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

Proceeding	78877323
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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No.	: 78/877,323	Philadelphia, PA 19103
Mark	: BONOBO BREW	
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REPLY BRIEF

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INTRODUCTION

On November 8, 2007, Applicant/Petitioner, Sally J. Coxe, an individual, appealed the decision of the Examining Attorney refusing registration of her Application Serial Number 78/877,323 to register the mark BONOBO BREW. The refusal is based on Lanham Act Section 2(d) in light of Registration No. 3,000,676 for the word mark BONOBO'S ("Cited Registration") owned by Bonobo's, LLC, Ltd. ("Registrant"). The Applicant now submits this brief in reply to the Examining Attorney's February 25, 2008 Response.

ARGUMENT

I. THE EXAMINING ATTORNEY HAS NOT SHOWN THAT THE APPLICANT'S GOODS ARE CLOSELY RELATED TO THE REGISTRANT'S GOODS

A. The Examining Attorney Mischaracterizes Applicant's Goods Overbroadly, Leading To False Analyses and Conclusions

As a preliminary matter, Applicant directs the Board's attention to the Examining Attorney's incorrect characterization of Applicant's goods. He lists the current goods as "coffee," in Class 30 and "beer," in Class 32. *See* 02/25/2008 Examiner's Statement, Docket No. 6, p. 1. During prosecution, Applicant filed an amended description that clarifies the goods as: "coffee sold in connection with raising funds for, and awareness of, the Bonobo and its habitat," in Class 30 and "beer sold in connection with raising funds for, and awareness of, the Bonobo and its habitat," in Class 32. *See* Exhibit "A". This amendment was made in Applicant's November 8, 2007 amended Response to the final Office Action and accepted by the U.S. Patent and Trademark Office. The Applicant also repeatedly referred to this description in her Appeal Brief. *See* 11/08/2007 Appeal Brief, pgs. 1-4 and 20.

The Examining Attorney relies on the inaccurate and substantially broader listing of goods throughout his brief. This error substantially impacts his analysis. For example, the Examiner repeatedly argues that consumers are likely to encounter the respective goods in the

same channels of trade under the broader "coffee" and "beer" labels. Instead, the Applicant's goods will be sold in specific and recognizable channels of trade such that the coffee and beer are sold in connection with raising funds for, and awareness of, the Bonobo and its habitat. The Examiner fails to recognize the distinguishing significance.

B. The Examining Attorney Fails to Connect the Service In the Cited Registration With the Coffee and Beer Provided By Applicant

Aside from relying on an incorrect recitation of goods, the Examiner fails to connect the service in the Cited Registration with the coffee and beer provided by Applicant. The Examining Attorney's remaining arguments regarding the relatedness of the goods are neither persuasive nor supported.

1. There is no likelihood that the parties' respective goods would be found in the same channels of commerce

The Examiner fails to sustain a likelihood that each party's goods may be found within the same channels of commerce. The Examiner argues that consumers are likely to encounter Applicant's beer and coffee in the same channels of commerce as the Registrant's goods. The evidence shows that the only channel of commerce for the Registrant's goods is its restaurant. There is no evidence that the Registrant sells beverages under the name BONOBO'S or that its restaurants serve coffee or beer or any other beverages bearing that label. The Cited Registration does not recite beverages of any kind and the foods listed are of a relatively narrow variety; namely, organic and natural foods such as fruits, vegetables, nuts and oils. Even assuming *arguendo* that the Registrant's restaurant might later serve coffee, nothing indicates that they would serve such goods under the BONOBO'S label or outside of the BONOBO'S restaurant. In fact, most restaurants serve coffee in unlabeled mugs or unmarked cups. For these reasons, there is no likelihood that the parties' respective goods would be found in the same channels of commerce.

2. Coffee and beer do not fall into the Registrant's logical zone of expansion

The Examining Attorney then fails to substantiate an argument that coffee and beer fall into the Registrant's logical zone of expansion. *See* Examiner's Statement, p. 7. The evidence submitted by the Registrant during prosecution of the Cited Registration and subsequent evidence undisputedly show that the Registrant's restaurant operates under a unique and strict philosophy of serving food akin to the diet of a Bonobo chimpanzee. The Registrant labels the food "eco-friendly"; i.e., entirely uncooked or semi-cooked vegetarian fare. *See e.g.*, Exhibit "A" of November 8, 2007 Response (stating, "[a]ll vitamins, minerals and other food components are not changed by heat."). Similarly, the Registrant's website proclaims that "[a]ll vitamins, minerals and other food components are not changed by heat." *See* Exhibit "A" of November 8, 2007 Response. With respect to its soups, it states, "warm soups [are] not heated above 118° F." *See id.* Since the Cited Registration lists organic and natural foods, the strict philosophy claimed in the Registrant's website will stay intact to appease customers of this particular dietary regimen.

