

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Applicant:	NSTO LLC	*			
		*	Law Office 107		
Mark:	NEED BEER	*			
		*			
Serial No.:	88/369,973	*	Examining Attorney: Troy Knight		
		*			
Filing Date:	April 3, 2019	*			
		*			
		*	*	*	*

RESPONSE TO OFFICE ACTION

In response to the Office Action dated June 26, 2019 regarding the NEED BEER mark (the “Mark”), please consider the following:

I. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The Office Action cited U.S. Registration No. 5058818 for the mark NEED (the “Registration”), asserting a likelihood of confusion exists between the Mark and the Registration. In light of the following comments, Applicant respectfully submits that no likelihood of confusion exists between the Mark herein and the Registration, and thus respectfully requests reconsideration and withdrawal of the refusal to register the Mark.

A. BASIS OF ANALYSIS

The basic principle in determining the issue of confusion is that “marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used.” In re National Data Corp., 753 F.2d 1056, 1058 (Fed. Cir. 1985). In determining whether there is a likelihood of confusion between two marks, a number of factors should be considered, including at least the similarity of the marks and the similarity of the goods and services described by those marks. See In re E. I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973). It is also important to recognize that the term “likelihood of confusion” is a term of art which means the *probability* of confusion, not merely the *possibility* of confusion. See, e.g., Sears, Roebuck & Co. v. All States Life Ins. Co., 246 F.2d 161, 168 (5th Cir.), cert. denied, 355 U.S. 894 (1957); see generally Carter Wallace Inc. v. Proctor & Gamble, Co., 434 F.2d 794 (9th Cir. 1979). Moreover, it is also important to consider the fact that *probable* confusion requires a finding of probable confusion of a substantial number of reasonable consumers as to the source or connection of the providers whose products or services are at issue. See, e.g., Motorola, Inc. v. Griffith Electronics, Inc., 317 F.2d 397, 399 (C.C.P.A. 1963). Accordingly, this Response shall consider whether there exists the probability of confusion by a substantial number of reasonable consumers as to the source of the Mark and the Registration, given a comparison of the marks and their respective goods and services in their entireties.

B. THE MARKS ARE IMMEDIATELY DISTINGUISHABLE IN APPEARANCE, SOUND, AND CONNOTATION

In asserting a similarity between the Mark and the Registration, the Office Action cites the sole common element among them of the term “NEED”, which as described below forms a part of many marks used to describe goods and services that are far more similar to the services in the Registration than those described in the instant application.

Applicant’s Mark comprises in its totality “NEED BEER.” While the Mark and the Registration do share the term NEED, the Mark is twice the size of the Registration and includes a wholly separate and distinct term – namely, the term “BEER”. The terms of the Mark “NEED BEER” when properly viewed together look and sound distinctive from the sole term “NEED.” Moreover, while the term “NEED” alone, when used in the context of restaurant services, seems to connote a mental impression of perhaps an altruistic restaurant ready to provide meals to the less privileged, the term “NEED BEER” connotes a highly distinctive impression that ties the term to imagery of a beer enthusiast anxious to obtain their next pour. The visual and phonetic differences between the Registration and the Mark in this case create clearly distinct commercial impressions from one another, such that one can only assert a likelihood of confusion by improperly disregarding an entire half of the Mark. Of course, in determining likelihood of confusion, marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. See Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 545-46 (1920). “It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.” China Healthways Institute, Inc. v. Wang, 491 F.3d 1337, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007), cert. denied, 128 S. Ct. 661 (2007).

In the instant case, the Office Action improperly dismisses the distinguishing portion of the Mark by dissecting the Mark down only to the term “NEED”. It has been held to be an improper dissection of a mark to focus on what is deemed a “prominent” feature of a mark and decide likely confusion solely on that feature, ignoring all other elements of the mark. Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 U.S.P.Q.2d 272 (C.C.P.A. 1974).

Still further, Applicant respectfully submits that the Office has granted a number of prior and still-active registrations that include the word “NEED” specifically in relation to the services cited in the Registration – namely, restaurant services (as opposed to Applicant’s goods, which comprise beer as explained in greater detail below), such that consumers viewing these terms in the commercial marketplace are already readily able to distinguish even the exact same services based on other differences in the marks. See, for example:

U.S. Reg. No. 3291919 for . . . THAT’S ALL YOU NEED for restaurant services.

U.S. Reg. No. 3670520 for LIFE NEEDS FROSTING for restaurant services.

U.S. Reg. No. 4483419 for NEED SAUCE? (& Design) for restaurant services.

U.S. Reg. No. 5223080 for YOU NEED PIE! for restaurant services.

U.S. Reg. No. 5499392 for WNEED for restaurant services.

