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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85108213

MARK: MOTHER EARTH BREWING



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Mother Earth Brewing, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

The applicant has appealed the examining attorney's¹ final refusal to register the trademark MOTHER EARTH BREWING for services, as amended, identified as "distributorships in the field of beverages, namely beer, brewed malt-based alcoholic beverages, distilled spirits and liquor, but not organic beer and not including beer comprised solely of organic components" in International Class 35 on the ground that the applied-for mark is likely to cause confusion, mistake, or deception under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the mark in U.S. Registration No. 3850662, ME MOTHER EARTH BREW CO. and design, for "beer comprised solely of organic components" in International Class 32.

STATEMENT OF THE FACTS

Applicant filed its application on August 16, 2010, seeking registration on the Principal Register for the mark MOTHER EARTH BREWING for "distributorships in the field of beverages" in International Class 35.

In the first Office Action, dated December 1, 2010, the examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that the applied-for mark, when used in connection with the identified distributorship services, so resembled the mark in U.S. Registration No. 3850662 as to be likely to cause confusion, to cause mistake, or to deceive. The examining attorney also advised the applicant that there may be a likelihood of confusion between the applied-for mark and a pending application, Serial No. 85042845. In addition, the applicant was required to disclaim the descriptive word BREWING apart from the mark as shown.

¹ The application was originally assigned to examining attorney Aisha Y. Salem. On December 12, 2013, the application was reassigned to the undersigned examining attorney, Elizabeth F. Jackson.

On December 7, 2010, applicant responded with a request that the application be suspending pending the disposition of Cancellation Proceeding No. 92053044.

On January 22, 2011, the examining attorney suspended the application pending disposition of Cancellation No. 92053044 and Serial No. 85042845. In addition, the refusal under Section 2(d) of the Trademark Act based on U.S. Registration No. 3850662 and the requirement to disclaim the descriptive wording BREWING were maintained and continued.

By order dated August 22, 2011, the Board granted respondent's motion for judgment on the pleadings and dismissed the applicant's petition to cancel U.S. Registration No. 3850662 with prejudice.

On September 2, 2012, the examining attorney issued a new non-final Office action refusing registration under Section 2(d) of the Trademark Act based on U.S. Registration No. 4122361. In addition, the refusal under Section 2(d) of the Trademark Act based on U.S. Registration No. 3850662 and the requirement to disclaim the descriptive wording BREWING were maintained and continued.

On March 4, 2013, the applicant disclaimed the descriptive wording and submitted a consent agreement with the owner of U.S. Registration No. 4122361. Further, the applicant submitted arguments against the refusal to register the mark under Section 2(d) of the Trademark Act with regard to U.S. Registration No. 3850662 and amended its identification of services.

On March 26, 2013, the examining attorney determined the consent agreement to be acceptable, and the refusal under Section 2(d) based on U.S. Registration No. 4122361 was withdrawn. In addition, the disclaimer statement was deemed acceptable, and the requirement was satisfied. As to the Section 2(d) refusal based on U.S. Registration No. 3850662, the examining attorney did not find the applicant's arguments or amended identification persuasive. Thus, the refusal to register the applied-for mark based upon a likelihood of confusion with U.S. Registration No. 3850662 was made final.

On September 26, 2013, the applicant filed an appeal with the Board. Jurisdiction was restored to the examining attorney on November 26, 2013. This appeal now follows.

On December 12, 2013, the Office reassigned the prosecution of this application to the undersigned examining attorney.

ISSUE ON APPEAL

The sole issue on appeal is whether the applicant's mark, MOTHER EARTH BREWING, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 3850662 as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act.

