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

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| Proceeding | 79228188 |
| Applicant | INIS TINE UISCE TEORANTA |
| Applied for Mark | GRACE O'MALLEY |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: US-Trademark Application for „ Grace O’Malley“

Applicant: Inis Tine Uisce Teoranta

Serial No.: 79/228,188

Filed: January 16, 2018

Examiner: Ryan Cianci

Law Office: 116

BRIEF OF APPEAL

TTAB
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Introduction:

This is an appeal from the Examiner’s final decision to refuse registration of applicant’s mark set forth above. Applicant brings this appeal pursuant to 15 U.S.C. §1070, 37 C.F.R § 2.141, after the Examiner finally denied applicant’s renewed Request for Reconsideration.

The Examiner initially refused registration of applicant’s mark “Grace O’ Malley” under 15 U.S.C. §1052(d) based on three references. During the course of the prosecution, applicant amended its recitation of goods and the Examiner withdrew his refusal based on the two registrations, but remained with the position of likelihood of confusion with the third registration, which is the relevant

reference. After applicant submitted two separate Requests for Reconsideration, which the Examiner denied, this appeal followed.

In the course of this brief, applicant will refer to the Examiner's Office Actions by date; respectively, applicant's replies to the Office Action, as well as the submitted evidence.

Argument

An Analysis under the duPont Factors Yields a Determination that Applicant's Mark is Not Confusingly Similar to the Cited Mark

Applicant asserts that the DuPont factors are the relevant test and that the factors as discussed are in favor of applicant. Similarity of the marks, similarity of the goods, trade channels and type of consumers were extensively discussed, see In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Applicant also believes that the factor relating to the sophistication of consumers is relevant to merit review, Shen Mfg. Co v. Ritz Hotel, Ltd., 393 F.3d 1238, 1241 (Fed Cir. 2004). Applicant also relies on the additional DuPont factor of fame of the mark.

Factor 1 - Dissimilarities of the Marks

The first factor examines the similarities or dissimilarities of the marks in their entirety as to appearance, sound, connotation, and commercial impression.

In a likelihood of confusion analysis, the marks must be compared in their entirety; "likelihood of confusion cannot be predicated on dissection of a mark, that

is, on only a part of a mark” In re National Data Corp., 224 USPQ 749, 750-51 (Fed. Cir. 1985). While it is acceptable to give more or less weight to a feature of the mark, this does not eliminate the requirement that the ultimate conclusion requires a review of the marks in their entirety.

***Applicant’s Mark Does Not Entirely Subsume Registrant’s Mark and
Pluralization is Not an Issue Here***

As applicant has argued, its mark “GRACE O’MALLEY” is sufficiently different from the reference mark “O’Malleys”. The Examiner put forth statements to the effect that the proposed mark entirely incorporates the registered mark (Ex. OA 12/3/2018). Whatever this statement means, in any event, it is incorrectly asserted that the reference mark is “entirely subsumed in applicant’s mark”. The reference mark is “O’Malleys”; applicant’s mark is GRACE O’MALLEY. O’ Malleys includes an “s” as the terminal letter and, thus, cannot be said to be incorporated into applicant’s mark in its entirety, (Appl. Reply 3/11/19). The Examiner’s position that if a registered mark is pluralized, it does not distinguish the compared marks, (Ex. OA 12/3/2018) is questionable at best. Pluralization of a term in the mark is not a concept that works here. It is submitted that a name is not “pluralized” if by pluralized it is asserted that there is more than one person addressed under the name, unless there is an article before the term.

Applicant’s Mark has Meaning

While GRACE O’MALLEY is a women’s name, it also refers to an Irish legendary historic figure that is well known. She was a female pirate and one of the most important women in Irish history. Born as the daughter of a chieftain of the

O'Maille clan, her life and career had great cultural impact on Ireland and England¹.
The Board is urged to take judicial notice of this historical fact.

