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Commissioner for Trademarks
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Re: U.S. Trademark Application No. 88/215,473
Mark: FLING
Filed: December 4, 2018
Response to Office Action mailed March 5, 2019

Dear Examining Attorney Webster:

This responds to the office action dated March 5, 2019 (the “**OA**”) addressed to Mr. Christophe Dupont with respect to U.S. trademark Application No. 88215473 regarding the trademark FLING (“**Applicant’s Mark**”). In filing this response, it is the intent of IPack SARL (the “**Applicant**”) to respond fully and completely to each and every issue raised in the OA. Any failure to do so is purely inadvertent.

In the OA, the examining attorney refused registration of Applicant’s Mark because of an alleged likelihood of confusion with (i) the mark in Reg. No. 3860525 in Class 32 for FLING (the “**Beer Mark**”) and (ii) the mark in Reg. No. 3409928 for FLING in Class 43 (the “**Bar Mark**”) pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d) and TMEP § 1207.01 *et seq.*

For the issue of likelihood of confusion, the examining attorney properly cites the decision in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). The court, in that decision, set forth an array of factors, the so-called “*du Pont factors*,” to be weighed in determining whether two marks, when applied to the applicable goods and/or services, are likely to deceive or cause confusion. The *du Pont* factors, indeed, are useful, but the ultimate question must not be forgotten, namely, “are consumers likely to be deceived or confused?” When one steps back and examines the respective channels of commerce, the

measures the parties themselves have taken to preclude confusion, the legal separation between the production of alcohol and its distribution (including at retail with bar services), and the enervated condition of FLING as a mark (from widespread use), it will be apparent that there is no likelihood of deception or confusion.

I. THE BEER MARK.

The examining attorney states:

In this case, the goods and/or services in the application and registration(s) are identical. Therefore, it is presumed that the channels of trade and class(es) of purchasers are the same for these goods and/or services.

This is, in fact, not the case. The Beer Mark covers “beer, ale, and lager” in Class 32. Applicant’s Mark covers canned, premixed cocktail drinks in Class 33. Although products in Class 32 and Class 33 have often been treated as “related,” they are not “identical.” Many consumers who consume beer would never drink a cocktail, and a number of cocktail drinkers would never drink beer.

Indeed, the owner of the Beer Mark and Applicant have **agreed that no confusion will exist**. On November 27, 2018, the owner of the Beer Mark, North American Breweries, Inc. (“NAB”), entered into a trademark co-existence agreement (the “**Agreement**”) with Applicant’s U. S. operating affiliate (and licensee), Boulevard Brewing Company (“**Boulevard**”). A copy of the Agreement is attached hereto as Exhibit A (and made a part hereof).

NAB, the party with the most to lose from consumer confusion, agreed as follows:

The Parties have concluded that consumer confusion is not likely to arise from the concurrent use of their respective marks in accordance with this Agreement, because such marks shall be used in connection with completely different products.

In Section 4 of the Agreement, the Parties covenant as follows:

The Parties will not intentionally use their respective marks or promote their goods in connection with their respective marks in a manner that is likely to cause confusion with the other Party's mark(s). Neither Party shall use or duplicate the other Party's trade

dress. Neither Party will suggest to any third party that there is an affiliation or association between itself and the other Party or the other Party's goods. The Parties will take reasonable measures and precautions to avoid any possible confusion in the marketplace between the goods offered by either Party under their respective marks or labels containing the word FLING, and the Parties agree to consult with each other in good faith should future conditions develop that would suggest to either Party the possibility that the Parties' respective marks or labels might be confused with each other. (Emphasis supplied)

Clearly, therefore, there is no likelihood of confusion between Applicant's Mark and the Beer Mark.

II. THE BAR MARK.

Having disposed of the Beer Mark, we next turn to the highly unusual refusal based on the Bar Mark in Class 43. Applicant and its affiliate, Brewery Ommegang Ltd., have filed applications for 241 trademarks in Class 32 and currently have 183 registrations in the United States, as shown on Exhibit B (attached hereto and made a part hereof). Applicant has never encountered a refusal based on bar services in Class 43, even though, until now, all of Applicant's products (and the products covered by the Beer Mark), beer, are commonly served in bars. The great irony is that a Class 43 bar services mark should now be cited in a refusal for Applicant's product least likely to be sold in a bar.