ARGUMENT

The Marks are Confusingly Similar Because Applicant's Mark, MOTHER EARTH BREWING, Creates the Same Overall Commercial Impression as Registrant's Mark ME MOTHER EARTH BREW CO. and Design, and the Goods and Services are Closely Related Such That Consumers are Likely to be Confused or Mistaken or Deceived as to the Source of the Goods and Services Under Section 2(d) of the Trademark Act

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the

factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and services, and similarity of the trade channels of the goods and services. See *In re Viterro Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.* The overriding concern is not only to prevent buyer confusion as to the source of the goods and services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

I. The Marks are Confusingly Similar Because the Dominant, Source-Identifying Term Within Each Mark is Identical and Conveys the Same Meaning

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general

rather than specific impression of trademarks and service marks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

In this case, applicant’s mark MOTHER EARTH BREWING and registrant’s mark ME MOTHER EARTH BREW CO. and design share the identical phrase MOTHER EARTH. This phrase is identical in sound and appearance, and it conveys the same commercial impression of “the mother of everything animate or inanimate upon the earth” or “soil; ground.”² This phrase is arbitrary and thus distinctive of applicant’s and registrant’s alcohol-related goods and services because neither an abstract mother figure nor soil describes a feature or characteristic of beer or distributorship services. Purchasers will therefore focus on this distinctive phrase in each mark and believe—mistakenly—that applicant’s mark and registrant’s mark both identify the same MOTHER EARTH brand of goods and services.

This confusion is even more likely because both applicant and registrant refer to their respective companies solely using the phrase MOTHER EARTH. On applicant’s website, applicant states “we put a lot of heart and imagination into every Mother Earth bottle”³, “look for Mother Earth’s world-class beers across North Carolina and Georgia”⁴, and “pick up Mother Earth beer at one of the locations listed below... order a Mother Earth brew.”⁵ On registrant’s website, registrant states “Here at Mother Earth, we aren’t trying to reinvent the wheel.”⁶ Thus, when purchasers encounter beer distributorship services offered under the mark MOTHER EARTH, they will mistakenly believe that the mark indicates the same source as the MOTHER EARTH brand of beer.

² See Applicant’s Response dated March 4, 2013 at pp. 119-121, Ex. 26 (citing *Webster’s Third New International Dictionary*).

³ See Applicant’s Response dated March 4, 2013 at p. 7, Ex. 3.

⁴ See Applicant’s Response dated March 4, 2013 at p. 9, Ex. 4.

⁵ See *id.*

⁶ See Applicant’s Response dated March 4, 2013 at p. 118, Ex. 25.

Not only do the marks share the distinctive phrase MOTHER EARTH, the additional wording—BREW CO. in registrant’s mark and BREWING in applicant’s mark—make source confusion even more likely. Though the additional words BREW and BREWING are descriptive, and thus have little source-indicating value, they are still very similar in terms of sound, appearance, and meaning because both use forms of the verb BREW, which describes the process of making beer. Furthermore, the term CO. in the registrant’s mark is an abbreviation for the word “Company”; business entity designations such as “Company” merely indicate a registrant’s legal entity type and generally do not function to indicate the source of goods. TMEP §1213.03(d); *see, e.g., Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888); *In re Patent & Trademark Servs., Inc.*, 49 USPQ2d 1537, 1539-40 (TTAB 1998); *In re The Paint Prods. Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988). Accordingly, purchasers will understand the term CO. as merely indicating registrant’s entity, and thus focus on the phrase MOTHER EARTH BREW to identify the source of registrant’s services. Because this phrase is very similar to MOTHER EARTH BREWING in applicant’s mark, purchasers will mistakenly believe that both marks indicate the same source of beer and distributorship services.

Furthermore, the additional term ME in the registrant’s mark does not obviate the similarity between the marks. Because the dominant wording MOTHER EARTH in applicant’s mark is wholly encompassed within the wording ME MOTHER EARTH in registrant’s mark, purchasers are likely to understand the ME in registrant’s mark as merely identifying an acronym for the wording MOTHER EARTH in applicant’s mark. The Board recently considered a similar situation: comparing the marks LP LEAK POINT in stylized font and LEAKPOINT in standard character form. *See In re Archer (UK) Ltd.*, Application. No. 79094466, 2013 TTAB LEXIS 480 (September 4, 2013).⁷ The Board stated “we find that applicant’s LEAKPOINT mark is highly similar to the mark LK LEAK POINT in the cited registration

⁷ To view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the application number specified. Find the final decision in the prosecution history and left click on it to view it as a .pdf document.

inasmuch as the wording in applicant's mark is subsumed in that of registrant. The mere presentation of registrant's mark in stylized script and the truncation of applicant's mark into a single term are not sufficient to distinguish them." See *In re Archer (UK) Ltd.*, 2013 TTAB LEXIS 480, at *6. Here, the wording MOTHER EARTH in applicant's mark is subsumed within registrant's mark, and thus the mere presentation of applicant's mark in stylized form and the truncation of applicant's MOTHER EARTH wording into a single term ME is not sufficient to distinguish the marks. The Trademark Trial and Appeal Board has stated that decisions designated as not precedential are not binding upon the Board *but* may be cited for whatever persuasive value they might have. TBMP §101.03; TMEP §705.05.

