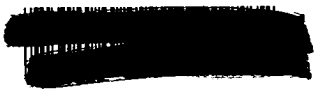
UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76691918

MARK: RIPS



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GENERAL TRADEMARK INFORMATION:
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TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: COOL TROPICS

CORRESPONDENT'S REFERENCE/DOCKET NO:
P-3751-4
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the trademark "RIPS" in connection with "fruit juice, and not including alcoholic beverages." Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) on the ground that applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 3,764,328 as to be likely to cause confusion, to cause mistake, or to deceive.

I. FACTS

On August 8, 2008, Cool Tropics (hereinafter, "Applicant") filed an application to register the mark "RIPS" for "100% Juice Slush Pouch Pack" in Class 032.

On November 19, 2009, the examining attorney refused registration on the basis that the identification of goods was unacceptable and that a substitute specimen was required. The Office Action also noted a prior pending application on which a likelihood of confusion could be found.

On December 29, 2008, Applicant responded to the Office Action by amending the identification of goods to, "FRUIT JUICE, AND NOT INCLUDING ALCOHOLIC BEVERAGES" and by arguing that the submitted specimen was acceptable on the grounds that it constituted a "stamping" under TMEP §904.03(b).

The amendments were accepted and on January 12, 2009, the application was suspended pending

the disposition of the earlier filed application, Serial Number 77/536939.

On August 2, 2010, the examining attorney refused registration of the mark under Section 2(d) of the Trademark Act on the ground that the applicant's mark, when used on or in connection with the identified goods, so resembled the mark in U.S. Registration No. 3,764, 328 ["RIPS" for "liquor and liqueur beverages, namely, frozen ready-to drink alcoholic beverages of fruit"] as to be likely to cause confusion, to cause mistake, or to deceive.

On August 23, 2010, the Applicant argued that diversity of products obviated any likelihood of confusion and that it had not been established that the products were marketed in a way that they would create the presumption that the goods originated from the same source.

On August 26, 2010, the examining attorney issued a final office action on the 2(d) refusal and on September 10, 2010, Applicant filed its notice of appeal and brief.

ISSUE ON APPEAL

The only issue on appeal is whether applicant's mark "RIPS", when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 3,764, 328 "RIPS" as to be likely to cause confusion, to cause mistake, or to deceive.

II. ARGUMENT

BECAUSE THE MARKS ARE IDENTICAL AND ARE USED IN CONNECTION WITH COMPLEMENTARY GOODS, THE PARTIES' MARKS ARE LIKELY TO CREATE CONSUMER CONFUSION AS TO SOURCE.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476

F.2d at 1361-62, 177 USPQ at 567.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

A. THE MARKS ARE IDENTICAL

Applicant seeks to register the mark "RIPS" in standard character form and Registrant owns the mark "RIPS" in standard character form. The marks are identical, and thus, there are no disparities in sound, appearance, or meaning. Where the marks of the respective parties are identical or virtually identical, there need be only a viable relationship between the relevant goods and/or services to support a finding of likelihood of confusion. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009); *In re Wilson*, 57 USPQ2d 1863, 1867 (TTAB 2001); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

B. THE GOODS ARE HIGHLY RELATED

I. Complementary Goods

The applicant's goods are "fruit juice, and not including alcoholic beverages" and the registrant's goods are, "liquor and liqueur beverages, namely, frozen ready-to drink alcoholic beverages of fruit". Despite the fact that Applicant has carved out an exception for alcoholic beverages, the goods are still

closely related because they are complementary goods which are used together and which travel to the same class of purchasers through similar channels of trade.

In this case, Applicant's goods are fruit juices. As the web printouts attached to the final office action illustrate, fruit juices are a type of mixer. Mixers are often used to sweeten or enhance the flavor of alcoholic beverages. Specifically, the website indicates that "Fruit juices are common additions to rum-based cocktails." (See page 3 Final Office Action). Therefore, Applicant's goods, "fruit juices", are commonly used in connection with Registrant's goods, "alcoholic beverages", thereby making "fruit juices" and "alcoholic beverages" complementary items. Moreover, Registrant's alcoholic beverages are specifically alcoholic beverages **of fruit**. Because Applicant's goods are "**fruit** juice", confusion of the marks is likely since they both involve the infusion or use of **fruit** in the beverages.

Courts have held, especially when the marks are identical as they are in this case, that complementary goods are sufficiently closely related to cause a likelihood of confusion. *See In re colonial Stores, Inc.*, 216 USPQ 793 (TTAB 1982) (likelihood of confusion found between COUNTRY PRIDE for bread and COUNTRY PRIDE for prepared meat products, despite weakness of marks, in view of identical marks and complementary goods which could be sold in same stores); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re TOG Machining Company, Inc.*, 174 LEXIS (TTAB 1997).

