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Subject: Examiner's Statement: 78587872

The Trademark Examining Operation is currently testing a new version of its FAST electronic workflow tool. Because of unforeseen changes made to FAST, the copy of the Examiner's Statement submitted earlier this day contained an error in the signature line. The Statement was written and submitted by the examiner of record, Ms. Karen Bracey, not the undersigned managing attorney. A corrected copy of the Statement is attached herewith. It is respectfully requested that the Board discard the earlier-filed Statement and replace it with this one.

Thank you.

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/587872

APPLICANT: BLUEBONNET NUTRITION CORP.

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: GREEN UTOPIA

CORRESPONDENT'S REFERENCE/DOCKET NO: 1303-30

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark "GREEN UTOPIA" pursuant to Section 2(d) of the Trademark Act because there is a likelihood of confusion with the registered mark "UTOPIA," Registration No. 2,926,406.

FACTS

The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, GREEN UTOPIA, when used on the goods, identified as "nutritional supplements," was found likely to cause confusion with the registered mark in U.S. Registration No. 2,926,406 UTOPIA for "Dietary Supplement."

On June 30, 2006, this refusal was made final. A Notice of Appeal was filed on January 2, 2007. A request for reconsideration was denied on January 25, 2007 and the applicant filed its brief on April 3, 2007. The application was forwarded to the examining attorney for a brief in accordance with Trademark Rule 2.142(b) on April 19, 2007.

ISSUE

The sole issue on appeal is whether the applied-for mark, when used in connection with the identified goods, so resembles the mark in Registration No. 2,296,406 as to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

ARGUMENT

THE APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH THE REGISTRANTS' MARK WHEN USED ON THE IDENTIFIED GOODS

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

I. **The Goods of the Parties are Identical**

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

As noted, the applicant's goods are identified as "nutritional supplements." The registrant's goods are identified as "dietary supplements." There is no argument but that the goods are legally identical. 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).

II. **The Marks are Confusingly Similar**

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. DuPont 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. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *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).

When determining whether there is a 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.*** (emphasis added) *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 applicant has applied for the mark “GREEN UTOPIA” in standard character form. The registered mark is “UTOPIA” in standard character form. The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont 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 (TTAB1988); *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 argues that there can be no likelihood of confusion because the applicant's mark consists of two words, "GREEN UTOPIA" and the term "GREEN" is the dominant element of the mark. In support of this argument, the applicant references *Truescents LLC v. Ride Skin Care, L.L.C.*, Opposition No. 91158556 (TTAB November 14, 2006) wherein the marks at issue were "GENUINE SKIN" and "GENUINE RIDE SKIN CARE". Despite the fact that the marks create wholly different meanings, the Board concluded, "the term 'RIDE' was *arbitrary as applied to the goods of the applicant*, (emphasis added) and therefore this term was the dominant feature." See applicant's brief page 3. From this, the applicant seemingly makes the leap that the two identical words in the marks at hand cancel each other out, leaving the remaining term "GREEN" as the "dominant" element. This is distortion of the Board's analysis. In *Truescents*, the Board found the marks were not confusingly similar because the marks looked very different, created a different connotation, and sounded different. Moreover, the term "RIDE" is not descriptive of skin care products and is therefore arbitrary as applied to the goods. Similarly in this case, the term "UTOPIA" is arbitrary as applied to the goods, namely, dietary or nutritional supplements. As a result, this term is the dominant element in each mark. The applicant merely added the descriptive term "GREEN" to the registrant's mark.

It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or matter that is descriptive or suggestive of the named goods or services. Sometimes the rule is expressed in terms of the dominance of the common term. Therefore, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral

differences. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (even though applicant's mark PACKARD TECHNOLOGIES (with "TECHNOLOGIES" disclaimed) does not incorporate every feature of opposer's HEWLETT PACKARD marks, similar overall commercial impression is created); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBOS (with "COMBOS" disclaimed) held likely to be confused with MACHO (stylized), both for food items as a part of restaurant services); *In re Computer Systems Center Inc.*, 5 USPQ2d 1378 (TTAB 1987) (CSC ADVANCED BUSINESS SYSTEMS for retail computer stores held likely to be confused with CSC for computer time sharing and computer programming services); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE held likely to be confused with RESPONSE CARD (with "CARD" disclaimed), both for banking services); *In re The U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS (stylized) for clothing held likely to be confused with SPARKS (stylized) for footwear); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Energy Images, Inc.*, 227 USPQ 572 (TTAB 1985) (SMART-SCAN (stylized) for optical line recognition and digitizing processors held likely to be confused with SMART for remote data gathering and control systems); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE and design for

automotive service stations held likely to be confused with ACCUTUNE for automotive testing equipment); *In re Denisi*, 225 USPQ 624 (TTAB 1985) (PERRY’S PIZZA held likely to be confused with PERRY’S, both for restaurant services); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and design (with “CALIFORNIA” disclaimed) held likely to be confused with COLLEGIENNE, both for items of clothing); *In re Pierre Fabre S.A.*, 188 USPQ 691 (TTAB 1975) (PEDI-RELAX for foot cream held likely to be confused with RELAX for antiperspirant).

