

ESTTA Tracking number: **ESTTA857864**

Filing date: **11/13/2017**

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

Proceeding	87046141
Applicant	Brickhouse Tavern, LLC
Applied for Mark	BREWUS' BRICKHOUSE
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Submission	Appeal Brief
Attachments	2017-11-13 Appeal Brief BRIC-011.pdf(443273 bytes)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Matter: In re Brickhouse Tavern, LLC
Applicant: Brickhouse Tavern, LLC
Mark: BREWTUS' BRICKHOUSE
Serial Number: 87/046,141
Date Filed: May 22, 2016
Examining Attorney: Sally Shih
Law Office: 106
Attorney Docket No.: BRIC-011

APPLICANT'S APPEAL BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

FACTS

Applicant hereby submits its brief in support of its appeal from the final refusal to register Applicant's Mark BREWTUS' BRICKHOUSE for "Restaurant and bar services" in International Class 43. The application for the mark BREWTUS' BRICKHOUSE, United States Trademark Application Serial Number 87/046,141, was filed with the United States Patent and Trademark Office on May 22, 2016 ("the Present Application").

Upon reviewing the Present Application, in an Office Action dated September 8, 2016, the Examining Attorney initially refused registration of Applicant's Mark under Trademark Act Section 2(d), 15 U.S.C. 1052(d), citing the following United States Trademark Registrations: (1) Registration No. 3,349,634 for the mark BRICK HOUSE SUBS covering "restaurant services"; (2) Registration No. 3,815,051 for the mark BRICK HOUSE TAVERN + TAP covering "bar services"; (3) Registration No. 3,815,053 for the mark BRICK HOUSE TAVERN + TAP (and Design) covering "bar services"; (4) Registration No. 4,943,731 for the mark BRICK HOUSE TAVERN + TAP covering "restaurant services"; and (5) Registration No. 4,797,136 for the mark BRICKHOUSEBREWERY covering "bar and restaurant services". *September 8, 2016 Office Action, TSDR.*

Applicant responded to the first Office Action on March 6, 2017 by arguing a lack of likelihood of confusion. *March 6, 2017 Response to Office Action, TSDR.* After considering Applicant's arguments, the Examining Attorney issued an Office Action dated March 28, 2017, which made the likelihood of confusion refusal final. *March 28, 2017 Office Action, TSDR.*

On September 14, 2017, Applicant filed a Notice of Appeal of the refusal to register the Applicant's Mark with the Trademark Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office ("USPTO"). *September 14, 2017 Notice of Appeal, TSDR.*

Pursuant to the TTAB's September 14, 2017 Order, Applicant now files its brief in support of the appeal of the refusal to register its mark BREWTUS' BRICKHOUSE.

STATEMENT OF THE ISSUES

At issue is whether consumers are likely to confuse Applicant's Mark BREWTUS' BRICKHOUSE for "restaurant and bar services" with respect to the following commonly-owned Trademark Registrations: (1) Registration No. 3,349,634 for the mark BRICK HOUSE SUBS covering "restaurant services"; (2) Registration No. 3,815,051 for the mark BRICK HOUSE TAVERN + TAP covering "bar services"; (3) Registration No. 3,815,053 for the mark BRICK HOUSE TAVERN + TAP (and Design) covering "bar services"; (4) Registration No. 4,943,731 for the mark BRICK HOUSE TAVERN + TAP covering "restaurant services"; and (5) Registration No. 4,797,136 for the mark BRICKHOUSEBREWERY covering "bar and restaurant services" (collectively referred to herein as "the Brickhouse Registrations").

ARGUMENTS

Applicant's and Registrant's marks are distinguishable, both visually and verbally, and have vastly different connotations. Additionally, the Examining Attorney has failed to conduct even a minimal analysis of the comparison between the Applicant's Mark and those of the Registrant – completely ignoring an entire, dominant term in the Applicant's Mark. For at least these reasons, Applicant's Mark is entitled to registration.