If goods are related in that they are used together or sold together, they clearly target the same consumers. The likelihood of confusion increases if the same consumers will encounter the similar marks. In *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984), the court found that "bread" and "cheese" were related goods because they were goods that are commonly used together.

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d

1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

II. Single Source

The fact that Applicant has carved out an exception for alcoholic beverage is also rendered moot because evidence shows that there are entities that provide non-alcoholic beverages and alcoholic beverages alike. Attached previously to the examining attorney's first refusal were copies of printouts from the USPTO X-Search database which showed third-party registrations of marks used in connection with the same or similar goods as those of applicant and registrant. These printouts have probative value to the extent that they serve to suggest that the goods listed therein, namely, alcoholic beverages and non-alcoholic beverages are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ 2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). The following are a sampling of some third party registrations:

- **VIP ALL ACCESS (RN 3737972):** Fruit drinks; Fruit flavored soft drinks; Fruit-based soft drinks flavored with tea; Fruit-flavored drinks; Frozen fruit beverages; Frozen fruit-based beverages; Fruit beverages; Fruit concentrates and purees used as ingredients of beverages; Fruit juice bases; Fruit juice concentrates; Fruit juices; Fruit nectars; Fruit punch; Fruit-flavored beverages; Fruit-flavoured beverages; Grape juice beverages; Non-alcoholic beverages containing fruit juices; Non-alcoholic fruit extracts used in the preparation of beverages; Non-alcoholic fruit juice beverages; Orange juice beverages; Pineapple juice beverages in Class 032; Alcoholic beverages of fruit; Alcoholic beverages except beers; Alcoholic bitters; Alcoholic cocktail mixes; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic punch in Class 033.
- **BAHAMARITA (RN 2567077):** Prepared non-alcoholic beverages, namely, fruit-flavored non-alcoholic drinks in Class 032; Prepared alcoholic beverages, namely, prepared alcoholic cocktails in Class 033.

- **THE CHALMATION (RN 3451773):** Non-alcoholic beverages, namely, fruit cocktails in Class 032; Alcoholic Beverages, namely, prepared alcoholic cocktails in Class 033.
- **AMERICAN BULL with design (RN 3066213)**: Non-alcoholic beverages, namely, mineral water; mineral water with vitamin or caffeine additives; isotonic drinks; sports drinks; and fruit-flavored drinks in Class 032; Alcoholic beverages, namely, sports, fruit flavored, and isotonic drinks containing vodka; whiskey; gin; rum; wine; brandy; cognac; and distilled spirits in Class 033.
- **HOOTERS (RN 3473389):** Non-alcoholic beverages in Class 032; Alcoholic beverages in Class 033.
- **RASTA (RN 3764064):** Non-alcoholic beverages, namely, soft drinks, flavored water, non-flavored drinking water, and sports drinks in Class 032; Alcoholic beverages, namely, liquors, distilled spirits, gins, rum and vodka.

These third party registrations illustrate that alcoholic and non-alcoholic beverages are often provided from a single source. For that reason, the fact that Applicant has carved out an exception for alcoholic beverages by amending the identification of goods to read, ""FRUIT JUICE, AND NOT INCLUDING ALCOHOLIC BEVERAGES" is ineffective and fails to obviate the finding under 2(d).

Finally, the Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods and/or services, but it also protects against "reverse confusion," that is, the junior user is the source of the senior user's goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Fisons Horticulture, Inc. v. Vigoro Indust., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994); *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 490-91, 6 USPQ2d 1187, 1190-91 (2d Cir. 1988).

In this case, it is likely that consumers seeing the mark "RIPS" on fruit juice and thereafter seeing the identical mark "RIPS" on "frozen ready-to drink alcoholic beverages of fruit" are likely to believe that such frozen drinks contain the fruit juice marketed under Applicant's RIPS mark as an ingredient in Registrant's ready to drink alcoholic beverages.

III. CONCLUSION

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988). *Burroughs Wellcome Co. v. Warner Lambert Co.*, 203 USPQ 191 (TTAB 1979), *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

In this case, the marks are identical and are being used in connection with complementary goods. Fruit juices are commonly used as mixers with alcoholic beverages and are thus likely to be encountered by the same purchasers in similar channels of trade. Additionally, consumers are likely to believe that Applicant's "fruit juices" marked RIPS are the same fruit juices which are used in Registrant's "alcoholic beverages of fruit" bearing the identical mark RIPS. Accordingly, there exists a likelihood of confusion with respect to the source of the parties' goods. For the foregoing reasons, the examining attorney respectfully requests that the refusal of registration under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) be affirmed.

Respectfully submitted,

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