**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 | {{applicant\_mark\_goods\_and\_services  }} | restaurant and bar services focused on burgers and barley-related drinks |

# 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

When examining the trademarks "HAYSTACK BURGERS & BARLEY" and "BURGERS & BARLEY," a clear distinction emerges based on their overall appearance, sound, connotation, and commercial impression...

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

While both marks are ostensibly related to restaurant and bar services, there is notable dissimilarity in the comprehensive nature of the goods and services offered under each brand...

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

The nature of the restaurant industry often means that consumers are attentive and sophisticated in their purchasing decisions, particularly when dining experiences are being selected...

# 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]

[Applicant’s attorney’s firm]

[Applicant’s attorney’s street address]

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