Copies of the foregoing trademark registrations are attached hereto as Exhibit A and incorporated herein by reference. Clearly, the co-existence of such previously granted registrations for marks that include the term “NEED” in relation to the same services as cited in the Registration (i.e., restaurant services) indicates that the consuming public is readily able to distinguish such marks based on other differences in the marks alone. Thus, greater weight must be given to the visual and phonetic differences between Applicant’s Mark and the Registration.

In sum, in viewing the Mark and the Registration in their entirety (as one must in evaluating any likelihood of confusion), it is quite apparent that the Marks create highly distinctive commercial impressions and are readily distinguishable in sound and appearance, and thus that the Mark and the Registration are readily distinguished.

C. THE APPLICANT’S GOODS AND THE REGISTRANT’S SERVICES ARE DIFFERENT

Applicant respectfully submits that the specific goods set forth herein to which its Mark relates are sufficiently distinct from those of the Registration, such that they may co-exist in their respective fields without creating a likelihood of confusion. See Quality Inns Int’l v. McDonald’s Corp., 8 U.S.P.Q.2d 1633, 1641 (D. Md. 1988); see also Borg-Warner Chem., Inc. v. Helena Chem. Co., 225 U.S.P.Q. 222, 224 (T.T.A.B. 1983) (“The Board . . . has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers”).

In the instant case, Applicant’s goods are simply beer. In contrast, the Registrant’s services are restaurant services. While restaurants often sell beer, along with a wide variety of other food and drink, ordinary consumers view the brand of such restaurant as associating with the restaurant services *per se*, and not with the brand of food or drink served by the restaurant. The evidence relied upon in the Office Action particularly confirms this to be the case. More specifically, the Office Action states “the attached internet evidence consisting of applicant’s dedicated beer menu establishes that registrant specifically highlights its beer as a featured product it serves.” In fact, when reviewing that evidence, it is immediately apparent that Registrant actually highlights a wide variety of third-party beers on tap – thus indicating that its “NEED” brand, to whatever extent it conceptually relates to beer, specifically refers to providing the restaurant service of offering a wide variety of third party craft beers to a beer connoisseur. Such a consumer would not expect, and likely would be quite disappointed, to arrive at a NEED branded restaurant, presumably known for offering such a variety of third party craft beers, to find only a single brand of beer offered by such restaurant. Such evidence shows that both consumers of restaurant services and beer products, and the providers of such restaurant services

and beer products, readily view those services and products as separate and distinct from one another, and would not associated the source of one with the source of the other.

Applicant therefore respectfully submits that the clear differences between the goods described by the Mark and the services set forth in the Registration become even more pertinent in distinguishing the Marks. Of course, such dissimilarity is of great importance given that in comparing the marks, one of the most important considerations is the similarity or dissimilarity of the goods or services for which the marks are used. See, e.g., In re National Data Corp., 753 F.2d at 1058; In re E. I. DuPont DeNemours & Co., 476 F.2d at 1360-62. Given such clear dissimilarity between the goods offered by the Applicant under the Mark and the services described by the Registration, Applicant respectfully submits that there is no likelihood of confusion between the Mark and the Registration, and thus respectfully requests reconsideration and withdrawal of the refusal to register.

II. DISCLAIMER

The Office Action requires Applicant to provide a disclaimer of the term “BEER,” asserting that such term “is not inherently distinctive.” While Applicant respectfully submits that the full mark NEED BEER is highly distinctive, simply in order to advance prosecution of the instant application, Applicant herein submits a disclaimer as required in the Office Action.

* * * * *

In light of the above remarks, Applicant respectfully submits that there is no likelihood of confusion between the instant Mark and the Registration. The mere possibility raised by the Office Action that relevant purchasers might relate the different marks does not meet the statutorily established test of likelihood of confusion. See, e.g., In re Hughes Aircraft Company, 222 U.S.P.Q. 263, 264 (TTAB 1984) (“the Trademark Act does not preclude registration of a mark where there is a possibility of confusion as to source or origin, only where such confusion is likely”). Thus, Applicant respectfully requests that the Examining Attorney approve the instant Mark for publication.

In the event that the Examining Attorney finds that a telephone conference would expedite resolution of the instant application, please do not hesitate to contact the undersigned.

Respectfully,

/GMS/

Date: December 26, 2019

Gregory M. Stone
Whiteford, Taylor & Preston L.L.P.
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Fax: (410) 234-2314

EXHIBIT A



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wneed

Word Mark WNEED
Goods and Services IC 043. US 100 101. G & S: restaurant services; Café services; bar services; tea rooms; providing of food and drink via a mobile truck; cafeteria services; hotel services; food sculpting; washoku restaurant services; making hotel reservations for others; hotel accommodation services; motel services; retirement home services; boarding for animals; rental of cooking apparatus; rental of chairs, tables, table linen, glassware. FIRST USE: 20170820. FIRST USE IN COMMERCE: 20170820
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 87540305
Filing Date July 24, 2017
Current Basis 1A
Original Filing Basis 1B
Published for Opposition November 28, 2017
Registration Number 5499392
Registration Date June 19, 2018
Owner

(REGISTRANT) Zhitao Gao INDIVIDUAL CHINA No.17 Dongxiaoqu, Beiliangdu Vil Weishui Tn,
Jingxing County Shijiazhuang, Hebei CHINA 050300

Attorney of Record Kao H. Lu
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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You Need Pie!