Applicant's Mark of a First Name and a Last Name is Nonetheless Unitary

Applicant's mark is a composite mark comprised of two word elements. Applicant's mark creates a unitary whole and must be viewed as such, T.M.E.P. §1213.05(f) despite this fact that the mark is of two word element. Accordingly, the mark is not a sum of individual parts but is a composite and unitary mark. Moreover, the anti-dissection rule forbids that the mark is viewed as two separate elements as the Examiner did.

Applicant's Mark has a Specific Connotation and Commercial Impression

The marks are also distinguishable in terms of connotation and commercial impression. Applicant's mark GRACE O'MALLEY has the historic connotation of a pirate queen, while O'Malleys appears simply to be a surname without particular connotation. That "O'Malleys" is regarded simply as a surname, was also determined during prosecution of that application. In order to overcome the refusal to register by the Examiner, registrant transferred the application to the Supplemental Register where it still resides².

Because of Their Differences in Appearance, The Two marks Do Not Give Consumers the Impression of a Single Source.

Under a likelihood of confusion analysis, the question to be determined is whether the marks will confuse people into believing that the goods identified by the

¹ Another name for the Grace O'Malley is 'Granuaile'

² Reg. No.: 3522904

mark emanate from the same source, and not whether people will simply confuse the marks, In re West Point-Pepperell Inc. 468 F.2d 200, 201, 175 USPQ 558, 558-559 (CCPA 1972); TMEP 1207.01(b). This is not made by a side-by-side comparison but by a determination as to whether the marks create the same overall impression, Recot, Inc. v. M.C. Becton, 214 F.2d 1322, 1329-30, 54 USPQ2d.1894, 1899 (Fed. Cir. 2000); Visual Info. Inst. Inc. v. Vicon Indust. Inc. 209 USPQ 179, 189, (TTAB 1980). Since the marks are dissimilar, applicant asserts that the marks are sufficiently different, so that no likelihood of confusion occurs. Therefore, this factor favors applicant.

Factor 2 - Dissimilarities of the Goods and Services

The second factor examines the relatedness of the goods and services as described in an application or registration in connection with which the prior mark is in use. DuPont, 467 F.2d at 1361.

As a threshold matter, it is notable that within the alcoholic beverage industry, certain drinks have a higher profile than others. For example, the market for whiskey currently favors whiskey drinkers. This is reflected in a multitude of new whiskeys, also from small distillers, found in every liquor store in the US. Ireland is one of the most well-known whiskey producers in the world. Because Irish whiskey is made up of a combination of grains and mostly triple distilled, it makes for a smooth whiskey as compared to, for example, Scotch whiskey.

Applicant's trademark application for GRACE O' MALLEY includes class 33 for among others, whiskey. Beers, liqueurs and cream liqueurs were specifically

excepted from the current recitation of goods. Applicant has not yet entered the U.S. market since it wants to secure protection for its name prior to entering the market.

Cream Liqueur is a Very Different Drink as Compared to Whiskey

Registrant's goods are "cream liqueur" only. Needless to say, cream liqueur is a very specific drink and resides in a very specific market. In particular, the liqueur is cream based, meaning it has to be stored in a cool place (below 25 degree), (Appl. Reply 3/11/19). In 2018, a food & drink blogger acknowledged online that the cream liqueur industry is struggling because of the perception by consumers of a high caloric content. This is only to emphasize, that whiskey drinkers and cream liqueur drinkers are in different camps referring to marketing. The cream in cream liqueur is a milk fat constituent. Those who favor the drink like it in particular in addition to the sweetness of the drink. Whiskey drinkers, on the other hand, may not like an alcoholic drink that contains milk fat cream and may not like the sweetness that goes with the drink.

Whiskey has 40, Alcohol, Cream Liqueur has 17%

Applicant does not dispute that cream liqueur has alcohol in it, albeit much lower than spirits, and that it is sold in liquor stores, but those facts do not make the marks confusingly similar, In re Viterro Inc. 671, F.3d 1358, 101 USPQ2d 1905, 1908 (Fed Cir. 2012).

