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Subject: 76604592

Thank you.

/Susan Hayash/
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Attachment Information:

Count: 2

Files: Req Juris Russian Vodka.doc, Russian Vodka.doc

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S REQUEST FOR REMAND

The trademark examining attorney requests that the Trademark Trial and Appeal Board remand this case to the examining attorney under 37 C.F.R. §2.142(d) for the following reasons(s):

As shown by the attached proposed Office Action, a number of prior registrations and pending applications were not cited against the applicant. Also, a further explanation of the exercise of legitimate control over the applicant's proposed certification mark is warranted.

Respectfully submitted,

/Susan C. Hayash/
Senior Attorney
(J. Leslie Bishop, Managing Attorney)
Law Office 107
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/604592

MARK: RUSSIAN VODKA



CORRESPONDENT ADDRESS:

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RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Russian Federal Treasury Enterprise
Soju ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

4774

CORRESPONDENT E-MAIL ADDRESS:

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OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:

The Office has reassigned this application to the undersigned trademark examining attorney.

Upon further consideration of this application, the following refusals and requirements are made. The undersigned apologizes for any inconvenience this may cause.

Section 2(d) - Likelihood of Confusion Refusal

Registration of the proposed mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 1852552, 1987870, 2831128, 3042399, 3236313, and 3236314. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registrations.

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468

F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

Comparison of the Marks

The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii). Here, as demonstrated below, all the marks share the same wording, RUSSIAN VODKA, the entirety of the applicant's mark.

Applicant's mark: **RUSSIAN VODKA**

Registration No. 1852552: **STOLICHNAYA RUSSIAN VODKA** with design

Registration No. 1987870: **VODKA PSHENICHNAYA IMPORTED FROM RUSSIA DISTILLED AND BOTTLED IN THE RUSSIAN CRISTALL DISTILLERY IN MOSCOW ECOLOGICALLY PURE PRODUCT 40 ALC. VOL. (80% PROOF) 50 CL COOL BEFORE DRINKING RUSSIAN VODKA** with design.

Registration No. 2831128: **SIBERIAN ALTAY SURPRISE RUSSIAN VODKA PRODUCT OF RUSSIA** with design.

Registration No. 3012399: **SPECIAL QUALITY OPUSUHANOHAR PYCCKAR BOGKA GENUINE RUSSIAN VODKA** with design.

Registration No. 3236313: **STOLICHNAYA STOLI CRANBERI CRANBERRY FLAVORED RUSSIAN VODKA** with design.

Registration No. 3236314: **STOLICHNAYA STOLI CRANBERI CRANBERRY FLAVORED RUSSIAN VODKA** with design.

As stated before, all the registered marks contain the whole of the applicant's mark **RUSSIAN VODKA**. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded

greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii).

Additionally, the applicant's mark could be considered a deletion of the wording in the registrant's prior marks. The mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *See In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). In the present case, applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

As a result, the applicant's entire mark is contained in the prior registrations and therefore could be considered confusing. If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b).

Comparison of the Goods/Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Applicant's mark RUSSIAN VODKA is a certification mark for vodka. Applicant is certifying that the goods meet its standards and originate from the Russian Federation.

All of the prior registrant's goods are for vodka or vodka-based beverages.

The applicant's certification mark is obviously related to the registrant's goods, in that the applicant presumably would be certifying that all of the prior registrant's goods were produced in the Russian Federation to the standards set by the applicant. The fact that the

goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein.

Although the trademark examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

Applicant should note the following additional potential ground for refusal.

Prior Pending Applications

Information regarding pending Application Serial Nos. 74614297, 78074001, 78347467 and 78360937 is enclosed. The filing dates of the referenced applications precede applicant's filing date. There may be a likelihood of confusion under Trademark Act Section 2(d) between applicant's mark and the referenced marks. If one or more of the referenced applications registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed applications.

If applicant believes that there is no potential conflict between this application and the earlier-filed applications, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

Upon receipt of applicant's response resolving the following requirement(s), action on this application will be suspended pending the disposition of Application Serial No(s). 74614297, 78074001, 78347467 and 78360937. 37 C.F.R. §2.83(c); TMEP §§716.02(c) and 1208.02(c).

Requirements

Exercise of Legitimate Control Over Use of the Certification Mark

The application states that the applicant intends to exercise legitimate control over the use of the certification mark in commerce on or in connection with the goods. However, the existence of six (6) current U.S. Registrations and numerous other applications (copies attached of the registrations and some of the applications) for alcoholic beverages that include the proposed mark raises some doubt as to the existence of the applicant's control over use of the mark.

Therefore, the applicant must provide additional information for the record regarding how it exercises control over the use of the mark. The explanation should include a detailed disclosure of all relevant facts, and be supported by documentation, where

appropriate. 37 C.F.R. §2.61(b); TMEP 1306.06(g)(iii). The examining attorney will reconsider the above refusals and potential refusals to register if the applicant can show that they exercise legitimate control over the above stated registrations and potential registrations.

The applicant must also indicate whether all of the prior registrations and applications for alcoholic beverages that include the term RUSSIAN VODKA in the mark are owned by authorized users of the applicant's mark whose goods have been certified by the applicant as meeting the requirements of the certification standard included in this application. If the prior registrants are authorized users of the term RUSSIAN VODKA in the United States but are not subject to the certification standards included in the application, the applicant must supplement the application with the certification standards that are actually applicable to the authorized users in the United States.

Given the extensive use by others of RUSSIAN VODKA and the presence of several registered marks in the USPTO database with the term, many of which contain a disclaimer of RUSSIAN VODKA, the current explanation of control is insufficient.

Trademark Rule 2.61(b) states, "The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application." The Trademark Trial and Appeal Board has upheld a refusal of registration based on the applicant's failure to provide information requested under this rule. *In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990)(failure to submit patent information regarding configuration).

Pending proper response, registration is refused under Section 4 of the Trademark Act, 15 U.S.C. §1054, on the ground that applicant does not exercise legitimate control over the mark sought to be registered.

For Applicant's Information Only

To expedite prosecution of this application, applicant is encouraged to file its response to this Office action through the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov/teas/index.html>.

/Susan C. Hayash/
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RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should

be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