Exceptions to the above stated general rule regarding additions or deletions to marks may arise if: (1) the marks in their entireties convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. *See, e.g., In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with “CATFISH” disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH’S GOLD’N CRUST and design (with “GOLD’N CRUST” disclaimed) for coating and seasoning for food items); *Inre S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics). The exceptions do not apply in this case because the marks do not create significantly different commercial impressions. Dictionary definitions of the terms “GREEN” and “UTOPIA” were submitted in the Office action dated January 25, 2007. Ordinary grammar rules place the adjective before

the noun, as in the applicant's mark "GREEN UTOPIA." The meaning of "UTOPIA" remains unchanged in either mark and the addition of the descriptive term "GREEN" does little to change the connotation. Contrary to the applicant's assertions, the term "UTOPIA" is not diluted or weak. As noted previously, Office records clearly show very few applications or registrations containing the term "UTOPIA" for the *same or similar goods as the parties*. (emphasis added) Therefore, it is clear that the term common to both marks, "UTOPIA" is arbitrary as applied to nutritional supplements and would be the dominant term consumers would look to as a source identifier.

The applicant next argues that the marks create substantially different meanings due to the addition of the term "GREEN" to the registered mark "UTOPIA." As noted, the applicant's mark consists simply of the adjective "GREEN" and the noun "UTOPIA." It is noted that "UTOPIA" refers to a perfect place and the addition of the term "GREEN," at best, connotes a perfect place having a lot of green foliage or green vegetables.

Contrary to the applicant's assertions, the meaning of "GREEN UTOPIA" is not vastly different from the meaning of "UTOPIA." If the addition of a term results in a unique and different meaning such as adding "BLACK" to "MAGIC" to yield "BLACK MAGIC" or adding "YELLOW" to "JACKET" to create "YELLOW JACKET" the analysis may be different. The applicant's mark is not analogous to these examples. As such, it is clear the two marks do not create vastly different commercial meanings sufficient to overcome a finding of similarity.

The applicant's final argument is that third party usage of the term "UTOPIA" shows it is a "weak" or "diluted" mark and only entitled to a narrow scope of protection. The applicant states, "...the mark 'UTOPIA' is a weak mark which is used to describe

numerous goods and services outside the scope of the Registrant's services." See applicant's brief page 6. However, the applicant has provided no evidence to support this naked assertion. In the absence of any actual evidence, the examining attorney remains unpersuaded.

CONCLUSION

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 in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379 (TTAB 1998); TMEP §§1207.01 *et seq.*

The applicant has clearly done nothing more than add the descriptive term "GREEN" to the registrant's mark "UTOPIA." The common and dominant element in each mark is the term "UTOPIA" which has the identical sound, spelling and connotation. The term is wholly arbitrary as applied to the goods and therefore becomes the most element consumers will look to when creating a commercial impression and discerning the source of the goods. The goods of both parties are essentially identical: "nutritional

supplements” and “dietary supplement.” These items clearly overlap and would travel in the identical channels of trade, targeting the identical consumers. Consumers would have every reason to conclude, albeit incorrectly, that the applicant’s goods comprise a different “formulation” of the registrant’s “UTOPIA” goods and, thus, emanate from the same source. For the reasons cited, the evidence is overwhelming that there is a likelihood of confusion and the refusal to registration under Section 2(d) of the Trademark Act must be affirmed.

Respectfully submitted,

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NOTICE OF NEW PROCEDURE FOR E-MAILED OFFICE ACTIONS: In late spring 2007, for any applicant who authorizes e-mail communication with the USPTO, the USPTO will no longer directly e-mail the actual Office action to the applicant. Instead, upon issuance of an Office action, the USPTO will e-mail the applicant a notice with a link/web address to access the Office action using Trademark Document Retrieval (TDR), which is located on the USPTO website at <http://portal.uspto.gov/external/portal/tow>. The Office action will not be attached to the e-mail notice. Upon receipt of the notice, the applicant can then view and print the actual Office action and any evidentiary attachments using the provided link/web address. TDR is available 24 hours a day, seven days a week, including holidays and weekends. This new process is intended to eliminate problems associated with e-mailed Office actions that contain numerous attachments.