

RESPONSE TO OFFICE ACTION

In the Office Action dated May 5, 2020, the Examining Attorney refused registration of the subject mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on an alleged likelihood of confusion with Registration Nos. 4481366 and 4609032. Applicant hereby submits the following response in support of registration.

APPLICANT'S MARK IS NOT CONFUSINGLY SIMILAR TO THE CITED MARK

The Office has preliminarily refused to register Applicant's TESLA mark covering "Distilled agave liquor; distilled blue agave liquor" in Class 33 based on an alleged likelihood of confusion with Registration No. 4481366 for the mark SPIRIT TESLA covering "Brandy; Distilled Spirits" in Class 33, owned by Bozic's Imports & Wholesale Liquors and Registration No. 4609032 for the mark SIXPOINT TESLA covering "beer" in Class 32, owned by Sixpoint Craft Ales. The Office asserts that because Applicant's mark and the cited marks share the word TESLA and identify arguably related goods, confusion is likely. For the reasons set forth below, Applicant respectfully disagrees.

To determine whether a likelihood of confusion exists between two marks, the Office must consider the factors identified in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). A review of the following *DuPont* factors demonstrates that no likelihood of confusion exists between Applicant's Mark and the cited mark:

- the visual, phonetic and connotative differences between the marks;
- the differences between the goods identified by the marks and their channels of trade; and
- the coexistence of analogous third-party marks for alcoholic beverages.

A. The Parties' Marks are Different in Sound, Appearance and Meaning

The similarity of trademarks is determined by evaluating "the marks in their entireties as to appearance, sound, connotation, and commercial impression." TMEP § 1207.01; *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). No likelihood of confusion exists between Applicant's Mark and the cited marks because they are different in appearance, sound, and overall commercial impression. The cited marks contain the distinguishing wording "SPIRIT" and "SIXPOINT" which are entirely absent from Applicant's Mark and which create visual, aural, and connotative differences between the parties' marks.

The fact that Applicant's Mark and the cited marks contain a common element does not lead to a conclusion that consumers are likely to be confused. To the contrary, the Board and courts have often found that marks that contain a common term are not confusingly similar, even if used for similar or overlapping goods or services, if the marks create different commercial impressions. *See, e.g., In re Hearst Corp.*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) (marks VARGA GIRL and VARGAS, both for calendars, sufficiently different in sound, appearance, connotation, and commercial impression to negate likelihood of confusion). Given the differences between Applicant's Mark and the cited marks in appearance, sound, and overall commercial impression, confusion is not likely.

B. The Goods Identified by Applicant's Mark and the Cited Marks are Distinguishable

Differences between the goods identified by even visually similar marks can be sufficient to overcome any potential confusion. *See, e.g., Harvey Hubbell, Inc. v. Tokyo Seimitsu Co.*, 188 U.S.P.Q. 517, 520 (T.T.A.B. 1975) (holding that no likelihood of confusion existed between PULCOM and PULSECOM based on differences between the parties' electronic goods); *In re Jacques Bernier Inc.*, 1 U.S.P.Q.2d 1924, 1925 (T.T.A.B. 1987) (finding no likelihood of confusion between INTERNATIONAL SPORTS CLUB for clothing and SPORTS CLUB for cologne).

In the instant case, and although the Office has included examples of retailers selling various alcoholic beverages to demonstrate that these goods travel in the same channels of trade, Applicant's goods, namely distilled agave liquor; distilled blue agave liquor, are distinct from the alcoholic beverages identified by the cited marks, namely beer and brandy. Federal law requires extensive and precise labeling rules which include disclosures that would ensure that no consumer could possibly be confused that the two products came from the same source. Moreover, and as evidenced by the summary of US laws attached as Exhibit A, alcohol and beer/ale are regulated differently, governed by separate regulations in the majority of states, and are even classified differently for trademark purposes. Alcoholic beverages are more highly regulated and controlled than beer. Therefore, the fact that beer and other beverages such as distilled spirits or wine contain alcohol is insufficient to prove that the goods are related. Due to the differences in regulations and the manner in which these goods are sold, consumers readily view beer and other alcoholic beverages differently, and in many states, purchase them in different venues.

Similarly, the coexistence of the analogous marks discussed below suggests the differences between alcoholic beverages are sufficient to render the marks distinct, particularly when the marks consist of the name of an individual. For this reason, the Office allowed registrations for the marks WILSON, WILSON VINEYARD, and WILSON'S ORCHARD each of which cover different alcoholic beverages, to coexist. If the Examining Attorney's view is that the goods identified by the cited marks could conceivably be sold together with Applicant's goods and by the same source, then certainly the goods identified by the foregoing third party marks could likewise be sold with the goods listed in the cited marks. Yet, the foregoing third party marks are registered on the Principal Register, and coexist. Applicant's Mark should be treated no differently, and should be approved for publication.

C. The Existence of Analogous Marks Indicates that Applicant's Mark and Cited Marks Can Coexist

A brief review of the Office's records discloses that registrations for marks consisting of a surname and covering alcoholic beverages coexist, namely:

Mark	Registration No.	Relevant Goods	Owner
LORD + WILSON	5833270	Distilled spirits in Class 33	Lord and Wilson, LLC
WILSON FOREIGNER	5143101	Wine in Class 33	Wilson Foreigner LLC
WILSON VINEYARD	5014307	Wine in Class 33	Wilson Vineyards
WILSON'S ORCHARD	4878178	Hard cider in Class 33	Fox Ridge Farm, Inc. DBA Wilson's Orchard
WILSON DANIELS	1943395	Wine, for sale to wholesalers and consumers in Class 33	Wilson Daniels Ltd.
WILSON	1178406	Whiskey in Class 33	Joseph E. Seagram & Sons, Inc. a.k.a.

			Wilson Distilling Company
GORDON & MACPHAIL	4929782	Scotch whisky in Class 33	Speymalt Whisky Distributors Limited
COSSART GORDON	3268440	Wine in Class 33	Madeira Wine Company, S.A.
GORDON'S	3391390	Distilled Spirits in Class 33	Diageo Brands B.V.
WILLIAM GORDON WINERY	4396354	Wine in Class 33	William Gordon, LLC
GORDON ROUGE. & Design	0312653	Champagne wines in Class 33	G.H. Mumm & Cie

Copies of the foregoing registrations are attached hereto as Exhibit B.

In light of the coexistence of these marks for alcoholic beverages, consumers have become conditioned to distinguish between those marks based on subtle differences between the marks and/or the goods they identify. See TMEP § 1207.01(b)(ix); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974) (stating that the public can "easily distinguish slight differences" between marks containing commonly used terms, even when the goods are related). Thus, the Office has acknowledged that marks listed above can co-exist on the Principal Register in this field.

Given that Applicant's Mark and the cited marks contain visual, phonetic, and connotative differences and are used in connection with distinguishable goods, Applicant submits that the Office should conclude that Applicant's Mark can coexist with the cited marks without causing consumer confusion just as the marks listed above can coexist.

III. **CONCLUSION**

For the foregoing reasons, Applicant respectfully requests that the Office reconsider and withdraw the refusal based on an alleged likelihood of confusion.