

In the United States Patent and Trademark Office

Applicant: Sycamore Brewing, LLC
Serial Number: 88/391,260
Mark: LUAU LEMONADE
Office Action Mailing Date: 07/01/2019
Examining Attorney: Joseph P. McCarthy

Response

I. Introduction

In the July 1, 2019, Office Action, Examining Attorney refused to register Sycamore Brewing, LLC's (the "Applicant") LUAU LEMONADE ("Applicant's Mark") mark for *beer; craft beer* on the basis of a potential likelihood of confusion with U.S. Registration No. 5219377 for LEMONGRASS LUAU ("Registrant's Mark") for *beer*.

The Examining Attorney refused registration on the grounds of an alleged likelihood of confusion because (1) the marks contain the word "LUAU", (2) the marks apply to the same class of goods, and (3) the marks appear in the same trade channels. Applicant respectfully disagrees with the Examining Attorney's conclusion as to the likelihood of confusion for at least the reasons set forth herein, and further contends that Applicant's mark be allowed to proceed to publication.

II. Likelihood of Confusion

Applicant's Mark, LUAU LEMONADE, is highly distinguishable from Registrant's Mark. While Applicant agrees with the Examining Attorney that the goods and trade channels through which the marks travel are commercially related, Applicant strongly believes that the marks are significantly different.

In determining the likelihood of confusion between two respective marks, the marks are to be compared in their entireties for similarity in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Vueve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v).

Indeed, a likelihood of confusion analysis cannot be predicated on the dissection of a given mark; that is, a *du Pont* examination may not apply to only part of a given mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). This is especially true in instances of a shared feature between marks. In analyzing the similarities of sight, sound, and/or meaning between two marks, an examination must take account of the overall impression created by the marks and not merely compare individual features. *See, e.g., Sun Banks of Fla., Inc. v. Sun Fed. Sav. and Loan Ass'n*, 651 F.2d 311, 317-18 (5th Cir. 1981); Restatement of Torts § 729 comment b.

Importantly, a likelihood of confusion is not satisfied by a "mere possibility," but instead requires probable confusion. *Bongrain Int'l (Am.) Corp. v. Delice de France, Inc.*, 1 USPQ 2d 1775, 1779 (Fed. Cir. 1987). When viewed in this context, Applicant's Mark is unlikely to cause confusion for the reasons set forth below.

A. Dissimilarity of the Marks

a. The Marks Differ in Appearance and Commercial Impression

The marks are significantly different in appearance and commercial impression, and the public will readily distinguish between LUAU LEMONADE and the Registrant's Mark. This situation is akin to the well-known case of *Stouffer Corp. v. Health Valley Natural Foods*, 1 USPQ 2d 1900 (TTAB 1987), where no likelihood of confusion was found between the applied for mark LEAN LIVING (for food, namely -- chicken crepes, lasagna and enchiladas) and the prior mark LEAN CUISINE (for similar goods -- frozen foods). The shared element "lean" was weak and the remaining features of the marks (LIVING v. CUISINE) were more than sufficient for consumers to distinguish between the marks. *See, also, Sun Banks v. Sun Federal Savings & Loan Assn.*, 651 F.2d 311 (11th Cir. 1983). That same proposition applies here. Consumers will rely on at least the distinctions between LEMONADE and LEMONGRASS as incongruent concepts or objects to distinguish between the respective marks and goods bearing those marks.

Additionally, "[t]he use of identical, even dominant, words in common, does not automatically mean that two marks are similar." *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987) (OATMEAL RAISIN CRISP distinct from APPLE RAISIN CRISP). When considered as wholes, the marks convey distinct respective impressions in a manner very similar to the marks at issue in *Juice Generation v. GS Enterprises LLC*, 115 USPQ 2d 1671 (Fed. Cir. 2015). In *Juice Generation*, the Court reasoned that although the dominant and shared features of the marks at issue (PEACE LOVE AND JUICE v. PEACE & LOVE) were virtually identical, an examination that lacked consideration for how the dominant and shared feature may convey a distinct impressions or connotations in consumers' minds was inadequate. *Id.* Here, LUAU as found in each of the marks is used as a modifier to modify LEMONGRASS and LEMONADE respectively. As to the former, LEMONGRASS is a reference to Cymbopogon, known commonly as "lemongrass," which is a grass/herb made popular through its widespread use in Asian cuisine, and which is consumed independently for its well-known healthful qualities. LEMONGRASS moreover ties the overall commercial impression of Registrant's Mark directly to those savory culinary sensibilities characteristic of herbs, and the savory nature of the luau cuisine typified by Asian Pacific pork barbecue seasoned with lemongrass among other healthy herbs. By contrast, the Applicant's Mark derives its distinct commercial impression and connotation from its obvious nod to a tropical party cocktail. LUAU LEMONADE thus connotes to the consumer a citrus fruit sweetened beverage complimented by the exotic luau beverages typified by tropical fruits like pineapple and starfruit, and which are regarded, if at all, for being antithetical to a health-conscious diet—a stark distinction from its LEMONGRASS counterpart.

