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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77541687
Applicant	The LETCO Group,LLC
Applied for Mark	LIVING EARTH
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Date	06/08/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant:	The LETCO Group, LLC	§	Examiner: Odessa Bibbins
Serial No.:	77/541,687	§	
Filed:	August 7, 2008	§	Law Office: 105
Mark:	LIVING EARTH	§	

APPLICANT'S REPLY TO THE EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant submits this Reply to the Examining Attorney's Appeal Brief filed on May 19, 2010.

I. There is Not a Likelihood of Confusion Between Applicant's LIVING EARTH Mark and the Cited LIVING SOIL Mark.

In assessing the likelihood of confusion between two marks, an overriding principle is that "marks must be compared in their entireties" and that "likelihood of confusion cannot be predicated on dissection of a mark." *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985). The question in this matter is not whether the term EARTH conveys a distinct impression from SOIL,¹ but rather, whether LIVING EARTH sufficiently differs from LIVING SOIL in terms of sound, appearance, and meaning when the marks are compared in their entireties.

A. Applicant's Mark and The Cited Mark Materially Differ in Terms of Sound and Appearance.

The Examining Attorney's arguments notwithstanding, there can be no question that Applicant's Mark and the Cited Mark materially differ in terms of sound and appearance. While

¹ The Examiner inappropriately dissects Applicant's mark and then launches her likelihood of confusion analysis based on this dissection, stating: "Living is the dominant term in the mark of the parties . . . Therefore the question is whether the term, EARTH in applicant's mark creates a different commercial impression and connotation that overcomes the likelihood of confusion." Examiners Appeal Brief, p. 3

the marks share the diluted LIVING component (discussed below), the only similarity between second components, “EARTH” and “SOIL,” is that they are both monosyllabic. Otherwise, “EARTH” and “SOIL” differ substantially in terms of pronunciation and orthography. This high degree of difference in sound and appearance of the marks is, in and of itself, sufficient to distinguish the marks and preclude a likelihood of confusion.

B. LIVING SOIL is a Weak Mark That Coexists With Numerous LIVE-formative Marks for use with Similar Goods:

The substantial differences between the marks in terms of sound and appearance is even more pronounced when the weak nature of the cited LIVING SOIL mark is considered. As shown in Applicant’s Appellant Brief (pp. 7-9), the cited LIVING SOIL mark coexists on the principal register with numerous LIVING/LIVE-formative marks for use with soil and fertilizer related goods, including: **DR. SUBLER’S LIVING SOIL** for soil additives, fertilizers and related goods, **LIVING MULCH** for use with potting soil and growing media for plants, **LIVE EARTH** for soil amendments and fertilizer, and **SOILS ALIVE** for use with fertilizers and soil amendments. That LIVING SOIL can coexist with these marks for directly overlapping goods without a likelihood of confusion arising shows that the shared LIVING/LIVE component is a weak component that it is unlikely to trip up consumers.

Just as LIVING SOIL can coexist with these numerous LIVING/LIVE-formative marks based on the differences between the marks, when considered in their entirety, Applicant’s LIVING EARTH formative mark can coexist with LIVING SOIL without a likelihood of confusion arising.

C. Applicant's Mark and the Cited Mark Materially Differ in Terms of Meaning and this Difference is Clear when Applicant's Mark is Not Improperly Dissected:

When Applicant's mark is considered in its entirety, as it should be, it is clear that the term EARTH is used to refer to its principal meaning—the Earth.² As Applicant has argued throughout the prosecution of this Application, Applicant's LIVING EARTH mark impresses upon consumers the image of a vibrant, fertile planet and suggests that the Class 1 potting soil goods covered by Applicant's Mark are conducive to fostering the ecological and environmental health of planet Earth. Applicant's Mark intentionally evokes environmental, earth-friendly connotations about its product—that by planting plants and trees using Applicant's product, consumers are contributing to the health of the planet.

In contrast, the cited LIVING SOIL mark solely focus consumers on the characteristics of the goods offered under the cited mark, namely soil.

