

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing:
November 13, 2013

Mailed:
December 30, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mother Earth Brewing, LLC

Serial No. 77716598

David W. Sar and Rebecca L. Cage of Brooks, Pierce,
McLendon, Humphrey & Leonard, L.L.P. for Mother Earth
Brewing, LLC.

J. Brendan Regan, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Cataldo and Lykos, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Mother Earth Brewing, LLC has appealed from the final refusal of the trademark examining attorney to register MOTHER EARTH BREWING and design, as shown below, for "beer, excluding both organic beer and beer comprised solely of organic components; brewed malt-based alcoholic beverage in the nature of a beer, excluding both organic beer and beer comprised solely of organic components" in Class 32 and

"distributorships in the field of alcoholic beverages, excluding both organic beer and beer comprised solely of organic components" in Class 35.¹ The word BREWING has been disclaimed.



Registration as to both classes has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of Registration No. 3850662 for MOTHER EARTH BREW CO. and design including the letters M and E, as shown below, with BREW CO. disclaimed, for "beer comprised solely of organic components."²



The registration describes the mark as follows:

¹ Application Serial No. 77716598, filed April 17, 2009, based on Section 1(b) of the Trademark Act (intent-to-use).

² Issued September 21, 2010.

The mark consists of a concentric circular design. The outer circle contains a tree, representing the tree of life. In addition, [sic] to the tree, the outer circle contains the words "Mother Earth Brew Co." and two Irish cross symbols. An inner circle contains a narrow band with a Celtic design. The middle contains vertical lines that represent waterfalls cascading over the letters "M" and "E", representing "Mother Earth".

Color is not claimed as a feature of the mark.

The appeal has been fully briefed, and an oral hearing was held. We affirm the refusal with respect to each class.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Turning first to the refusal with respect to Class 32, the goods identified in the cited registration are "beer comprised solely of organic components." Applicant's goods are also beer, but it has excluded "organic beer and beer comprised solely of organic components" from its

identification.³ Applicant has argued at length that organic beer, and beer excluding organic beer, are different. We are not persuaded by these arguments. Organic beer and "non-organic beer" are both beer. "Organic" in the context of the identification in the registration refers to the methods of growing the ingredients, but the end product still uses the same basic ingredients as non-organic beer and is made in essentially the same manner. Thus, as opposed to the situation in many of the cases cited by applicant, organic beer and non-organic beer are essentially the same goods.

Moreover, the record shows that both applicant and the registrant make craft beers, and that organic beer is a subset of the craft beer market. See May 17, 2011 article,

³ We note that applicant amended its application to exclude organic beer/beer made from organic components after the examining attorney issued the final Office action. Thus, throughout the examination of the application, the examining attorney treated the goods as legally identical, in that applicant's previous identification in Class 32 ("beer, brewed malt-based alcoholic beverage in the nature of a beer") encompassed the registrant's organic beer. However, it is clear that the examining attorney determined that it was unnecessary to submit additional evidence regarding the relatedness of the goods or services, as amended, stating in the request for reconsideration that issued the same date as applicant's request to amend the identification (which the examining attorney treated as a request for reconsideration), that it did not "raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action." June 5, 2012 denial of request for reconsideration.

"ENN: Environmental News Network-Know Your Environment."⁴
Eel River Brewing Company's CEO described that company
"[a]s a craft brewer, an organic craft brewer."⁵ Applicant
promotes its product as a craft beer: "Mother Earth Brewery
is a 40 barrel craft brewery";⁶ "We craft beer with
artisanal devotion...,"⁷ while registrant describes itself as
specializing "in quality handcrafted beer and homebrew
supplies."⁸ The record includes evidence that craft beers,
whether organic or non-organic, are promoted together.
See, e.g., article in Sign On San Diego, submitted by
applicant and discussing the various local craft breweries,
including registrant's.⁹ The evidence further shows that
beer makers, both craft beer makers and mainstream beer
makers, also make organic beer:

For years, many craft-brews (made from non-
automated breweries in limited amounts) have gone
organic, both with specialty products and entire
company standards.
www.tasteforlife.com, Response filed April 24,
2012, p. 120.