Given the specific nature of the food served at the Registrant's restaurant, listed in the Cited Registration, the Registrant's strict philosophy, and the fact that the Cited Registration does not list beverages, there is virtually no likelihood that coffee and beer are to be considered within the Registrant's ***logical*** zone of expansion. The Examining Attorney states only that ***typical*** restaurants often serve beverages such as coffee and beer. As explained above, the Cited Registration is not for a typical restaurant. It is also worth noting that the Examining Attorney argues that a restaurant that sells vegetarian and natural foods could easily expand their product lines to include coffee and beer. *See* Examiner's Statement, p. 7. For a restaurant to conform to a practice of providing unheated foods, with a concentration in fruits and vegetables, it is

unreasonable to extend the Registrant's service to provide coffee and beer which are both heated during their preparation. In this context, fruit and vegetable entrees are as unrelated to beer and coffee, as "natural fruits" are to "junk food and candy" as recognized by *In re Mars*, 741 F.2d 395 (Fed. Cir. 1984). *See* Examiner's Statement, p. 9.

C. There Is No Likelihood of Reverse Confusion

Surprisingly, the Examining Attorney elicits an argument of reverse confusion, an argument never previously raised during prosecution. He speculates that consumers could develop a "low opinion" of Applicant's product and then associate this low opinion with the Registrant's restaurant services. There is no evidence of any reverse confusion or the chance of any reverse confusion occurring. And even assuming *arguendo* that consumers develop a "low opinion" of the Applicant's coffee and beer, they will surely not tie their opinion to Registrant's restaurant services. The Registrant's heavily advertised intent and philosophy for specific cuisine relieves customers of potential confusion. The Registrant advertises to differentiate its restaurant from the competition. *See* Exhibit "A" of November 8, 2007 Response (stating, "most food choices are made from social habit, we suggest being adventurous and trying new and exciting tastes that Nature has provided for us to enjoy.") Further, the purchasers of raw, vegetarian or eco-friendly foods are conscious of the health benefits of such foods and thus relatively sophisticated. This sophistication limits the consumers' selections to conform to their preferred unique diet. These purchasers would certainly recognize the stark differences between brewed and heated products, such as coffee and beer, and raw fruit and vegetable selections. Because consumers of raw vegetarian foods will recognize the distinction between the Registrant's unique cuisine from beer and coffee, the consumers would not "suffer great harm" as proposed by the Examining Attorney. *See* Examining Attorney's Statement, p. 12.

The Examining Attorney also fails to show that the Registrant's restaurant produces brewed beverages. *See* Examiner's Statement, p. 10. Nothing in the record indicates that the Registrant's restaurant produces brewed goods. Teas are provided, but whether they are brewed cannot be presumed. *See* Exhibit "A" of November 8, 2007 Response. Again, the Registrant's menu states that "warm soups [are] not heated above 118° F." *See id.* This clear statement supports the notion that the Registrant's restaurant does not serve beverages heated to a temperature required for brewing.

For the foregoing reasons, it is respectfully submitted that the Examining Attorney has not shown that the Applicant's goods are closely related to the Registrants.

II. THE EXAMINING ATTORNEY HAS NOT SHOWN THAT THE APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTRANT'S MARK

A. The Examining Attorney Improperly Dissects the Marks

In arguing that the respective marks are similar, the Examining Attorney improperly dissects the marks by focusing too heavily on the word "Bonobo" while ignoring the full textual mark of BONOBO BREW. In addition, the Examining Attorney trivializes the differences between the marks by stating that the "'s" included in the Registrant's BONOBO'S mark is not sufficient to distinguish the respective marks.

It is well-established that the marks must be considered in their entireties and in connection with the particular goods or services for which they are used. *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 851 (Fed. Cir. 1992). When considering the marks as a whole, the marks are sufficiently dissimilar. In fact, the PTO recently passed to registration an application for the trademark BONOBOS (Serial No. 76/647,660) for "reconfigurable mealtime accessory totes." The BONOBOS mark differs only from the cited BONOBO'S mark by only an apostrophe which is less than the "'s" that the Examiner

characterizes as an insignificant difference between the present marks. Further, the BONOBOS application recites goods that are more similar to the Cited Registration's than the Applicant's goods. In particular, the BONOBOS application recites food related goods, namely, "reconfigurable ***mealtime*** accessory totes." It is irrelevant that the application for BONOBOS is now abandoned, as argued by the Examiner. The fact remains that the PTO passed this application despite the Cited Registration's existence.

