RESPONSE TO OFFICE ACTION

Applicant respectfully requests that the Examining Attorney reconsider the Section 2(d) refusal to register the mark LTK in application serial number 88496299 (the "Mark") based on U.S. Registration No. 3154635 (U.S. Registration No. 3154635 the "Cited Mark").

For the reasons set forth below, Applicant respectfully contends that the Mark is not likely to cause confusion with the Cited Mark because of the distinct differences between the Cited Mark's services and the Mark's goods. Accordingly, Applicant's Mark is registerable over the Cited Mark.

I. Argument Regarding 2(d) Refusal

The Examining Attorney refused registration of Applicant's Mark LTK in Class 33 for "Wine" under Section 2(d) of the Lanham Act, asserting that Applicant's Mark is likely to be confused with the Cited Mark for LTK in Class 43 for "Restaurant services." Applicant submits that its Mark is not likely to be confused with the Cited Mark for the reasons detailed below, and respectfully requests that the refusal be withdrawn.

Determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (Fed. Cir. 1973). Those factors include the Mark and Cited Mark's similarity or dissimilarity of the goods or services. *Id*.

A likelihood of confusion may be negated even between identical marks, if "the goods and services are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source." T.M.E.P. §1207.0l(a)(i). Differences between the Mark's goods and the Cited Mark's services eliminates any likelihood of confusion among prospective purchasers.

A. Applicant's Goods Associated with the Mark are Substantially Different than the Services Associated with the Cited Mark.

The Cited Mark is a registration for restaurant services in International Class 43. Meanwhile, Applicant's Mark is for use in connection with selling wine. There is no dispute that the Mark's good (wine) is different than the Cited Mark's services (restaurant services). Instead, the Examining Attorney asserts that wine and restaurant services are related because "entities commonly produce its own wine and also provide restaurant services, all under the same mark." Office Action, p. 3.

However, there is no per se rule that similar marks used in connection with both beverage products and restaurant services equates to a likelihood of confusion. *See* TMEP 1207.01(a)(ii)(A). As a result, "the relatedness of such goods and services may not be assumed and the evidence of record must show 'something more' than that similar or even identical marks are used for food products [or beverages] and for restaurant services." *Id.*; *see also In re Coors*

Brewing Co., 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (quoting *Jacobs v. Int'l Multifoods Corp*., 668 F.2d 1234, 1236, 212 USPQ 641, 642 (C.C.P.A. 1982).

The Examining Attorney's apparent argument that there is "something more" is due to the fact that some entities that produce wine also provide restaurant services. The Examining Attorney attaches as evidence seven website pages of entities selling wine and providing restaurant services. However, all of the cited evidence is for wineries, rendering the evidence inapplicable to the present situation:

- Marilake *Winery*
- Grace *Winery*
- Narcisi *Winery*
- Folino Estate *Vineyard & Winery*
- Sorrenti Cherry Valley *Vineyards*
- Cooper's Hawk *Winery* & Restaurants
- The New Home *Winery*

See Office Action, pp. 8-39. The fact that a winery also provides food options via restaurant services to customers who are there to drink proprietary wine does not demonstrate that there is confusion between the Mark and the Cited Mark. Notably, the Cited Mark is not for a winery. Instead, it is for a restaurant in Boston, Massachusetts named Legal Test Kitchen (LTK). *See* Exhibits 1 and 2. Although Legal Test Kitchen's website mentions serving alcoholic beverages, nowhere does it specifically mention wine, its own brand of alcoholic drinks, or that it produces its own brand of wine. *See id*.

The present situation is similar to that faced by the Federal Circuit in *In re Coors Brewing Co*. In that case, the examining attorney introduced evidence from several sources discussing the practice of some restaurants to offer private label or house brands of beer; evidence that brewpubs who brew their own beer often feature restaurant services; and copies of several third-party registrations showing that a single mark had been registered for both beer and restaurants services. *In re Coors Brewing Co*., 343 F.3d at 1345. Ultimately, the Federal Circuit held there was no likelihood of confusion because it was "a very weak evidentiary basis for a finding of relatedness" that "a tiny percentage of all restaurants also serve as a source of beer." *Id*. The same rationale applies here.

According to the National Restaurant Association, there are more than 1 million restaurants in the United States. *See* Exhibit 3. According to the National Association of American Wineries, there are 10,043 wineries in the United States as of January 2019. *See* Exhibit 4. If you assume every winery offers restaurant services—which is not the case—then approximately 1% of businesses offering "restaurant services" are also selling their own branded wine. That is "a very weak evidentiary basis for a finding of relatedness." *See In re Coors Brewing Co*., 343 F.3d at 1345.

Board decisions further illustrate that point. In *In re Wente Bros. d/b/a Tamas Estates*, the applicant sought to register the mark ANDIAMO for "wine" in Class 33, but was refused by the examining attorney based on ANDIAMO in Class 43 for "restaurant services." 2009 WL 4085608

(TTAB Aug. 6, 2009). The Board reversed the refusal and allowed the mark to register, reasoning as follows:

> There is no evidence that registrant is a source of wine or that anyone other than applicant is such a source. The fact that applicant has a restaurant at its winery is not enough to show that the goods are related. 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." *Bongrain International (American) Corp. v. Delice de France, Inc*., 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987). Indeed, we have no reason to conclude that the level of confusion would be higher in this case than in Coors Brewing.

Id. at *5. *See also* In *In re Javiers, Inc*., 2008 WL 1741899 (TTAB April 2, 2008) (reversing refusal of applicant's JAVIER'S mark for restaurant services, notwithstanding JAVIER ASENSIO mark for wines and liquors noting, "It is undisputed that restaurants serve wine, beer, and liquor, and that applicant, in fact, serves beer, tequila, and brandy. However, it does not necessarily follow that consumers expect that restaurant services and wines and liquors to emanate from a single source.").

There is even less potential for confusion here than there was in *In re Wente Bros*., as Applicant does not offer any restaurant services (which the applicant did in that case). In sum, the mere fact that restaurants serve wine and other alcoholic beverages does not mean that consumers expect restaurant services and wines to emanate from a single source. To the contrary, consumers typically do not encounter wine and restaurant services from the same source, with the possible exception of when a consumer visits a winery, which is far different than the present situation dealing with an ordinary restaurant that is not a winery and does not produce its own wine.

As a result, there is no likelihood of confusion between the Mark and the Cited Mark, and Applicant's mark should be allowed to register.