

I. Section 2(d) Refusal.

The Examining Attorney has refused registration based on a likelihood of confusion with the mark in U.S. Reg. No. 5536132.

The mark in Reg. No. 5536132 (the '132 Registration) is DR HOPS KOMBUCHA BEER and is registered for "beer, namely, kombucha beer, alcoholic kombucha tea" in Int. Class 032. The '132 Registration is owned by a California limited liability company named Dr Hops Kombucha Beer, LLC.

Applicant's mark is DOC HOPPS and the identification is "craft beers in Int. Class 032."

A. The DuPont Factors Weigh in Applicants Favor.

In *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals (CCPA) announced thirteen factors relevant for determining likelihood of confusion under §2(d). These factors are:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use);
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
9. The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
10. The market interface between applicant and the owner of a prior mark: (a) a mere “consent” to register or use, (b) agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party, (c) assignment of mark, application, registration and good will of the related business, or (d) laches and estoppel attributable to the owner of the prior mark and indicative of lack of confusion;
11. The extent to which the applicant has a right to exclude others from use of its mark on its goods;
12. The extent of potential confusion, i.e., whether *de minimis* or substantial.
13. Any other established fact probative of the effect of use.

See *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

No single factor is dispositive. However, Applicant believes that the *Du Pont* factors weigh in Applicant's favor and requests the Examiner reconsider and withdraw the Section 2(d) refusal.

B. The Marks Must Be Considered in their Entireties.

In comparing Applicant's and Registrant's marks, the marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. 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. See e.g., *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Dreyfus Fund, Inc. v. Royal Bank of Canada*, 525 F. Supp. 1108, 213 U.S.P.Q. 872 (S.D.N.Y. 1981) (quoting treatise); *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) ("[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark."); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) ("[I]n analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks

and not merely compare individual features.”); *Duluth News-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093, 38 U.S.P.Q.2d 1937 (8th Cir. 1996) (“Rather than consider the similarities between the component parts of the marks, we must evaluate the impression that each mark in its entirety is likely to have on a purchaser exercising the attention usually given by purchasers of such products.”).

A significantly different display of the same term or an addition of a distinctive element (i.e. term or design) can avoid a likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)). The use of a design as part of a mark minimizes any likelihood of confusion. *Harlem Wizards*, 952 F. Supp. At 1096 (citing McCarthy at §23:15[5]). See also, *In re NBA Properties, Inc.*, 2000 TTAB LEXIS 863 (TTAB 2000) (when considered in their entireties, the marks differ in appearance and create distinctly different commercial impressions; applicant’s mark is a composite consisting of a word and a design, both of which must be considered in determining the overall commercial impression the mark conveys).

Applicant respectfully submits that the Examiner erred in failing to give due weight to the differences between Applicant’s Mark and the mark in the cited registration. “Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight.” *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, the Applicant sought to register VARGA GIRL for calendars. The Trademark Trial and Appeal Board refused registration in light of the prior registration VARGAS,

registered for posters, calendars, greeting cards" and related goods. On Appeal, the Federal Circuit reversed the Board's refusal.

The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component "girl." By stressing the portion "varga" and diminishing the portion "girl", the Board inappropriately changed the mark. Although the weight given the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word "girl". When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely. *Id.*

Similarly, Applicant's DOC HOPPS mark must be viewed in its entirety. Applicant respectfully submits that the term DOC HOPPS is an alliteration that makes the mark fun to say and easy to remember. It rolls off a customer tongue and creates playful imagery. In addition, the term DOC is a nickname that adds to this lighthearted idea. The overall commercial impression is completely different than that of the Registrant's mark. Registrant's mark is formal and traditional. The use of DR indicates the use of the whole word DOCTOR, which is what a consumer will assume. When looking at the whole mark, DR HOPS KOMBUCHA BEER, it gives the impression of a specific person who has created this product, namely a doctor. This mark conveys a proper image, one that is not fun or lighthearted. When the two marks are viewed side by side, it is clear that a consumer would never assume they come from the same source. They give completely different ideas, feelings, and emotions when viewing

