

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Our File No. 2015-164)

Mark: PRL BEER)
)
Applicant: Polish Folklore Import Co., Inc.)
)
Serial No. 88/322,387)
)
Registration No. N/A)

I hereby certify that this correspondence is being filed electronically on this 15th day of May, 2020.

By: /Kevin J. Lahey/
Kevin J. Lahey

Diane Collopy
Examining Attorney
Law Office 107

May 15, 2020

Request for Reconsideration Following Examiner’s Final Office Action

Dear Ms. Collopy,

Applicant, Polish Folklore Import Co., Inc. (“PFI”) is in receipt of your Final Office Action dated November 15, 2019, having a deadline to respond of May 15, 2020. The final office action articulated the following singular issue as the basis for the refusal to register the Applicant’s mark in IC 032 (Beer):

(I) Section 2(d) Refusal to Register in IC 032 - Likelihood of Confusion with mark in IC 043

Applicant respectfully requests that you reconsider your refusal to register its desired standard character wordmark trademark application, PRL (the “applied-for mark”), as being likely to be confused with Registration No. 4,914,935 (the “registered mark” or “935 mark”), and in support thereof states as follows:

Registration for the above-identified standard character wordmark has been refused because of a likelihood of confusion with U.S. registration number 4,914,935

(hereinafter '935), which is a wordmark registered in IC 043 for a singular casino bar in Mississippi.

Applicant concedes that the applied-for mark and the '935 mark share the same standard characters, PRL. However, the likelihood of confusion is determined by focusing on the question whether the purchasing public would mistakenly assume that the applicant's goods originate from the same source, or are associated with, the goods in the cited registration. *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1314 (Fed. Cir. 2003).

In your Final Office Action, you state that to be considered confusing to the consumer, the marks only need to 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." (Final Office Action at pp 2-3, citing *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) (emphasis added)). Additionally, you state the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. (Final Office Action at p 3, citing *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)) (emphasis added).

Therefore, you ultimately held, upon encountering these marks and goods and services in commerce, consumers are likely to be confused and mistakenly believe that the goods and services emanate from a common source. (Final Office Action at p 3) (emphasis added).

Subsequent to filing its Response in November 2019 to your Non-Final Office Action issued in this Application, Applicant has since learned that the singular bar bearing the registered mark PRL at Scarlet Pearl Casino in Mississippi has been converted to a sportsbook and renamed the DraftKings at Scarlet Pearl Sportsbook. (See submitted evidence, which are screenshots taken from various webpages touting the change and showing the new sportsbook in place of the now-shuttered PRL Bar; the URL of each page is contained on the screenshot, and the undersigned hereby attests that all the screenshots were taken on Friday, May 15, 2020).

As the bar is no longer operating under the name PRL, there is no marketing bearing the registered mark. Nor is there any chance that a member of the purchasing public would encounter the registered mark in commerce at the casino. Moreover, buyer confusion is non-existent as there is not a bar service bearing the registered mark from which a buyer could purchase alcohol, specifically beer. To that end, it is now even less likely that anyone would confuse the source of the Applicant's beer with the owner of the registered mark.

Please note, the Applicant is making no statement whatsoever concerning the legitimacy of the registered mark. Applicant fully concedes that the registered mark remains valid in IC 043 (bar services) despite its current non-use. The Applicant merely stresses that the current non-use of the registered mark only strengthens its position that no likelihood of confusion exists in the eyes of the purchasing public regarding the source of its goods, beer in IC 032.

In light of the above arguments, Applicant respectfully requests that this mark be allowed in IC 032 (Beer).

Conclusion

As Applicant believes that the arguments set forth above and the evidence submitted hereto resolves the lone outstanding issue regarding likelihood of confusion, it respectfully requests that you reconsider your final refusal, and that its application for the wordmark 'PRL' be allowed in IC 032 (Beer).

Thank you for your time and reconsideration.

Best regards,

/Kevin J. Lahey/

Kevin J. Lahey
Attorney of Record, Illinois Bar Member