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Subject: U.S. Trademark Application Serial No. 88371684 - SWEETWATER - N/A - Request for Reconsideration Denied - Return to TTAB

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United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 88371684

Mark: SWEETWATER

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Applicant: SWEETWATER BREWING COMPANY, LLC

Reference/Docket No. N/A

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REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: **May 10, 2021**

Applicant's request for reconsideration is denied. *See* 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling

evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Applicant has requested registration of the configuration mark comprising of a tap handle for dispensing beer and ale in the shape of a trout with stylized splash of water at the tail end of the trout and below this the words "SWEETWATER" for "ale; beer" in Class 32.

On September 16, 2020, the examining attorney maintained and made final a refusal of registration for the following reasons:

- Proposed alteration of the mark drawing is a material alteration and not accepted,
- Requirement for an amended drawing of the mark to include all the wording and remove matter not part of the mark, and
- Requirement for an amended mark description to include all the elements of the drawing.

MATERIAL ALTERATION OF MARK DRAWING

In applicant's Request for Reconsideration filed March 16, 2021, applicant argues that removal of distinctive elements from the mark drawing does not constitute a material alteration because the remaining elements of the mark are still distinctive. Applicant agrees that the mark and the wording SWEETWATER is distinctive. However, applicant argues that portion of the tap handle containing the stylized trout and splash of water is what is seen by the public to identify the applicant's beer and ale and thus in a sense discrete and separable from the rest of the tap handle that functions on its own as a mark. And by contrast the wording SWEETWATER at the base of the tap handle is not readily apparent to the public. Therefore the removal of the wording SWEETWATER from the mark would not be a material alteration. The examining attorney is not persuaded.

The basis for the refusal is whether or not the proposed amendment to the mark would constitute a material alteration of original drawing, and not as applicant appears to believe whether or not the proposed amended mark with parts of the mark removed is still distinctive or functional.

The USPTO cannot accept the proposed changes because they would materially alter the mark in the drawing filed with the original application or as previously amended. 37 C.F.R. §2.72(a)(2), (b)(2); TMEP §807.14. Accordingly, the proposed amendment will not be entered; the previous drawing of the mark will remain operative and the initial drawing is still not acceptable. See TMEP §807.17.

The original drawing shows the mark as a three-dimensional configuration comprising of a tap handle for dispensing beer and ale in the shape of a trout with a stylized splash of water at the tail end of the

trout and the proposed word “SWEETWATER” on the base of the handle. The proposed amended drawing would eliminate the word “SWEETWATER” from the drawing of the mark.

The USPTO cannot accept an amendment to a mark if it will materially alter the mark in the drawing filed with the original application, or in a previously accepted amended drawing. 37 C.F.R. §2.72(a)(2), (b)(2); TMEP §807.14. An amendment to the mark is material when the USPTO would need to republish the mark with the change in the USPTO [Trademark Official Gazette](#) to fairly present the mark to the public. *In re Thrifty, Inc.*, 274 F.3d 1349, 1352, 61 USPQ2d 1121, 1123-24 (Fed. Cir. 2001) (citing *In re Hacot-Columbier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997)); TMEP §807.14.

That is, an amendment is material if the altered mark does not retain “the essence of the original mark” or if the new and old forms do not “create the impression of being essentially the same mark.” *In re Hacot-Columbier*, 105 F.3d at 620, 41 USPQ2d at 1526 (quoting *Visa Int’l Serv. Ass’n v. Life-Code Sys., Inc.*, 220 USPQ 740, 743-44 (TTAB 1983)); *see, e.g., In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000) (amendment from “TACILESENSE” to “TACTILESENSE” a material alteration); *In re CTB Inc.*, 52 USPQ2d 1471, 1475 (TTAB 1999) (amendment of TURBO with a design to just the typed word TURBO without design a material alteration – Specifically stating that “the deletion of matter from a mark should be evaluated according to the same standard as a proposed addition to the mark” and finding that “the swirling cyclone design in the instant case has to be deemed to be distinctive matter” and to delete it from the mark would be a material alteration.).

In the present case, applicant’s proposed amendment would materially alter the mark in the drawing filed with the original application or as previously amended because it would remove the distinctive wording SWEETWATER from the mark and thus changing the essence of the original mark.

AMENDED DRAWING OF THE MARK

Because the proposed drawing amendment is refused, the original drawing of the mark will remain operative which is still not acceptable and thus the applicant is required to submit an acceptable amended new drawing for the two reasons outlined below.

First, applicant must submit a new drawing showing the grey shading at the top of the drawing deleted from the mark because this matter is not part of the mark. *See* 37 C.F.R. §2.72; TMEP §§807.02, 807.14(a).

Second, the wording "SWEETWATER" does not appear in full on the mark although it is referenced in the mark description and appears to be part of the mark. Therefore, applicant must submit a new drawing showing the mark with the word "SWEETWATER" in full.

If the mark cannot be adequately depicted in a single rendition, applicant must file a petition to the Director requesting that the requirement to provide a single rendition of the mark be waived. TMEP §§807.10, 1202.02(c)(iv).

Alternatively, the applicant may choose to keep the single rendition of the mark and submit a new drawing removing the grey shading, however, an amended mark description must be provided describing only the visible letters in the mark, namely, "EETA" and not the full wording "SWEETWATER" as proposed below.

AMENDED DESCRIPTION OF MARK REQUIRED

The proposed drawing amendment is refused for the reasons discussed above, thus the proposed amended mark description removing the wording "SWEETWATER" is also refused and the original mark description will remain operative which is still not acceptable. Applicant is therefore required to provide an acceptable amended mark description.

Applicant has applied for a three-dimensional mark; however, applicant did not include a sufficient description of the mark in the application. Therefore, applicant must provide a clear, concise, and complete description of the mark that does the following:

- (1) Indicates the mark is a three-dimensional configuration of the goods or packaging or of a specific design feature of the goods or packaging.
- (2) Specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark.
- (3) Specifies any elements that are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.

See 37 C.F.R. §§2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii).

The following mark description is suggested:

The mark consists of a three-dimensional configuration comprising of a tap handle for dispensing beer and ale in the shape of an upward facing trout with a stylized representation of a splash of water at tail end of the trout **and the word "SWEETWATER" also** appearing at the base of the handle, all extending upward from the beer faucet. The broken lines depicting lower and back portion of the tap handle which attaches to the keg indicate placement of the mark on the goods and are not part of the mark.

Alternatively, if the applicant chooses to maintain the current elements of the drawing with a single rendition of the drawing showing only the letters "EETWA", the following description is suggested:

The mark consists of a three-dimensional configuration comprising of a tap handle for dispensing beer and ale in the shape of an upward facing trout with a stylized representation of a splash of water at tail end of the trout **and the letters "EETWA" also** appearing at the base of the handle, all extending upward from the beer faucet. The broken lines depicting lower and back portion of the tap handle which attaches to the keg indicate placement of the mark on the goods and are not part of the mark.

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated September 16, 2020 are **maintained and continued**:

- Material Alteration of Mark Drawing Refused
- Amended Drawing Requirement
- Amended Mark Description Requirement

See TMEP §§715.03(a)(ii)(B), 715.04(a).

If applicant has already filed an appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If applicant has not filed an appeal and time remains in the six-month response period, applicant has the remainder of that time to (1) [file another request for reconsideration](#) that complies with and/or overcomes any outstanding final requirement(s) and/or refusal(s), and/or (2) [file a notice of appeal](#) to

the Board. TMEP §715.03(a)(ii)(B). Filing a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §715.03(c).

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