⁴ Response filed April 24, 2012, p. 124. Page numbers for
papers filed during prosecution refer to the pagination found in
the USPTO's Trademark Status & Document Retrieval (TSDR) data
base.

⁵ Response filed April 24, 2012, p. 123.

⁶ www.motherearthbrewing.com, response filed April 24, 2012,
p. 24.

⁷ Id. at p. 132.

⁸ Response filed April 24, 2012, p. 57.

⁹ Response filed April 24, 2012, pp. 58-65.

Even Anheuser-Busch (<http://www.anheuser-busch.com>) (makers of Budweiser) has entered the organic beer market...
www.tasteforlife.com, Response filed April 24, 2012, p. 120.

...Orlio Organic Beer Company, a new wholly-owned subsidiary of Magic Hat Brewing...
Massachusetts Beverage Business,
www.beveragebusiness.com, Response filed April 24, 2012, p. 116.

The Wolaver's [organic beer] sells for about a dollar more a six than the Otter Creek.
www.beveragebusiness.com, Response filed April 24, 2012, p. 117.

Thus, even if we were to treat the differences in how the ingredients are grown as creating different types of beers, such that they are not considered identical, they are still closely related. Although there are certain requirements for a beer to be labeled "organic," this does not mean that the brewers of non-organic beers cannot and do not brew organic beers. The distinction between organic and non-organic beers does not obviate the likelihood of confusion. Consumers would assume that if they were sold under confusingly similar marks that they emanate from the same source.

We must also consider organic and non-organic beers to be sold in the same channels of trade. Applicant has pointed to statements made about registrant and the manner in which it sells its beer in an attempt to differentiate

the trade channels. Specifically, registrant's Facebook page states that it is a microbrewery and homebrew supply retail store located in Vista, San Diego, CA, and states that it "Takes Reservations," "Walk-Ins Welcome," "Good for Groups," and lists limited hours for its tasting room.¹⁰

Applicant would have us treat registrant's goods as being sold only in this particular location, or at special events such as the Vista Strawberry Festival,¹¹ i.e., not through third-party outlets, and therefore that its channels of trade differ from those of applicant, which sells its beer through convenience stores, grocery stores, bars, restaurants and the like. The problem with this argument is that registrant's certificate of registration is prima facie evidence of registrant's exclusive right to use the mark in connection with the goods identified in the registration. See Section 7(b) of the Trademark Act, 15 U.S.C. § 1057; *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Likelihood of confusion must be determined on an analysis of the mark as applied to the goods or services recited in an applicant's application vis-à-vis the goods or services recited in the

¹⁰ www.motherearthbrewco.com, response filed April 24, 2012, pp. 56-57.

¹¹ Response filed April 24, 2012, pp. 128-29.

registration, rather than what the evidence shows the goods or services to be. See *id.* Thus, we must treat the registrant's goods as traveling in all channels of trade appropriate for goods of this type, and that would include the same channels in which non-organic beer is sold. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

As for the customers of organic beer, the evidence indicates that there is overlap: "It's not a coincidence that the market for organic beer looks a lot like the market for craft beer: picky, well-informed, deliberately different, curious, and willing to pay more for perceived quality."¹² Although the evidence indicates that the purchasers of organic beers do not necessarily purchase mass-market beers, they do purchase craft beers, and as noted, applicant's beer is promoted as a craft beer and craft beers are encompassed by the identification of goods in its application.

We now turn to a consideration of the marks, keeping in mind that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of*

¹² www.beveragebusiness.com article, *supra*, response filed April 24, 2012, p. 116, 118.

America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Again, although applicant has restricted its identification to non-organic beer, and the registrant's beer is specifically identified as being made from organic components, these products are virtually identical, in that they are both beer. Thus, applicant's amendment to limit its beer to exclude organic beer does not make applicant's product and the registrant's beer made from organic components significantly different in nature.

