

Precedent of the TTAB

Mailed: February 1, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Charlie's Chalk Dust, LLC

Serial No. 88417905

S. Roxanne Edwards, of Bell Nunnally & Martin LLP for Charlie's Chalk Dust, LLC.

Angela M. Micheli, Trademark Examining Attorney, Law Office 101,
Zachary R. Sparer, Managing Attorney.

Before Shaw, Heasley, and Dunn,
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Charlie's Chalk Dust, LLC (Applicant) seeks registration on the Principal Register of the standard character mark PACHAMAMA for

Essential oils; non-medicated topical skin care preparations; CBD vape oil, namely, electronic cigarette liquid (e-liquid) comprised of essential oils; all of the foregoing containing naturally occurring trace amounts of CBD derived from hemp and less than .3% THC, in International Class 3;

Herbal tinctures; medicated topical skin care preparations; all of the foregoing containing naturally occurring trace amounts of CBD derived from hemp and less than .3% THC, in International Class 5.¹

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the goods identified in the application, so resembles the marks PACHAMAMA BOTANICA (BOTANICA disclaimed) for "Flower essences for cosmetic purposes; Hair shampoo; Natural soap bars; Non-medicated herbal body care products, namely, body oils, salves, and lip balms; Sun care lotions," in International Class 3, and PACHAMAMA PEOPLE for "Dietary and nutritional supplements made of herbs; Herbal tinctures for use as nutritional supplements; Herbal tinctures for use in healing" in International Class 5, both on the Principal Register,² as to be likely to cause confusion, to cause mistake, or to deceive. Both cited registrations state that the English translation of "PACHAMAMA" is "MOTHER EARTH."

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed.

¹ Application Serial No. 88417905, filed on May 6, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce. The application also includes goods in International Class 34, which are not the subject of the refusal of registration. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §1403.05 (2021) ("A refusal to register or a requirement may be made for less than all the classes in an application.").

References to the application are to the downloadable .pdf version of documents available from the TSDR (Trademark Status and Document Retrieval) database. The TTABVUE citations refer to the Board's electronic docket, with the first number referring to the docket entry and the second number, if applicable, referring to the page within the entry.

² Registration No. 4878204 issued December 29, 2015, and Registration No. 5498789 issued June 19, 2018, to different owners.

Upon review, the Board remanded the application for consideration of a refusal that Applicant lacked a bona fide intent to use the mark in lawful commerce as to specific goods in International Class 5 and 30 that are subject to the Federal Food, Drug, and Cosmetic Act (“FDCA”) and will contain cannabidiol (CBD) in violation of the statute. On remand, the application was amended so that goods in International Class 5 are deleted in part and International Class 30 is deleted in its entirety. The remaining goods are not subject to the FDCA. The appeal again was resumed.

We affirm the refusal to register.

I. Likelihood of Confusion Analysis

Section 2(d) of the Trademark Act prohibits registration of a mark that “so resembles a mark registered in the Patent and Trademark Office” as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each relevant *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and

differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1628 (TTAB 2018).

Because we find that there is a likelihood of confusion between Applicant’s mark PACHAMAMA and the cited mark PACHAMAMA PEOPLE, we need not reach the issue of whether Applicant’s mark also conflicts with the other cited registration.

A. Similarity or Dissimilarity of the Marks

We compare Applicant’s mark PACHAMAMA and the cited mark PACHAMAMA PEOPLE, both in standard characters, in their entireties as to appearance, sound, connotation, and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1689 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x (Fed. Cir. 2019). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d at 1630.

The term PACHAMAMA is the whole of Applicant’s mark, and the first and most dominant portion of the registered mark PACHAMAMA PEOPLE. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (“The identity of the marks’ initial two words is particularly significant because consumers typically notice those words first.”); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895,

1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). The cited registration states that the English meaning of PACHAMAMA is “MOTHER EARTH.” The record contains a third party website explaining the term’s origin:³

Pachamama is a goddess revered by the indigenous people of the Andes. She is also known as the earth mother. In Inca mythology, Mama Pacho or Pachamama is a fertility goddess who presides over planting and harvesting.

We find that PACHAMAMA is inherently distinctive, and has the same connotation of natural ingredients in both marks when applied to the goods of the two parties, which rely on herbal ingredients. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant feature in determining the commercial impression created by the mark as long as the mark is considered in its entirety.”).

