

PTO Form 1957 (Rev 5/2006)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78484217
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (no change)	
ARGUMENT(S)	
<p>REQUEST FOR RECONSIDERATION OF FINAL REFUSAL</p> <p>Dear Ms. Vallillo,</p> <p>We are appealing the final refusal dated November 9, 2005 and hereby request reconsideration of the final refusal for the reasons set forth below. In that Office Action, the Examining Attorney required the disclaimer of SUPERFOOD and refused the registration of ODWALLA SUPERFOOD and design on the basis of a likelihood of confusion with a prior registration.</p> <p><u>DISCLAIMER</u></p> <p>The applicant hereby disclaims SUPERFOOD apart from the mark as shown.</p> <p>Thus, the applicant complies with one of the requirements of the refusal.</p> <p><u>SECTION 2 (D) LIKELIHOOD OF CONFUSION REFUSAL</u></p> <p>Applicant argued that the presence of the famous and distinctive ODWALLA mark made confusion unlikely given the weak character of SUPERFOOD. The Examining Attorney dismissed the Applicant's arguments that the presence of the distinctive house mark ODWALLA eliminated any likelihood of confusion. However, the Trademark Trial and Appeal Board recently held that the addition of a house mark is sufficient to distinguish marks where the common portion is highly suggestive. See: <i>Knight Textile Corp v. Jones Investment Co</i>, 75 USPQ 2d 1313 (TTAB 2005). In that case, "Norton McNaughton Essentials" for clothing was deemed not confusing similar to opposer's registered "Essentials" mark for similar goods. The TTAB held "that confusion is not likely to occur, even if the marks are used on identical goods that are marketed in the same trade channels to same class of purchasers." <i>Id.</i> at 1313.</p>	

Applicant submits that the Board's rationale in the *Knight Textile Corp* case is even more compelling in the present case, where the similar term at issue, namely, SUPERFOOD, is descriptive, if not generic, not just highly suggestive, as in the cited case. The SUPERFOOD registration relied on by the Examiner is on the Supplemental Register. The application was amended to the Supplemental Register after the Trademark Office *refused the mark as descriptive*. The Examining Attorney has required the Applicant to disclaim SUPERFOOD in this application on the grounds that the term is descriptive. Applicant has complied with the requirement. MedicineNet.com defines "superfood" as "foods with alleged healing or health-promoting capabilities". When the term "superfood" is searched in Google, more than 600,000 hits come up. A quick review of a sample of those hits reveals that the term is commonly used to refer to any food product or supplement that promotes healing or health. Thus, the highly descriptive, if not generic, character of the term is beyond dispute.

In addition, the cited registration co-exists on the Trademark Register with several other SUPERFOOD formatives for food products owned by third parties. We note GREENS-SUPERFOOD OF THE 21st CENTURY (Registration No. 2,199, 426), EMERALD GREENS HERBAL SUPERFOOD (Registration No. 2,381,363), WHOLE-BODY SUPERFOOD MEGAFLAX HEART OMEGA 3 PHYTONUTRIENTS-FIBER and design (Registration No. 3, 080, 285), MICELLEAN BIOACTIVE SUPERFOOD (Registration No. 2, 892, 945), GOLDEN VITALITY SUPERFOOD SUPPORT BAR (Registration No. 2, 528, 165) and SUPERFOOD (Registration No. 2,642,729). While the goods covered by these registrations are not beverages per se, they are often mixed with liquids and consumed as a beverage. For example, in GREENS+ SUPERFOOD registration listed above, the goods are described as "dietary food supplement in powdered drink mix form or in capsules or tablets." Thus, the respective products are closely related.

Case law teaches that where the only similarity of two marks is based on the presence of common descriptive terms in both marks, the common descriptive term should not be the deciding factor in a likelihood of confusion analysis. *Gruner + Jahr USA Publishing v. Meredith Corp*, 991 F.2d 1072, 1078 (2nd Cir. 1993)(holding no likelihood of confusion between PARENTS and PARENT'S DIGEST because of the descriptive character of "parents").

As noted earlier, the present case for finding no likelihood of confusion is far more compelling here than in the *Knight Textile Corp* case since the common term in that case was deemed highly suggestive of the goods, as opposed to the clearly descriptive SUPERFOOD term in the present case. Applicant submits that the presence of a powerful and distinctive mark ODWALLA and design combined with the weak and descriptive character of the term SUPERFOOD eliminates any likelihood of confusion.