Moreover, the addition of the term ME actually exacerbates the likelihood of confusion between the two marks. In comparing the marks BRAND CAMP and BC BRANDCAMP UNIVERSITY, the Board stated "the stylized letters 'BC' reinforce the dominant wording of applicant's mark. Thus, we give less weight to the stylized letters 'BC' than we do to the wording of the mark 'BRANDCAMP UNIVERSITY.'" See *In re The Flemings Group LLC*, Application No. 85368760, 2013 TTAB LEXIS 224, *10 (May 1, 2013).⁸ Thus, in this case, the acronym ME is less significant, only serving to reinforce the dominant wording MOTHER EARTH in the registrant's mark. Because this dominant wording is identical to the dominant portion of the applicant's mark, purchasers are likely to believe—mistakenly—that the marks identify the same MOTHER EARTH brand of beer distributorship services and beer goods. Thus, the marks are confusingly similar.

Moreover, the fact that registrant's mark also contains a design element does not obviate the similarities the applied-for mark shares with the registered mark. For composite marks containing both words and a design, the word portion generally may be the dominant and most significant feature of a mark because consumers will request the goods using the wording. See *In re Viterro Inc.*, 671 F.3d 1358,

⁸ To view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the application number specified. Find the final decision in the prosecution history and left click on it to view the .pdf document.

1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1247 (TTAB 2010). For this reason, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii). In this case, despite the design, purchasers will call for both the registrant's goods and applicant's services using the distinctive phrase MOTHER EARTH. Thus, purchasers are likely to be confused as to the source of the beer and the distributorship services.

In addition, the applicant has applied for the mark in standard characters. A mark in standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterro Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and with a design element generally will not avoid likelihood of confusion with a mark in standard characters because the marks could be presented in the same manner of display. See, e.g., *In re Viterro Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display"). Thus, in this case, applicant has the freedom to display its mark in the exact same stylization as that in the registrant's mark. Therefore, the addition of stylized lettering and a design to registrant's mark does not avoid a likelihood of confusion with applicant's mark in standard characters.

Thus, applicant's mark and registrant's mark are highly similar in that both marks have the same distinctive, source-identifying phrase MOTHER EARTH. Accordingly, purchasers will likely believe that

both marks identify the same MOTHER EARTH brand of beer and beer distributorship services. Thus, the marks are confusingly similar.

Applicant argues that the design element sufficiently distinguishes the marks. However, as noted above, the TTAB has held that the wording in a mark is more dominant than the design element because purchasers will use the wording to call for the goods. Purchasers are far more likely to call for registrant's beer using the phrase MOTHER EARTH, rather than by describing the goods as having a picture of a tree and waterfall. Accordingly, purchasers will call for both applicant's distributorship services and registrant's beer using the same literal element MOTHER EARTH; therefore, consumers will mistakenly believe that the marks identify the same brand of beer and beer-related services.

Applicant also argues that the applicant's mark conveys an impression of a person in the act of brewing, while registrant's mark does not suggest the act of brewing nor a personality. However, both marks evoke the dual meaning of MOTHER EARTH—as soil or the mother of all things—and both marks convey the process of making beer by the use of a form of the verb BREW. Acknowledging that the marks are different, that is not the test for a likelihood of confusion. *See* TMEP §1207.01(b). Because both marks create the same mental image, purchasers are likely to believe the marks identify the same source of beer goods and distributorship services.

