
To: BLUEBONNET NUTRITION CORP. (mail@egbertlawoffices.com)
Subject: TRADEMARK APPLICATION NO. 78587872 - GREEN UTOPIA - 1303-30
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UNITED STATES PATENT AND TRADEMARK OFFICE**SERIAL NO:** 78/587872**APPLICANT:** BLUEBONNET NUTRITION CORP. **CORRESPONDENT ADDRESS:**

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MARK: GREEN UTOPIA**CORRESPONDENT'S REFERENCE/DOCKET NO:** 1303-30**CORRESPONDENT EMAIL ADDRESS:**

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1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
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Serial Number 78/587872

The applicant is requesting reconsideration of the final refusal issued June 30, 2006. The application was refused registration in light of one registered mark, Registration No. 2,926,406, under Section 2(d) of the Trademark Act. For the reasons that follow, the Final refusal is maintained and continued.

Section 2(d) - Likelihood of Confusion Refusal

Registration of the proposed mark was refused because of a likelihood of confusion with the mark in U.S. Registration No. 2,926,406. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.*

As repeatedly noted, Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services.

TMEP §1207.01. 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 consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. (emphasis added) *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

Comparison of the Marks

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b).

The applicant's mark consists of the wording "GREEN UTOPIA" in standard character form. The registrant's mark consists of the term "UTOPIA" in standard character form. As can be seen, the applicant has placed the term "GREEN" in front of the registered term "UTOPIA". In arguing against the refusal, the applicant makes the following arguments: 1) the marks are different in appearance, 2) the marks have different meanings, 3) the term "GREEN" is the dominant element in the applicant's mark and 4) the term "UTOPIA" is weak.

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The only difference between the marks is the applicant's addition of the term "GREEN" to the registrant's mark "UTOPIA". The term found in both marks, "UTOPIA" has the identical sound, appearance and connotation. The term "GREEN" may indeed modify the term "UTOPIA" but the result of the modifier is that consumers might conclude that this particular formulation of "UTOPIA" contains nutrients from green vegetables. Consumers are well accustomed to seeing various modifying terms or phrases for goods and are less likely to view such descriptive words as singling out the source of the goods. For example, there could just as easily be nutritional supplements with such marks as "CITRUS UTOPIA," "DIET UTOPIA," "VEGAN UTOPIA" or "SENIOR UTOPIA". In each case, consumers would look to the term "UTOPIA" as the source and to the additional wording as a particular formulation of the brand "UTOPIA" i.e. containing extra vitamin C, containing fewer calories, not being made from animal products, etc. In relation to the identified goods, nutritional supplements, the term "UTOPIA" is arbitrary in the sense that it does describe anything about the goods. However, as the applicant indicates, the term "GREEN" refers to "leafy 'green' vegetables like lettuce, spinach and kale." See Applicant's 1-1-07 response, page 1.

The applicant argues that the marks are different in connotation and therefore, confusion is not likely. The applicant argues that the registrant's mark means "perfect harmony" and that the applicant's mark means "green vegetables creating harmony in the body." The applicant does not provide evidence for either assertion. The term "UTOPIA" is defined as "An ideally perfect place, especially in its social, political, and moral aspects." [1] The term "GREEN" may be defined as "Abounding in or covered with green growth or foliage," [2] or "Made with green or leafy vegetables." [3] Given that the goods are nutritional supplements, it is logical to conclude that consumers would infer the applicant's goods contained nutrients from green vegetables or were made with green vegetables. On the other hand, consumers may infer the registrant's goods do not contain nutrients of green vegetables. In either case, the term "GREEN" describes the contents or specific formulation of the goods, but does not yield much information about the source of the goods.

Applicant further argues against the refusal to registration by stating the term "GREEN" is the dominant element of the mark. Interestingly, the applicant chastises the examining attorney's assertion that the arbitrary, as in nondescriptive, term "UTOPIA" is the dominant element by stating, "The Examiner has not provided any analysis whatsoever as to why the term 'UTOPIA' should garner more weight in the Applicant's mark" but then proceeds to declare "In the present case, the dominant portion of the Applicant's mark is 'GREEN' not 'UTOPIA' as argued by the Examiner." This assertion is not backed up by any meaningful analysis. The applicant cites *Truescents LLC v. Ride skin Care, LLC*, Opposition No. 91158556 in which the marks under consideration were "GENUINE SKIN" and "GENUINE RIDE SKIN CARE" for skin care products. The Board found the term "RIDE" to be arbitrary as applied to the goods and therefore the dominant element of the mark. The same analysis may be used here – the term "UTOPIA" is arbitrary as applied to the goods and therefore is the dominant element. As such, the marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii).

Finally, the applicant argues that the term "UTOPIA" is weak and not entitled to a broad range of protection. The applicant does not provide even a scintilla of evidence that is admissible to the record that this assertion is true. Even if applicant has shown that the cited mark is "weak," such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

In sum, the marks are similar in appearance and both contain the identical term "UTOPIA". It is this dominant element that consumers will look to for the source of the goods and not a descriptive term such as "GREEN". The goods of the parties are legal equivalents, the applicant's goods are "nutritional supplements" and the registrant's goods are "dietary supplements." If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied 506 U.S. 1034 (1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b). For these reasons, the refusal to registration is maintained and continued.

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the point(s) at issue in the final action. TMEP §715.03(a). Therefore, the

request for reconsideration is **denied** and the **final refusal(s) is continued**. 37 C.F.R. §2.64(b); TMEP §715.04.

The filing of a request for reconsideration does *not* extend the time for filing a proper response to the final action, which runs from the date the final action was mailed. 37 C.F.R. §2.64(b); TMEP §§715.03 and 715.03(c).

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Karen Bracey/
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