In and Before the United States Patent and Trademark Office

Mark: GLITTER MOON
Serial No. 88-273,469
Response to Office Action 4/15/2019

Applicant's Mark Is Not Likely To Cause Confusion

Applicant has applied to register GLITTER MOON for use in connection with beer. In an office action dated April 15, 2019 ("Office Action"), the examining attorney has refused registration under Lanham Act §2(d) based on a likelihood of confusion with a prior registration of SUN GLITTER also for use on beer.

As an initial comment, the Office Action incorrectly identifies the cited registration as "Glitter Sun." Instead, the cited registration is SUN GLITTER. The difference is significant because, as discussed below, the transposition of terms materially changes the analysis as to whether the marks are confusingly similar.

"Marks are compared along the axes of their "appearance, sound, connotation and commercial impression." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail." *Estate of P.D. Beckwith, Inc., v. Comm'r of Patents*, 252 U.S. 538, 545-46, 40 S.Ct. 414, 64 L.Ed. 705 (1920). [The CCPA has] explained that "a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion." *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981). That does not preclude consideration of components of a mark; it merely requires heeding the common-sense fact that the message of a whole phrase may well not be adequately captured by a dissection and recombination. *See FCC v. AT&T Inc.*, 562 U.S. 397, 406, 131 S.Ct. 1177, 179 L.Ed.2d 132 (2011) (making similar point about "personal privacy"). It is the mark in its "entiret[y]" that must be assessed. *DuPont*, 476 F.2d at 1361." *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 1340-41 (Fed. Cir. 2015)

In comparing the visual similarity of marks, it a common guideline that consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Here, for Applicant's mark, the first term is GLITTER while in contrast, the first term of the cited mark is SUN. Clearly, these two terms are not similar along any of the axes of similarity.

A similar analysis applies to the aural presentation of the mark. When pronouncing the mark, because the terms are transposed, the common term GLITTER plays a different role. The aural dominance of the common term GLITTER changes depending on its position within the entire mark. Also, because one mark uses SUN and the other MOON, and position with their respective marks is different, the cadence of pronunciation of the two marks is different.

Critical to the analysis is that the transposition of the position of the term GLITTER changes the commercial impression of the two cited marks. "[T]he fact that two marks are composed of reverse combinations of the same elements is not necessarily conclusive on the issue of likelihood of confusion since registration may be permitted if the transposed marks create

distinctly different commercial impressions." *Bank of America National Trust and Savings Association v. The American National Bank of St. Joseph*, 201 USPQ 842 (TTAB 1978) (*citing In re Sybron Corporation*, 165 USPQ 410 (TTAB 1970)).

In *Bank of America National Trust and Savings*, the Board identified several cases where the transposition of terms was sufficient to avoid confusion:

- *Murphy, Brill and Sahner, Inc. v. New Jersey Rubber Company*, 102 USPQ 420 (Comr., 1954) [FLITE TOP for hosiery -- TOPFLITE for shoe soles -- registration permitted]
- *Marriott-Hot Shoppes, Inc. v. Hedwin Corporation*, 161 USPQ 742 (TTAB 1969) [TALK O' THE TABLE for coasters, trays, napkin rings, and lazy susans -- TABLE TALK for a periodical publication -- registration permitted]
- *In re Mavest, Inc.*, 130 USPQ 40 (TTAB 1961) [SQUIRETOWN for men's sport coats -- TOWN SQUIRES for men's shoes -- registration permitted]

See also

- *In re Akzona Incorporated*, 219 USPQ 94, 96 (TTAB 1983) ("Applicant's mark 'SILKY TOUCH,' conveys the impression that applicant's synthetic yarns are silky to the touch. On the other hand, registrant's mark "'TOUCH O' SILK,' suggests that registrant's clothing products contain a small amount of silk.")

The key to each of these cases is that the role of the literal elements changed when transposed. For example, in the *Mavest* decision, the applicant's mark had the term "squire" modifying the type of "town" while in the cited mark "town" modified the kind of "squire". Similarly, in *Akzona*, the term "silk" functions as an adjective in the applicant's mark while it is a noun in the cited mark.

An analogous effect happens here. In the cited mark, the term SUN, as the first element of the mark, functions as an adjective, identifying a kind of GLITTER. It's not any kind of glitter, but sun glitter. In contrast, in Applicant's mark, the term GLITTER is the first term and it functions as an adjective, identifying a kind of MOON. It's not any kind of moon but a glitter moon.