When the marks are properly compared in their entireties, it is quite clear that they convey distinct meanings and materially different commercial impressions. When this difference is considered along with the material differences in sound and appearance and the very weak nature of the cited mark, it is clear that confusion is unlikely.

II. EARTH is Not a Generic or Descriptive Component of Applicant's Mark and A Disclaimer is Not Necessary:

As noted in Applicant's Appeal Brief, the test for determining whether a term is generic in connection with certain goods or services is whether the term's principal significance to the purchasing public is the name of an article. *Ty Inc. v. Softbelly's, Inc.*, 353 F.3d 528, 69

² While the Examining Attorney contends that the term "Earth" has multiple meanings and can also be used to refer to dirt, by improperly dissecting Applicant's Mark in her analysis, the Examining Attorney has failed to consider which meaning of "EARTH" is likely to be perceived by consumers when they encounter Applicant's Mark in its entirety.

U.S.P.Q.2d 1213 (7th Cir. 2003) (The “primary significance” of the term is the legal test of genericness.)

Because the primary significance of the term “EARTH” to the purchasing public is the undoubtedly the word itself, the Earth, the term is not generic or descriptive for Applicant’s Class 1 potting soil goods. As previously noted, a consumer interested in purchasing gardening supplies would not inquire at a store for “earth.” Rather, and much more naturally, the consumer would inquire about and purchase “soil,” “dirt,” “mulch,” “peat moss,” etc. The Examining Attorney has simply failed to address this.

That the term “EARTH” is not interpreted in the marketplace (or by the U.S.P.T.O.) to be a generic or descriptive term for soil amendments, potting soil, and related Class 1 goods is evidenced by the 26 registered or published EARTH-formative U.S. marks shown in Applicant’s Appellant Brief (pp. 10-16), all for use with related goods and none of which contain disclaimers for “EARTH.” These marks include: **LIVE EARTH, PURE EARTH, RENEWED EARTH, EARTH BLEND, EARTH PERFECT, MAGIC EARTH, MIRACLE EARTH, and SOLID EARTH.** Just as EARTH-formative marks were published or registered on the Principal Register without the need for a disclaimer of the “EARTH” component, Applicant’s Mark should be allowed to register on the Principal Register without such a disclaimer.

It is also important to note that, when Applicant’s Mark is properly considered in its entirety, it is clear that “EARTH” is not used in a descriptive or generic manner. By taking the “EARTH” component out of the context of the composite mark and solely focusing on the Examining Attorney’s contention that “EARTH” equates to dirt, the Examining Attorney has missed the suggestive nature of Applicant’s Mark altogether—that that Applicant’s goods are conducive to fostering the ecological and environmental health of planet Earth. When this

context is considered, however, it is clear that Applicant's uses "EARTH" to refer to the planet, rather than soil and, thus, that Applicant is not using the term in a generic or descriptive sense.

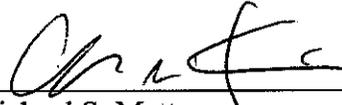
Lastly, as noted in Applicant's Appellant Brief but not addressed by the Examining Attorney in her Appeal Brief, even if "EARTH" was understood to mean "dirt," or "soil," then Applicant's combination of "LIVING" and "EARTH" would give rise to an incongruity ("dirt" or "soil" cannot be said to be "living") and the mark would therefore be unitary such that no disclaimer would be required. *See e.g.*, T.M.E.P. §1213.05(d). ("If two or more terms are combined in a mark to create an incongruity (e.g., URBAN SAFARI, MR. MICROWAVE, and DR. GRAMMAR), the mark is unitary and no disclaimer of nondistinctive individual elements is necessary.").

III. CONCLUSION

For the foregoing reasons, Applicant submits that its LIVING EARTH mark is entitled to registration on the Principal Register, and that disclaimer of "EARTH" should not be required. Based on the Board's established practice of resolving any doubt in the applicant's favor, Applicant respectfully requests that the Board reverse the Examining Attorney's decision refusing registration of Applicant's Mark and requiring disclaimer of "EARTH."

Respectfully submitted,

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