Word Mark YOU NEED PIE!
Goods and Services IC 043. US 100 101. G & S: Restaurant services; Restaurant services featuring pie. FIRST USE: 20060615. FIRST USE IN COMMERCE: 20060615
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 87233210
Filing Date November 10, 2016
Current Basis 1A
Original Filing Basis 1A
Published for Opposition March 28, 2017
Registration Number **5223080**
Registration Date June 13, 2017
Owner (REGISTRANT) CMT2, Inc. CORPORATION COLORADO 509 Big Thompson Ave #300 Estes Park COLORADO 80517
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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Word Mark	NEED SAUCE?
Goods and Services	IC 043. US 100 101. G & S: Restaurant services, namely, providing of food and beverages for consumption on and off the premises. FIRST USE: 20040614. FIRST USE IN COMMERCE: 20040614
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	03.09.07 - Hedgehogs; Porcupines; Porcupines, armadillos, animals with exteriors of spines or quills 03.09.24 - Stylized small mammals, rodents, kangaroos, wallabies 19.09.03 - Bottles, jars or flasks with straight, vertical sides; Flasks with straight or vertical sides; Jars with straight or vertical sides
Serial Number	85722980
Filing Date	September 7, 2012
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	December 3, 2013
Registration Number	4483419
Registration Date	February 18, 2014
Owner	(REGISTRANT) Golden Flame Hot Wings, Inc DBA Golden Flame CORPORATION COLORADO Suite 156 1875 E. Hampden Ave Aurora COLORADO 80013

Attorney of Record Johnny Wilson

Description of Mark The color(s) Black, gold, orange white is/are claimed as a feature of the mark. The mark consists of black wording, "NEED SAUCE?" under the design of an armadillo on its back holding a bottle, with a body of gold and orange with white accents on its body and black stripes on the tail, arms and back.

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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...THAT'S ALL YOU NEED

Word Mark ...THAT'S ALL YOU NEED
Goods and Services IC 043. US 100 101. G & S: Restaurant services. FIRST USE: 20060000. FIRST USE IN COMMERCE: 20060000
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Trademark Search Facility Classification Code NOTATION-SYMBOLS Notation Symbols such as Non-Latin characters,punctuation and mathematical signs,zodiac signs,prescription marks
Serial Number 78741999
Filing Date October 27, 2005
Current Basis 1A
Original Filing Basis 1B
Published for Opposition June 20, 2006
Registration Number 3291919
Registration Date September 11, 2007
Owner

(REGISTRANT) GS ENTERPRISES LLC Fernando Garcia, a citizen of Mexico LIMITED LIABILITY COMPANY DELAWARE SUITE 902, 7272 WURZBACH RD. SAN ANTONIO TEXAS 78240

Attorney of Record L. Jeremy Craft and Andrew W. Chu
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20180314.
Renewal 1ST RENEWAL 20180314
Live/Dead Indicator LIVE

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LIFE NEEDS FROSTING

Word Mark LIFE NEEDS FROSTING

Goods and Services IC 043. US 100 101. G & S: Cafe and restaurant services; Cafe-restaurants; Cafeteria and restaurant services; Carry-out restaurants; [Bar and] restaurant services; Fast-food restaurants and snackbars; Take-out restaurant services; Self-service restaurants; Restaurant [, bar] and catering services; Coffee-house and snack-bar services; Preparation of food and beverages. FIRST USE: 20090203. FIRST USE IN COMMERCE: 20090203

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 77480772

Filing Date May 21, 2008

Current Basis 1A

Original Filing Basis 1B

Published for Opposition October 21, 2008

Registration Number **3670520**

Registration Date August 18, 2009

Owner (REGISTRANT) Cinnabon, Inc. CORPORATION WASHINGTON Suite 200 200 Glenridge Point Parkway Atlanta GEORGIA 303421450

(LAST LISTED OWNER) Cinnabon Franchisor SPV LLC LIMITED LIABILITY COMPANY
DELAWARE 5620 GLENRIDGE DRIVE ATLANTA GEORGIA 30342

Assignment Recorded ASSIGNMENT RECORDED
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20190801.
Renewal 1ST RENEWAL 20190801
Live/Dead Indicator LIVE

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