Applicant's mark consists of the words MOTHER EARTH BREWING and the design of a woman's head. The cited mark consists of the words MOTHER EARTH BREW CO. and a design of a tree that incorporates the letters M and E. The words MOTHER EARTH are identical in both marks. The additional words BREWING in applicant's mark and BREW CO. in the registered mark (although descriptive and therefore having little or no source-indicating value), are very similar in appearance and meaning. As a result, the literal portions of the marks are essentially identical. Despite this similarity, applicant contends that the differences in the design portions of the marks are sufficient to distinguish them.

It is true that when one views the marks together, one can clearly see the differences in the design elements.

However, "the test to be applied in determining likelihood of confusion is not whether marks are distinguishable on the basis of a side-by-side comparison, but rather whether they so resemble one another as to be likely to cause confusion, and this necessarily requires us to consider the fallibility of memory over a period of time." *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Both marks, of course, have concentric circles with the words MOTHER EARTH in the outer circle. There are specific differences in the design elements, in that applicant's mark prominently depicts a female head that the viewer is likely to understand as a personification of "mother earth," a nurturing figure. The registered mark, on the other hand, has a tree on top of a circle, with what appear to be the roots of the tree leading into the letters "M" and "E" and with additional lines that might also be understood as a continuation of the roots or, as the registrant has stated in its description of the mark, waterfalls. Whether this element is viewed as tree roots or waterfalls, the entire design portion suggests the earth as a nurturing place, and the letters would be seen as the initials for MOTHER EARTH, thereby reinforcing the meaning of and connection with the words. As a result, even though the design elements of the two marks have specific

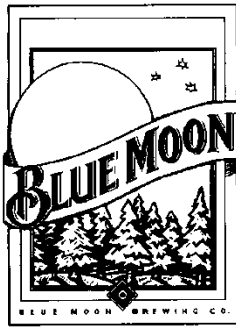
differences, when viewed in connection with the words MOTHER EARTH, they project similar connotations and commercial impressions.

Marks must, of course, be compared in their entirety. However, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). When marks consist of words and designs, the words are generally accorded greater weight because they would be used by purchasers to request the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553, 1554 (TTAB 1987). We see no reason to depart from that approach in the present case. A patron in a bar is likely to ask for MOTHER EARTH beer, rather than the beer with the picture of a woman's head, or the beer with the tree and waterfall. Or if someone were to recommend the beer to a friend, it is more likely that the person would refer to it by the words, rather than by describing the design.

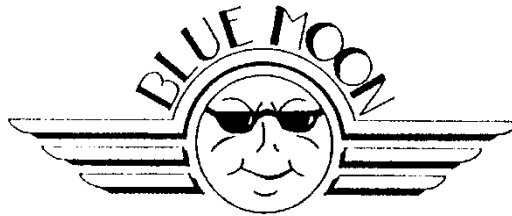
Applicant asserts that both it and the registrant use their respective marks as "umbrella" marks, and use other marks for their particular beers, such that a consumer would order a beer by the "model" mark, rather than by the respective MOTHER EARTH marks. However, there is no

restriction in the identifications of either the application or registration that would require the marks to be used in this manner. Further, even if the marks were used as "umbrella" marks to identify all beers emanating from applicant or the registrant, a customer could still go into an establishment and ask what MOTHER EARTH beer it carried. To the extent that applicant implies that the consumer would then ask about the particular MOTHER EARTH beers, and determine from the subsidiary trademarks which MOTHER EARTH brewery made which beer, that scenario would not be sufficient for us not to find likelihood of confusion. The determination of likelihood of confusion is based on whether the applied-for mark is likely to cause confusion with a registered mark, not on whether further inquiry, such as the location of the brewery or knowledge of particular brands also offered by the brewery, would enable the customer to figure out, from information separate from the marks at issue, the actual source of the goods.

