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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/541687

MARK: LIVING EARTH



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GENERAL TRADEMARK INFORMATION:

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TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

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LETC:002

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's final refusal to register the mark, LIVING EARTH for the following goods only, in International Class 001: soil amendments, potting, and planting soil. The goods in International Classes 019 and 031 are not at issue. The examining attorney refused registration because of a likelihood of confusion with the mark, LIVING SOIL in U.S. Registration No. 3289351, used with planting soil, namely, planting mix in International Class 001. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

Applicant also appealed the requirement to disclaim "EARTH", as descriptive and likely generic for the same goods in International Class 001. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

For the reasons and authorities cited below, it is requested that the 2(d) refusal to register and disclaimer requirement be affirmed.

FACTS AND PROCEEDING BELOW

On August 7, 2008, the applicant filed to register the mark, LIVING EARTH for goods, in other international classes, but as it pertains to this refusal and requirement, for the following goods in International Class 001 only: soil amendments, potting, and planting soil. On November 18, 2008, the examining attorney issued a refusal to register for the mark, because of a likelihood of confusion with the mark, LIVING SOIL in U.S.

Registration No. 3289351, pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* The examining attorney also required the applicant to disclaim EARTH, because it is certainly descriptive and likely generic for these same goods in International Class 001, and to amend the identification of goods in International Classes 019 and 031.

On May 15, 2009, the applicant responded that there was no likelihood of confusion between its mark and the cited mark, and that its mark should also be allowed to register without a disclaimer of EARTH. The examining attorney was not persuaded by applicant's arguments against the 2(d) Likelihood of Confusion Refusal and disclaimer requirement, and maintained both the refusal and the requirement. Applicant also amended the identification of goods, in International Classes 019 and 031. The examining attorney made the refusal Final on June 9, 2009.

The applicant filed a request for reconsideration on December 9, 2009, which the examining attorney denied on December 28, 2009. The notice of appeal was filed on December 9, 2009.

Applicant subsequently filed its brief on March 15, 2010.

ISSUES ON APPEAL

1) Whether the applicant's proposed mark, LIVING EARTH, to be used with soil amendments, potting, and planting soil is likely to cause confusion among consumers with the registered mark, LIVING SOIL for planting soil, namely, planting mix , under Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq.

Similarity of the Marks

The applicant's standard character mark, LIVING EARTH and registrant's typed mark, LIVING SOIL share the identical term, LIVING. LIVING is the dominant term in the mark of the parties, as SOIL in registrant's mark is disclaimed, and EARTH should be disclaimed in applicant's mark. 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.

The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether

there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression.

The terms, EARTH in applicant's mark and SOIL in the registrant's mark while different in sound, do not obviate the similarity between the marks. Additionally, the terms, EARTH and SOIL also look different; however, both terms create the same commercial connotation of 'dirt' in the minds of consumers when seeking applicant's goods, namely, soil amendments, potting, and planting soil in the marketplace. The examining attorney previously provided a definition in the record which describes dirt as "soil or EARTH". (See page 4 of Office Action issued 11/18/08).

Consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); *see Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services); TMEP §1207.01(b).

Applicant argues that “while the term, ‘EARTH’ may be used to refer to ‘soil’ or ‘dirt’, EARTH is not limited to this meaning, but is in fact used to convey a wide range of meanings.” The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e).

Applicant also argues that the term, “LIVING” is weak as it is diluted by numerous third party uses for goods and services similar or related to those of applicant and registrant. Of the 15 applications and registrations provided in Table 1 by applicant, only two contain the term, “LIVING” in the mark, for goods related to applicant and registrant, U.S. Registration No. 2912899, Dr. SUBLER’S LIVING SOIL and No. 3456111 for LIVING MULCH. (See Applicant’s Brief page 8)

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks

registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Furthermore, third-party registrations are entitled to little weight on the question of likelihood of confusion because they are “not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *see In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(d)(iii). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF*, 474 F.2d at 1406, 177 USPQ at 269; *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999).

For these reasons applicant’s mark creates a similar commercial connotation in the minds of consumers and is confusingly similar to registrant’s mark.

Similarity of Goods

Applicant’s goods in International Class 001, namely, soil amendments, potting, and planting soil are related to registrant’s planting soil, namely, planting mix. The examining attorney provided copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar

goods as those of applicant and registrant in this case. (See Final Office Action issued 06/09/2009 pages 7 thru 13) These printouts have probative value to the extent that they serve to suggest that the goods listed therein, namely, *potting soil, planting soil, and planting mix* are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001). Applicant did not provide any arguments regarding the relatedness of the goods.

2) Whether the term, EARTH is descriptive and likely generic when used in connection with soil amendments, potting, and planting soil, and conveys the same commercial connotation to consumers, as SOIL, and must be disclaimed under Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

Applicant's goods are soil amendments, potting, and planting soil. As defined in the first Office action, the word, EARTH is another name for soil or dirt, which is a common name for these goods. (See dictionary definition previously provided on page 4 of the Office Action issued 11/18/08)

Applicant submits “ ‘EARTH’ does not principally signify ‘dirt’ or ‘soil’ to the purchasing public and is not generic vis-à-vis Applicant’s Class 001 goods, but is suggestive.” However, the examining attorney notes in the definitions provided by applicant, the term, EARTH is defined as “soil”; and “soil” is defined as – “a particular kind of earth or ground,” which further supports the examining attorney’s assertion that the terms, EARTH and soil convey the same commercial impression among consumers,

when used in the context of applicant's goods. (See pages 20 and 21 of Applicant's Brief)

Applicant also argues that this Office "has granted registrations on the Principal Register for marks incorporating the term, EARTH or analogous elements for identical, similar or related goods and services, without a disclaimer of EARTH, as evidence that this term is suggestive." Applicant provided a summary (See Table 2, page 13 of Applicant's Brief), along with copies of printouts of U.S. registrations and applications, from the USPTO Trademark Electronic Search System (TESS). (See pages 24 thru 97 of Applicant's Brief). The examining attorney respectfully disagrees, and refers to copies of U.S. registrations where this Office disclaimed the term, EARTH, used with potting and planting soil and related goods, previously provided in the Final Office Action. For example:

- U.S. Registration No. 2295023 for WILD EARTH used with potting soil, top soil and soil mixes, has a disclaimer of EARTH; and
- U.S. Registration No. 2618864 for MIGHTY EARTH used with potting soil, garden soil and soil conditioners has a disclaimer of EARTH.

(See pages 17 thru 20 of the Final Office Action issued 06/09/2009)

Prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own

merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973).

Lastly, Applicant asserts “the principal significance of the term, EARTH to the purchasing public is the proper name for our planet.” The examining attorney respectfully disagrees, because any consumer when considering the purchase of soil amendments, potting, and planting soil, would not understand the term, EARTH to mean, the proper name for our planet, but would immediately understand the goods to be soil or dirt. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness (genericness in this case). *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984). More than descriptive, when viewed in connections with applicant’s goods, it is clear that the term, EARTH is likely generic for the goods.

CONCLUSION

For the foregoing reasons and authorities, the examining attorney respectfully submits that the refusal to register the proposed mark, LIVING EARTH under Section 2(d) of the Trademark Act, because of a likelihood of confusion with the registered mark, LIVING SOIL, and the requirement to disclaim EARTH pursuant to Trademark Act Section 6, should be affirmed.

Respectfully submitted,

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