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

Proceeding	86896129
Applicant	Simply Gum, Inc.
Applied for Mark	SIMPLY MINTS
Correspondence Address	BLAKE PERKINS BLAKE PERKINS, COUNSEL 26 BROADWAY, 17TH FLOOR NEW YORK, NY 10004 UNITED STATES perkins@blake-perkins.com
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Filer's Name	BLAKE PERKINS
Filer's e-mail	perkins@blake-perkins.com
Signature	/Blake Perkins/
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Ex Parte Appeal

Applicant's Brief

Mark at issue:
SIMPLY MINTS

In re the application of:
Simply Mints., Inc.

Application Serial Number:
86896129

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Examining Attorney:
Cassandra Anderson, Esq.
Law Office 103

Citations.

Cases:

In re August Stock KG, 218 USPQ 823 (TTAB 1983).....4

In re British Bulldog, 224 USPQ 854 (TTAB 1984).....4

In re Hi-Country Foods Corp. v High-Country Beef Jerky, 4 USPQ2d 1169 (TTAB 1987).....1, 3, 4, 5

In re Mars, Inc., 741 F.2d 395 (Fed. Cir. 1984).....1, 3

In re Mucky Duck Mustard Co., 6 USPQ2d 1467 (TTAB 1988), *aff'd per curiam*, 864 F.2d 149 (Fed. Cir. 1988).....3

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Swiss Grill v Wolf Steel, 115 USPQ2d 2001 (TTAB 2015).....3

Wilson v Delaney, 245 F.2d 887 (C.C.P.A. 1957).....3

Published sources:

The American Heritage Dictionary (5th ed. 2011).....2

The Collins English Dictionary (12th ed. 2014).....2

The Oxford English Dictionary (1991); www.oxforddictionaries.com (accessed 6 July 2016).....2

Webster's College Dictionary (2010).....2

Factual background.

On 23 July 2016 the Examining Attorney issued a final action denying the SIMPLY MINTS application covering hard mint candies based on a likelihood of confusion between the mark and the SIMPLY MINT mark (U.S. Registration Number 2458268) covering teas and related beverages.

Argument.

1. The goods at issue are unrelated.

The facts in each case vary and there can be no rule that certain goods or services are *per se* related such that there must be a likelihood of confusion from the use of similar marks in relation to them. *Hi-Country Foods Corporation v High Country Beef Jerky*, 4 USPQ2d 1169, 1171-72 (TTAB 1987)

The facts of this case bear a striking resemblance to the facts of two leading cases on point. *In re Mars*, 741 F.2 395 (Fed. Cir. 1984) involved the two marks CANYON, and the Court “treat[ed] the two marks as legally identical word-marks.” The pre-existing mark covered candy; the Applicant’s covered “fresh citrus fruits.” The Federal Circuit reversed the refusal of the TTAB to register the subsequent mark, rejecting its opinion that “candy bars and fresh citrus fruits bear...a close relationship.” 741 F.2d 395

In *Hi-Country Foods*, the TTAB rejected the opposition to the application at issue. There, citing *Mars*, the TTAB allowed registration of a mark, HI-COUNTRY, covering “meat snack foods” that was identical to opposer’s mark covering “various fruit juices.” The Board allowed the application even though it found that

“there is no question that the commercial impression generated by the mark as a whole is that of the term HI-COUNTRY. That is, the spoken component of the mark is the way consumers would call for the goods.... This commercial impression is identical to that created by opposer’s HI-COUNTRY mark.” 4 USPQ2d 1169

The TTAB also found “the respective marks to be virtually identical.” The Board, however, “believe[d] that prepared beef snack foods and fruit juices, while both edible food products, are completely different in character” and found “the products involved to be sufficiently disparate food products such that no confusion is likely....” 4 USPQ2d 1171-72

In this case, the facts are indistinguishable from *Mars* and *Hi-Country*. The goods at issue, tea and tea-related beverages on the one hand and hard candy on the other, “are completely different in character.” The goods in this case are at least as disparate as the candy and fruit involved in *Mars*, or the snack food and juice involved in *Hi-Country*.