A. Legal Separation of Alcohol Production and Retail Sale.

Once one recognizes how the production, packaging, and distribution of alcohol is regulated in this country, it will become apparent that a producer of alcoholic beverages such as Applicant can never be confused with a provider of bar services, the two functions being separated by law. In the alcohol industry, the commercial source of alcoholic beverages and bar services are *compulsorily* antithetical and unrelated. The ratification of the Twenty-First Amendment in 1933 ended Prohibition and left the governance of the production and distribution of alcohol largely to the states. The result was a nationwide pattern of three-tier regulations intended to promote an orderly and competitive marketplace wherein the suppliers of alcoholic beverages first sell their

products to state-licensed wholesale distributors, which subsequently sell those products to state-licensed retailers such as bars, restaurants, and liquor stores. State and federal laws prohibit (with certain narrow exceptions) a supplier from vertically integrating into wholesale or retail distribution or from selling directly to consumers.

The Federal Alcohol Administration Act (27 U.S.C. § 201 *et seq.*), signed into law by President Roosevelt in 1935, prohibits certain unfair trade practices including ‘tied-house’ arrangements in order to protect retailer independence and promote consumer choice. A ‘tied-house’ describes the relationship where a supplier or distributor offers something of value or holds an interest that is used to control a retailer. Without the ‘three-tier’ system or ‘tied-house’ prohibitions, the largest alcohol suppliers could operate bars and liquor stores *directly* and exclude competitors’ products. Apart from the statutory exceptions that allow a licensed brewery to operate a taproom or a licensed winery or distillery to operate a tasting room/restaurant at its production facility,¹ consumers recognize alcoholic beverage suppliers do not operate bars and liquor stores, and, conversely, bars and liquor stores do not operate as alcoholic beverage suppliers. Consequently, consumers would not associate a bar with a beverage producer. Indeed, consumers would be astonished to learn that an alcohol producer had somehow managed to circumvent the eighty-five-year-old prohibition on producer/retailer ownership.

B. Antithetical, Not Related, Products/Services.

The Bar Mark is not for a beverage of any kind (alcoholic or otherwise). Rather, the Bar Mark is for services. In many ways, the products covered by Applicant’s Mark are antithetical to the services covered by the Bar Mark. The Bar Mark denotes the interaction between a human bartender and his/her patrons. It includes the care, customer service, and conversation that comes from mixing and serving at a bar. By contrast, Applicant’s products are formulated in a remote production facility and packaged in a can. Applicant’s products, in fact, **REPLACE** the bar services covered by the Bar Mark.

¹ It is this narrow exception to the above-referenced prohibition on the connection between alcohol production and alcohol distribution that accounts for the scant few examples of the operation of bars and restaurants by alcohol producers. Each and every example cited by the examining attorney is either a brewery taproom or a winery/distillery premises restaurant.

Contending that the Applicant’s products are related to the Bar Mark’s services is like arguing that a vinyl siding manufacturer is related to a house painter. No one would think that a vinyl siding manufacturer also sends out crews of house painters. They are antithetical to each other – just as bar services and cans of premixed cocktails are antithetical to each other. Ordinary consumers just will not think that there is some sort of affiliation or sponsorship relationship between the providers of the two.

C. **The Leap of Faith.**

The connection between bar services (furnished, by definition, in bars) and canned premixed cocktails, which are primarily sold in grocery and liquor stores, is made in the OA with virtually no analysis and no precedent. In fact, both the TTAB and the United States Court of Appeals for the Federal Circuit have warned that leaps of that magnitude (linking alcohol production to retail restaurant services) require genuine and substantial support.

The Federal Circuit, *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) held that beer and restaurant services were **not related, thus permitting** Coors to register BLUE MOON for beer, despite the existence of a registration for “Blue Moon” for restaurant services. That the marks themselves were identical and that some restaurants also sell beer under the same name as that of the restaurant were insufficient to establish likelihood of confusion. Judge BRYSON, speaking for the Court, said “something more”² was required. To establish that “something more,” the examining attorney offered, without success, the following:

- (1) A number of brewpubs are also restaurants,
- (2) Some restaurants that are not brewpubs nonetheless sell their own private label beer, and
- (3) Some businesses have obtained registrations for beer and restaurant services under the same mark.

Id. at 1342

In this regard, the Judge was following well-established precedent of the predecessor court. *In Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982), the predecessor court held that just because some restaurants serve food and beverages is not enough to render food and beverages related to restaurant services for purposes of determining likelihood of confusion.