By dissecting the marks and drawings comparison only to the shared element, LUAU, the Examining Attorney does not adequately capture the clear difference between Registrant's Mark and Applicant's Mark as the Court in *Juice Generation* forewarned. In doing so, the Examining Attorney flattens the overall meaning of the respective marks and thus misses the clear distinction made available through viewing the marks in their entireties. More specifically, by isolating its analysis of LUAU LEMONADE to the shared element as referenced, the Examining Attorney denies Applicant's Mark the significant contribution LEMONADE makes to its overall impression of a party cocktail-inspired sweet, tropical and fruited beverage.

Of additional and notable import, no likelihood of confusion exists because Applicant uses its mark in connection with its house mark, SYCAMORE, as shown below:



The Trademark Trial and Appeal Board (“TTAB”) has instructed that, “the addition of a house mark may avoid confusion when there are recognizable differences between common elements of the marks.” *In re Aspen Technology Inc.*, Serial No. 76/399,475 (T.T.A.B. July 19, 2006); *see also Rockwood Chocolate Co., v. Hoffman Candy Co.*, 152 USPQ 599 (C.C.P.A. 1967) (ROCKWOOD BAG-O-GOLD for candy not confusingly similar to CUP-O-GOLD for candy). Under our facts, Applicant not only uses its house mark, SYCAMORE, along with its LUAU LEMONADE mark, but Applicant also has a recognizable difference in the underlying mark itself, namely, the additional element LEMONADE that is nonexistent in the Registrant’s Mark and the use of the word LUAU at the beginning of the mark unlike the Registrant’s Mark that uses the shared element only at the end of its mark. Moreover, Applicant has a standard business practice of juxtaposing its house mark along with its individual product marks as shown below:





This consistent and reliable standard of use only further bolsters Applicant's position that the marks at issue are significantly different in appearance and commercial impression. It also serves as an additional counter to the Examining Attorney's position that a consumer might somehow confuse Applicant's Mark for some sort of proximate or disjointed variation of Registrant's Mark, or vice versa. Accordingly, the public will readily distinguish between the marks, and thus no likelihood of confusion exists.

b. The Marks Differ in Sound

Registrant's Mark and Applicant's Mark also differ in sound. A difference of as seemingly small as one letter has been found sufficient to dispel the likelihood of confusion, even on identical goods and even where the prior mark's use has been deemed famous. *See Swatch AG v. M.Z. Berger & Co., Inc.*, 108 USPQ2d 1463 (T.T.A.B. 2013) (finding no confusion between SWATCH and IWATCH). Although Applicant acknowledges the marks share the prefix LEMON, the respective suffixes attached to the respective uses of LEMON create marks that look and sound completely different—LEMON-ADE looks and sounds wholly different than LEMON-GRASS. Moreover, LEMONADE is much more rhythmic and concise in the full context of LUAU LEMONADE than is the harsher, less rhythmic suffix GRASS in LEMONGRASS LUAU. Accordingly, the public will readily distinguish between the marks, and thus no likelihood of confusion exists.

c. Trademark Examiner Misapplies Case Law in Comparing the Marks for Confusing Similarity

In asserting that Applicant's Mark presents confusing similarity to Registrant's Mark, the Examining Attorney applies valid legal precedent in two (2) distinct instances where the supposed underlying facts do not exist.

1. THE MARKS DO NOT SHARE THE SAME FIRST WORD

As a key proposition in his determination that Applicant's Mark is confusingly similar to Registrant's Mark, the Examining Attorney argues in relevant part:

In this case, the respective marks share highly similar shared wording LUAU. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark

[Emphasis added].

While the marks indeed share the word LUAU, that shared word appears first in only the Applicant's Mark. Thus, the Examining Attorney's reliance upon *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005) to compare the first words of the marks as prominent features, and *Century 21 Real Estate Corp., v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992) to support the burden on consumers to first notice an identical lead word, and *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047 (Fed. Cir. 2018) to emphasize the particular significance of a shared initial word between marks in defining their respective identities is done in error.