In each of the cited cases where the Board found confusion was not likely, both of the transposed terms were identical. In contrast, in the instant situation, further separation between the marks is created because Applicant's mark uses MOON while the cited mark uses SUN. While both sun and moon can be characterized as celestial bodies, they are different kinds of celestial bodies. SUN is a reference to a gaseous star at the center of a solar system burning bright and emitting copious amounts of heat. MOON refers to a cold, dark object that revolves around a planet and emits no light or heat of its own. These two terms create their own separate commercial impression.

This distinction between sun and moon further emphasizes the difference between the two marks. SUN GLITTER emphasizes the brightness of the sun as it creates its own light, its own kind of glitter. Applicant's mark combines two incongruous terms. As noted above, the moon is inherently dark and creates no light of its own. The term glitter suggests something that sparkles and emits light. Pairing these terms is incongruous.

Each of these factors highlights that the commercial impression of Applicant's mark is distinct from the commercial impression of the cited registration. The SUN and MOON are distinct celestial bodies. The single common element is GLITTER which plays a different role in Applicant's mark and the cited registration. Indeed, the differing role of GLITTER is emphasized by the incongruous pairing with MOON in Applicant's mark while being used in a complementary manner with SUN in the cited registration.

For the foregoing reasons, Applicant requests the refusal to register under §2(d) be withdrawn and that its application to register GLITTER MOON be approved for publication.

Substitute Specimen

In the Office Action, registration has been refused because the specimen submitted with the application "appears to consist of a digitally altered image or a mock-up of the mark on the goods or their packaging and does not show the applied-for mark in actual use in commerce." Although the submitted specimen is a valid image of how the mark is used in commerce, submitted with this response as Exhibit A is a substitute specimen which will allay any concern as to whether Applicant's mark is being used in commerce and which will confirm the validity of the specimen.

Information About the Original Specimen

Despite the fact that Applicant has submitted a substitute specimen, the Office Action provides that "applicant must respond to the following questions and requests for documentation to satisfy this request for information:"

(1) How are applicant's goods sold? Specify the retail, wholesale, or other sales environment in which the goods are sold.

Response: The goods identified in the application is beer. Applicant's beer is sold through traditional sales channels for alcoholic beverages. Applicant sells its product to distributors who then sells the product to retails outlets such as grocery stores and liquor stores. The product is also distributed to businesses where the beer is offered for sale for on-premises consumption such as restaurants and bars.

(2) Please provide copies of invoices, bills of sale, or other documentation of sales of the goods.

Response: Attached as Exhibits B and C are two packing slips for the shipment of the subject product to two different distributors. The quantities shipped are proprietary and have been redacted from the packing slip.

(3) Was the specimen created for submission with this application?

Response: No.

(4) Does the specimen show applicant's product as it is currently being sold to consumers?

Response: Yes. The substitute specimen is an image of a can of beer where the label that is affixed to the can is the same as the original specimen. Applicant notes that the original specimen, an image of the label alone without being affixed to packaging, has historically been a legally sufficient specimen of use. Applicant believes both the original and substitute specimens are valid specimens of use in commerce. However, with the submission of a substitute specimen, the validity of the original specimen should be moot.

(5) How do applicant's goods appear in the actual sales environment? If sold in stores, provide photos showing the goods for sale in the stores. If sold online, identify the websites and provide copies of the webpages showing the goods for sale. And if sold in another type of sales environment, provide photos and/or documentation showing the goods for sale in that environment.

Response: Photos of the product on sale in stores and on-premises establishments are not readily available to Applicant. As noted above, Applicant sells its product to distributors. Applicant does not have a direct relationship with the individual retail and on-premises businesses where the product is sold to the consumer. However, attached as Exhibit D is a screenshot from Instagram where a retailer, 3 Ten Liquor, has posted an image showing that GLITTER MOON beer is now in stock.

(6) If the information in question (5) about how the goods appear in the actual sales environment is not available to applicant, then please describe how applicant's goods are transported for sale and provide photos and other documentation showing how applicant's mark appears on the goods and/or its packaging when the goods are being transported for sale.

Response: Applicant's beer is sold through distributors and it also sells beer through its brewery in Sparks, Nevada. Attached are two screenshots from Applicant's website. Exhibit E is a screenshot of Applicant's distributor map along with a list of the businesses that currently distribute Applicant's beer. Exhibit F is a screenshot listing the beers on sale at Applicant's taproom in Sparks, Nevada.

Conclusion

Having addressed all of the issues raised in the Office Action, Applicant asserts that the subject application to register GLITTER MOON is ready for publication.