In the present case, what the examining attorney HAS FOUND amounts to much less than what fell far short of the required “something else” in *Coors*. That there was a “very small number of . . . dual use registrations” tended to show, not that confusion was possible, but just the opposite, that confusion was unlikely. Here, the examining attorney has not found “a very small number of” dual use registrations; the examining attorney has found **NO INSTANCES of dual use registrations**.

In *Coors*, fewer than one in five hundred restaurants (counting brewpubs) produced and sold beer under the same name as that of the restaurant. One in five hundred, small as it is, still surpasses what the examining attorney has found in the present case. Out of the thousands and thousands of bars in this country, the examining attorney has found only three dubious instances of bars that also sell their own premixed canned cocktails. Rather than identifying “something more” that the *Coors* court requires; what exists here is “nothing more.”

in the case of *In re Nikolaos Mastorogiannakis* Serial No. 77858375 (August 1, 2012) (involving a conflict between MY BIG FAT GREEK RESTAURANT and MY BIG FAT GREEK WINE), the TTAB found that the “something more” required of the *Coors* court was demonstrated, and the magnitude of that demonstration stands in stark contrast to the nearly total absence of “something more” in the present case. The *In re Nikolaos Mastorogiannakis* panel stated:

To support her contention that "something more" exists in this case, the **examining attorney submitted 20 use-based, third party registrations** showing that, in each instance, a single entity has adopted the same mark for both wines and restaurant services.

The “something more” in the *Nikolaos Mastorogiannakis* case, also included fourteen websites promoting dual uses of the same name/mark for restaurant services and wine.

The twenty dual registrations for wine and restaurant services and the fourteen websites featuring, under the same name, wine and restaurant services, found in the *Nikolaos Mastorogiannakis* case contrasts sharply and tellingly with the **complete absence of dual registrations** in the present case and the meager three establishments that operate “bars” and sell canned premixed cocktails under the same mark.

The examining attorney found Uncle Billy's, Cutwater, and Southern Tier. The sheer paucity of evidence (three lonely instances), alone, should be enough to dispense with any notion of "relatedness," but we continue because even these purported instances of dual use, in fact, are false cognates. None of these is just a bar. They are all either brewery taprooms or winery/distillery on-premises restaurants,³ and they are all destinations offering a cavalcade of experiences, bar services being only one. If there is a relationship between canned premixed cocktails and any of these establishments, the relationship could as easily be between the canned cocktails and (i) a smokehouse linked to the persona of an early Texas settler (Uncle Billy's); or (ii) an avant-garde distillery (Cutwater); or (iii) a "farm to glass" brewery/distillery, the bar at Southern Tier distilling being in a brewery/distillery "tasting room."⁴

None of the establishments found by the examining attorney is a typical bar. Uncle Billy's, found on the Web at: <https://unclebillys.com> and in bricks and mortar in Austin, Texas, is a menagerie consisting of a smokehouse, distillery, and brewery. Uncle Billy's is described on its own Website as:

Uncle Billy's was named for Texas settler, William "Uncle Billy" Barton, who in the 1830s established a homestead on the land on the west bank of the Colorado River and the mouth of Spring Creek, the location that is now home to Barton Springs Pool. The name was chosen as a reflection of Barton's independent spirit, and the laid-back vibe of Austin.

The addition of canned cocktails came to Uncle Billy's in October 2018, around two months before Applicant's filing. These canned cocktails are new, strange, and part of the offering of an uncommon combination of a smokehouse restaurant, a distillery, and a brewery situated in

³ Each of these three falls squarely within the narrow exception (discussed above at Part 2.A) to the tri-level regulatory scheme that prohibits alcohol producers from also being retail providers.

⁴ This is not a bar that sells canned cocktails as a kind of tribute to or extension of the bar. Rather, this is a tasting room, where the distillery is showing off its distilled spirits. The linkage, if there is one, is between the distillery and the canned cocktails, not the canned cocktails to the bar, the bar being surely incidental. This is evident from the Website, which explains:

The Empty Bottle tasting room is a full-service cocktail bar, where we highlight every spirit in unique handmade cocktails. We also offer a range of wine and Southern Tier beers.

Playing off Southern Tier Brewery's "The Empty Pint", soon the distillery's "The Empty Bottle" was created. We began serving handmade cocktails following our guidelines of "farm to glass". Original cocktails recipes were created with fresh squeezed juices, Southern Tier spirits, and old faithful, our taste buds.

the heart of laid-back Austin. This is hardly the kind of situation that gives rise to an expectation. Indeed, its very strangeness seems to be the point.

