

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK EXAMINING OPERATION**

In re trademark application

Examining Attorney: Cristel John  
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Serial No.: 88/212,413  
Mark: SOUTHERN GENTLEMAN  
Applicant: Southern Kitchen Nashville, LLC  
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Attorney Docket No.: 20878-019941

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**RESPONSE AND AMENDMENT**

This document is filed in response to the Office Action dated March 7, 2019.

**I. Refusal as to Reg. No. 4962565 – THE SOUTHERN GENTLEMAN**

Applicant respectfully contends that its application for SOUTHERN GENTLEMAN for “sauces, relishes” should be allowed because the mark is not likely to be confused with the registered mark THE SOUTHERN GENTLEMAN, U.S. Reg. No. 4962565, because the marks are distinguishable based on several of the *DuPont* factors. *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (holding that likelihood of confusion should be determined by assessing any combination of the relevant listed factors). The relevant factors here are the differences in goods and services, the dissimilarity of trade channels, the conditions under which sales are made, and the length of time of concurrent use.

**a. The marks’ are not likely to be confused because one’s good is different from the other’s service.**

Applicant’s product – “sauces, relishes” – is a good, which is not likely to be confused with the prior registrant’s restaurant services. The Board has found that even two food products

are distinguishable, and similar marks appearing on each product are not likely to be confused due to the differences among food products. *Outback Steakhouse of Fla., Inc. & Os Asset, Inc.*, No. 2002, 2009 WL 129559, at \*6 (Jan. 7, 2009) (“As to opposers’ baked goods, we find the differences between these goods on one hand, and bottled water on the other, are too great to find a likelihood of confusion in the absence of any evidence to support such a conclusion.”). In our case, Applicant’s claimed goods are food products, whereas the registrant claims the mark for restaurant services – not even a food product at all.

Applicant’s mark is not likely to be confused with the registered mark because sauces and relishes (goods) do not compete with the services provided at a restaurant. *In re Coors Brewing Co.*, 343 F.3d 1340, 1346 (Fed. Cir. 2003) (holding that evidence that some restaurants brew or serve private label beer was inadequate to support a conclusion that beer goods are likely to be confused with restaurant services). *In re Coors* stands for the proposition that a *per se* rule giving trademark protection to restaurants against any food or beverage items with similar names would undo the policy of trademark protection and render off-limits a large swathe of terms and designs that would otherwise deserve such protection. *In re Coors*, 343 F.3d at 1346; *see also In re Constellation Wines U.S., Inc.*, SERIAL 78803750, 2008 WL 1897560, \*2 (Trademark Tr. & App. Bd. Apr. 17, 2008) (“In analyzing the similarity or dissimilarity and relatedness of the goods and/or services, we must keep in mind that there is no rule that certain goods are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in

relation thereto.”). Conflating Applicant’s goods with the registrant’s services ignores this important precedent.

The *Coors* case sets out an important rule that applies here, too: “the degree of overlap between the sources of restaurant services and the sources of beer is *de minimis*” such that, while restaurants may produce certain specific items that would garner trademark protection, the mere existence of a food or beverage and a restaurant of the same name does not eviscerate the right to trademark protection. *In re Coors*, 343 F.3d at 1346. Here, the evidence that restaurants use sauces or sell their in-house sauces does not mean that consumers assume that all sauces derive from restaurants or that a sauce with a name similar to a restaurant *must* have come from that restaurant. *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 1236 (C.C.P.A. 1982) (holding that the facts of each dispute must be assessed independently and that establishment of likelihood of confusion requires “something more than that similar or even identical marks [] used for food products and for restaurant services”); *accord In re Constellation Wines*, 2008 WL 1897560, \*3. Restaurants offer lots of types of foods – nearly every food offered in a restaurant also is offered at a grocery store. Refusing Applicant’s mark because its product appears in restaurants would create the *per se* rule the Board has warned against.