While the goods are considered related because they are both alcoholic beverages, it is important to look at the circumstances surrounding their marketing, see Coach Serv. Inc. v. Triumph Leaning LLC, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). The main market place for alcoholic beverages is the

liquor store or the supermarket, where the bulk of alcoholic beverages are sold³. There, spirits are displayed away from liqueurs and there is no confusion as to a buyer of either of the goods.

Highly Similar and Identical Marks are Able to Co-Exist Without Confusion and the Board Should Take These Into Consideration

In that context, applicant points to a compendium (Evidence, evi_980248210 3/11/19) it created with respect to marks in the alcoholic beverage industry registered in the USPTO. It was found that many highly similar and nearly identical marks, in some cases identical marks, are able to co-exist without confusion. This includes varieties of spirits and wine, liqueurs and whiskeys, all sold presumably within the same liquor store. Upon checking some of these for further disposition, it did seem that none these marks encountered any oppositions or cancellations and thus, it can be safely assumed that at least a portion of these marks are existing side by side in the market place.

The Examiner had rejected applicant's submission of evidence as not proper because applicant did not supply each and every certificate of registration. In a second Request for Reconsideration applicant submitted each and every registration certificate from the list of registered trademarks, (evi_9802482 4/16/19).

Based on the foregoing, this factor is also in favor of applicant.

Factor 3- Dissimilarity of Trade Channels

³ In a great number of states, spirits are not shipped from orders over the internet.

As a general rule, unless the trade channels are specified, it is assumed that the goods flow through all channels of trade. The alcohol industry is one of the most highly regulated industries with a 3-Tier system⁴. Depending on the state, there may be separation between the wine, beer, and liquor distribution or not. Thus, spirits and liqueurs may or may not travel in the same channels of trade. Therefore, particular channels of trade are irrelevant here because of the state's system of regulation. However, whether encountered in one or the other Tier in the system, those involved in the various Tiers are cognizant of the specific goods that are being moved, that is, whether the goods are whiskey or cream liqueur. In that context, it is pointed out that Applicant has limited its goods in class 33 to a number of spirits and excepted beer and liqueurs entirely.

Based on the foregoing, this factor thus remains neutral.

Factor 4- Sophisticated Purchasers

The fourth factor examines "the condition under which and buyers to whom sales are made i.e. impulse versus careful sophisticated purchasing, "DuPont" 467 F2d at 1361.

In recent times with the proliferation of micro-distilling, purchasers of alcoholic beverages - especially spirits - have become even more sophisticated. Both

⁴ The 3-Tier system in the United States grew out of historic facts related to alcohol. Thus, Tier 1 is the manufacturer that sells to licensed importers, distributors and control boards. Federal excise tax is collected when the product leaves premises of the manufacturer or the facilities of the importer. Tier 2 are the licensed importers acting in cooperation with state and local government. Importers distributors and control boards are only allowed to sell to licensed retailers. Tier 3 are the licensed outlets like liquor store, bars or restaurant that ensure that alcohol is sold to those who are of legal age.

applicant's and registrant's goods are specialty drinks that are targeted to sophisticated drinkers. Consumers of alcoholic beverages tend to seek out specific types and brands and types of alcohol. A purchaser of whiskey and cream liqueur chooses carefully because the product is pricey and the purchaser is likely to have a favorite brand. It is therefore highly unlikely that someone searching for whiskey whether Irish or not, will be confused with registrant's product of cream liqueur, or its source, See Calypso Technology, Inc. v. Calypso Capital Management, LP, 100USPQ2d 12 13 (TTAB 2011) (no confusion found for 'Calypso' for financial software and 'Calypso' for financial investing, consumers for the products are sophisticated and will exercise care due to cost and purpose of services). Purchasers of either product will be able to distinguish applicant's goods from registrant's goods and vice versa, especially considering the different types of alcohol.