In addition, unlike the explicit findings in either *Mars* or *Hi-Country*, the commercial impressions generated by the marks at issue are different.

2. The marks at issue convey significantly different commercial impressions.

It is, as noted at the outset of section 1 of this memorandum, a basic tenet of trademark law that each application must be considered on its particular facts, essentially on an *ad hoc* basis. It also is an assumption in the trademark field that adding an ‘s’ to a mark ordinarily renders the singular form of the term plural. In that case the singular and plural marks are considered essentially the same. Due to the words involved in the marks at issue, however, this is not an ordinary case.

The addition of the ‘s’ to Applicants mark does not merely render the term ‘mints’ plural: It redefines it to create a commercial impression distinct from SIMPLY MINT.

Every dictionary draws a distinction between two different definitions of the word ‘mint.’ The *Oxford English Dictionary*, for example, explains:

“There are two main definitions of *mint* in English.”

One of them refers to an “aromatic plant native to temperate regions of the Old World, several of which are used as culinary herbs.”

The other refers to a “peppermint candy.”

Webster’s College Dictionary (2010) distinguishes the adjective mint, meaning “flavored with mint; *mint* tea” from the noun meaning “a mint-flavored candy.”

The American Heritage Dictionary (5th ed. 2011) distinguishes a “candy flavored with natural or artificial mint flavoring” from any of “various similar or related plants or their leaves “cultivated for their aromatic oil and foliage” or “used as a seasoning.”

The *Collins English Dictionary* (12th ed. 2014) distinguishes “(Plants) any N temperate plant of the genus *Mentha*....” from “(Cookery) a sweet flavored with mint.”

The SIMPLY MINT mark covers tea and tea flavored beverages that may include mint as an ingredient. In other words that mark refers to the plant or flavoring ingredient. It refers to a constituent or additive of the good, not to the good itself.

Applicant's mark, however, does refer to the good itself. Its mark refers to "hard mint candies," to the distinct alternative definition.

The distinction is significant. In common usage, a person will say 'I am going to buy some mints' when intending to buy candy, but nobody would say that in reference to tea or a drink more generally. The SIMPLY MINT mark also may be distinguished from Applicant's mark because it uses the adjective form of the term. The commercial impression of SIMPLY MINT is to describe a flavoring, not the product itself; a good may be 'Simply Mint Tea' or a 'Simply Mint tea-based beverage containing fruit' but no good covered by the mark would ever be considered by a consumer something called a 'Simply Mint' alone.

The addition of the 's' to Applicant's mark prevents any likelihood of confusion because in the specific circumstances of this case it transforms the meaning of the word 'mints' to convey a significantly different commercial impression from the SIMPLY MINT mark

Even if the addition of the 's' to applicant's mark did not render its commercial impression distinct from SIMPLY MINT, the cases cited on this issue in the Office Action are inapplicable. They each involve identical goods. *Wilson v Delaney*, 245 F.2d 877 (C.C.P.A. 1957) involved confections; *Swiss Grill v Wolf Steel*, 115 USPQ2d 2001 (TTAB 2015) involved grills; and *Weider Publ'ns v D & D Beauty*, 108 USPQ2d 1347 (TTAB 2014) involved the concept of fame. In *Mars*, the Federal Circuit explicitly distinguished cases involving identical goods from those, like *Mars* itself, *Hi-Country* and this one, which involve different goods.

Even if the marks in this case did convey identical impressions, the goods are not identical so confusion about their source is not likely.

3. The marks at issue would not be expected to originate from the same entity.

Third party trademark registrations "*may have some probative value to the extent that they may serve to suggest that goods... may emanate from a single source.*" As the qualified language indicates, third party registrations are not dispositive. They do not, standing alone, render goods related and may only be considered "along with other types of evidence to establish that the type of goods at issue are related." TMEP 1207.01(d)(iii) (emphasis added), *citing In re Mucky Duck Mustard Co.*, USPQ2d 1467, 1470 n. 6, *aff'd per curiam*, 864 F.2d 149 (Fed. Cir. 1988) In this case no other evidence establishes that the goods are related.

