

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Pensacola Bay Brewery, LLC  
MARK: RIPTIDE  
SERIAL NO.: 88262848  
CLASS: 033

Attn: Rachael Dickson  
Trademark Examining Attorney  
Law Office 125

**REQUEST FOR RECONSIDERATION FROM FINAL REFUSAL**

The Examining Attorney has issued a Final Office Action refusing to register Applicant's mark RIPTIDE for "whiskey" under Section 2(d) of the Trademark Act, citing Registration No. 5348454 for the mark RIPTIDE for "beer" and Registration No. 3673690 for the mark BREWDOG RIPTIDE for "beer, ale, lager, stout, pilsner, porter."

The Examining Attorney contends that confusion with the cited registrations is likely based on the similarity of the marks and the parties' goods. Applicant respectfully disagrees and requests the Examining Attorney's reconsideration. As discussed below, Applicant is the owner of cited Registration No. 5348454 for the mark RIPTIDE for "beer", and its RIPTIDE trademark in Registration No. 5348454 *was issued registration over* Registration No. 3673690 for the BREWDOG RIPTIDE mark, evidencing that the Patent and Trademark Office did not believe confusion is likely between the marks. Indeed, both the Trademark Trial and Appeal Board and the Federal Circuit have repeatedly held that the mere fact that marks contain the same term or element for the same or similar goods or services does not render them confusingly similar. That conclusion is further bolstered by the fact there have been no instances of actual confusion

between Applicant's RIPTIDE trademark in Registration No. 5348454 and the BREWDOG RIPTIDE mark in Registration No. 5348454 in over eight years of concurrent use. For the reasons more fully discussed below, Applicant therefore respectfully requests that the Examining Attorney withdraw the refusal to register and approve the applied-for mark for publication.

**I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND THE CITED MARKS**

The assessment of whether a likelihood of confusion exists between two marks is to be made on a case-by-case basis applying the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (CCPA 1973). The Examining Attorney bears the burden of showing that a mark falls within the statutory bar of Section 2(d). 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:75 at 19-228, 19-229 (4th Ed.); *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) ("The PTO has the burden of proving that a trademark falls within a prohibition of § 1052."). The Examining Attorney need not consider all factors, but may consider those factors that are most relevant to the case at hand. *In re Dixie Restaurants, Inc.*, 41 U.S.P.Q. 2d 1531, 1533 (Fed. Cir. 1997).

It is axiomatic that marks must be examined in their entirety. 4 *McCarthy* § 23:41 at 23-171 ("It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof that is important."); *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920) ("The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.").

Mere similarity or even *identity* between two marks can never alone be decisive of likelihood of confusion. As the court stated in *Jacobs v. Int'l Multifoods Corp.*, 212 U.S.P.Q.

641, 642 (CCPA 1982) (emphasis added), “[t]o establish likelihood of confusion a party must show *something more than that similar or even identical marks are used.*” Moreover, it is well-settled that even where two marks share a common term, the shared term by itself does not render the marks confusingly similar. “The use of identical, even dominant, words in common does not automatically mean that two marks are similar. ... [A] court must look to the overall impression created by the marks and not merely compare individual features.” *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987); *Steve’s Ice Cream, Inc. v. Steve’s Famous Hot Dogs*, 3 U.S.P.Q.2d 1477, 1478 (TTAB 1987) (STEVE’S for ice cream and STEVE’S and design for restaurant services held not confusingly similar).

The Board and the courts have repeatedly found that the mere fact that marks contain the same term or element for the same or similar goods and services does not render them confusingly similar. *Gruner + Jahr USA Publishing v. Meredith Corp.*, 26 U.S.P.Q. 2d 1583 (2d Cir. 1993) (holding “PARENTS” and “PARENTS DIGEST” for the same type of magazines not confusingly similar); *In re Ferrero*, 178 U.S.P.Q. 167 (CCPA 1973) (holding “TIC TAC” for candy not confusingly similar to “TIC TAC DOE” for ice cream); *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) (holding “VARGAS” and “VARGA GIRL”, both for calendars, sufficiently different so that there was no likelihood of confusion); *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (holding K+ and design and K+EFF (stylized), both for potassium supplements, not confusingly similar); *Howard Johnson Company v. The Ground Pat’i Inc.*, 214 U.S.P.Q. 214 (TTAB 1982) (holding “THE GROUND PAT’I” and design not confusingly similar to “THE GROUND ROUND” and design, both for restaurant services).

Thus, even where two marks contain one or more identical terms, slight differences in the appearance, sound, connotation, or commercial impression conveyed by the marks can be sufficient to dispel confusion. *Gen. Mills.*, 824 F.2d at 627 (“OATMEAL RAISIN CRISP” not confusingly similar to “APPLE RAISIN CRISP” both for breakfast cereal); *Consol. Cigar Co. v. RJR Tobacco Co.*, 491 F.2d 1265, 1267 (CCPA 1974) (“DUTCH APPLE” for pipe tobacco not confusingly similar to “DUTCH MASTERS” for cigars); *In re August Storck KG*, 218 U.S.P.Q. 823, 825-26 (TTAB 1983) (“JUICY 2” stylized not confusingly similar to “JUICY BLEND II” stylized); *Standard Brands Inc. v. Peters*, 191 U.S.P.Q. 168, 172 (TTAB 1975) (“CORN-ROYAL” for butter and margarine held not confusingly similar to “ROYAL” for liquid shortening and other food products).

As an initial matter, Applicant is the owner of cited Registration No. 5348454 for the mark RIPTIDE for “beer”. Respectfully, citation to Applicant’s Registration No. 5348454 for the RIPTIDE mark should therefore be withdrawn as a bar to registration of Applicant’s subject Application for the RIPTIDE mark for whiskey.

Further, Applicant’s Registration No. 5348454 for the RIPTIDE mark for beer was issued registration over Registration No. 3673690 for the BREWDOG RIPTIDE mark, clearly evidencing that the Patent and Trademark Office did not believe confusion is likely between the marks. Just as no confusion was considered likely between Applicant’s previously registered RIPTIDE mark for beer in Registration No. 5348454 and the BREWDOG RIPTIDE mark Registration No. 3673690, Applicant respectfully submits that there is no confusion between Applicant’s RIPTIDE mark whiskey and the BREWDOG RIPTIDE mark for beer.

As discussed above, both the Trademark Trial and Appeal Board and the Federal Circuit have repeatedly held that the mere fact that marks contain the same term or element for the same or related goods or services does not render them confusingly similar. Moreover, the conclusion that there is no likely confusion is further bolstered by the fact Applicant's RIPTIDE mark for beer and whiskey and the BREWDOG RIPTIDE mark have co-existed for many years without any known instance of actual confusion.

## II. CONCLUSION

For the reasons stated above, Applicant respectfully requests that the Examining Attorney withdraw the refusal under Section 2(d) and approve the subject Application for publication.

Dated: January 9, 2020

Applicant Pensacola Bay Brewery, LLC

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