In light of the referenced discrepancy between the Examining Attorney's cited precedent and the favorable distinction therefrom provided by the Applicant's Mark as compared to the Registrant's Mark, Applicant respectfully submits that such discrepancy be viewed in the Applicant's favor. Therefore, because the initial words LUAU and LEMONGRASS lack any cognizable similarity of spelling, sound, syllable, or prefix, the public will readily distinguish between them and no likelihood of confusion thus exists.

2. A REDUCED OR SHORTENED VERSION OF THE MARKS IS NOT 'PSYCHEDELIC'

As an additional proposition in his determination that Applicant's Mark is confusingly similar to Registrant's Mark, the Examining Attorney argues in relevant part:

In addition, consumers are often known to use shortened forms of names, and it is highly likely that registrant and its mark would be referred to as simply PSYCHEDELIC Cf. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: "the users of language have a universal habit of shortening full names – from haste or laziness or just economy of words")

[Emphasis added].

Four days prior to the receipt of this Office Action on June 27th, 2019, Applicant received an Initial Refusal on its trademark registration application for PSYCHEDELIC FLOW from the Examining Attorney. In that Initial Refusal, the Examining Attorney asserted the following as a component part of his likelihood of confusion analysis:

In addition, consumers are often known to use shortened forms of names, and it is highly likely that registrant and its mark would be referred to as simply PSYCHEDELIC Cf. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: "the users of language have a universal habit of shortening full names – from haste or laziness or just economy of words")

[Emphasis added].

Applicant recognizes the general applicability of certain likelihood of confusion rule constructions and propositions like the one above. Applicant further recognizes that efficiency in administration of these Office Actions may justify a copy-and-paste technique where the underlying facts and circumstances between two distinct Office Actions are substantially similar. In such instances, the otherwise arbitrary inclusion of PSYCHEDELIC as the reference point to a shared element would be a mere oversight and the substantive application of the *Abcor Development* precedent would thus remain valid. However, that is not the case here.

Here, as demonstrated in the subsection 1 immediately above, the Examining Attorney has centered the likelihood of confusion analysis on the shared first word proposition, and seeks to further support that position with the *Abcor Development* finding. Applicant respectfully contends, therefore, that such is done in error, because the underlying fact assumed by the Examining Attorney—that Applicant’s Mark and Registrant’s Mark contain the same first word—is not true. In the present case, the first word of Applicant’s Mark is LUAU, while the first word in the Registrant’s mark is LEMONGRASS. It is thus not “highly likely” that consumers will shorten Registrant’s Mark in a manner consistent with how consumers will shorten Applicant’s Mark, because it is not clear how consumers will shorten the marks individually.

On the contrary, Applicant respectfully contends that the obvious disparity between the marks’ first words along the *Abcor Development* standard is so substantively favorable to a finding of distinctiveness that the Examining Attorney would not have promulgated that standard but for the mistaken belief that the marks share an identical first word. Accordingly, and considering that neither of the parties’ marks at issue contain the word PSYCHEDELIC, the public will readily distinguish between the marks, and thus no likelihood of confusion exists.

B. Existence of Third Party Use

The shared element between the marks, LUAU, is so widely used by third party breweries in their own marks, and so well distinguished by the beer consuming public on a regular basis, that Registrant’s Mark is entitled to a very narrow scope of protection. If third-parties in a particular field commonly use marks containing a shared term, consumers become conditioned to look to other elements of a mark to distinguish the source of the goods. *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996). Indeed, such “evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). Moreover, “where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. *Fleetwood Co. v. Mende*, 298 F.2d 797, 799, 49 C.C.P.A. 907, 1962 Dec. Comm’r Pat. 116 (C.C.P.A. 1962). An analysis of third-party marks must be done with respect to, “the types of [goods or] services rendered by the parties in the present proceeding.” *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1034 (TTAB 2016).

Here, Registrant’s Mark is entitled to a very narrow scope of protection, because the term LUAU is diluted and thus weak within the industry of beer. While there exist two (2) trademark registrations in the category of beer incorporating LUAU, a general search for “LUAU” through Untapped—the geosocial networking service and mobile phone application that allows its users to “check in” specific beers as they consume them, and share such check-ins and respective locations with other users—reveals more than one hundred (100) third party uses of substantial similarity to Registrant’s and Applicant’s marks. The two (2) trademark registrations and a small cross-section of fifteen (15) Untappd check-ins using LUAU is shown below, followed by a screen capture of the specific search via the Untappd engine:

United States Patent and Trademark Office

Registered Mark	Owner	Good	Registration Number
LUPU-LUAU	Dogfish Head Marketing, LLC	Class 032: Beer	5292573
LUAU KRUNKLES	Terrapin Beer Company, LLC	Class 032: Beer	5475137

Untappd

Unregistered Mark	Owner	Good
LU'AU RAKKER	Rakker Bierbrouwerij	Beer
CAPITAL LUAU	Marz Brewing Company	Beer
SOUTH PACIFIC LUAU	Nomad Brewing Co.	Beer
LUAU DAYDREAM	Mikkeller Brewing NYC	Beer
MIDNIGHT LUAU	Yellow Bridge Brewing Co.	Beer
LUAU	Twisted Spike Brewing Co.	Beer
CAMPERDOWN LUAU	Malt Shovel Brewery	Beer
WINTER LUAU	Prairie Artisan Ales	Beer
HUMULUS LUAU	Wild Mind Artisan Ales	Beer
LUAU SLUSH	Wiley Roots Brewing Company	Beer
CHI-TOWN LUAU	MobCraft Beer	Beer
LEAP YEAR LUAU IMPERIAL IPL	Eternity Brewing	Beer
TROPIC LUAU	Columbia Kettle Works	Beer
LATE TO THE LUAU	Oregon City Brewing Company	Beer
BELGIAN LUAU	Brown Iron Brewhouse	Beer

The screenshot shows the Untappd website interface. At the top, the URL is 'untappd.com/search?q=luau&type=beer&sort=all#'. The navigation bar includes 'UNTAPPD DRINK SOCIALLY', 'The Pub', 'Top Rated', 'Supporter', and 'Help'. A search bar contains 'luau' and a 'Search' button. Below the search bar, there are tabs for 'Beer', 'Brewery', and 'Venue'. The main content area displays '7367 beer results for "luau"' and a 'Sort by: Most Popular' dropdown. Five beer results are listed:

Beer	Brewery	ABV	IBU	Rating
Luau Krunkles Terrapin Beer Co. IPA - American		6.5%	72	4.5 (3,754)
Lupu-Luau IPA Dogfish Head Craft Brewery IPA - American		7.3%	45	4.5 (3,588)
Lemongrass Luau Kona Brewing Company Spiced / Herbed Beer		5%	20	4.5 (3,517)
Lemongrass Saison Mau Brewing Company Farmhouse Ale - Saison		5.2%	15	4.5 (3,568)
Luau Lemonade Sycamore Brewing Sour - Gose		4.7%	N/A	4.5 (3,719)

On the right side, there are sections for 'Global Top Beers' and 'Trending Locations'. The 'Global Top Beers' list includes Guinness Draught, Kentucky Breakfast Stout, Canadian Breakfast Stout, Bourbon County Brand S..., Celebration Fresh Hop IPA, Heineken, IPA, Tripel Karmeliet, Stone Enjoy By 01.01.20..., and Punk IPA. The 'Trending Locations' section shows Madison Square Garden.

While an individual business may register its beers and marks on Untappd, third-party use of such beer and marks is completely user driven. In other words, the owner of a given mark is made manifest only through a third-party “check-in” of a beer product connected thereto. Such widespread and routine distinction between the marks upholds the aforementioned *Bongrain Int’l* proposition that a likelihood of confusion may not rest on the mere possibility of confusion; that a likelihood of confusion must be probable. *Bongrain Int’l (Am.) Corp. v. Delice de France, Inc.*, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987). Due to the many LUAU-formative third party marks in the beer industry, as illustrated above, consumers have on tens of thousands of individual occasions readily distinguished between the Registrant’s Mark and the Applicant’s Mark, and will continue to do so. Recognition about the existence of such third-party use and the well-conditioned beer consumer thus reveals that there is no likelihood of confusion between the parties’ marks.

III. Conclusion

When the marks are compared in their entireties, Applicant’s Mark is not confusingly similar to the Registrant’s Mark cited by the Examining Attorney. Particularly, the applied for mark LUAU LEMONADE is highly distinguishable from the Registrant’s Mark due to the differences in appearance, sound, and overall commercial impression. Additionally, the narrowed scope of protection afforded the Registrant’s Mark due to the widespread third-party use of LUAU-formative marks further warrants registration of Applicant’s Mark. For the

foregoing reasons, it is respectfully submitted that the Applicant's Mark can co-exist with the Registrant's Mark, and further that the Examining Attorney allow Applicant's Mark to proceed to publication.

Respectfully Submitted,

Sycamore Brewing, LLC

_____/s/_____

W. Michael Boyer, Esq.
Attorney of Record