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

Proceeding	78587872
Applicant	BLUEBONNET NUTRITION CORP.
Applied for Mark	GREEN UTOPIA
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APPLICANT: BLUEBONNET NUTRITION CORP.

SERIAL NO.: 78/587872 CLASS: 005

FILED: March 15, 2005 EXAMINER: Bracey, K.

MARK: GREEN UTOPIA LAW OFFICE: 116

BRIEF ON APPEAL

This is an appeal from the January 25, 2007 Final Rejection, refusing the registration of the mark "GREEN UTOPIA" in International Class 005. In the refusal of registration, the Examiner has refused registration under the Trademark Act § 2(d) claiming that there is a "likelihood of confusion" between Applicant's mark and a previously registered mark.

BACKGROUND

The registration of the present mark was refused due to the Examiner's contention that the mark "GREEN UTOPIA" would create a "likelihood of confusion" with a mark of a prior registration, namely, "UTOPIA" in Class 005 for dietary supplements, U.S. Reg. No. 2,926,406. As will be demonstrated herein, the Examiner was incorrect to conclude that a likelihood of confusion is present because, among other things, the dominant portion of Applicant's mark is the term "GREEN", the terms at issue create a different commercial impression and connote different meanings, and the previously registered mark is weak and should be afforded narrow protection. The present application should therefore be allowed to proceed to an eventual registration.

ARGUMENT

A. Applicant's Mark, as a Whole, and the Referenced Mark Create a Different Commercial Impression

Applicant's mark "GREEN UTOPIA" differs in commercial impression and connotes a different meaning than the Registrant's mark. Applicant does not dispute that Applicant's mark and the reference mark share the common term "UTOPIA". It is submitted, however, that Applicant's mark and the reference mark differ in commercial impression because an addition, subtraction or substitution of letters or words, may be sufficient to make the marks dissimilar in appearance, depending on the overall commercial impression given to the relevant public. T.M.E.P. § 1207.01(b)(ii). The dominant portion of Applicant's mark is the addition of the word "GREEN" in combination with the word "UTOPIA". Applicant's mark, as a whole, differs in and creates a separate and distinct commercial impression because of the addition of the word "GREEN".

Applicant's coined term "GREEN UTOPIA" is comprised of two words, but the term "GREEN" is dominant. This Board has repeatedly examined similar marks and determined, as submitted by Applicant, that one portion of a mark is dominant as opposed to another word that is included in a mark and identical to a registered mark. For example, in the *Ride Skin Care* opposition, the board examined whether there existed a likelihood of confusion between the similar marks "GENUINE SKIN" and "GENUINE RIDE SKIN CARE" on skin care products. *See Truescents LLC v. Ride Skin Care, L.L.C.*, Opposition No. 91158556 (TTAB November 14, 2006). As can be seen, the two terms shared the identical word "GENUINE". Nevertheless, the

Board found no likelihood of confusion despite the inclusion of this identical term. The Board explained that a likelihood of confusion was lacking because of the lack of similarity in commercial impression of the relevant marks because the term "GENUINE" was not the dominant portion of the applicant's mark, finding instead that the term "RIDE" was arbitrary as applied to the goods of the applicant, and therefore this term was the dominant feature. Likewise, in this case, Applicant submits that the dominant feature of Applicant's mark is "GREEN", not "UTOPIA" as the Examiner erroneously concluded.

The distinctive term in Applicant's mark is "GREEN" and the cited registration consists solely of the term "UTOPIA". Applicant respectfully submits that there can be no likelihood of confusion between these marks. When comparing these marks in their entirety, Applicant submits that any similarity which results from the presence of the laudatory and weak word "UTOPIA" is greatly outweighed by the obvious dissimilarities, when viewed as a whole, between the marks. Most importantly, the presence of the arbitrary and dominant word "GREEN" in Applicant's mark eliminates any alleged likelihood of confusion. Consumers are not likely to assume the existence of a source connection merely because of a presence of the laudatory word "UTOPIA" in both marks. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 U.S.P.Q. 1313 (TTAB 2005) (Board determined that the mark NORTON-MCNAUGHTON ESSENTIALS not confusingly similar to ESSENTIALS). Instead, purchasers will readily look to the term "GREEN" and the combination of the words "GREEN" and "UTOPIA" as a means of distinguishing between the source of the Applicant's and the cited Registrant's products. As a result, consumers will not be confused as to the source of the goods and there is no likelihood of confusion.

In the Office Action denying Applicant's Request for Reconsideration, the Examiner seems to argue that the dominant term ("GREEN") in Applicant's mark does no more than modify the term "UTOPIA" and that "consumers are well accustomed to seeing various modifying terms or phrases for goods and are less likely to view such descriptive words as singling the source of the goods." *See Final Office Action Denying Applicant's Request for Reconsideration, Page* 2. Applicant respectfully disagrees. As explained in Section B below, the unique and distinctive combination of both "GREEN" and "UTOPIA" connotes a special meaning that identifies the source of the goods and is not merely descriptive of the type of "UTOPIA". Unlike the examples cited by the Examiner, i.e. "CITRUS UTOPIA," "DIET UTOPIA," "SENIOR UTOPIA," etc., Applicant's terms does much more than modify and connotes much more than the descriptive terms cited by the Examiner. Rather, Applicant's mark connotes "green vegetables creating harmony in the body." *See Applicant's Request for Reconsideration of Final Office Action, Page* 1. As such, the combination of Applicant's terms creates a different commercial impression and affords an different overall impression from the Registrant's mark, and there is no likelihood of confusion.