Cutwater, found on the Web at: <https://cutwaterspirits.com> and in bricks and mortar in San Diego, California, like Uncle Billy's, is admittedly and proudly different. Located in laid-back San Diego, it consists of a restaurant that serves lunch, dinner, and happy hour appetizers. This is not a bar. It does produce and sell premixed cocktails, but again, this is not usual or part of a commonplace association that gives rise to any relatedness in the minds of consumers. This place and its founders pride themselves, not on being part of a pattern of conventional consumer expectations, but rather, as being true pioneers, pushing their way out front of or in a direction different from the crowd. Cutwater's Website states:

Whiskey, vodka, gin, rum, liqueur, mixers, canned cocktails, and beyond. We're always focused on the horizon, the road ahead. We're just hardwired that way. Armed with some heavy experience, hard earned awards, and boundless energy, we're charging ahead to carve out our place in the global spirits industry.

In 2016 our band of liquid pioneers began building one of the West Coast's largest new distilleries. What started as an off shoot of Ballast Point Brewing back in 2007, is now a completely separate company, facility, and product line. Our new home is a 50,000 square foot world class production facility in San Diego where our distillers can tap into their curiosity and creativity, build on tradition, all the while with their minds wide open to the unconventional.

Activities focused on the "horizon," that are actuated by "pioneers," and that are "wide open" and "unconventional" are not the stuff of which consumer associations and relationships are made. It is the habitual, customary, conventional, and ordinary that shape consumer expectations and that make goods and services "related." These examples found by the examining attorney do not furnish the "something more" to connect canned, premixed cocktails to bar services. These are not illustrations; they are aberrations, and aberrations do not build consumer expectations.

D. The Connection.

For the TTAB panel in *Nikolaos Mastorogiannakis* (the My Big Fat Greek case), citing a score of examples of dual registrations for wine and restaurants and finding fourteen dual use

instances on the Web, though contributing to a finding of the *Coors* “something more,” were still not enough. Pushing beyond those findings, the TTAB explained in great detail how fine dining and fine wine are coupled, the technical term being “paired.” Examples of how restaurants touted their fine food and their perfectly paired wines cascaded over the pages of the opinion *ad nauseum*. Some examples included:

Kiepersol Estates Restaurant offers “fine dining” with “the finest foods available” and serves Kiepersol private label “world renowned” wines to complement your meal.

The South Coast Winery Restaurant offers “menus that have received rave reviews,” and a “select group of varietals” under the South Coast Winery label along with “an extensive wine list, showcasing vintages from South Coast” to “complement these dishes.”

The Magnanini Winery & Restaurant offers “a six-course dinner, Northern Italian cuisine” as well as Magnanini labeled wines and suggested wine and food pairings.

The Restaurant at Ponte features “Our award-winning outdoor restaurant” along with “a full selection” of Ponte labeled wines “ready to pair with each dish.”

Bully Hill Restaurant located at Bully Hill Vineyards offers “one of the finest places to dine in the Finger Lakes Region” with suggested wine and food pairings and an array of Bully Hill labeled wines.

From these examples (all of which, by the way, being winery, on-premises tasting rooms), it became evident to the *Nikolaos Mastorogiannakis* panel that wine is often paired with food (and beer is too). Cocktails are seldom paired with food. But the point is that, even with the close connection between wine and restaurant services (as discussed above), the TTAB was reluctant to jump to the conclusion that restaurant services were “related” to bottled wine. The *Nikolaos Mastorogiannakis* panel put it this way:

We cannot find based on the website evidence that wine is the type of product that a restaurant, as opposed to a winery, might package for retail sale, or that restaurants typically, or ever, package wine for sale under their own marks. It is possible that purchasers may

assume some other source connection exists between the wine and restaurant.

Thus, even with this mountain of evidence linking restaurant services with wine (as contrasted with the nearly nonexistent evidence of any association between canned cocktails and bar services in the present case), the TTAB still looked for more. It finally found the “something more” in the overlapping ethnic character of the wine and the restaurant services. The *Bloomberg Businessweek* (businessweek.com) reported that “between 60% and 75% of Greek wine sold in the U.S. is through restaurants.” There is no evidence that the majority of canned cocktails are sold by bars. On the contrary, almost no canned cocktails are sold at bars; canned cocktails, the overwhelming majority of the time, are sold in grocery and liquor stores. Therefore, the “something more” that convinced the *Nikolaos Mastorogiannakis* panel of the relatedness of Class 33 wine and Class 43 restaurant services is utterly absent in this case, making it apparent that alcohol production in Class 33 is not related to bar services in Class 43.