Further Factors To Be Considered

Of the original 13 DuPont factors DuPont" 467 F2d at 1361, those most often reviewed are the previous 4 factors discussed supra. However, several other factors are instructive here for example, the fame of the mark (5.) and the number and nature of similar marks in use on similar goods (6.).

Fame of Applicant's Mark

Referring to the above discussion, the Board should take judicial notice that the name GRACE O'MALLEY is indisputably famous as seen from the Reference A submitted herewith and this fact should be taken into account.

On the other hand, a search for the product marketed under registrant's mark could not be found in the metropolitan area of New York, except for one reference on Google stating that Sam's Club carries the product.

In view of the foregoing, the Board is urged to conclude that applicant carried its burden of proof that the marks are not confusingly similar.

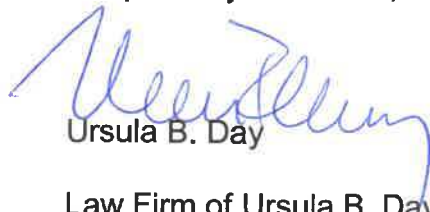
The List of Similar or Identical Marks or Record Should be Taken Into Account

Applicant has provided proof in form of registration certificates of registered marks that are very similar or identical and are for alcoholic beverages such as wine, whiskey and liqueur.

CONCLUSION

The foregoing shows how the DuPont factors play out here, in particular with regards to five factors presented in addition to the evidence of record. From the totality of circumstances it is a fair assessment to conclude there is not likelihood of confusion.

Respectfully submitted,



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15 U.S.C. §1052(d) ... p. 1

REFERENCE A

Grace O'Malley - Famous Female Pirate



(/picture/picture-of-famous-pirate-grace-omalley/)

Grace O'Malley (born around 1530, died around 1603) was one of the most important women in Irish history, a Queen of Umaill (territory in the Ireland), chieftain of the Ó Máille clan and a pirate. Known under several pseudonyms (GráinneNíMháille, Granuaile, GráinneMhao, and many other), she today represents important figure in an Irish folklore

and history, which is best represented by her title "The Sea Queen OfConnaugh". She spent her lifetime ruling the lands of West Ireland, fighting for their independence against the English.

GráinneNíMháille was born in Ireland around 1530, in a time when Henry VIII was king of England, and Irish lords were mostly independent. Born as a daughter of the chieftain of the Ó Máille clan, she soon became fond of the seas. After many disagreements with her family she finally cut her hair and secretly boarded father's ship. After discovering her, her entire family laughed and accepted her wishes. Although she spent much time on a ship, she received formal education and knowledge of foreign languages (such as Latin).

In 1546 she became married to DónalanChogaidh Ó Flaithbheartaigh, another Irish lord with whom she had three children. After he died in battle, Grace defeated his killers and returned to her castle as a defacto ruler of majority of West Ireland. In 1566 she married for second time, this time to lord Ríseárd an Iarainn Bourke who controlled majority of iron trade in the Ireland. Exactly one year later, Grace divorced him and kept all his wealth for himself, greatly increasing her influence.

During her lifetime Grace fought countless battles on the sea and land. She expanded her influence, until she became well known even in England. During 1596 her two sons became captive of Queen Elizabeth I. The two queens met in Greenwich Palace to

for second time, this time to lord Ríseárd an Iarainn Bourke who controlled majority of iron trade in the Ireland. Exactly one year later, Grace divorced him and kept all his wealth for himself, greatly increasing her influence.

During her lifetime Grace fought countless battles on the sea and land. She expanded her influence, until she became well known even in England. During 1596 her two sons became captive of Queen Elizabeth I. The two queens met in Greenwich Palace to discuss terms of their release, where Grace famously refused to bow down to Elizabeth. Grace continued with her exploits on the land and sea, further more expanding her influence and fame across the Europe. She died sometimes around 1603 in Rockfleet Castle, in the same year as Elizabeth I.

Life and career of Grace O'Malley had a great cultural impact on the Ireland and England. Her life was scrutinized by countless modern historians, she was the centerpiece of many music pieces, stage plays, movies and other media.