

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

In the matter of trademark application Serial No 86267467
For the mark KIMO SABE
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WASABE BEVERAGES INC
v.
DWLL, INC

NOTICE OF OPPOSITION

WASABE BEVERAGES INC
A CALIFORNIA CORPORATION
6986 PASO ROBLES DRIVE
OAKLAND, CA 94611

The above-identified opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are related to the Registered Trademarks of Wasabe Beverages Inc.

REGISTERED TRADEMARKS

Wasabe Beverages Inc ("Registrant") is the owner of trademark Registration Number 3935384 for the word mark SABE SAKE in connection with "IC 033. US 047 049. G & S: Distilled Spirits; Distilled spirits of rice (awamori); Gin; Japanese white liquor (shochu); Liqueurs; Potable spirits; Sake; Spirits; Spirits and liqueurs; Vodka." The disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE SAKE APART FROM THE MARK AS SHOWN is included in the file.

Registrant is the owner of trademark Registration Number 3926153 for the word mark KUMOSABE in connection with "IC 033. US 047 049. G & S: Distilled Spirits; Distilled spirits of rice (awamori); Gin; Potable spirits; Sake; Sake; Spirits; Spirits and liqueurs; Vodka."

Both registrations are on the Principal Registrar.

BASIS FOR OPPOSITION

In the original office action, the Examining Attorney cited likely confusion between the proposed mark **KIMO SABE** and the Registered Trademark **KUMOSABE**. The Registrant strongly asserts that there will be confusion. The Registrant does not find the arguments presented by the Applicant as valid and this Notice of Opposition will lay out the many reasons why.

The Examining Attorney should have relied upon both of the above Registered Trademarks. The **SABE SAKE** registration was not included in the office action by the Examining Attorney but is equally

important to consider as the Registrant believes the proposed mark is likely confusing with that mark. Additionally, the **KUMOSABE** trademark is a line extension from the trademark **SABE SAKE**. The origin of the word **KUMOSABE** trademark comes directly from the word **KEMOSABE**, which is a known word in the English language. The Registrant slightly modified its word mark to **KUMOSABE** to reflect key brand characteristics while taking advantage of this word. Consumers that first pronounce the name **KUMOSABE** immediately reference the word **KEMOSABE** – that simple fact will lead to confusion between **KIMO SABE** and **KUMOSABE**.

In the initial office action, the Examining Attorney was absolutely correct that the respective marks **KUMOSABE** and **KIMO SABE** are nearly identical. The Applicant claims that the marks are “*distinct in appearance, sound and apparent origin, when considered in their entirety*”. The Registrant strongly disagrees with this claim and asserts that **KUMOSABE** and **KIMO SABE** are nearly identical looking and sounding. In addition, the origin of **KUMOSABE** is based on the Registrant’s primary Registered Trademark **SABE SAKE** which was not referenced or considered in the Office Action. Each Applicant claim in its response to the office action is directly refuted below point by point:

- (1) Distinct in appearance: At its core, both word marks consist of eight letters with only one vowel being different (i.e., 7 of 8, or 88% common). One vowel in a four syllable word is the only difference in appearance between the appearance of **KUMOSABE** and **KIMO SABE**. The same can be said of the lower case format **kumosabe** and **kimo sabe**.
- (2) Sound: The space that separates **KIMO** and **SABE** does not matter in the pronunciation of the word mark and further links the marks.
- (3) Omitted origin: **SABE SAKE** is the Registrant’s primary brand and Registered Trademark. When deciding upon a line extension for the **SABE SAKE** brand, the Registrant considered the brand name **KEMOSABE**. **KEMOSABE** is a known word in the English language, but focus group research found the prefix **KEMO** was too close to **CHEMO** (i.e. Chemotherapy). As such, the Registrant opted to use the prefix **KUMO** instead as it meant cloud in the Japanese language. As such, the line extension became **KUMOSABE**. The relative similarity to **KEMOSABE** aids in recall of **KUMOSABE** and is directly tied to the mark and cannot be separated.
- (4) The word **SABE** is **not** an English speaking word – it’s a word derived from other languages. In Registrant Trademark record, Registrant notes that the English translation of “**SABE**” in the mark is “The beauty that comes with age”. The Applicant should not be permitted use of a word that is not from the English language that is already part of a Registered Trademark.
- (5) Word origin: Applicant cites **KIMO SABE** as being a phrase from the Native American sidekick Tonto. The actual word is spelled with no spaces - **KEMOSABE**. Countless internet searches confirm this point (whereas very few show that spelling). Applicant has simply added a space as a way to create a difference in the marks and looks like they intentionally misspelled the word.
- (6) Registrant origin: The Applicant claims that **KUMOSABE** evokes a Japanese origin and provides “proof” with a few of Japanese restaurants are named **KUMO** to try to distinguish between that and **KIMO**. The Registrant notes in the trademark application that “The wording “**KUMOSABE**” has no meaning in a foreign language” and as such does not evoke Japanese origin. The Applicant cannot generalize that a few restaurants with the first part of the Registered Mark constitutes universal belief in the etymology of the word. In fact, on a simple internet search the restaurant **KIMO’S MAUI** came up, which is a Japanese inspired