A. The Likelihood of Confusion Standard

In *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973), the Court of Customs and Patent Appeals enumerated several factors to be weighed in a Section 2(d) likelihood of confusion analysis. When conducting its likelihood of confusion analysis, the TTAB must consider all *du Pont* factors for which there is evidence in the record. *Han Beauty Inc. v. Alberto-Culver Co.*, 57 USPQ2d 1557 (Fed. Cir. 2001). As discussed in greater detail below, in this case, the *du Pont* factor most relevant to this case is the dissimilarity of the marks in their entireties. *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567; *See also In re Majestic Distilling Cop., Inc.*, 65 USPQ2d 1201 (Fed. Cir. 2003). Each case must be decided on its own facts and any one *du Pont* factor may be dispositive in a confusion inquiry. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 47 USPQ2d 1459 (Fed. Cir. 1998).

It is well settled that marks should be viewed in their entireties and that it is improper to dissect a mark. *In re Shell Oil Co.*, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). The marks at issue must be compared in their entireties as to appearance, sound, connotation, and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689 (Fed. Cir. 2005). Furthermore, it is the impression that the mark creates as a whole on an average buyer, and not

the parts of the mark, which his important. *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985). In addition, the Board has noted that no element of a mark is ignored simply because it is less dominant or would not have trademark significance if used alone. *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991).

B. The Examiner Has Not Analyzed the Marks

The Applicant believes that its mark BREWTUS' BRICKHOUSE, in light of the differences in sight, sound, and meaning between Applicant's Mark and the Registrant's Marks, is not sufficiently similar to BRICKHOUSE TAVERN + TAP, BRICKHOUSE BREWERY, or BRICKHOUSE SUBS so as to be likely to cause confusion, to cause mistake, or deceive based on Trademark Act Section 2(d). The addition of the term "BREWTUS'", which is not present in any of the Registrant's Marks, serves to distinguish the sight, sound, and connotation of the Applicant's Mark when compared to the Registrant's Marks.

If properly analyzed as a whole, it should be found that the Applicant's Mark raises an entirely different commercial impression than the Registrant's Marks. Applicant has pointed out differences in sight, sound, and meaning, as to each of the Registrant's Marks, in Applicant's response to the Examining Attorney's refusals. Applicant wishes now to incorporate its comments and analysis, which are part of the record in this Appeal, for consideration by the Board.

The Court of Appeals for the Federal Circuit has provided the following guidance for evaluating marks in their entirety under the likelihood of confusion standard: "The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on

dissection of a mark, that is, on only part of the mark.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). It is well settled that a mark should not be dissected but rather must be considered as a whole in determining likelihood of confusion. *Franklin Mint Corp. v. Master Manufacturing Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981).

The Examining Attorney has issued two refusals in this case: a first refusal on September 8, 2016 and a second refusal on March 28, 2017. In both of the refusals, the Examining Attorney has completely abrogated her responsibility to actually compare and analyze the Applicant’s Mark as compared to the Registrant’s Marks. The Examining Attorney has treated the Applicant’s Mark as encompassing only the term “BRICKHOUSE”, and completely ignored the existence of the additional term “BREWTUS” which, as discussed herein and previously in Applicant’s Response to the September 8, 2016 refusal, significantly alters the sight, sound, and meaning of the Applicant’s Mark with respect to the Registrant’s Marks.

From reading the Examiner’s refusals, one would not fault a reader for failing to notice that the term “BREWTUS” is present at all in the Applicant’s Mark. In the September 8, 2016 refusal, the sole mention of the term “BREWTUS”, other than in the header, is the sentence “[i]n the present instance, the proposed mark is BREWTUS’ BRICKHOUSE for restaurant and bar services”. *September 8, 2017 Office Action, TSDR, p. 2.*

In the March 28, 2017 refusal, other than the headers and the above-referenced sentence which was copied from the previous refusal, the Examiner’s sole mention of the term “BREWTUS” comes in the form of a response to the Applicant’s arguments. *March 28, 2017 Office Action, TSDR, p. 2.* The Examining Attorney merely repeats the word “BREWTUS”

when referencing Applicant's previous arguments and again conclusively finding that "the marks are similar" without any actual analysis. *March 28, 2017 Office Action, TSDR p. 2.*