In the registered mark PACHAMAMA PEOPLE, the term PEOPLE serves merely to reinforce the dominant term PACHAMAMA. That is, the term PACHAMAMA PEOPLE suggests to the prospective consumer that Registrant is the source of PACHAMAMA products. *See The Scholl Mfg. Co., Inc. v. Lowell Shoe, Inc.*, 180 USPQ 95, 96 (TTAB 1973) (“Also, it seems apparent that members of the shoe-buying public who are aware of opposer’s ‘FOOT COMFORT’ products ... will be more than likely, upon encountering ‘THE COMFORT PEOPLE’ on nurses or professional shoes, to assume that such shoes either originate from or are sponsored by or are in some way

³ September 8, 2020 Office Action TSDR 50.

associated with opposer.”); *Sprague Elec. Co. v. Elec. Utilities Co.*, 209 USPQ 88, 96 (TTAB 1980) (“[Registrant], by its use of ‘THE CAPACITOR PEOPLE,’ is merely puffing its position in the capacitor field”). In short, the marks PACHAMAMA and PACHAMAMA PEOPLE share the identical first (or only) word, and so appearance, sound, and connotation are in part identical, and the addition of the term PEOPLE in the registered mark does not alter the marks’ identical commercial impression.

We disagree with Applicant’s argument that the involved marks “exist in a crowded field of identical, nearly identical, and closely similar marks,” that the term PACHAMAMA (or the variant PACHA MAMA) is “weak and should be afforded very narrow protection for the relevant goods” and “consumers will rely on [] PEOPLE to distinguish the source of the parties’ goods.”⁴ The record shows third party registrations that feature a different mark, or different goods, or which are not in United States commerce at all. Applicant submitted third party registrations (Nos. 5886658, 5714296, 5537009, 5338775, 3435946) for the marks PACHA SOAP CO., PACHA PACHA’S, and PACHA and design.⁵ There is no evidence that the term PACHA is recognized as a shortened version of the term PACHAMAMA, and we do not find that these registered marks are “closely similar” to the term PACHAMAMA. *See Inn at St. John’s*, 126 USPQ2d at 1745-46 (discounting probative value of third-party registrations “contain[ing] the non-identical term ‘Fifth’” in showing that the cited registered mark 5IVESTEAK was weak).

⁴ 13 TTABVUE 3.

⁵ September 8, 2020 Response to Office Action TSDR 23-35; April 14, 2021 Request for Reconsideration TSDR 12.

The record includes two registrations which are not in use in the relevant field of herbal tinctures and supplements. The use-based registration for the mark PACHA MAMA and design is for “panela sugar” (Registration No. 5003398).⁶ *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration). The registration for the mark PACHAMAMAI (Registration No. 5705931) is based on a foreign registration instead of use in commerce, and so is entitled to no weight on the issue of what U.S. consumers encounter in the market.⁷ *Cf. Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1221 (TTAB 2011) (absent Section 8 filing, registrations based on international registrations are not evidence “that any of the marks have been used in the United States for goods and services that are the same as those of the parties herein.”); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (“Because these registrations [based on Section 44 or Section 66 of the Trademark Act] are not based on use in commerce they have no probative value in showing the relatedness of the services, and they have not been considered.”).

The evidence of third party use also fails to persuade us that the term PACHAMAMA should receive only a narrow scope of protection.⁸ Applicant

⁶ September 8, 2020 Response to Office Action TSDR 37.

⁷ April 14, 2021 Request for Reconsideration TSDR 8-11.

⁸ Again, we do not regard the evidence of third party use of the term PACHA as relevant to the determination of how the relevant public perceives the different term PACHAMAMA.

submitted webpage excerpts from two Etsy stores, one named PACHA MAMA BODY CARE for skin care preparations⁹ and the other named PACHAMAMA for an essential oil spray;¹⁰ an online store named PACHAMAMA selling, among other things, “Pachamama white sage elixir spray” made with essential oils;¹¹ an online store named MEDICINA PACHAMAMA selling “make your own tincture” custom formulas;¹² an online store called MAMA PACHA HERBAL selling skincare products;¹³ an online PACHAMAMA MARKET selling, among other things, skincare products;¹⁴ and a PACHA MAMA froth bomb listed on the Poshmark ecommerce site.¹⁵ The third-party evidence here is far less in quantity and quality than that in *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015), which included at least 26 uses or registrations of the same phrase for restaurant services. *See also In re i.am.symbolic, LLC*, 127 USPQ2d at 1636 (“These five uses of WILLPOWER, while somewhat probative, are insufficient to “show that customers ... have been educated to distinguish between different ... marks on the basis of minute distinctions.”) (citation omitted).

⁹ September 8, 2020 Response to Office Action TSDR 39-40.

¹⁰ *Id.* TSDR 75.

¹¹ *Id.* TSDR 42-47.

¹² *Id.* TSDR 49-57.

¹³ *Id.* TSDR 59-64.

¹⁴ *Id.* TSDR 66-73.

¹⁵ *Id.* TSDR 77.

While we agree with Applicant's point¹⁶ that there is no strict numerical requirement for third party uses to find that a term has become weak, that does not change our view of the record here. Applicant introduced just enough information about the seven third party websites to show that the marks and goods or retail services are similar to those at issue here. The record does not include any information which would indicate the quantity of traffic to the websites, or any other indicia that the websites are not obscure or unfrequented, and so show that the website resulted in the public encountering the PACHAMAMA mark in connection with the relevant goods. *Compare L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1437 (TTAB 2012) (Contributing to the mark's fame, "Opposer has sold these products at drug stores, supermarkets and mass merchandisers throughout the United States, including Walmart, Target, Kmart, Rite-Aid, Walgreens, CVS and Kroger, and through online retail websites such as www.drugstore.com").