SUMMARY

The Applicant has complied with the required to disclaim SUPERFOOD and brought recent case law to the Examiner's attention. This *Knight Textile Corp* case held that a house mark distinguishes two marks if the only shared element is a highly suggestive term, even where the goods and purchasers are the same. In the present case, the common element is not highly suggestive, but merely descriptive, if not generic, as indicated by the Examiner's requirement for a disclaimer and the state of the Trademark Register. Hence,

the rationale in that cited case is even more compelling here.

For the reasons stated above, the Applicant states that the application is now in condition for approval for publication.

Respectfully submitted,

/James H. Johnson, Jr./

James H. Johnson, Jr.
Attorney for Applicant
404-853-8395

ADDITIONAL STATEMENTS SECTION

DISCLAIMER	"No claim is made to the exclusive right to use SUPERFOOD apart from the mark as shown."
SIGNATURE SECTION	
DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/James H. Johnson, Jr/
SIGNATORY NAME	James H. Johnson, Jr.
SIGNATORY POSITION	Attorney for Applicant
SIGNATURE DATE	05/05/2006
FILING INFORMATION SECTION	
SUBMIT DATE	Fri May 05 13:35:11 EDT 2006
TEAS STAMP	USPTO/ROA-65.196.113.177- 20060505133511939349-7848 4217-3208d41b6f7621c8c9d3 cba52f9d9d17a85-N/A-N/A-2 0060505133026086608

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OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. 78484217 has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

REQUEST FOR RECONSIDERATION OF FINAL REFUSAL

Dear Ms. Vallillo,

We are appealing the final refusal dated November 9, 2005 and hereby request reconsideration of the final refusal for the reasons set forth below. In that Office Action, the Examining Attorney required the disclaimer of SUPERFOOD and refused the registration of ODWALLA SUPERFOOD and design on the basis of a likelihood of confusion with a prior registration.

DISCLAIMER

The applicant hereby disclaims SUPERFOOD apart from the mark as shown.

Thus, the applicant complies with one of the requirements of the refusal.

SECTION 2 (D) LIKELIHOOD OF CONFUSION REFUSAL

Applicant argued that the presence of the famous and distinctive ODWALLA mark made confusion unlikely given the weak character of SUPERFOOD. The Examining Attorney dismissed the Applicant's arguments that the presence of the distinctive house mark ODWALLA eliminated any likelihood of confusion. However, the Trademark Trial and Appeal Board recently held that the addition of a house mark is sufficient to distinguish marks where the common portion is highly suggestive. See: *Knight Textile Corp v. Jones Investment Co*, 75 USPQ 2d 1313 (TTAB 2005). In that case, "Norton McNaughton Essentials" for clothing was deemed not confusing similar to opposer's registered "Essentials" mark for similar goods. The TTAB held "that confusion is not likely to occur, even if the marks are used on identical goods that are marketed in the same trade channels to same class of purchasers." *Id.* at 1313.

Applicant submits that the Board's rationale in the *Knight Textile Corp* case is even more compelling in the present case, where the similar term at issue, namely, SUPERFOOD, is descriptive, if not generic, not just highly suggestive, as in the cited case. The SUPERFOOD registration relied on by the Examiner is on the Supplemental Register. The application was amended to the Supplemental Register after the Trademark Office *refused the mark as descriptive*. The Examining Attorney has required the Applicant to disclaim SUPERFOOD in this application on the grounds that the term is descriptive. Applicant has complied with the requirement. MedicineNet.com defines "superfood" as "foods with alleged healing or health-promoting capabilities". When the term "superfood" is searched in Google, more than 600,000 hits come up. A quick review of a sample of those hits reveals that the term is commonly used to refer to any food product or supplement that promotes healing or health. Thus, the highly descriptive, if not generic, character of the term is beyond dispute.

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For the reasons stated above, the Applicant states that the application is now in condition for approval for publication.

Respectfully submitted,

/James H. Johnson, Jr./

James H. Johnson, Jr.
Attorney for Applicant
404-853-8395

Additional Statements

"No claim is made to the exclusive right to use SUPERFOOD apart from the mark as shown."

Declaration Signature

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Response Signature

Signature: /James H. Johnson, Jr/ Date: 05/05/2006

Signatory's Name: James H. Johnson, Jr.

Signatory's Position: Attorney for Applicant

Serial Number: 78484217

Internet Transmission Date: Fri May 05 13:35:11 EDT 2006

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