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Subject: U.S. TRADEMARK APPLICATION NO. 86384029 - A MODERN ANCESTRAL DIET - 1073-01 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86384029

MARK: A MODERN ANCESTRAL DIET

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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: Sammy Snacks, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

1073-01

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appealed the examining attorney's refusal to register the trademark A MODERN ANCESTRAL DIET (in standard character form) on the ground that it is confusingly similar to the registered mark THE ANCESTRAL DIET MEETS MODERN NUTRITION (in standard character form) in U.S. Registration No. 3722281, pursuant to Trademark Act §2(d), 15 U.S.C. §1052(d).

FACTS

On September 3, 2014, applicant applied for registration on the Principal Register for the mark A MODERN ANCESTRAL DIET (in standard character form) for "Cat food; Cat treats; Dog food; Dog treats; Pet food; Pet treats" in International Class 31. On December 15, 2014, during prosecution of the application, registration was refused under Trademark Act §2(d), based on a likelihood of confusion with Registration No. 3722281, THE ANCESTRAL DIET MEETS MODERN NUTRITION (in standard character form) for "pet food" in International Class 31, because applicant's mark is likely to cause confusion or to cause mistake or to deceive, when used in connection with the identified goods.[1] On December 26, 2014, applicant responded with arguments against the Section 2(d) refusal. Upon review of the response, the examining attorney was not persuaded and issued a Final refusal under Section 2(d) on January 13, 2015. Applicant filed an appeal brief on May 10, 2015.

ARGUMENT

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 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*

[1] In addition, applicant was required to disclaim the descriptive wording "DIET" and claim ownership of prior Registration Number 4359319. Applicant satisfied both requirements in the Response dated December 26, 2014.

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)). 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; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterra 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*.

A. THE GOODS OF THE RESPECTIVE PARTIES ARE CLOSELY RELATED

The first step in determining whether there is a likelihood of confusion is to compare the goods of the respective parties. In assessing the relatedness of the goods, all circumstances surrounding the sale of the goods is considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. In comparing the goods, it is necessary to show that they are related in some manner. *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)(vi).

With respect to applicant's and registrant's goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

In this present case, applicant's mark is for "Cat food; Cat treats; Dog food; Dog treats; Pet food; Pet treats" and registrant's mark is for "pet food."

Accordingly, the identifications set forth in the application and registration have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

Further, the registration uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in applicant's more narrow identification. *See In re Jump Designs*, *LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

First, it is noted that applicant's "pet food" is identical to registrant's "pet food," and therefore these goods are considered closely related for likelihood of confusion purposes. *See Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012).

Second, the examining attorney refers to the previously attached internet evidence from MacMillan Dictionary, showing that cats and dogs are pets. *See* 12/15/14 Office Action, pp. 5-6.

Accordingly, applicant's "cat food" and "dog food" are encompassed in registrant's "pet food," and therefore considered closely related for likelihood of confusion purposes.

Finally, the examining attorney refers to the previously attached third-party internet evidence from The Honest Kitchen, Halo Pets and Canidae and ten (10) third-party registrations, showing that the same entity commonly provides applicant's "cat treats," "dog treats" and "pet treats" and registrant's "pet food," under the same mark, in the same stream of commerce, to the same class of consumer, in the same field of use. *See* 12/15/14 Office Action, pp. 7-10; 1/13/15 Final Action, pp. 4-30.

Accordingly, upon encountering registrant's mark used for pet food and applicant's mark for pet food, pet treats, cat food, cat treats, dog food and dog treats, consumers are likely to be confused and mistakenly believe that the respective goods emanate from a common source.

In response to the initial Office action and in the Appeal Brief, applicant does not dispute that the goods of applicant and registrant are nearly identical, closely related and commonly provided by a single source, under the single mark, in the same stream of commerce and to the same class of consumers. Instead, applicant argues that the absence of evidence of actual confusion in the market place argues against a likelihood of confusion.

However, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion and it is not necessary to show actual confusion to establish that there is 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).

Accordingly, applicant's and registrant's goods are closely related for likelihood of confusion analysis purposes.

B. THE PROPOSED MARK IS HIGHLY SIMILAR TO THE REGISTERED MARK

The second step in the likelihood of confusion analysis is comparison of the marks. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *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); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

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 terms of their overall commercial

impression that confusion as to the source of the goods offered under the respective 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); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Additionally, where the goods of an applicant and registrant are identical or virtually identical, 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 goods. *See United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (*quoting Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); TMEP §1207.01(b).

