

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

Date: March 6, 2020

To: Elissa Garber Kon  
Examining Attorney  
Law Office 106  
United States Patent and Trademark Office

Re: Ser. No.: 88474353  
Mark: SIR WINSTON  
Office Action: July 11, 2019

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**APPLICANT'S RESPONSE TO OFFICE ACTION**

The Examining Attorney has refused registration of Applicant's Mark, SIR WINSTON for use in connection with "bourbon whiskey." ("Applicant's Mark"), based on likelihood of confusion under 15 U.S.C. § 1052(d) with U.S. Registration No. U.S. Registration Nos. 4044161 and 4044160 ("Registrant's Marks") for SIR WINSTON'S and SIR WINSTON'S (design) covering "restaurant and bar services."

Based on the amendments to Applicant's Mark and arguments set forth below, Applicant respectfully requests that the Examining Attorney reconsider and withdraw the rejection and pass Applicant's Mark on to Publication.

**I. Applicant's Mark is Not Likely to Cause Confusion with Registrant's Mark**

The Applicant's Mark is not likely to cause confusion as to source with the Registrant's Marks. First, the Marks have differing overall commercial impressions and second, there is not "something more" linking Registrant's services to Applicant's goods so as to support a finding that they are related.

***A. The Marks Have Differing Overall Commercial Impressions***

Applicant's Mark differs in overall commercial impression from Registrant's Marks. While the dominant portion of the Marks may be SIR WINSTON, the addition of the apostrophe S on Registrant's Marks is significant in that it changes both the sight and sound of Registrant's Marks in meaningful ways, but more importantly the meaning, as it transforms the wording from a noun to a possessive. In the context of Registrant's services—"restaurant and bar services"—it

implies that those services are being provided by SIR WINSTON, which here clearly refers to Sir Winston Churchill, as demonstrated by Registrant's design mark.

Applicant's Mark SIR WINSTON, on the other hand, is made in reference to the name of a dog owned by the Applicant's owner: Winston. This is readily apparent from the specimen submitted herewith.

As such, Applicant respectfully asserts that the differences in overall commercial impression between Applicant's Mark and that of the Registrant are sufficient to make confusion unlikely, particularly in view of the differences in services discussed below.

*B. The Marks Are For Different Goods / Services*

Applicant directs the Examining Attorney to TMEP 1207.01(a)(ii)(A), discussing the fact that there is no *per se* rule connecting food or beverage products with restaurant services, and the requirement that "something more" must be shown in the record to lead to a conclusion of confusion.<sup>1</sup>

First, the general sense, there is insufficient evidence of record to establish that restaurant services are sufficiently similar to establish confusion with whiskey because there is not a showing of "something more." The Office Action purports to establish the "something more" requirement by discussing the occasional practice of private labeling of bourbon for restaurants. Applicant respectfully disagrees that such evidence meets that burden in the present matter.

In *In re Coors*, the court discussed the "something more" requirement in the context of private labeling for beer, which is undoubtedly more common than in the case of spirits:

While there was evidence that some restaurants sell private label beer, that evidence did not suggest that such restaurants are *numerous*. And although the Board had before it a few registrations for both restaurant services and beer, the very small number of such dual use registrations does nothing to counter Coors' showing that only a very small percentage of restaurants actually brew their own beer or sell house brands of beer; instead, the small number of such registrations suggests that it is quite uncommon for restaurants and beer to share the same trademark. Thus, the evidence before the Board indicates not that there is a substantial overlap between restaurant services and beer with respect to source, but rather that the degree of overlap between the sources of restaurant services and the sources of beer is *de minimis*. We therefore disagree with the Board's legal conclusion that Coors' beer and the registrant's restaurant services are sufficiently related to support a finding of a likelihood of confusion.

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<sup>1</sup> *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) ); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Applicant respectfully notes that while the Office Action makes note of the “trend” of providing private labeling of whiskey, no persuasive statistics or numbers have been provided to substantiate that such a practice is anything more substantial than the de minimis labeling found in *Coors*. As such, Applicant respectfully submits that the Office Action fails to establish “something more” to support a conclusion of likely confusion in the present matter.

Further, in this specific case, Applicant respectfully submits that Registrant’s services are not substantially similar to the applied-for goods because Registrant *does not* provide SIR WINSTON private label whiskey. In fact, quite the opposite is true. As shown in the attached webpage, Registrant operates a restaurant aboard the *Queen Mary*. Also attached is a copy of Registrant’s menu, which very clearly features several name-brand spirits as well as, coincidentally, co-labeled spirits featuring the *Queen Mary* name along with that of the spirit maker (Woodford Reserve, Whistle Pig, etc.). Such practice by the Registrant would seem to make confusion in the present matter more unlikely.

And while Applicant maintains that Registrant’s private labeling does not indicate that the practice is widespread, such usage in this actual matter contrasts sharply with the Board’s finding of “something more” requirement in *Tao Licensing, LLC v. Bender Consulting Ltd.*,<sup>2</sup> where the Board found that TAO VODKA for “alcoholic beverages” was likely to cause confusion with the mark TAO for “restaurant and nightclub services” where the record showed that the Registrant used the TAO mark “to promote alcoholic beverages, its primary source of revenue, and that its menus featured beverages with TAO-formative names, amongst other business practices linking the TAO mark with alcohol, which met the requisite ‘something more’ to establish that the goods and services were related” TMEP 1207.01(a)(ii)(A).

As is readily apparent from the above evidence, Registrant is in the opposite position, and any concern about confusion as to source or as to future competition between the parties that would be harmful to Registrant is highly unlikely. As such, there is not “something more” here in either the general case or the specific facts at hand, and therefore the goods and services are not sufficiently related to support the 2(d) rejection, so it should be withdrawn.

As such, Applicant respectfully asserts that confusion in the present matter is unlikely and requests passage on to publication.

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<sup>2</sup> 125 USPQ2d 1043, 1060 (TTAB 2017).

**II. Consent**

The name shown in the mark does not identify a particular living individual.

**III. Specification**

With this paper, the Applicant has submitted a new specimen.

**IV. Conclusion**

In light of the foregoing, Applicant respectfully requests withdrawal of the above rejections and passage of the Applicant's Mark on to Publication.

Respectfully submitted,

DAVIS BROWN LAW FIRM

Dated: March 6, 2020

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