As demonstrated by the rulings in *Mars* and *Hi-Country*, the other caselaw cited in this memorandum and the other applicable evidence, including the distinct commercial impressions created by the different marks, the goods at issue are unrelated and the third party registrations attached to the Office Action are not probative. In any event none of the third party registrations covers mints, the only good at issue.

As the TTAB stated in *Hi-Country*, “there can be no ‘per se’ rule that all food products are related goods by nature.” There, the TTAB added that both of the “edible food products” at issue “would not normally be sold in the same sections of food stores or convenience stores and would not be expected to originate from the same entity, even when sold under virtually identical trademarks.” 4 USPQ2d 1171-72

The facts do not differ in this case. Beverages like the ones covered by the SIMPLY MINT mark and the hard candy covered by Applicant’s mark, which unlike the marks in *Hi-Country Foods* are not identical, are not normally sold in the same sections of stores or online retailers and would not be expected to originate from the same entity any more than the beverages and snacks involved in *Hi-Country Foods*. The mere fact that some entities may produce unrelated products under the same mark does not render the products in this case related.

Other cases sharing the same fact pattern as this one have reached the same conclusion, and the fact that both marks apply to goods in the same International Class has not been an impediment to registration of the subsequent mark, especially where, as in this case, the marks create different commercial impressions. *In re Sears, Roebuck*, 2 USPQ2d 1312, 1314 (TTAB 1987) (CROSS-OVER for bras not likely to cause confusion with CROSSOVER for women’s sportswear); *In re British Bulldog*, 224 USPQ 854, 856 (TTAB 1984) (PLAYERS for underwear not likely to cause confusion with PLAYERS for shoes); *In re Seydel Lingerie*, 197 USPQ 629, 630 (TTAB 1977) (BOTTOMS UP for underwear not likely to cause confusion with BOTTOMS UP for men’s clothing).

4. Sale of Applicant’s goods in the same channels of trade as SIMPLY MINT goods would not render them related to create a likelihood of confusion.

The mere fact that two different goods are provided through the same trade channels to the same class of purchasers does not prove the goods are related. *7-Eleven v Wechsler*, Opposition No. 91117739 (TTAB 2007)

That is especially the case were the goods at issue are different foods. *In re August Stock KG*, 218 USPQ 823 (TTAB 1983) (Reiterating the “well-established and frequently articulated doctrine... that there exists no *per se* rule that all food products are deemed to be related goods by nature or by virtue of their capability of being sold in the same food markets.”)

In *Hi-Country*, the TTAB rejected the argument that sale of the goods at issue in common trade channels created a likelihood of confusion about their origin “There is no question,” the Board explained,

“but that applicant’s beef snacks and opposer’s fruit juice could very well be found in grocery stores, convenience stores, supermarkets and the like. However,

notwithstanding these common trade channels... there can be no *per se* rule that all food products are related goods... by virtue of their capability of being sold in the same food markets, (i.e. the modern supermarket environment with its enormous variety of food, cleaning, paper and other products offered for sale).” 4 USPQ2d 1171-72

The same reasoning is even more applicable to internet providers, who offer for sale an even vaster variety of goods than the supermarkets of 1987, when the decision in *Hi-Country* appeared.

In this case as in *Hi-Country*, the possibility that Applicant’s candy may share trade channels with SIMPLY MINT tea or beverages does not render the goods in question related and would not create any likelihood of confusion about their origin.

Conclusion.

For the reasons set forth in this memorandum the SIMPLY MINTS trademark application should be granted.

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/Blake Perkins/
Blake Perkins
26 Broadway, 17th floor
New York
New York 10004
perkins@blake-perkins.com
tel. 212.797.1007