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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87046141

MARK: BREWTUS' BRICKHOUSE



CORRESPONDENT ADDRESS:

MICHAEL NEUSTEL

NEUSTEL LAW OFFICES LTD

2534 SOUTH UNIVERSITY DRIVE SUITE 4

FARGO, ND 58103

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Brickhouse Tavern, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

BRIC-011

CORRESPONDENT E-MAIL ADDRESS:

michael@neustel.com

EXAMINING ATTORNEY'S APPEAL BRIEF

I. STATEMENT OF THE CASE

Applicant has appealed the final refusal to register the proposed mark, BREWTUS' BRICKHOUSE, in standard character form, for use in connection with "restaurant and bar services." Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the proposed mark is likely to be confused with the marks in U.S. Registration Nos. 3349634, 3815051,

3815053, 3943731 and 4797136 (U.S. Registration No. 3349634 for the mark BRICK HOUSE SUBS, in standard character, form for use in connection with “restaurant services”, U.S. Registration No. 3815051 for the mark BRICK HOUSE TAVERN + TAP, in standard character form, for use in connection with “bar services”, U.S. Registration No. 3815053 for the mark BRICK HOUSE TAVERN + TAP, in special drawing form, for use in connection with “bar services”, U.S. Registration No. 3943731 for the mark BRICK HOUSE TAVERN + TAP, in standard character form, for use in connection with “restaurant services” and U.S. Registration No. 4797136 for the mark BRICKHOUSE BREWERY, in standard character form, for use in connection with “restaurant services.”) It is respectfully requested that the Trademark Act Section 2(d) refusal be affirmed.

II. FACTS

On May 22, 2016, Applicant filed the instant application seeking registration on the Principal Register of the proposed mark, BREWTUS' BRICKHOUSE, in standard character form, for use in connection with “restaurant and bar services.” In the first Office action, e-mailed September 8, 2016, registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that the proposed mark was likely to cause confusion with the marks depicted in U.S. Registration No. 3349634 for the mark BRICK HOUSE SUBS, in standard character, form for use in connection with “restaurant services”, U.S. Registration No. 3815051 for the mark BRICK HOUSE TAVERN + TAP, in standard character form, for use in connection with “bar services”, U.S. Registration No. 3815053 for the mark BRICK HOUSE TAVERN + TAP, in special drawing form, for use in connection with “bar services”, U.S. Registration No. 3943731 for the mark BRICK HOUSE TAVERN + TAP, in standard character form, for use in connection with “restaurant services” and U.S. Registration No. 4797136 for the mark BRICKHOUSE BREWERY, in standard character form, for use in connection with “restaurant services.”

Applicant filed a response to the refusal on March 6, 2017, submitting arguments against a likelihood of confusion with the cited marks. In an Office action e-mailed March 28, 2017, the Section 2(d) refusal citing U.S. Registration Nos. 3349634, 3815051, 3815053, 3943731 and 4797136 was maintained and made final.

III. ARGUMENT

THE PROPOSED MARK IS NOT ENTITLED TO REGISTRATION BECAUSE A LIKELIHOOD OF CONFUSION EXISTS WITH THE CITED REGISTERED MARKS

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrant. See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, “[n]ot all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis “on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services].” *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

1. The Marks Of The Parties Are Confusingly Similar

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); TMEP §1207.01(b).

In the present instance, the proposed mark is BREWTUS' BRICKHOUSE, in standard character form, and the registered marks are BRICK HOUSE SUBS in which the word SUBS has been disclaimed, in standard character form; BRICK HOUSE TAVERN + TAP in which the wording TAVERN + TAP has been disclaimed, in standard character form; BRICK HOUSE TAVERN + TAP in which the wording TAVERN + TAP has been disclaimed, in special drawing form, BRICK HOUSE TAVERN + TAP in which the wording TAVERN + TAP has been disclaimed, in standard character form, and BRICKHOUSEBREWERY in standard character form.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's services is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

The proposed mark and the registered mark share the common significant term BRICKHOUSE. The only differences in the marks is the term BREWTUS' in the proposed mark and the disclaimed matter in the registered marks.

Applicant argued that the term BREWTUS' in the proposed mark alters the common commercial of the marks.

The term BREWTUS does not distinguish the proposed mark from the cited marks because all the cited marks contain additional wording such as SUBS, TAVERN + TAP and BREWERY in addition to the wording BRICK HOUSE or BRICKHOUSE. An average consumer is likely to perceive the restaurant and bar services are offered from the same source as the restaurant and bar services offered by registrant.

Then, applicant argued that “the term “BRICK HOUSE” is a common term across a range of industries.”

It appears that applicant is implying that the wording BRICK HOUSE and its phonetic equivalent term BRICKHOUSE are weak or diluted. Please note that all cited registrations are owned by the same party.

Moreover, assuming arguendo that the said wording is weak, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for closely related services. TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010). Thus, this protection under Section 2(d) extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1743 (TTAB 2016) (citing *Towers v. Advent Software, Inc.*, 913 F.2d 942, 946, 16 USPQ2d 1039, 1042 (Fed. Cir. 1990); *In re Research & Trademark Corp.*, 793 F.2d 1276, 1278, 230 USPQ 49, 49 (Fed. Cir. 1986); *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978)).

Accordingly, the proposed mark and the registered mark are confusingly similar.

2. The Services Of The Parties Are Highly Related

The compared services need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000);

Recot, Inc. v. Becton, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i).

They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

The overriding concern is not only to prevent buyer confusion as to the source of the 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. 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, 1026 (Fed. Cir. 1988).

In the present instance, both applicant and registrant offer restaurant and bar services. Moreover, the services of the parties are not limited to any particular trade channel. Where the services of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Accordingly, the services offered by the applicant and the registrant are related and likely to be encountered by the same consumers in the same channels of trade.

III. CONCLUSION

Consumers encountering the proposed mark, BREWTUS' BRICKHOUSE, in standard character form, for use on or in connection with “restaurant and bar services” used simultaneously with the U.S. Registration No. 3349634 for the mark BRICK HOUSE SUBS, in standard character, form for use in connection with “restaurant services”, U.S. Registration No. 3815051 for the mark BRICK HOUSE TAVERN + TAP, in standard character form, for use in connection with “bar services”, U.S. Registration No. 3815053 for the mark BRICK HOUSE TAVERN + TAP, in special drawing form, for use in connection with “bar services”, U.S. Registration No. 3943731 for the mark BRICK HOUSE TAVERN + TAP, in standard character form, for use in connection with “restaurant services” and U.S. Registration No. 4797136 for the mark BRICKHOUSEBREWERY, in standard character form, for use in connection with “restaurant services” are likely to mistakenly conclude that the services are related and originate from a common

source. Accordingly, it is respectfully requested that the refusal to register under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

/Sally Shih/

Sally Shih

Trademark Examining Attorney

Law Office 106

United States Patent & Trademark Office

571-272-9712

sally.shih@uspto.gov

Mary I. Sparrow

Managing Attorney

Law Office 106