In the present case, applicant's mark, A **MODERN ANCESTRAL DIET**, is highly similar to registrant's mark, THE **ANCESTRAL DIET** MEETS **MODERN** NUTRITION, because they both share the same wording, namely, "MODERN" and "ANCESTRAL DIET." (Emphasis added).

Confusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions. TMEP §1207.01(b)(vii); *see, e.g., In re Wine Soc'y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design, for "wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant," likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to members of the registrant); *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER, with

"RUST" disclaimed, for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil).

When the marks at issue comprise “reverse combinations of the same elements, the primary concern is that ordinary prospective purchasers, not being infallible in their ability to recall trade designations, may transpose the elements in their minds and, as a result, mistakenly purchase the wrong products or engage the wrong service.” *In re Best Products Co., Inc.*, 231 USPQ 988, 989 (TTAB 1986). Such transposition may lead to confusion where the marks evoke the same or substantially the same commercial impression. *Id. See also Royal Crown Cola Co. v. Bakers Franchise Corp.*, 150 USPQ 698 (TTAB 1966), aff'd, 404 F.2d 985, 160 USPQ 192 (CCPA 1969) (RITE DIET for low fat milk v. DIET-RITE for low calorie soft drinks; identical commercial impressions suggesting the same characteristic of the related goods).

Applicant's ordering of the wording "MODERN ANCESTRAL DIET" in the reverse order as registrant's "ANCESTRAL DIET MEETS MODERN" does not obviate the overall similarity of the marks because the ordering of the elements does not alter the meaning or significance of the wording in any significant way. Where transposed marks do not convey different commercial impressions, likelihood of confusion is ordinarily found. *See Royal Crown Cola Co. v. Bakers Franchise*, 150 USPQ 698 (TTAB 1966), aff’d, 404 F.2d 985, 160 USPQ 192 (CCPA 1969) (“… the applicant’s compound mark includes the same words which make up opposer’s mark, that is to say ‘RITE DIET’ is merely ‘DIET-RITE’ transposed. The marks of the parties create substantially the same commercial impressions …”); *In re General Tire & Rubber Company*, 213 USPQ 870 (TTAB 1982) (affirming refusal to register SPRINT STEEL RADIAL for pneumatic tires based on registration for RADIAL SPRINT for vehicle tires, finding that the marks “convey the same meaning, that is, a steel radial tire called ‘SPRINT’ or a radial tire called ‘SPRINT’ both of which could emanate from the same source”); *Fisher Scientific Company v. Ipco Hospital Supply Corporation*,

165 USPQ 471, 472 (TTAB 1970) (sustaining opposition to MIX O THERM based on THERMIX used for identical goods, stating “they are in their essentials merely reverse combinations of the same words, and such being the case, would more than likely convey substantially the same commercial impressions”).

Here, the ordering in applicant's and registrant's marks creates a substantially similar commercial impression of pet food that is a combination of modern and ancestral diets. As such, the reversal of the terms fails to obviate the likelihood of confusion.

Moreover, given that three of the four words that comprise applicant's mark are identical to wording in registrant's mark, applicant's deletion of "MEETS" and "NUTRITION" fails to create a distinct commercial impression because additional wording merely aids in creating the shared connotation that the goods are pet food that is a combination of modern and ancestral diets. Accordingly, applicant's deletion of the wording fails to alter the meaning of the mark in any significant way.

Specifically, "MEETS" merely serves to create the commercial impression that registrant is combining MODERN and ANCESTRAL DIETS, which is the same commercial impression created through applicant's use of "MODERN ANCESTRAL DIET." The examining attorney refers to the previously attached internet evidence from Dictionary.Com defining "meets" as conjoin or unite. *See* 1/13/15 Final Action, p. 2. Accordingly, "MEETS," as used in the applied-for mark, merely serves to enhance the commercial impression that the goods unite modern and ancestral diets.

In addition, "NUTRITION" merely refers to the idea that registrant's goods are food. The examining attorney refers to the previously attached internet evidence from Oxford Dictionaries defining "nutrition" as "food". *See* 1/13/15 Final Action, p. 3. Accordingly, NUTRITION, as used in the applied-for mark, does not alter the overall commercial impression of registrant's mark in any significant way because it serves to identify that the goods are food.

In its Brief, applicant argues that the marks are not similar because "THE", "MEETS" and "NUTRITION" are deleted from registrant's mark and the wording "MODERN" and "ANCESTRAL DIET" are reversed. Applicant argues that these changes alter the sound, appearance and meaning of the marks, creating a distinct commercial impression.

