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

[USPTO Examining Attorney]

[Law Office Assigned]

[USPTO Examining Attorney’s Phone Number]

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RE: Serial No.: [Application Serial Number]

Mark: [Applicant’s Mark]

Applicant: [Applicant]

Action of: [Sent Date of Office Action]

# APPLICANT’S RESPONSE TO OFFICE ACTION

Applicant, HAYSTACK BURGERS & BARLEY (hereinafter “Applicant”), respectfully submits the following response to the Office Action, regarding the above referenced application:

# ARGUMENT AGAINST REFUSAL UNDER § 2(d) LIKELIHOOD OF CONFUSION

The Examining Attorney preliminarily refused registration of Applicant’s word mark because of the mark in U.S. Registration No. [U.S. Registration No.].

|  |  |  |
| --- | --- | --- |
|  | Our mark | The mark cited by the examiner |
| Mark | HAYSTACK BURGERS & BARLEY | BURGERS & BARLEY |
| Goods/Services | full-service restaurant | Restaurant and bar services |

# Legal Standard

The likelihood of confusion between two marks under Section 2 of the Lanham Act, 15

U.S.C. § 1052, is determined on a case by case basis, aided by the *Du Pont* factors. The thirteen factors set forth in *DuPont* are used to determine a likelihood of confusion between two marks, where available. These factors are:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i. e. “impulse” vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
10. The market interface between applicant and the owner of a prior mark.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion, i. e., whether de minimis or substantial.
13. Any other established fact probative of the effect of use.

[*Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361](https://casetext.com/case/application-of-ei-dupont-denemours-amp-co) (C.C.P.A. 1973).

# Arguments

**A.** The dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression

The dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression is evident when comparing HAYSTACK BURGERS & BARLEY to BURGERS & BARLEY. The applicant's mark, HAYSTACK BURGERS & BARLEY, contains the distinguishing term "HAYSTACK," which is neither generic nor descriptive of the services offered, creating a unique visual, auditory, and conceptual identity. The initial word "HAYSTACK" is phonetically distinct and infuses the mark with a rustic, artisanal quality, potentially invoking imagery related to farming or abundance, which is absent in the competing mark. Meanwhile, by starting simply with "BURGERS," the conflicting mark BURGERS & BARLEY lacks such distinctive characteristics and carries a more straightforward impression centered on the food (burgers) and drink (barley). This foundational difference in the beginning of each mark alters the commercial impression under which consumers perceive and recall each brand, significantly reducing the likelihood of confusion.

**B.** The dissimilarity and nature of the goods or services and trade channels of the two marks

Examining the dissimilarity and nature of the goods or services and trade channels, HAYSTACK BURGERS & BARLEY and BURGERS & BARLEY, while both operating in the realm of restaurant and bar services, cater to potentially different audience expectations and experiential promises due to their branding. HAYSTACK BURGERS & BARLEY's emphasis on a full-service dining experience that includes a specific focus on artisanal food offerings (e.g., specialty burgers, sandwiches, and craft beer) contrasts with the broader scope suggested by BURGERS & BARLEY. Although both establishments provide dine-in and take-out, the former's branding implies an elevated or niche dining theme, which can influence patron perception and inform trade channel strategies. Additionally, potential differences in ambiance, service style, and consumer marketing based on their respective brand identities help delineate the target customer groups and further minimize overlap in consumer base and subsequent confusion.

**C. The conditions under which and buyers to whom sales are made, i. e. “impulse” vs. careful, sophisticated purchasing.**

The conditions under which and buyers to whom sales are made, along with the consideration of sophisticated purchasing, argue against likely confusion between HAYSTACK BURGERS & BARLEY and BURGERS & BARLEY. The clientele engaging with these establishments are likely to be discerning consumers who make decisions based on specific dining preferences, culinary experiences, and brand loyalty. Especially in the craft or gourmet segments of the restaurant market, consumers often exhibit heightened brand awareness and are motivated by unique differentiators such as menu offerings, culinary reputation, and thematic ambiance. Even casual diners might recognize the implicit narrative or thematic branding associated with "HAYSTACK" and seek it out purposefully for its particular dining style or selection, thus employing a level of thoughtful selection that diminishes confusion potential amidst similar service categories. This informed consumer behavior under sophisticated purchasing contexts provides a strong barrier against the likelihood of mistaken identity between these two dining establishments.

# Conclusion

There is no likelihood of confusion between the Applicant’s mark HAYSTACK BURGERS & BARLEY and the Cited Mark BURGERS & BARLEY. Considering the foregoing arguments, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant’s mark.

[Applicant’s attorney’s name]

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