E. **Relative Strength of the Marks.**

The mark at issue here is not a made-up, fanciful, or distinctive term. The term at issue is “FLING,” a term that is in common use for an array of beverages. When a term is in common use, the likelihood of consumer confusion is reduced significantly, particularly where, as here, the goods, premixed canned cocktails (in Class 32) and bar services (in Class 43) are not closely related. *McCarthy*, at § 23, states:

Confusion is Less Likely if the Element Common to Both Marks is “Weak.” Whether a mark is classified as “strong” or “weak” is a very important element in deciding likelihood of confusion. If the common element of conflicting marks is a word that is “weak” then this reduces the likelihood of confusion. A portion of a mark may be “weak” in the sense that such portion is descriptive, highly suggestive, or **is in common use by many other sellers in the market.**

“FLING” is in common use. Harkness Edwards Vineyards offers a wine called Fling. See <https://www.harknessedwardsvineyards.com/product/Fling-Chardonnay>. The Maize Valley winery offers a wine called Summer Fling. See <https://www.maizevalley.com/shop/summer-fling>,

and Moonlight Meadery offers a wine called Fling. See <https://www.moonlightmeadery.com/shop>. In addition to the array of vintners, breweries, and others that produce a FLING alcoholic beverage, the Internet is full of recipes for Fling cocktails:

- Absolut Drinks offers a Spring Fling recipe at <https://www.absolutdrinks.com/en/drinks/spring-fling>.
- Ketel One Vodka offers a Spring Fling recipe at <https://www.ketelone.com/vodka-drinks/spring-fling>.
- Food Republic furnishes a Summer Fling recipe at <https://www.foodrepublic.com/recipes/summer-fling-cocktail-recipe>.
- Geoffrey Zakarian shares his Spring Fling recipe on the Food Network at <https://www.foodnetwork.com/recipes/geoffrey-zakarian/spring-fling-3269863>
- An Internet publication called PUNCH publishes a recipe for Summer Fling Cocktail at <https://punchdrink.com/recipes/summer-fling>.

The march of FLING recipes continues, seemingly, *ad nauseam*. A term so commonly in use (almost to the point of being descriptive) enjoys only the narrowest band of protection. Surely, such a term does not deserve the unprecedented reach across eleven International Classes from bar services to canned cocktails.⁵ Consumers are as likely, if not more likely, to associate FLING with any zesty cocktail with citrus or other bright fruit than with a specific bar inside a casino. FLING, therefore, is like BLUE MOON, and as the Federal Circuit held, is not sufficiently distinctive to link together services involving on-premises consumption and canned or bottled products.

F. Coexistence.

That the Bar Mark and the Beer Mark have coexisted for many years is proof that there is no relationship between canned or bottled beverages and bar services. The Bar Mark was not even cited when the application for registration of the Beer Mark was filed. To the knowledge of the

⁵ In the *Nikolaos Mastorogiannakis* decision, the TTAB cited the distinctive quality of the mark in question further to bolster its finding of likely confusion. As the TTAB put it, “registrant’s mark must be regarded as unique for restaurant services.” In neither the *Coors* case, which involved “BLUE MOON,” a term not infrequently found in restaurant names, nor in the present case, which employs the commonplace term “FLING,” is the mark at issue even close to being distinctive.

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Applicant, there **HAS NEVER BEEN A SINGLE INSTANCE** of consumer confusion even though the registrations have coexisted for eight years. NAB has never considered the Bar Mark to be an issue or to pose any remote possibility of confusion.

Therefore, identical marks can coexist, and do coexist, for beer (a beverage sold in a bar) and bar services. Ordinary consumers just do not think there is a source relationship between a ready-to-drink beverage and the service of measuring, mixing, shaking, and serving beverages.

III. CONCLUSION.

If one focuses on the core concern, likelihood of confusion, it is glaringly apparent that there is absolutely no likelihood of confusion possible between the Applicant's Mark and either the Beer Mark or the Bar Mark. Consequently, we look forward to receipt of the notice of allowance for registration of Applicant's Mark.

KUTAK ROCK LLP

Very truly yours,



Ed Marquette

Enclosure(s)