Just because some restaurants may offer relishes or sauces, and some parties sell those products, does not mean one party’s goods are likely to be confused with the other party’s services. Restaurants provide a service; the registrant specifically registered its mark for restaurant *services*. There is not “something more” of a connection between a sauce or relish and

a restaurant that would support a connection to these two disparate things. *In re Landscape Structures, Inc.*, 77724146, 2011 WL 1495464 (Trademark Tr. & App. Bd. Mar. 31, 2011) (re-affirming the rule that the Office Action must show “something more” than a mere possibility that the goods and services are related and specifically refusing to enforce a “*per se* rule” without specific, contextual evidence that the two are related). The registrant offers restaurant services that could include all sorts of food. Applicant produces a good – specifically, relishes and sauces. There is no likelihood of confusion between the two.

The Board has considered, and rejected, the possibility of confusion in cases similar to this. For example, in 2009 the Board held that:

It is true that some consumers who have patronized registrant’s ANDIAMO restaurant may go to applicant’s winery and eat at The Restaurant at Wente Vineyards. They may then order a bottle of ANDIAMO wine and conclude that the source of these goods and services are related. However, while it is possible that some consumers may believe that there is an association between goods and services, the “statute refers to likelihood, not the mere possibility, of confusion.”

*In re Wente Bros. DBA Tamas Estates*, SERIAL 77314718, 2009 WL 4085608, \*5 (Trademark Tr. & App. Bd. Aug. 6, 2009) (quoting *Bongrain International (American) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987)) (emphasis added). The Board’s reasoning is in accordance with the precedent established in *In re Coors*. Noting that “some restaurants sell their own private label ice cream, while others sell their own private label coffee,” the Court established that “that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant”

and enforced the rule that “in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.” *In re Coors*, 343 F.3d at 1346 (quoted approvingly by *In re Wente*, 2009 WL 4085608, \*6). Applicant should be allowed to register its SOUTHERN GENTLEMAN mark for relishes and sauces despite the existence of a restaurant. Accordingly, the marks are not likely to be confused due to the difference between goods and services.

**b. The marks have distinguishable trade channels.**

Applicant’s food products are not likely to be confused with the registrant’s restaurant services because these goods and services move in different channels of trade. The registrant’s restaurant services are not likely to be found in grocery stores and other retail outlets where Applicant’s products are found. As the Board has noted, its precedents “caution that little can be concluded merely from the fact that two items can both be found in retail outlets such as a grocery store or served in a restaurant.” *Outback*, 2009 WL 129559, at \*6 (citing *Hi-Country*, 4 USPQ2d at 1171-72). That case warned that, “[s]hould we follow that reasoning, we would come to the same conclusion in nearly every case involving food items and/or beverages.” *Outback*, 2009 WL 129559, at \*6 (denying an opposition and allowing registration of a design mark with the words AUSTRALIAN OUTBACK for bottled water despite opposition by owner of the restaurant OUTBACK for restaurant services and alcohol products). In the same way, food products are sold in multiple channels, but the mere existence of a restaurant does not mean

consumers are likely to be confused between a food product such as a sauce or relish, and a restaurant offering restaurant services.

In the *Hi-Country* case, the Board distinguished the channels of trade between two HI-COUNTRY marks on a much thinner basis than the difference in channels in our case. There, the Board determined that “prepared beef snack foods and fruit juices,” though both were “edible food products,” were “completely different in character, would not normally be sold in the same sections of food stores or convenience stores and would not be expected to originate from the same entity, even when sold under virtually identical trademarks, absent a showing (not made in this case) that the mark involved was a well recognized or famous one.” *Jerky v. Jerky*, 4 U.S.P.Q.2d 1169 (T.T.A.B. 1987). Thus, similar types of product – food – sold in the same trade channel are still distinguishable because consumers distinguish among different types of food product. Even more so, consumers also distinguish between food products such as relishes and sauces compared to restaurant services.

Additionally, the Board distinguished between two food products – fruit juices compared to snack foods – even though they travel in the same trade channel (namely grocery stores) because, “notwithstanding these common trade channels, . . . there can be no ‘per se’ rule that all food products are related goods by nature or by virtue of their capability of being sold in the same food markets . . . .” *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171-72 (TTAB 1987).