In terms of the question of the similarity of the marks, the situation before us is similar to that presented in *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003), in which the applicant sought to register the mark



for beer, and registration was refused in light of



for restaurant services. On appeal, the Board found that the marks were similar, examining the appearance, sound, connotation and commercial impression of the two marks. The Court upheld that finding, despite the fact that the two moon figures were quite different.¹³

The present case presents an even stronger argument for finding the marks to be similar. The literal parts of the marks are essentially identical in pronunciation and connotation, and the marks as a whole are similar in pronunciation, connotation and commercial impression. The

¹³ The Court reversed the Board's ultimate decision affirming the refusal because of the lack of evidence that beer and restaurant services were related. That, of course, is not the situation here, where the goods are both types of beer.

marks also have a similar overall appearance, as they both consist of concentric circles with the words MOTHER EARTH in the outer circle. The specific differences in the marks due to the design elements do not outweigh these similarities.

Applicant has argued that the term common to both marks, MOTHER EARTH, is weak, "and the scope of protection afforded to the cited registration should be deemed so narrow that the Application for [applicant's mark] should be allowed." Brief, p. 17. In support of this argument, applicant points to a dictionary definition for "mother earth" and to certain third-party registrations for marks which contain the term MOTHER EARTH, or include a translation statement that has the words MOTHER EARTH. The dictionary defines the term as "the mother of everything animate or inanimate upon the earth" and "soil; ground."¹⁴ Applicant claims that in the context of beer comprised of organic components, the term is descriptive. We are not persuaded. Based on the dictionary definition, we cannot agree that MOTHER EARTH immediately and directly describes beer that is composed of organic ingredients. At most, the term somewhat suggests that the registrant's beer is made

¹⁴ Webster's Third New International Dictionary, submitted with April 24, 2012 response.

of natural ingredients. Although a suggestive term is entitled to a lesser scope of protection than an arbitrary term, the protection to which the registered mark is entitled would certainly extend to prevent the registration of a similar mark containing the words MOTHER EARTH for virtually identical goods. We also point out that in applicant's mark the term MOTHER EARTH has the same connotation, suggesting that applicant's beer is natural and not made of man-made ingredients.

As for the third-party registrations, applicant is incorrect in stating that they show that the term is commonly used. It has long been recognized that the mere existence of third-party registrations is not sufficient to show that the public is familiar with them. "We will not assume any knowledge on the part of the purchasing public of mere registrations in the Patent Office and neither will we assume that marks are in continuing use, so as to have had any effect on the mind of the purchasing public, merely because they have been registered." In re Helene Curtis Industries, Inc., 305 F.2d 492, 134 USPQ 501, 503-04 (CCPA 1962). Because applicant has not shown any third-party use of MOTHER EARTH marks, its reliance on In re Hartz Hotel Services Inc., 102 USPQ2d 1150 (TTAB 2012), is inapposite. That case included evidence of numerous third-party use of

GRAND HOTEL marks, e.g., a declaration of an investigator who confirmed the use of seven establishments using GRAND HOTEL or GRANDE HOTEL in their marks, and website evidence advertising ten additional third-party uses. Similarly, in the case of *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996), the record included evidence of extensive third-party use of the particular common term, BROADWAY, for restaurant services (the services at issue in that case), including a Dun & Bradstreet report and information from telephone directories.

Third-party registrations can, however, be used in the manner of a dictionary definition, to show that a term has a significance within a particular industry. *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 185 USPQ 422 (CCPA 1975). The third-party registrations for goods that are far removed from the goods of the registrant and applicant have little probative value in this regard. For example, the registrations for MOTHER EARTH for organic potting soil (Nos. 3252545 and 3254164) obviously reference EARTH as a synonym for "soil, ground." See definition above. Nor is it clear what significance MOTHER EARTH has in the registrations for, inter alia, computer software (No. 3272691), paper products (No. 3793559) or paddle surfboards (No. 4031276). As for the

registrations for food and beverages, at best they show only that MOTHER EARTH has the significance that the dictionary definition of "the mother of everything animate or inanimate upon the earth" somewhat suggests, namely, something that is nourishing and wholesome and natural.¹⁵ We certainly cannot conclude from the limited number of third-party registrations submitted by applicant, particularly from the three currently existing registrations for beverages (No. 3593000 for GAIA for sotol, No. 3342899 for MADRE TIERRA for wine and No. 2958978 for MATER TERRAMATER for wine),¹⁶ that MOTHER EARTH has a strong suggestive connotation for beverages, and that we must therefore give greater weight to the design