In the examination before registration, Applicant had a right that its mark be considered as a whole, and that the term "BREWUS" not be ignored. The Examining Attorney has not compared these marks in their entireties. In fact, it could be argued that she has not compared these marks at all. The entirety of the Examiner's "analysis", other than quoting various cases, is the following conclusory statement: *"The proposed mark and the registered marks share the common significant phonetic equivalent terms of BRICKHOUSE and BRICK HOUSE. Furthermore, the services offered by the registrant and applicant are closely related, even identical."* *September 8, 2017 Office Action, TSDR, p. 3.*

Applicant is entitled to an analysis which takes into account the Applicant's Mark in its entirety, without completely ignoring the dominant term in the Applicant's Mark. As discussed below, had the Examining Attorney properly analyzed these marks, she would have found no likelihood of confusion due to a dissimilarity between the marks.

C. Dissimilarity of the Marks.

As the Applicant has previously argued, the inclusion of the term "BREWUS" in the Applicant's Mark serves to alter the appearance, sound, and connotation of the Applicant's Mark in a manner which has an effect on its commercial impression. Each of the Registrant's Marks includes the dominant term "BRICK HOUSE". While the Applicant's Mark also includes this term (the only term which is shared with any of the Registrant's Marks), the addition of the term "BREWUS" alters the commercial impression.

As to the appearance of the respective marks, it is abundantly clear that the Applicant's Mark includes a term (BREWUS') which is absent from the Registrant's Marks, and that each

of the Registrant's Marks include terms (TAVERN, TAP, BREWHOUSE, SUBS) which are absent from the Applicant's Mark. The Applicant's Mark is clearly distinguishable when compared in appearance to the Registrant's Marks due to its use of the "BREWTUS" term and its exclusion of the other terms present in the Registrant's Marks.

As to the sound of the respective marks, it should be evident that the Applicant's Mark has a distinguishable sound when spoken aloud as compared to any of the Registrant's Marks. As the Applicant's Mark includes the term "BREWTUS", which conveys ownership as discussed below, the focus of the Applicant's Mark would invariably be on that portion of the mark and not on the subject of ownership – "BRICKHOUSE". When spoken aloud, it is typically the possessive term which is given most prominence ("this is MY house" rather than "this is my HOUSE").

As to connotation, the possessive term "BREWTUS" alters the meaning of Applicant's Mark when compared with the Registrant's Marks. As pointed out by the Applicant in its March 6, 2017 response, the dominant term "BRICK HOUSE" is a common term across a range of industries. *March 6, 2017 Response to Office Action, TSDR, p. 5*. It has been used to reference a type of masonry used in building homes and can have a wide variety of connotations. The term has been associated with a wide range of brick-and-mortar establishments including restaurants. It is likely that a consumer would view the term as being suggestive of any establishment housed in a building – including restaurants or bars.

With that in mind, it is clear that the additional term "BREWTUS" in the Applicant's Mark alters its connotation by establishing a possessive ownership of the "BRICKHOUSE". As pointed out previously, the term "BREWTUS" is a play-on-words, combining both the word

“BREW”, which is used to describe the process of preparing beer or ale, as well as “BRUTUS”, which is a common name.

The use of an apostrophe conveys the meaning of ownership. Thus, a consumer would not view the Applicant’s Mark as being “a brickhouse”, but instead would view the Applicant’s Mark as being “*Brewtus*’ brickhouse”. The addition of a term conveying ownership or possession serves to alter the commercial impression of the Applicant’s Mark when compared with any of the Registrant’s Marks – none of which contain any such possessive term.

Applicant encourages the Board to review the Examining Attorney’s “analysis” in both refusals. The Examining Attorney’s failure to even make mention of a term which is prominent in the Applicant’s Mark and completely absent from the Registrant’s Marks is reversible error. Had the Examining Attorney properly analyzed the Marks, such as by making even a passing reference to the Applicant’s use of the term “BREWTUS”, it is likely that the Examining Attorney would have reached a different conclusion.

D. Conclusion.

For the foregoing reasons, it is submitted that the present application is in condition for allowance and publication, and the Applicant requests that the Board order that such action be taken on this application.



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