLICATION NO. 76530111 - 8422-036-999
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/530111

APPLICANT: DIAMOND HONG INC.

CORRESPONDENT ADDRESS:

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK:

CORRESPONDENT'S REFERENCE/DOCKET NO: 8422-036-999

CORRESPONDENT EMAIL ADDRESS:
kennethcli@hotmail.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Diamond Hong Inc., has appealed the trademark examining attorney's final refusal on the Principal Register to register the trademark of a design of two roosters facing each other and the wording "half chicken/rooster" in Chinese characters for distilled spirits made of rice, peas or sorghum, herb liquors, port wine, rum, sake, fruit wine, red wine,

white wine and cooking wine, in International Class 33, on the ground of a likelihood of confusion with the United States Trademark Registration No. 2159050 under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The cited registration is a design of two roosters facing each other for wines, in International Class 33. The examining attorney attaches the copies of the registration at the end of this brief.

FACTS

On July 15, 2003, the applicant, Diamond Hong Inc., applied to register on the Principal Register the trademark of a design of two roosters facing each other and the wording “half chicken/rooster” in Chinese characters for distilled spirits made of rice, peas or sorghum, herb liquors, port wine, rum, sake, fruit wine, red wine, white wine and cooking wine, in International Class 33.

In an Office Action issued on December 22, 2003, the examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant’s mark, when used on the identified goods, so resembles the mark in United States Registration No. 2159050 – a design of two roosters facing each other for wines, in International Class 33, as to be likely to cause confusion, to cause mistake, or to deceive. On June 2, 2004, the applicant responded to the refusal by arguing that the applicant’s mark does not cause a likelihood of confusion with the cited registered mark. After carefully reviewing the applicant’s response but finding it unpersuasive, on August 27, 2004, the attorney issued a final refusal under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). On February 18, 2005, the applicant filed a Notice of Appeal and its Appeal Brief.

ARGUMENT

The applicant’s basis of the arguments is that the applicant and registrant’s marks are

sufficiently distinctive such that there is no likelihood of confusion in light of the relevant factors to be considered in *In Re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The relevant factors are (1) the similarity of the marks, and (2) the relatedness of the goods. The applicant argues that the marks of the parties are distinguishable and that the normal channels of trade are dissimilar.

I. The Marks of the Parties Are Similar in Sight and Commercial Impression

The applicant argues that the marks of the parties are dissimilar because the applicant's mark is a composite mark consisting of words and design, whereas the registrant's mark consists merely of a design. As such, the applicant argues that greater weight should be given to the wording and cites *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement).

This case can be distinguished from the facts of *Electrolyte* because both of the marks in *Electrolyte* are composite marks, whereas in this case, the applicant's mark is a composite mark and the registrant's mark is design only.

The court in *Electrolyte* stated that "appropriate weight is given to the effect of features common to both marks." *Electrolyte*, 1947 (emphasis added). If there are features common to both marks, then appropriate weight must be given to the common features. However, in this case, there is only one common feature. The common feature is that both marks have design elements. The uncommon feature is that the applicant's mark includes words while the registrant's mark does not include words. Therefore, the more appropriate cases are those that refer to additions to the mark.

The mere addition of a term to a registered mark does not obviate the similarity between the

marks nor does it overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (“BENGAL” and “BENGAL LANCER”); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (“THE LILLY” and “LILLI ANN”); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) (“MACHO” and “MACHO COMBOS”); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (“CAREER IMAGE” and “CREST CAREER IMAGES”); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (“CONFIRM” and “CONFIRMCELLS”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (“ACCUTUNE” and “RICHARD PETTY’S ACCU TUNE”); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (“HEAD START” and “HEAD START COSVETIC”); TMEP §1207.01(b)(iii).

The court in *Electrolyte* continued on to state that “there is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *Electrolyte*, 1947. The comparison depends on the type of the marks and the common features presented in the marks. In this case, just because the registrant’s mark does not include any words, the registrant should not be left vulnerable against other marks with very similar designs but with words. Given that the registrant’s mark does not have any words, the Board should look to the common features and give greater weight to the designs, and not to the fact that the registrant’s mark does not include any wording. Therefore, the likelihood of confusion analysis should rest on the similarity of the designs. The common feature of the marks is that both designs are two roosters facing each other.

