From: Sander, Drew

Sent: 3/7/2016 12:16:48 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 86323047 - EARTH PETS NATURAL PET MARKET - N/A - EXAMINER BRIEF

****

Attachment Information:

Count: 1

Files: 86323047.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86323047

MARK: EARTH PETS NATURAL PET MARKET

CORRESPONDENT ADDRESS:

MATTHEW H. SWYERS, ESQ.

THE TRADEMARK COMPANY PLLC

344 MAPLE AVE W STE 151

VIENNA, VA 22180-5612

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Huber, Steven A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

admin@thetrademarkcompany.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's FINAL refusal to register the mark EARTH PETS NATURAL PET MARKET (in standard characters) for "retail pet stores" on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

I. FACTS

The applicant has applied for registration on the Principal Register for the mark EATH PETS NATURAL PET MARKET in standard characters, for "retail pet stores" in International Class 35. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d) based on likelihood of confusion with registered marks in U.S. Registration No. 3351024, NATURAL PET MARKET (with design) for "retail stores featuring health food for pets;" and U.S. Registration No. 3621455, NATURAL PET MARKET (in standard characters) for "retail pet stores." Both marks are owned by the same registrant. This appeal follows the examining attorney's final refusal on the issue of likelihood of confusion.

II. ARGUMENTS

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/or 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, 1361, 177 USPQ 563, 567 (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). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260;

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or 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).

A. APPLICANT'S MARK IS SIMILAR TO THE REGISTERED MARKS

Considering first the similarity of the marks at issue, the examining attorney submits that applicant's mark is highly similar to the marks in the cited registrations.

Applicant's mark is EARTH PETS NATURAL PET MARKET in standard characters. Registrant's marks are NATURAL PET MARKET featuring a design element in U.S. Registration No. 3351024, and NATURAL PET MARKET in standard characters in U.S. Registration 3621455.

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); TMEP §1207.01(b).

Applicant's mark merely adds the wording "EARTH PETS" to the wording in the mark in U.S. Registration No. 3351024, NATURAL PET MARKET featuring a design element, and to the mark in U.S. Registration No. 3621455, NATURAL PET MARKET in standard characters. Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Rather, marks have been found confusingly similar where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. In this case the applicant's mark shares the phrase "NATURAL PET MARKET" with registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub*

nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); TMEP §1207.01(b)(ii)-(iii).

Further, the wording EARTH PETS in applicant's mark does not sufficiently differentiate the applied-for mark from the registered marks. Applicant has disclaimed the wording PETS in the applied-for mark. Additionally, applicant's website, www.earthpetsflorida.com, as shown in the evidence section of the examining attorney's final refusal, provides that applicant's retail pet stores source "the very best all **natural** foods." [emphasis added]. This suggests that the wording EARTH in the applied-for mark refers to the goods sold under the applied-for mark being of natural ingredients that come from the Earth, as opposed to man-made or processed ingredients. Therefore, the wording EARTH in the mark does not create a sufficiently distinct commercial impression from the registered marks.

With regard to the design element in U.S. Registration No. 3351024, the design does not alter the commercial impression of the mark. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *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). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

The design element in U.S. Registration No. 3351024 consists of a stylized human bust along with two stylized "pets," all within a simple square with rounded edges. This design is minimal and highly suggestive

of happy pets and a happy pet owner. It does not, accordingly, substantially impact the commercial impression of the mark. Therefore, the wording NATURAL PET MARKET remains the dominant portion of the registered mark.

Additionally, the applied-for mark is in standard characters. A mark in typed or 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 Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g.*, *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909. Therefore, applicant's mark could appear in any lettering style, including a style that is highly similar or even identical to registrant's mark.

Applicant argues that the applied-for mark is not confusingly similar to the registered marks because the registered marks, and the elements of applicant's mark that overlap with those marks, are weak. However, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974) (likelihood of confusion is "to be avoided, as much between 'weak' marks as between 'strong' marks, or as between a 'weak' and 'strong mark'')). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g.*, *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978).

In this case, the wording in the registered marks is entirely incorporated into the applied-for mark and the additional wording of the applied-for mark is not sufficiently distinctive to create a different commercial impression from the registered marks.

Applicant further argues that the wording EARTH creates a different commercial impression from the registered marks. However, marks must be considered in their entireties; therefore, a disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). Therefore, the wording in registrant's marks, and its similarity to the wording in applicant's mark, cannot be discounted in a likelihood of confusion analysis.

As applicant's mark merely adds the wording "EARTH PETS" to the registered marks, the applied-for mark is similar to the registered marks.

B. APPLICANT'S SERVICES ARE HIGHLY RELATED TO SERVICES IN THE REGISTERED MARKS

Applicant's services are "retail pet stores" in International Class 35. The services for the registered marks are "retail store featuring health food for pets" in International Class 35 for the mark in U.S. Registration No. 3351024 and "retail pet stores" in International Class 35 for mark in U.S. Registration No. 3621455.

The 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); TMEP §1207.01(a)(i). The respective 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/or 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)); TMEP §1207.01(a)(i).

Applicant's services consist of retail pet stores and could therefore consist of providing a wide variety of goods for pets. By comparison, registrant's retail stores feature more narrow goods, namely, health food for pets. Applicant's services entirely encompass the services in U.S. Registration No. 3351024.

The identification set forth in the application and registration(s) has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application use(s) broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification.

When analyzing an applicant's and registrant's services for similarity and relatedness, that determination is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

In this case, the identifications set forth in the application and U.S. Registration No. 3621455 are identical and have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. *See Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). Accordingly, the services of applicant and the registrant(s) are considered highly related for purposes of the likelihood of confusion analysis.

Where the services of an applicant and registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion

is not as great as in the case of diverse services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); TMEP §1207.01(b). In the present case, applicant's services are highly related and/or identical to registrant's services, the similarity of applicant's mark to registrant's marks supports a finding of likelihood of confusion

Applicant argues that there is no evidence of actual confusion between the marks. 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).

Therefore, applicant's services are highly related and/or identical to registrant's services.

III. CONCLUSION

As applicant's mark is similar to the registered marks, and as applicant's services are highly related and/or identical to registrant's services, consumers encountering applicant's mark and registrant's marks in the marketplace are likely to mistakenly believe that the services emanate from a common source. For the foregoing reasons, the examining attorney submits that the refusal to register the applied-for mark under Trademark Act Section 2(d) should be affirmed.

Respectfully submitted,

/Drew Sander/
Drew M. Sander
Trademark Examining Attorney
Law Office 110
(571) 270-3361
drew.sander@uspto.gov

Chris A. F. Pedersen
Managing Attorney
Law Office 110