¹⁵ We say "at best" because it is not clear to us that GAIA, which is translated in Registration No. 3593000 as "Mother Earth or Goddess of the Earth," and which is translated in Registration No. 3676512 as "Earth or Mother Earth" actually would be understood to have the meaning of "mother earth" per se. The dictionary definition of GAIA is "the goddess of the earth, who bore Uranus and by him Oceanus, Cronus, and the Titans" (from Greek *gaia*, meaning earth). Dictionary.com, from Collins English Dictionary, unabridged, 10th ed. (2009). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Nor is it clear that the Latin phrase MATER TERRAMATER (Registration No. 2958978) would be the equivalent of MOTHER EARTH, or that people would understand it this way, and it is also unclear whether DAICHI (Registration No. 3023585 for rice) or MADRE TIERRA (Registration No. 3342899 for wine) would be translated and therefore viewed as "mother earth."

¹⁶ A fourth registration submitted by applicant, MOTHER EARTH MINERALS for mineral water, has been cancelled for failure to file a Section 8 affidavit.

features when we compare applicant's mark and the cited mark.

Applicant has also argued that the du Pont factor of the conditions of purchase favors a finding of no likelihood of confusion, because both its craft beer and the registrant's beer made from organic components are "premium and specialized products," and the consumers "are well-versed in the styles of beer being offered and are knowledgeable about the sources (i.e., the brewers) of the beers they select." Brief, p. 22.

To the extent that applicant contends that confusion is not likely because consumers will go behind the trademark and rely on the name of the brewers, that is not an argument that we can entertain. As we stated above, we must determine likelihood of confusion based on the involved marks, not on whether there is additional information that the potential consumer can obtain to determine the source of the goods. We do agree with applicant that at least some of the purchasers of craft beers and organic beers are more discriminating than consumers of mass market beers, and even that some consumers of organic beers specifically choose such beers because they are organic. However, even discriminating purchasers are likely to be confused by the use of

applicant's mark on its craft beer in view of the registrant's mark for beer made from organic components. That is, even if such purchasers note the difference in the design elements in the marks, they are not likely to view the different designs as indicating separate sources for the goods. Rather, they are likely to assume that a single source has adopted these marks as variations of each other, perhaps to differentiate its organic beer from its non-organic beer. As we have previously discussed, the evidence shows that the same entity can make both organic and non-organic beer.

The final du Pont factor that has been discussed is the lack of evidence of actual confusion. As applicant candidly admits, the parties are not in the same locations or channels of trade. Brief, p. 24. As a result, there has been no opportunity for confusion to occur, and we can draw no conclusion from the lack of evidence of actual confusion that confusion is not likely. Because of the presumptions of Section 7(b) due to the registrant through its ownership of the cited registration, we must assume that registrant may sell its beer nationwide, including in the area in which applicant sells its beer, and that the beer may be sold in all appropriate channels of trade for such goods.

In considering the relevant du Pont factors, we find that the factors of the similarity of the goods and channels of trade heavily favor a finding of likelihood of confusion, that the factor of the similarity of the marks (and giving weight to the factor of the similarity of the goods) also favors a finding of likelihood of confusion, while the factors of third-party use and lack of actual confusion are neutral. In addition, the term MOTHER EARTH is only slightly suggestive, such that the registered mark is entitled to a normal scope of protection. Although the factor of the conditions of purchase favors applicant in that we accept that the purchasers are discriminating, for the reasons we have already discussed, this factor does not outweigh the factors favoring a finding of likelihood of confusion. Thus, when we balance the factors, we find that applicant's mark for non-organic beer and non-organic brewed malt-based alcoholic beverage in the nature of a beer is likely to cause confusion with the registered mark for beer made of organic components.