The applicant cites three other cases: (1) *In re Cooper Tire and Rubber Company*, 22 USPQ2d 1079 (CAFC 1991) (THE INDY TUBE held not likely to be confused with INDY 500); (2) *Cortex Corp. vs. W.L Gore & Associates, Inc.*, 28 USPQ2d 1152 (CAFC 1993) (CORTEX held not likely to be confused with GORE-TEX), and (3) *In re The Hearst Corp.*, 982 F.2d 493 (CAFC 1992) (VARGA GIRL held not likely to be confused with VARGAS). All three of these cases are distinguishable from this case because none of these cases dealt

with composite marks or design marks.

One specific difference that the applicant raises is that there is a difference in appearance in the designs of the roosters. The applicant describes the registrant's mark as "hollow designs" with "white back ground with black strokes." The applicant describes its mark as "two mirror images in solid black color." Granted, the marks are not identical. However, the commercial impressions are very strong and similar. Both marks are silhouette designs of two roosters facing each other. The Board should look to the similarities and not to the slight differences.

When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956); TMEP §1207.01(b).

Further, the fact that the applicant's mark includes Chinese characters may work against the applicant and support the finding that the design elements are more significant in the U.S. channels of trade where most people do not read Chinese characters. Because most people in the U.S. do not read Chinese characters, they will look to the designs to recall and locate a product as opposed to Chinese characters that they cannot decipher.

II. The Goods Are Identical

The significance in the *DuPont* analysis is not the dominance of one factor over the other factors but the relationship among the major factors. The determination of likelihood of confusion is not based on one factor alone, such as the similarity of the marks, but also on the weight of the other major factor, which is the relationship of the goods.

Here in this case, the goods of the parties are identical. The applicant does not dispute the closeness of the relationship of the goods and does not discuss this factor at all. The fact

that the goods are identical is not a point to ignore, but this fact weighs heavily in the entire analysis of likelihood of confusion. Contrary to the applicant's position of lessening the significance of this factor, the Board should not neglect to give proper weight to this factor and consider highly the close relationship of the goods involved in this case.

The registrant's goods are "wines." This includes all types of wines including all the various types included in the applicant's identification of goods, which are distilled spirits made of rice, peas or sorghum, herb liquors, port wine, rum, sake, fruit wine, red wine, white wine and cooking wine.

Various alcoholic beverages have been shown to be related goods for purposes of 2(d) analysis. *In re Majestic Distilling Co.*, 65 USPQ2d 1201 (Fed. Cir. 2003) (likelihood of confusion between RED BULL for tequila and RED BULL for malt liquor); *In re Salierbrau Franz Sailer*, 23 USPQ2d 1719 (TTAB 1992) (likelihood of confusion between CHRISTOPHER COLUMBUS for beer and CRISTOBEL COLON & design for sweet wine); *Somerset Distilling Inc. v. Speymalt Whiskey Distributors Ltd.*, 14 USPQ2d 1539 (TTAB 1989) (likelihood of confusion between JAS. GORDON and design for scotch whiskey and GORDON'S for distilled gin and vodka); *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069 (TTAB 1989) (likelihood of confusion between BRAS D'OR for brandy and BRADOR for beer); *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (likelihood of confusion between trademark COLAGNAC for cola flavored liqueur and certification mark COGNAC for brandy); *In re Hennessy*, 226 USPQ 274 (TTAB 1985) (likelihood of confusion between HENNESSY for cognac brandy and A LESLIE HENNESSY SELECTION for wine).

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-5 (TTAB 1980).

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described including those in the applicant's more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); TMEP §1207.01(a)(iii).

The applicant does argue that there may be a difference in the normal channels of trade because the applicant's mark includes Chinese characters. "Since applicant's mark in Chinese means 'half chicken/rooster,' applicant's mark primarily targets oriental customers. So, the channels of marketing and advertising have little chance of overlap." Applicant's Brief, page 7. The registrant, however, is not prohibited at all from entering any Asian marketplace in the United States.

Specifically, even if the applicant may target Asian customers, the applicant has not restricted the application in any way to a specific channel of trade or specific target customer. Just because the applicant's mark includes Chinese characters, this is not an indication of any restriction on the channel of trade. The applicant is an entity of the United States. It has applied for a federal trademark registration requesting the full force of the registration to be effective in all parts of the United States.

CONCLUSION

The fact that the goods are identical buttressed with the finding of the similarity of the marks leads to the proper conclusion that there is a likelihood of confusion between the registrant's mark and the applicant's mark.

For the foregoing reasons, the refusal to register on the basis of § 2(d) of the Trademark

Act, 15 U.S.C. § 1052(d), for the reason that there is a likelihood of confusion, should be affirmed.

Respectfully submitted,

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