

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re Application of:

APPLICANT	Rubin Wines LLC
MARK:	SYMPHONY
SERIAL NO.	88/359,661
MAILING DATE:	June 4, 2019
ATTORNEY:	James Ringle Law Office 111

RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. §2.62

Rubin Wines LLC (“Applicant”) offers the following remarks in response to the Examining Attorney’s Office Action dated June 4, 2019, concerning the application referenced above.

SECTION 2(D) OBJECTION: PRIOR REGISTERED MARKS AND PENDING APPLICATIONS

The Examining Attorney has refused registration of Applicant’s SYMPHONY mark on the grounds there is a potential likelihood of confusion with three prior pending applications and one prior registered mark. The cited marks are (collectively the “Cited Marks”):

A. OBSESSION SYMPHONY & Design, Registration No. 5,064,697, owned by Kautz Vineyards, Inc., for use in connection with “wine” (the “Kautz Mark” or the “Cited Registration”); and

B. CHALFONTE SYMPHONY, Application No. 87/711,710 owned by Chatam International Incorporated for use in connection with “Alcoholic beverages, except beer; Cognac”; and

C. SYMPHONY FARM, Application No. 88/066,624, owned by Chatam International Incorporated for “Alcoholic beverages, except beer; Alcoholic egg nog”; and

D. ORIGINAL SYMPHONY FARM EGG NOG, Application No. 88/069,800 owned by Chatam International Incorporated, for “Alcoholic beverages,

except beer; Alcoholic egg nog” (collectively, the “Chatam Marks” or the “Cited Applications”).

Applicant respectfully submits that Applicant’s mark and the Cited Registration and Cited Applications are not confusingly similar for the following reasons:

Differences in Marks.

The Examining Attorney has refused registration of Applicant’s mark arguing it is highly similar to Registrant’s mark “because both marks are comprised of the same dominant portion: SYMPHONY.”

Applicant must respectfully disagree. The most prominent features of Registrant’s mark, as shown below, are the term OBSESSION and the large design element. The term “Symphony” is used in much smaller lettering beneath the two more prominent elements as, a secondary mark. In contrast, Applicant intends to use the term as a primary mark. As a result, Applicant’s mark is both visually and aurally different from the Kautz Mark.




Moreover, as depicted in the registration, it is highly unlikely that Registrant’s customers would refer to this wine as “Symphony” as opposed to “Obsession,” or perhaps, “Obsession Symphony” which virtually negates the possibility of consumer confusion.

The same is equally true of the Chatam Marks.”Chalfonte” is clearly the dominant element of the CHALFONTE SYMPHONY mark, and SYMPHONY FARM and ORIGINAL SYMPHONY FARM EGG NOG have entirely different commercial impressions from Applicant’s mark.

Co-Existing Marks on the Registry

The Cited Registration and the Cited Applications co-exist on the registry both with each other as well as with two other “Symph” marks. See chart below:

MARK	SN/RN	STATUS	CLASS/GOODS	OWNER
ORIGINAL SYMPHONY FARM EGG NOG	App 88069800	NOA issued	Int. Cl. 33 Alcoholic beverages, except beer; Alcoholic egg nog	Chatam International Incorporated
SYMPHONY FARM	App 88066624	NOA issued	Int. Cl. 33 Alcoholic beverages, except beer; Alcoholic egg nog	Chatam International Incorporated
CHALFONTE SYMPHONY	App 87711710	NOA issued	Int. Cl. 33 Alcoholic beverages, except beer; Cognac	Chatam International Incorporated
	App 86326987 Reg 5064697	Registered	Int. Cl. 33 wine	Kautz Vineyards, Inc.
SYMPHONIC	App 87366314 Reg 5300853	Registered	Int. Cl. 32 beer	Wisacre, LLC
GOLDEN SYMPHONY	App 86018150 Reg 4806333	Registered	Int. Cl. 33 vodka	ALCONOST

The allowance of these multiple marks all within the alcohol beverage industry indicates that the SYMPHONY or SYMPH-formative term is entitled to a somewhat narrow scope of protection. *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996) (third party use of shared terms is evidence that consumers are conditioned to look to other portions of the mark in differentiating them); *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 867-68 (TTAB 1985) (a common feature of a mark is unlikely to have significant impact on consumers in terms of distinguishing source). At the very least, the PTO has not viewed any of the third-party marks as confusingly similar to each other.

Applicant respectfully submits that if these marks that contain SYMPHONY or a SYMPH-formative term, including the Kautz Mark and the Chatom Marks, can co-exist, then consumers have learned to distinguish the marks and the goods associated with them, and Applicant’s mark should be able to co-exist with the Cited Marks without causing confusion.

The Extent of Potential Confusion is De Minimis

A final factor that should be considered in this case is the extent to which there is likely to be confusion. It is well established that the law is not concerned with mere theoretical possibilities of confusion, deception, or mistake, but with the practicalities of the commercial world. *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403, 164 U.S.P.Q. (BNA) 43 (C.C.P.A. 1969). Applicant submits that the Examining Attorney's allegation of potential confusion is merely theoretical or at most *de minimis*. It is not consistent with trademark law to deny registration on this basis.

CONCLUSION

Likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely possible. *Estee Lauder, Inc. v. The Gap, Inc.*, 103 F.3d 1503, 42 U.S.P.Q.2d 1228, 1232 (2d Cir. 1997). *See also* 3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §23.3, at 23-13 (4th ed. 2000). “The test . . . is not whether confusion is possible; nor is it whether confusion is probable among customers who are not knowledgeable. Rather, the test, correctly stated . . . is whether confusion is probable among numerous customers who are ordinarily prudent.” *Estee Lauder*, 42 U.S.P.Q. at 1233-34. Here, there is simply no probability that ordinarily prudent customers of Applicant’s wine will believe there is any affiliation or connection between the source of these goods and those of the Cited Registrant or the Cited Applicant. There is therefore no likelihood of confusion under Trademark Act §2(d) to bar the registration of Applicant’s mark.

Applicant respectfully submits that due to the differences between the marks themselves there is no likelihood of confusion under Trademark Act §2(d) to bar the registration of Applicant’s mark. On the basis of the above Remarks, Applicant therefore requests that its application be approved for publication.

Respectfully submitted,

DONAHUE FITZGERALD LLP

Date: June 28, 2019

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