

U.S. Serial No 88289441

Mark: DITCH

Response to Office Action of April 24, 2019.

Applicant has filed to register the word mark DITCH for use with distilled spirits. The examiner has refused registration on a claim of likelihood of confusion with the mark in U.S. Registration No. 2413522, THE LAST DITCH, for use with wines, spirits and liquors.

In evaluating the du Pont factors (*In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (1973)) the examiner has focused on similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services and not evaluated any of the other du Pont factors.

For the reasons argued below, as supported by the three (3) attached exhibits, it is requested the examiner withdraw the rejection and permit applicant's mark to be allowed.

A. The cited du Pont factors are misapplied to the marks. The marks are distinct as are the goods of applicant and the prior registration.

- 1) The marks are notably distinct and not similar.

The applicant's mark for the word **DITCH** is distinct in appearance and meaning and does not convey or connote the same or a similar meaning as the idiom mark of the prior registrant. Specifically, **DITCH** might mean a long narrow cavity in the earth (noun), to make a forced landing of an airplane (verb), to get rid of or discard (verb), or to end an association (verb). Exhibit 1. Whereas **THE LAST DITCH** is an idiom and unitary mark referring to desperation or unyielding defiance or a final effort to avert disaster (adjective). Exhibit 2; TMEP 1213.05 (Unitary Marks). The subject component of the registered unitary mark, DITCH, is not properly isolated from the idiom as a whole and has no relation to the applicant's use of the mark **DITCH** as a distinct mark.

A mark is considered "unitary" when it creates an impression separate and apart from any component. In a unitary mark the elements combine to give the mark a distinct meaning independent of the meaning of its constituent elements. In other

words, a unitary mark creates a single and distinct commercial impression. When a mark is unitary its elements are inseparable. TMEP 1213.5; *Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 1561 (Fed. Cir. 1991).

As a corollary, attempts to extract components of unitary marks to extend any scope are generally disfavored. For example, the use of "CUE" in CUE ACOUSTICS even as a senior mark is not properly considered when applied to other "CUE" uses in other marks. *Cue, Inc. v. Gen. Motors LLC*, No. 1:13-cv-12647-IT, 2016 WL 4074134 (D. Mass., 2016); See also "Sugar & Spice" in *In re Colonial Stores, Inc.*, 394 F.2d 549 (1968).

A prime example is the use of "L'Air Du Temps," a French idiom that loosely translates to "of the times," or "of the current trend." Whereas, "L'Air D'or," is linguistically similar, and contains the same, "L'Air" term, but has a distinct meaning indicating something is golden or royal. While the two marks appear similar at first blush, they convey completely different meanings and confusion between the two is unlikely. *Nina Ricci, SARL v. Gemcraft Ltd.*, 612 F. Supp. 1520 (S.D. N.Y., 1985).

Finally, there is a strong public interest consideration that militates against reading idiomatic or unitary marks beyond their strict meaning. When it comes to considering the exclusive appropriation of plain speech, or terms like 'The Last Ditch,' for trade purposes, "the bar should be set high, and the test should be made more exacting. Any ambiguities or doubts in this regard should be resolved in favor of broader, rather than narrower, access and circulation of words and terms in the public domain." *Bigstar Entertainment, Inc. v. Next Big Star, Inc.*, 105 F.Supp.2d 185, 54 U.S.P.Q.2d 1685 (S.D. N.Y., 2000), citing *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp.*, 937 F.Supp. 204 (S.D.N.Y. 1996).

The term of applicant's mark is found in the idiom of the prior registration, but there is no shared meaning or conveyance, nor is there any indication that the two terms might in and way be seen as confusingly similar.

2) The subject goods are distinct.

THE LAST DITCH, is owned by D'Arenberg of Australia and on a good faith review, appears to be a discontinued line from the vineyard. See Exhibit 3, indicating the product is no longer listed on the registrant's web page. (<https://www.darenberg.com.au>)

Further, all available evidence is the mark has only been used for wine and never for the claimed spirits of the registration.

Applicant's stated use is for distilled spirits, and *not* wine. Distilled spirits, such as vodka, whiskey and gin, are distinct and not easily confused with wine, beer, or other fermented beverages. Distilled spirits are also often sold in distinct outlets, such as liquor stores, and subject to distinct marketing and sales regulations.

(3) The channels of the goods are distinct.

Wine and distilled spirits are generally marketed distinctly, used distinctly, and not interchangeable in commerce or use. Wine wholesalers generally focus on wine and fermented products and target to general retail sales. Distilled spirits are generally limited to 'liquor stores.' While there may be some overlap in some channels, the two are managed, handled, regulated and consumed distinctly without any likelihood of confusion.

(B) The balance of the du Pont factors favor allowance.

The balance of the du Pont factors: (4) the conditions in which the products are generally purchased – liquor stores verses general retail; (5) the fame of the prior mark – nominal outside of Australia and apparently discontinued; (6) the nature of similar marks on similar goods – not apparently relevant; (7) the presence of actual confusion – non-existent with registrant's discontinued product; (8) the length of time without actual confusion– not apparently relevant; (9) variety of goods on which a mark is used – distinct between wine and distilled spirits; (10) the market interface between the marks being disputed – distinct between wine and distilled spirits; (11) the extent to which a trademark holder has the right to exclude others from using the mark – minimal when applied to idioms; (12) the extent of potential confusion – non-existent with registrant's discontinued product; and (13) any other relevant facts – not relevant. Each of these are either neutral or weigh in favor of allowance.

Having responded to the initial rejection with the above arguments applicant submits allowance of registration for DITCH for use with Distilled Spirits is

proper.

/s/Carl D. Crowell

Owner

Admitted in Oregon, OSB#982049

Sept. 3, 2019

Carl D. Crowell

P.O. Box 923

Salem, OR 97308

503-581-1240