restaurant based in Maui. Based on the line of thinking proposed by the Applicant, **KIMO** must then evoke Japanese. This line of thinking is simply flawed and completely biased to try to create an argument where there is no argument. Incidentally, **KIMO** means nothing in the English language – that simple fact means there will inevitably be confusion.

- (7) Applicant idea: The fact that the Applicant is looking to produce a mezcal and is communicating that it is something from the American Southwest is a completely fabricated and misleading story – mezcal is a distilled spirit produced in Mexico and has nothing to do with Tonto, the Lone Ranger or the American Southwest. This connection is false and misleading and should not be permitted on that basis. The Trademark Registry should not allow false and misleading brand names.

One of the cornerstone arguments but the Applicant is that “*the goods and services are not identical.*” The Applicant goes onto claim that “*both being alcoholic beverages*” and admits that both are in the same class of goods. This admission proves that the Applicant is fully aware they are trying to secure an already Registered Trademark. Amending the goods description to limit the goods with which the **KIMO SABLE** mark is associated to “*Distilled Spirits, namely mezcal*” should not be considered a valid argument as it dilutes the Registrant’s ability to extend its product line into other categories. The Registrant has the right to expand the Registered Trademark to cover other categories within IC 033. Many other registrants have filed trademark applications and have brands within IC 033 that are in different categories within that class that are covered by the same trademark. This includes Registered Trademarks for wine and spirits, spirits and ready to drink cocktails, spirits and liqueurs, and different spirits. In every case, those products were not introduced at the same time but over time allowing the registrants to leverage their existing trademarks – here are just a few of the countless examples on the registrar:

(1) Cupcake (wine brand) and Cupcake (vodka brand) are both marketed in IC 033. The wine was first introduced and later the vodka was introduced.

(2) Skinnygirl (ready to drink cocktails), Skinnygirl (vodka brand) and Skinnygirl (wine brand) are all marketed in IC 033. The ready to drink cocktail was first introduced followed by the vodka line and then the wine line.

(3) Bacardi (rum brand) and Bacardi Silver (low alcoholic malt based ready to drink) are both marketed in IC 033. The rum was first introduced and then the low alcoholic malt based drink.

(4) Jack Daniel’s (whiskey brand), Jack Daniel’s Honey (liqueur) and Jack Daniel’s Tennessee Fire (liqueur) are all marketed in IC 033. The whiskey was first introduced followed by the liqueurs.

(5) Van Gogh Blue (vodka brand) and Van Gogh (gin brand) are both marketed in IC 033. The gin was first introduced followed by the vodka line.