B. The Examining Attorney Fails To Account For the Fact That More Similarity Between the Marks Is Required Because the Goods Are Not Directly Competitive

Further, it is undisputed that the goods are not directly competitive. Therefore, more similarity between the marks is required before a likelihood of confusion can be found. When considering the marks in their entireties and in light of the goods, the Applicant's two-word mark is sufficiently dissimilar from the Registrant's one-word mark, in sight, sound and meaning. *See In re Island Oasis Frozen Cocktail Company, Inc.*, Serial No. 75/883,870, 2002 TTAB LEXIS 319, *6 (TTAB 2002)) (UNPUBLISHED) (finding no likelihood of confusion between ISLANDER and ISLANDER COFFEE HOUSE).

In overemphasizing the importance of the term "Bonobo," the Examining Attorney argues that there is only one registration bearing the Bonobo name and that the term Bonobo is "uncommon in daily use." *See* Examiner's Statement, Docket No. 6, p. 3. First, the Examiner fails to include that there are other applications for marks that include the term Bonobo, which are relevant. *See e.g.*, Application Serial No. 78/223774. Second, the Examiner provides no support for his assertion that the term Bonobo is "uncommon in daily use."

C. Applicant's Arguments Regarding the Descriptiveness of the Registrant's Mark Are Proper

Finally, the Examining Attorney argues that the Applicant's arguments regarding the apparent descriptiveness of the Registrant's mark, are improper and may be raised only in a cancellation proceeding. However, it is well-established that the strength of a prior mark is relevant in determining whether a likelihood of confusion exists. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (stating that number and nature of similar marks in use on similar goods factor in determining likelihood of confusion); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (strength of plaintiff's mark one factor in determining likelihood of confusion).

CONCLUSION

Based on the foregoing and on her Appeal Brief, the Applicant respectfully submits that the BONOBO BREW mark is not likely to cause confusion with the mark of the Cited Registration. Applicant's goods are specifically "coffee and beer sold in connection with raising funds for, and awareness of, the Bonobo and its habitat," in Classes 30 and 32, which are unrelated to the Cited Registration's restaurant goods and services. Further, Registrant's specimens and other evidence clearly show that the restaurant serves raw vegetarian food in keeping with Registrant's philosophy of providing raw, "eco-friendly" foods and is therefore distinguishable from coffee and beer. For the foregoing reasons, Applicant, once again, respectfully requests that the Board reverse the Examining Attorney's refusal to register BONOBO BREW under Section 2(d).

Respectfully submitted,

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EXHIBIT A

BON-07-093

Coney, Carol Ann

From: teas@uspto.gov
Sent: Thursday, November 08, 2007 3:36 PM
To: IP Philadelphia Mailbox
Subject: Received Your Response To Office Action for serial number 78877323

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NOV 8 2007
IP DEPT.

We have received your Response to Office Action Form form below.

To the Commissioner for Trademarks:
Application serial no. **78877323** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:
The present amendment is being filed in conjunction with remarks and supporting evidence filed separately on the same day.

CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 030 for coffee
Original Filing Basis:
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/10/2005 and first used in commerce at least as early as 02/00/2006, and is now in use in such commerce.

Proposed: Class 030 for coffee sold in connection with raising funds for, and awareness of, the Bonobo and its habitat
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/10/2005 and first used in commerce at least as early as 02/00/2006, and is now in use in such commerce.
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 032 for beer, fruit juice beverages and vegetable juice beverages
Original Filing Basis:
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/10/2005 and first used in commerce at least as early as 02/00/2006, and is now in use in such commerce.

Proposed: Class 032 for beer sold in connection with raising funds for, and awareness of, the Bonobo and its habitat
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/10/2005 and first used in commerce at least as early as 02/00/2006, and is now in

use in such commerce.

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: /william l. bartow/ Date: 11/08/2007
Signatory's Name: William L. Bartow
Signatory's Position: Attorney of record

The signatory has confirmed that he/she is either (1) an attorney who is a member in good standing of the bar of the highest court of a U.S. state; or (2) a Canadian attorney/agent who has been granted reciprocal recognition under 37 C.F.R. §10.14(c) by the USPTO's Office of Enrollment and Discipline. He/she further confirms that (1) the applicant has not previously been represented in this matter by an authorized attorney; and (2) he/she is the applicant's attorney or an associate of that attorney.

Thank you,

The TEAS support team
Thu Nov 08 15:36:12 EST 2007
STAMP: USPTO/ROA-206.181.226.34-20071108153612259546-78877323-40052dcbc18b5fffcad99ff8ed72da3c49-N/A-N/A-20071108152754649567