In light of the difference in goods and services, Applicant's mark should be allowed because consumers encounter many food products in many places. Just because a food product is sold does not mean that a consumer who encounters a restaurant with a similar name is going to be confused. Without more, the mark should be allowed. *See, e.g., Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899-1900 (Fed. Cir. 2000) (absent some evidence that the products are sold in close proximity to one another, the fact that the involved products are sold in supermarkets did not weigh in favor of confusion being likely); *Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1142 (TTAB 2009) ("It has long been held that the mere fact that two different items can be found in a supermarket, department store, drugstore or mass merchandiser store is not a sufficient basis for a finding that the goods are related."). Consumers seeking to buy food products such as relishes and sauces are not likely to be confused when they encounter a restaurant offering its restaurant services, even if the mark is similar. There is no likelihood of confusion because Applicant and the registrant operate in different or distinguishable channels of trade.

**c. The Parties Have Operated without Confusion for Years**

There is no likelihood of confusion because the parties have used their respective marks for years without any known confusion. The prior registrant began using its mark in November 2014 – nearly five years ago. (*See* U.S. Reg. No. 4962565 (the "565 Reg."), incorporated by reference in this response.) Applicant began using its mark in April 2012 – more than seven

years ago. (See Applicant's claim of first use in this application.) The parties have operated for nearly five years without a single instance of known confusion between the two.

Moreover, Applicant is the prior user of the SOUTHERN GENTLEMAN component of the mark, yet Applicant did not see fit to oppose the '565 Reg. when it was proceeding through the USPTO; there was no perceived likelihood of confusion between the marks. The parties should be able to continue to operate without concern confusion, and Applicant's mark should be allowed.

In sum, Applicant's mark should be allowed to register because Applicant and registrant do not offer similar goods and services, do not operate in the same or similar channels of trade, and have operated for years without confusion.

## **II. Refusal as to Reg. No. 2349121– VIRGINIA GENTLEMAN**

Applicant's mark should be allowed to register despite Reg. No. 2349121 (the "121 Reg.") for VIRGINIA GENTLEMAN because the marks are distinguishable. In our case, the marks are highly distinguishable because the overall impression of each mark is distinct. Each mark should be analyzed in its totality – not as many separate elements but as a whole. *Juice Generation*, 794 F.3d at 1340 (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”) (internal quotation omitted). Taking each mark in its entirety, the marks are distinguishable and not similar. *See, e.g., Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 423 (6th Cir. 1999) (holding that trademarks should be analyzed in their totality, not as many separate elements but as a whole); *see also* TMEP



§ 1207.01 (“The basic principle in determining confusion between marks is that marks must be compared in their entirety . . .”). In that case, the court held that the marks JET and AEROB-A-JET were not likely to be confused because the marks, in total, were distinct.

By this measure, Applicant’s mark is very distinguishable from the registered mark – the word VIRGINIA and the word SOUTHERN are not similar at all, creating different impressions between VIRGINIA GENTLEMAN and SOUTHERN GENTLEMAN. Each of these marks is an arbitrary application in the context of sauces – they describe the word GENTLEMAN but have no relevance to the actual product. While the marks share commonality with the use of GENTLEMAN, in each case that common word is the second word in the mark. *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1372 (Fed. Cir. 2005) (focusing on VEUVE because it was an arbitrary use of the word and was the first word in each mark). To focus only on the similarity of the second and less prominent word in each mark minimizes the distinctiveness of each mark in whole, so focusing only on the similarity of GENTLEMAN erases the distinction and overall commercial impression of each mark. Looking at VIRGINIA GENTLEMAN and SOUTHERN GENTLEMAN creates two different impressions.

If trademarks are not reviewed in their entirety, then the first party to register a mark containing a certain word – e.g., “GENTLEMAN” – may effectively exercise a monopoly over all subsequent users. In our case, the existence of the registered mark could prevent any person from using the word GENTLEMAN for food products. Such an eventuality would enable a

trademark holder to misappropriate the trademark laws by monopolizing the word. Trademarks should be viewed in their “entirety”, because “[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail”. *Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 851 (Fed. Cir. 1992) (internal quotation omitted). However, by applying the anti-dissection rule, we can view a mark in its entirety and limit a senior user’s monopoly to only those marks that are actually confusingly similar.