Another argument proposed by the Applicant is that wines, spirits and cocktail mixes are merchandised in separate locations of retail stores. In each of the cases above (Cupcake, Skinnygirl, Bacardi, Jack Daniel’s and Van Gogh), the Registered Trademarks can be found in different sections of the same store and that simple fact serves as a way to increase brand equity across the retail store. The argument that the Applicant makes regarding sake and mezcal being different categories is a meaningless argument and completely disproven by countless examples of Registered Trademarks that cross categories (wines and spirits and liqueurs and ready to drink cocktails). Further illustrating this point, the Registrant will soon introduce a new hybrid line extension under the **SABLE** brand name that is a blend of sake and tequila. The line extension has been in development for nearly three years and has

successfully received federal formula and label approvals from the TTB. The Registrant owns the Trademark and the Applicant's proposed trademark would seriously harm this line extension.

Regarding **KIMO SABLE** and how that conflicts with **SABLE SAKE** and **KUMOSABLE** is best seen through examples. Looking at different examples further illustrates Registrant points – the first example relates to the **SABLE SAKE** trademark compared to the **GREY GOOSE VODKA** trademark; the second example relates to the **KUMOSABLE** trademark compared to the **GREY GOOSE** trademark. Grey Goose is a vodka brand that has achieved wide success in the alcoholic beverage space and serves as a perfect example as it has been granted trademark protection for different word combinations.

EXAMPLE #1 – class of goods in the word mark

(1) **GREY GOOSE VODKA** (Serial No 78827853, Registration No 3274676).

IC was 033. US 047 049. G & S: Vodka.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE VODKA APART FROM THE MARK AS SHOWN.

(2) **SABLE SAKE** (Serial No 77886662, Registration No 3935384).

IC 033. US 047 049. G & S: Distilled Spirits; Distilled spirits of rice (awamori); Gin; Japanese white liquor (shochu); Liqueurs; Potable spirits; Sake; Spirits; Spirits and liqueurs; Vodka

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE SAKE APART FROM THE MARK AS SHOWN.

CONCLUSION: Had Applicant filed a trademark application for **KIMO GREY GOOSE** and claimed that there would be no confusion because Applicant planned to market mezcal, the application would be denied registration based on likely confusion – yet this is the basis of Applicant argument. Substitute **SABLE** for **GREY GOOSE**. The fact that **SABLE** means nothing in the English language further validates the Registrant's argument.

EXAMPLE #2 – no class of goods in the word mark

GREY GOOSE (Serial No 74700966, Registration No 2095678).

IC was 033. US 047 049. G & S: Vodka.

KUMOSABLE (Serial No 77626023, Registration No 3926153).

IC 033. US 047 049. G & S: Distilled Spirits; Distilled spirits of rice (awamori); Gin; Japanese white liquor (shochu); Liqueurs; Potable spirits; Sake; Spirits; Spirits and liqueurs; Vodka

CONCLUSION: Had Applicant filed a trademark application for **GREEDY GOOSE** (adding two letters which is similar to changing one and adding a space) and claimed there would be no confusion with **GREY GOOSE**, the application would be denied registration based on likely confusion – yet this is the basis of Applicant argument between **KIMO SABLE** and **KUMOSABLE**. In fact, **GREEDY GOOSE** (Serial No 79061737) was denied registration. The fact that **KUMOSABLE** means nothing in the English language further escalates the Registrant's argument.

There is no debate that the marks are confusingly similar taken together or separately. The argument made regarding the differences between the goods has been refuted with repeated examples. The difference in channels of trade has been refuted by the same repeated examples. Based on the immense evidence, the Registrant strongly objects to the Applicant's proposed mark and submits that not only is there likelihood of confusion between multiple Registered Trademarks, but the Registrant will suffer as a result of the proposed registration. The Applicant's response is completely without merit. The Registrant has spent years and considerable capital in developing the **SABE SAKE** and **KUMOSABE** brands under the protection of its Registered Trademarks in which the product line is available for sale in more than 40 states. Whatever brand equity has been achieved will be harmed by Applicant's proposed mark.

We believe in the review process and have confidence that this registration will be blocked from registration on the Trademark Registry for the many reasons outlined in this Notice of Opposition. Should any clarification be need, feel free to contact at your convenience. Should the Registrant need to engage an attorney to pursue this matter further, it will do so.

By	Jim Andrews
Signature	/Jim Andrews/
Title	Founder & CEO, Wasabe Beverages Inc
Date	4/2/2015