Applicant argues that the marks do not sound the same because purchasers are more likely to call for the beers applicant distributes and registrant's beer using the name of particular brews, such as the registrant's "Rysing Tide"⁹ or applicant's "Endless River."¹⁰ First, there is no rule—or evidence in the record—that an umbrella or company mark is rendered silent because of the use of secondary trademarks. Second, it is unlikely that purchasers will refer to applicant's distributorship services by the

⁹ *See* Applicant's Response dated March 4, 2013 at p. 7, Ex. 3.

¹⁰ *See* Applicant's Response dated March 4, 2013 at p. 118, Ex. 25.

name of one particular flavor of beer. Ultimately, when purchasers call for applicant's distributorship services, they will use the dominant wording MOTHER EARTH. Thus, source confusion is likely to result.

Applicant also contends that registrant's mark is a logo, and thus "harder to be 'said.'" The wording within registrant's mark clearly states ME MOTHER EARTH BREW CO., and when purchasers are interested in using registrant's services, they will use the wording within the logo to call for those services. Thus, consumers can easily "say" registrant's mark using the distinctive wording MOTHER EARTH, which is identical to the dominant element of the applied-for mark.

Applicant attached third party registrations to show dilution of the term MOTHER EARTH and then points to the case *In re Hartz Hotel Services, Inc.* to argue that descriptive language added to a diluted phrase is sufficient to distinguish the mark from others with the same dominant term. See 102 USPQ2d 1150 (TTAB 2012). First, the weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with similar goods and services. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

Because applicant has not shown any actual third party use of MOTHER EARTH marks, its reliance on *In re Hartz Hotel Services, Inc.* is inapposite. That case included several examples of third party use of the term GRAND HOTEL shown through Internet websites and an investigator's declaration. See *In re Hartz Hotel Servs*, 102 USPQ2d at 1153.

Moreover, even if the third party registrations *did* prove weakness of the phrase MOTHER EARTH in commerce, *In re Hartz Hotel Services, Inc.* is still irrelevant here. In that case, the TTAB pointed to five third party registrations using the phrase GRAND HOTEL in combination with geographically descriptive language, among other evidence, to allow registration of the mark GRAND HOTEL NYC. All five third party registrations, in addition to the registrant's and applicant's marks, were for identical services: "hotel services." See *id.* at 1152. In the instant case, unlike in *Hartz*, the applicant has not provided one third party registration—much less five—to show the dilution of the term MOTHER EARTH for beer or distributorship services in the field of alcoholic beverages. Accordingly, there is no evidence in the record that the phrase MOTHER EARTH is a weak or diluted mark for beer goods or alcohol distributorship services and therefore, the registration is entitled to the full scope of protection afforded by the Trademark Act.

Applicant argues that the phrase MOTHER EARTH is "conceptually weak" because it is descriptive of registrant's goods. However, there is no evidence that people use the phrase MOTHER EARTH to describe a particular feature or characteristic of beer. In fact, the dictionary definitions of the phrase MOTHER EARTH only establish that the phrase is arbitrary and thus inherently distinctive of beer. Moreover, the mark is registered on the Principal Register without a claim of acquired distinctiveness or disclaimer of that phrase.

Ultimately, when purchasers encounter applicant's beer distributorship services and registrant's beer, they are likely to be confused as to the source of the goods and services by the contemporaneous use of marks with the identical dominant term MOTHER EARTH. Thus, the marks are confusingly similar.

II. Applicant's Distributorship Services in the Field of Alcoholic Beverages are Closely Related to Registrant's Beer Comprised Solely of Organic Components

The goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). The respective goods and services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

Applicant has amended the identification of services to the following: “distributorships in the field of beverages, namely beer, brewed malt-based alcoholic beverages, distilled spirits and liquor, but not organic beer and not including beer comprised solely of organic components” in Class 35. The registrant has identified “beer comprised solely of organic components” in Class 32.

Applicant's distributorship services in the field of alcoholic beverages are related to registrant's beer. Specifically, consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture). For example, in *In re United Service Distributors, Inc.*, the TTAB found that distributorship services in the field of health beauty aids were related to skin creams, noting that retailers, "familiar with health and beauty aids sold under a particular mark, upon coming into contact with a distributor of health and beauty aid products whose distributorship services are rendered under a similar mark, would erroneously believe that said distributorship services and the beauty aid products were somehow sponsored by or associated with the same source." *See* 229 USPQ 237, 239 (TTAB 1986). Likewise, in this case, beer retailers will mistakenly believe that the distributorship services in the field of beer and the beer goods, both offered under marks with the identical, dominant phrase MOTHER EARTH are somehow sponsored or associated with the same source. Thus, the goods and services are related.