However, as discussed above, applicant's deletion of MEETS and NUTRITION from registrant's mark fails to create a distinct commercial impression because the wording merely serves to enhance the shared commercial impression, connotation and meaning, namely, that applicant's and registrant's marks are for food that combines modern and ancestral diets. Any difference in the appearance or sound of the marks is insufficient to obviate the overall likelihood of confusion between the marks, given that three of the four words in applicant's mark are shared with registrant and the nearly identical nature of applicant's and registrant's goods.

Applicant compares the present case to *In re Hearst Corp.* 982 F.2d 493 (1992) for the proposition that the deletion of "NUTRITION" and "MEETS" and the reverse ordering of the wording creates a distinct commercial impression, similar to applicant's addition of "GIRL" to registrant's mark "VARGAS." However, as the *In re Hearst Corp*. court noted, the determination of whether marks are confusingly similar relies heavily on the facts presented in each case. *In re Hearst Corp.* 982 F.2d 493, 494 (highlighting the "fact-dependency of such determinations" in footnote 2). Here, applicant does did not provide any evidence beyond mere conclusory statements that the deletion of the wording and reversal of the terms is sufficient for obviating a likelihood of confusion. Moreover, as discussed above, the evidence on record shows that the deletion of the wording from registrant's mark and reversal of the order of the shared wording "MODERN" and "ANCESTRAL DIET," fails to create a distinct commercial impression because the meaning and connotation of the marks is nearly identical such that the ordinary

prospective purchasers may transpose the elements in their minds and, as a result, mistakenly believe that applicant's goods and registrant's goods emanate from a common source.

Finally, applicant argues that the wording is diluted due to the existence of two (2) marks for similar goods, namely, ANCESTRAL MODEL DIET and ANCESTRY.

First, it is noted that to make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006); *In re Ruffin Gaming*, 66 USPQ2d, 1924, 1925 n.3 (TTAB 2002); TBMP §1208.02; TMEP §710.03. Applicant failed to make the referenced registrations part of the record, and accordingly, this argument is of little probative value.

Second, even if taken into consideration, the mark ANCESTRAL MODEL DIET (former Reg. No. 3524525) is dead and does not include the word "MODERN" which is highly significant in this instant case. Here, applicant's and registrant's marks include the identical wording "MODERN" and "ANCESTRAL DIET" which combine to create the commercial impression of food that combines both modern and ancestral-style diets. The referenced registration does not create the same commercial impression.

Third, the existence of applicant's registration for ANCESTRY (Reg. No. 4359319) is insufficient for showing that the wording "MODERN ANCESTRAL DIET" is diluted. 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/or 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 one registration is generally entitled to little weight in determining the strength of a mark, because the registration does not establish that the registered mark

identified is in *actual use* in the marketplace or that consumers are accustomed to seeing it. *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). Furthermore, the registered mark does not create the same commercial impression as applicant's and registrant's marks because it does not include the word MODERN and because the word ANCESTRY makes a different commercial impression and has a different meaning than the word ANCESTRAL.

Finally, it is noted that the overriding concern is not only to prevent buyer confusion as to the source of the goods, 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).

Accordingly, given shared wording, MODERN and ANCESTRAL DIET, the marks at issue create a highly similar commercial impression, sufficient for finding a likelihood of confusion.

C. FAME OF REGISTRANT'S MARK IS A NEUTRAL ELEMENT

In its Brief, applicant argues that there is no evidence that registrant's mark is famous, arguing against finding a likelihood of confusion. However, because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the examining attorney to

submit evidence as to the fame of the cited mark in an ex parte proceeding. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). And, in an ex parte analysis of the du Pont factors for determining likelihood of confusion, the "fame of the mark" factor is normally treated as neutral when no evidence as to fame has been provided. *See id*.; *see also In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (noting that the absence of evidence as to the fame of the registered mark "is not particularly significant in the context of an ex parte proceeding").

Accordingly, applicant's argument regarding length of time that the cited mark has been registered is of little probative value in the likelihood of confusion analysis. The length of time of registration does not account for applicant's use prior to registration, since May 30, 2007, the extent of registrant's advertising, marketing and sales, or any other data relevant to the issue of whether registrant's mark is famous. As such, this element of the analysis remains neutral.

CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C (SECTION) 2(d), be affirmed.

Respectfully submitted,

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