We now consider the application in Class 35 for "distributorships in the field of alcoholic beverages, excluding both organic beer and beer comprised solely of organic components." We should point out that to be a service, the distributorship must be for the benefit of

others. That is, if applicant's distributorships consist only of distributing its own beer on its own behalf, this would not constitute a service. We have some concerns that this is the case. For example, in its response filed April 24, 2012, at p. 18, applicant states that it "produces close to 10 times as much product, and primarily distributes product (and, of course, performs its distributorship services) through hundreds of third party retailers...." In its brief, under Recitation of Facts, it states, at p. 7:

Applicant owns and operates a 40 barrel craft brewery and distributorship located in Kinston, North Carolina. It bottles, kegs and cans beer for sale and distribution in hundreds of outlets....

Applicant sells and distributes over ten varieties of craft beer.

Again, at p. 23 of its brief, it states:

...Applicant produces close to 10 times as much product [as registrant], and primarily distributes product (and of course, performs its distributorship services) through hundreds of third party retailers....

However, despite our suspicion that applicant is not actually performing distribution services, as services are understood in the Trademark Act and case law, we will not remand the application to the examining attorney pursuant to Trademark Rule 2.142(f)(1) to consider whether

registration should also be refused on this basis. This is because the application was based on Section 1(b), intent-to-use, and a refusal of this sort would normally not be made until the applicant submits its specimens of use, i.e., at the time it files an amendment to allege use or a statement of use.

Therefore, in deciding the appeal, we will proceed on the assumption that applicant is rendering a service, and that it is distributing beer made of non-organic components for third parties, rather than for itself.

Applicant has not addressed the similarity of its services and the registrant's goods, except to the extent that it argues the differences in the goods that are the subject of the services (non-organic beer) and the registrant's goods (beer made from organic components), that is, its arguments are the same as those it put forth in connection with its application in Class 32. It would appear that applicant accepts that if non-organic and organic beer are found to be similar, then distribution services for non-organic beer would be similar to organic beer.

We have found, as discussed above, that the goods are virtually identical. However, we do not treat this as a concession of the relatedness of applicant's services and

the registrant's goods. Our finding that the goods and services are related is based on the complementary nature of the goods and the services of distributing such goods. The distinction made between organic beer and non-organic beer does not make the services and goods unrelated. Consumers, i.e., retail establishments which would be the users of the distribution services, are likely to assume that the company that does distribution services also sells beer. In fact, the distinction in the type of beer, with applicant's distribution services being for non-organic beer and registrant's goods being beer made of organic components, is likely to heighten the likelihood of confusion. That is, consumers could assume that a company that produces beer could use its distribution system to distribute beer for others, and that since the registrant makes an organic beer, it would choose to distribute non-organic beers for third parties, rather than organic beers that would compete more directly with its own products.

The comments that we have made with respect to the similarities of the marks, strength of the registrant's mark, and lack of evidence of actual confusion are applicable here. As for the conditions of purchase, we treat the retail establishment purchasers/resellers of beer which would be the customers of applicant's distribution

services as discriminating and sophisticated purchasers. However, as we said earlier, even though we accept that the purchasers will note the specific differences in the design elements in both marks, they are not likely to treat these differences as indicating separate sources for the goods and services. Rather, they are likely to view the marks as variations of each other, with both indicating origin in a single source, perhaps having the design differences in order to show that one is for goods and the other for services.

We find, upon considering all of the relevant du Pont factors, that confusion is likely between applicant's mark for its identified services and the mark and goods identified in the cited registration. To the extent that there is any doubt on this issue, it must be resolved in favor of the registrant. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal of registration as to both classes in the application is affirmed.