In addition, though applicant has specifically stated that it does *not* distribute organic beer, registrant's organic beer is still related to distributorship services featuring non-organic beer. First, many companies that manufacture non-organic beer also make organic beer. The article from Massachusetts Beverage Business¹¹ states that Anheuser-Busch and Magic Hat Brewing have both begun brewing organic beers. The article from Tasteforlife states "[f]or years, many craft-beers (made from non-automated breweries in limited amounts) have gone organic, both with specialty products and entire company standards."¹² The website from JR's Beer Warehouse shows that the Sam Smith brand offers organic ale, organic stout, and organic cider in addition to chocolate stout, imperial stout, India

¹¹ *See* Applicant's Response dated March 4, 2013 at p. 109, Ex. 21.

¹² *See* Applicant's Response dated March 4, 2013 at p. 113, Ex. 22.

ale, nut brown ale, and oatmeal stout all under the Sam Smith mark.¹³ Therefore, beer retailers, in choosing beer to sell in their stores, are accustomed to encountering companies that make both organic and non-organic beer. Second, as noted above, beer retailers are likely to presume an association between an alcoholic distributorship service and beer goods if both are offered under marks with the same dominant, distinctive phrase. Thus, when beer retailers encounter organic beer and distributorship services of non-organic beer both offered under a MOTHER EARTH mark, they are likely to believe that the marks identify the same source of goods and services.

Furthermore, the fact that applicant distributes non-organic beer and registrant provides organic beer may actually *heighten* the likelihood of confusion. The TTAB recently stated:

“The distinction made between organic beer and non-organic beer does not make the services and goods unrelated. Consumers, i.e., retail establishments which would be the users of the distribution services, are likely to assume that the company that does distribution services also sells beer. In fact, the distinction in the type of beer, with applicant's distribution services being for non-organic beer and registrant's goods being beer made of organic components, is likely to heighten the likelihood of confusion. That is, consumers could assume that a company that produces beer could use its distribution system to distribute beer for others, and that since the registrant makes an organic beer, it would choose to distribute non-organic beers for third parties, rather than organic beers that would compete more directly with its own products.”

See In re Mother Earth Brewing, LLC, Application No. 77716598, 2013 TTAB LEXIS 630, at *25-26 (November 30, 2013).¹⁴ Thus, in this case, purchasers are likely to believe—mistakenly—that the MOTHER EARTH brand of organic beer provides distributorship services only in non-organic beer to avoid distributorship services of its direct competitors' goods. Thus, the relevant consumer may note the difference between the goods and services, yet still believe that both are offered by the same source. Therefore, the goods and services are related.

¹³ See Examining Attorney's outgoing Office action dated March 26, 2013 at p. 4.

¹⁴ To view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the application number specified. Find the final decision in the prosecution history and left click on it to view it as a .pdf document.

Applicant does not dispute that distributorship services of alcoholic beverages are related to registrant's organic beer; rather, the bulk of applicant's argument is concerned with registrant's organic beer being unrelated to the non-organic beer that applicant distributes.

Applicant argues that registrant's organic beer is subject to different regulations and thus marketed to different consumers. Applicant is correct in that there are certain requirements for a beer to be labeled "organic". Ultimately, though, this classification only refers to the particular method of growing the ingredients. The end product of beer—organic or not—is made with the same basic ingredients and in essentially the same manner. Thus, organic beer and non-organic beer are essentially the same goods. Furthermore, even if the registrant's organic beer is subject to additional regulations or restrictions, the purchaser is not. Therefore, while the regulations related to brewing organic beer may factor into a manufacturer's decision to make organic beer, the regulations do not factor into the purchaser's decision to buy it.

Applicant argues that consumers of organic and non-organic beer are "are well-versed in the styles of beer being offered and are knowledgeable about the sources (i.e. the brewers) of the beers they select."¹⁵ Neither the application nor the registration limits the goods to certain sophisticated users and the identifications are broad enough to cover individuals who are not knowledgeable in the field. Even if registrant's goods are used by knowledgeable consumers, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). The knowledge of the consumers does not obviate a likelihood of confusion.