Considering the marks in their entirety, the distinguishing part of each mark is the first part. In another close case, the Board held that TAMAYA was not likely to be confused with MAYA, both for wines, even though the marks both contained the word MAYA and sounded similar. *Oakville Hills Cellar, Inc. DBA Dalla Valle Vineyards v. Viña Casa Tamaya S.A.*, 77561695, 2013 WL 3188902, at \*5 (Apr. 15, 2013). The Board was able to distinguish these marks in part because the first two letters of the applicant’s mark created a distinct impression for the overall mark. *Viña Casa*, 2013 WL 3188902 at \*5.<sup>1</sup> In our case, SOUTHERN GENTLEMAN creates a significantly more distinct and robust impression from VIRGINIA GENTLEMAN than “TAMAYA” from “MAYA.”

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<sup>1</sup> While the case also suggested that the term MAYA had a meaning that was well known to the U.S. public, another opposition filed by the owner of MAYA against applicant for MAYARI also found that these two marks were not likely to be confused without relying on the public recognition of MAYA. *Viña Casa*, 2013 WL 3188902 at \*6; *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 91211612, 2015 WL 4573202, at \*4 (July 16, 2015). Thus, it is possible for the Board to distinguish such marks without reliance on the public’s recognition of the meaning of MAYA.

In sum, taking the marks in their entirety, they are not likely to be confused because they are distinguishable, such that “[a]n alert purchaser could readily distinguish” the two marks. *In re N.A.D. Inc.*, 754 F.2d 996, 999 (Fed. Cir. 1985). In that case, the Federal Circuit allowed registration of NARKOMED despite the prior registration of NARCO and NARCO MEDICAL SERVICES. Applicant’s mark in our case is even more distinctive and distinguishable because it refers to an entirely different type of product. For the foregoing reasons, Applicant respectfully suggests that its mark is not likely to be confused and requests that it be allowed. Viewing the marks in their entirety in our case, Applicant asserts that there is no likelihood of confusion because Applicant’s mark is visibly distinguishable from the registered mark.

In the alternative, Applicant suggests that the ’121 Reg. is due for a renewal on May 11, 2020. Therefore, Applicant requests that this application be suspended until it is determined whether the ’121 Reg. will be renewed.

\* \* \*

Applicant submits that this Response places the application in a condition for publication of the mark for opposition.

Respectfully submitted,

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**Int. Cl.: 30**

**Prior U.S. Cl.: 46**

**Reg. No. 2,349,121**

**United States Patent and Trademark Office**

**Registered May 9, 2000**

**TRADEMARK  
PRINCIPAL REGISTER**

**VIRGINIA GENTLEMAN**

**A. SMITH BOWMAN DISTILLERY, INC. (VIR-  
GINIA CORPORATION)  
ONE BOWMAN DRIVE  
FREDERICKSBURG, VA 224087318**

**FIRST USE 1-1-1999; IN COMMERCE  
1-25-1999.**

**OWNER OF U.S. REG. NO. 347,081.**

**SN 75-596,954, FILED 11-30-1998.**

**FOR: SAUCES, NAMELY, BARBECUE AND  
STEAK SAUCES, IN CLASS 30 (U.S. CL. 46).**

**CYNTHIA SLOAN, EXAMINING ATTORNEY**

# United States of America

United States Patent and Trademark Office

## THE SOUTHERN GENTLEMAN

**Reg. No. 4,962,565**

GYPSY KITCHEN, LLC (GEORGIA LIMITED LIABILITY COMPANY)  
128 E. ANDREWS

**Registered May 24, 2016**

ATLANTA, GA 30305

**Int. Cl.: 43**

FOR: RESTAURANT SERVICES, IN CLASS 43 (U.S. CLS. 100 AND 101).

**SERVICE MARK**

FIRST USE 11-27-2014; IN COMMERCE 11-27-2014.

**PRINCIPAL REGISTER**

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 86-560,786, FILED 3-11-2015.

KEVIN CORWIN, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office