B. Applicant's Mark Connotes a Different Meaning so that There is No Likelihood of Confusion

Applicant' mark utilizes the coined term "GREEN UTOPIA" and this mark connotes different meanings in the mind of the consumer than the cited registration term "UTOPIA". As is readily apparent, Applicant's mark is comprised of the words "GREEN" and "UTOPIA", and the Applicant's mark must be reviewed as a *whole* and not simply as component parts. *In re Hearst Corp.*, 25 U.S. P.Q. 2d 1238, 1239 (Fed. Cir. 1992) ("marks tend to be perceived in their

entireties and all components thereof must be given their proper weight." . . . "When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely."). When viewing Applicant's mark as a whole, there is no likelihood of confusion.

In the Examiner's final refusal of Applicant's request for reconsideration, the examiner improperly determined that the weak mark "UTOPIA" is the dominant element and therefore dismissed Applicant's argument that the term "GREEN" is the dominant term. Applicant respectfully disagrees and submits that the portion of the mark containing the word "GREEN" is arbitrary as applied to the goods, and it is the dominant word in the mark and it should therefore be afforded more weight. *See In Re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985). At a minimum the entire term "GREEN UTOPIA" as a whole should be compared in its entirety when conducting a proper Section 2(d) analysis. As can be seen, the addition of the word "GREEN" alters the mark so that the marks are certainly different in appearance. In addition, the marks connote different meanings. For example, Registrant's mark "UTOPIA", taken literally means "perfect harmony" as opposed to, presumably, imperfect harmony. In the alternative, according to the Examiner's analysis, the term "UTOPIA" is defined as "An ideally perfect place, especially in its social, political and moral aspects." *See Office Action Denying Request for Reconsideration*, *Page* 3. With the addition of the word "GREEN", the resulting combination of "GREEN UTOPIA" displays to consumers an entirely different meaning altogether, namely, (1) green vegetables to create perfect harmony in the body or (2) the creation of an ideally perfect place in the body in all aspects abounding or covered with green growth or foliage. In either case, the connotation is strikingly different from the cited registration and as a result there is no likelihood of confusion between the marks. Applicant's mark

"GREEN UTOPIA" is altered so there is no meaningful similarity in appearance, connotation or sound with the registrant's mark.

Because of the above-referenced differences in similarity of the marks and the different connotation, consumers will not suffer any confusion as to the identify of the source of the goods. Moreover, as explained above, these differences also create a separate and distinct overall impression and therefore will not result in a likelihood of confusion. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 U.S.P.Q. 2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Viacon Indus., Inc.*, 209 U.S.P.Q. 179 (TTAB 1980). Applicant respectfully submits that given the differences in appearance and connotation the marks are dissimilar so as to create a separate and distinct overall impression and there is no valid basis for any alleged likelihood of confusion.

C. Third Party Usage Evidence Demonstrates that "UTOPIA" is a Weak Mark and Should be Afforded Narrow Protection

As argued to the examiner below, the common term between the Applicant's mark and the cited registration which formed the basis of the Examiners refusal is the term "UTOPIA". The term "UTOPIA" has a varied and widespread use among many goods and services. The TTAB has given weight to credible and probative evidence of widespread, significant, and unrestrained use by third parties of marks containing elements in common to demonstrate that confusion is not, in fact, likely. *Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 U.S.P.Q.2d 1445, 1462 (TTAB 1986). Applicant contends that the mark "UTOPIA" is a weak mark which is used to describe numerous goods and services outside of the scope of the Registrant's services. In the case of weak marks, even slight differences between the marks may

be deemed sufficient to avoid a finding that confusion is likely. *See In re Dayco Products -Eaglemotive Inc.*, 9 U.S.P.Q.2d 1910, 1912 (TTAB 1988) ("As such, we find the term to be a relatively weak mark and we agree with applicant that the scope of protection afforded such a mark is considerably narrower than that afforded a more arbitrary designation."); *see also In re Copytele Inc.*, 31 U.S.P.Q.2d 1540, 1542 (TTAB 1994). A search of the *TESS* list of registrations and applications containing the disputed term reveals over 192 instances and is probative to demonstrate that the term "UTOPIA" has been adopted by a number of other users as a good or service designation. As such, the term is not distinctive of the cited Registrant. As demonstrated herein, consumers are certainly accustomed to encountering the mark "UTOPIA" used in conjunction with a cornucopia of trademarks. The consumer would therefore look to other terms in the marks for identification of the source of the goods, and this produces noticeably dissimilar marks.

In the end, the term "UTOPIA" is an awfully dilute mark, similar to such a degree that the public is inundated with this term in day to day life on an assortment of goods and services; therefore, it should be granted very narrow protection on this basis. As can be seen from this basis alone, there is no likelihood of confusion.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Trademark Examiner be reversed and that the present mark be allowed to register as a registered trademark on the Principal Register of the United States Patent and Trademark Office.

An oral hearing is not requested.

Respectfully submitted,

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/s/ 1303-30

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