¹⁵ *See* Applicant's Response dated March 4, 2013 at p. 22.

Further, applicant argues that registrant “does not appear to sell through any third party retail stores, such as grocery stores, convenience stores” or liquor stores;¹⁶ such stores are presumably the consumers of applicant’s distributorship services. However, a trademark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant’s exclusive right to use the mark in commerce in connection with the specified goods. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Likelihood of confusion must be determined on an analysis of the mark as applied to the goods recited in an applicant's application vis-a-vis the goods recited in the registration, rather than what the evidence shows the goods to be. See *id.* Thus, it is presumed that registrant's goods travel in all channels of trade appropriate for goods of this type, including grocery stores, convenience stores, and liquor stores, including consumers of applicant’s distributorship services. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Further, organic beer and non-organic beer *do* travel in the same channels of trade. For example, the BevMo! websites show organic beer sold alongside non-organic beer.¹⁷ The JR’s Beer Warehouse websites show organic beer offered in the same specialty stores.¹⁸ The website from Kegs & Barrels proclaims, “Ale, Cider, Fruit Beer, Imported Beer, Lager, Organic Beer, Mead and Microbrews! Amber, blonde, or dark! Can’t decide? Mix Your Own Six Pack right in our stores!”¹⁹ The Port Chester Beer websites show that organic and non-organic beer are sold in the same specialty stores, that is, purchasers interested in buying beer.²⁰ The Save-Mor Beer & Pop Warehouse sells organic beer alongside non-organic beer.²¹ The website from Total Wine & More shows that organic beer and non-organic beer are offered in the same department.²² Thus, purchasers are accustomed to encountering

¹⁶ See Applicant’s Response dated March 4, 2013 at p. 23.

¹⁷ See Examining Attorney’s outgoing Office action dated March 26, 2013 at pp. 2-3.

¹⁸ See Examining Attorney’s outgoing Office action dated March 26, 2013 at p. 4.

¹⁹ See Examining Attorney’s outgoing Office action dated March 26, 2013 at p. 5.

²⁰ See Examining Attorney’s outgoing Office action dated March 26, 2013 at pp. 6-7.

²¹ See Examining Attorney’s outgoing Office action dated March 26, 2013 at p. 8.

²² See Examining Attorney’s outgoing Office action dated March 26, 2013 at pp. 9-10.

organic and non-organic beer offered in the same channels of trade. Accordingly, when purchasers encounter organic beer and distributorship services of non-organic beer offered under similar marks, they will believe that the goods and services are offered by the same source. Thus, the goods and services are related.

Lastly, the applicant states that it “is not aware of any evidence of actual confusion” since registrant began using its mark on April 28, 2010 and applicant began use of its mark on October 31, 2009. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion; it is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant’s assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Here, the evidence establishes that purchasers are likely to be confused as to the source of beer and distributorship services offered under similar MOTHER EARTH marks.

Ultimately, when consumers of beer distributorship services encounter beer under a similar MOTHER EARTH mark, they are likely to be confused as to the source of the beer-related goods and services. Thus, the goods and services are related.

Moreover, the TTAB recently agreed with this finding in a very similar case. In *In re Mother Earth Brewing, LLC*, the TTAB held that applicant's mark MOTHER EARTH BREWING with a design was confusingly similar to registrant's mark MOTHER EARTH BREW CO. with a design, and applicant's distributorship services in the field of alcoholic beverages were related to registrant's organic beer; thus, purchasers were likely to be confused as to the source of the goods and services. See 2013 TTAB LEXIS 630. In the instant case, the marks are even more similar because of the potential for applicant to display its standard character mark in the exact same stylization as that of registrant's mark.

CONCLUSION

Therefore, because the marks containing the identical dominant phrase MOTHER EARTH are confusingly similar and the beer-related goods and services of applicant and registrant are related, purchasers are likely to be confused or mistaken or deceived as to the source of the goods and services. Thus, for all of the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) should be affirmed.

Respectfully submitted,

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