The paucity of third party uses and the imprecision surrounding those uses lead us to conclude that Applicant has not shown the term PACHAMAMA is weak as applied to registered herbal supplements and tinctures, and so entitled to a lesser scope of protection as the dominant feature in the registered mark PACHAMAMA PEOPLE. Even assuming, *arguendo*, that PACHAMAMA is weak, Applicant does not explain how its mark can be distinguished from the cited mark—based on "minute distinctions"—when Applicant's entire mark consists solely of the common word, PACHAMAMA. We accord the registered mark "the normal scope of protection to

¹⁶ 13 TTABVUE 2-3.

which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

Considering the marks PACHAMAMA and PACHAMAMA PEOPLE in their entirety, we find that the similarity created by the inclusion of the dominant, shared term PACHAMAMA is not outweighed by the addition of the term PEOPLE in the registered mark. The first *DuPont* factor, similarity of the marks, weighs heavily in favor of finding likelihood of confusion.

B. Relationship between the Goods and Channels of Trade and Classes of Purchasers

With regard to the relationship between the goods, their channels of trade and classes of purchasers, we must make our determination under these factors based on the goods as they are identified in the application and cited registration. *See In re i.am.symbolic*, 123 USPQ2d at 1749. In assessing the similarity or dissimilarity and nature of the goods, the Board “considers whether ‘the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the[ir] source or origin’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)).

As to Applicant’s International Class 5 goods, we find that its “herbal tinctures ... containing naturally occurring trace amounts of CBD derived from hemp and less than .3% THC,” are legally identical to the registered “herbal tinctures for use as nutritional supplements; herbal tinctures for use in healing.” That is, Registrant’s herbal tinctures are not restricted as to ingredients, and so are presumed also to

include herbal tinctures containing CBD, and Applicant's herbal tinctures are not restricted to any particular use, and so are presumed also to be used as nutritional supplements and for healing. *See In re St. Julian Wine Co., Inc.*, 2020 USPQ2d 10595, *4 (TTAB 2020) ("Because the identification of Applicant's [hard cider] is unrestricted, we must assume that 'hard cider' encompasses hard cider of all types, including hard cider made from apples grown in Michigan or hard cider originating from Michigan."); *In re Uncle Sam Chem. Co.*, 229 USPQ 233, 234 (TTAB 1986) ("[W]hile applicant has restricted the scope of its cleaning preparations and degreasers to industrial and institutional use, the Examining Attorney has correctly pointed out that in the absence of a restriction in the identification of goods in the cited registration, applicant's assumptions about the nature of registrant's goods are entitled to no weight.").

The identity of certain goods within the identifications means that no more is necessary to demonstrate a finding of similarity of goods to support a likelihood of confusion. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Where, as here, in goods in the application at issue and the cited registration are in part identical, we must presume that the channels of trade and classes of

purchasers for these goods are the same. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Information Builders Inc.*, 2020 USPQ2d 10444, *3 (TTAB 2020).

As to Applicant's International Class 3 goods, we find Applicant's "essential oils; non-medicated topical skin care preparations ... containing naturally occurring trace amounts of CBD derived from hemp and less than .3% THC," are both closely related and complementary to the registered "dietary and nutritional supplements made of herbs; herbal tinctures for use as nutritional supplements; herbal tinctures for use in healing." Hemp is defined as an herb, and a tincture can be applied topically as well as consumed,¹⁷ and so the application and registration themselves show a relationship between the goods. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) ("While additional evidence, such as whether a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis, the Board did not consider the important evidence already before it, namely the ITU application and HP's registrations."). The goods are related because of their common herbal ingredients. *See Merritt Foods v. Assoc. Citrus*

¹⁷ We take judicial notice of the following definitions:

Hemp: a tall widely cultivated Asian herb (*Cannabis sativa* of the family Cannabaceae, the hemp family) that is cultivated for its tough bast fiber and edible seeds and oil and that is often separated into a tall loosely branched species (*C. sativa*) and a low-growing densely branched species (*C. indica*)

Herbal: of, relating to, utilizing, or made of herbs

Tincture: a solution of a medicinal substance in an alcoholic solvent.

Merriam-Webster.com Dictionary, Merriam-Webster, <https://www.merriam-webster.com/dictionary/>. Accessed 31 Jan. 2022. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

Packers, Inc., 222 USPQ 255, 257 (TTAB 1984) (fresh citrus fruits and frozen confections related because purchaser may assume “that a citrus fruit producer would market fruit juices or fruit-ades on the one hand and fruit juice-based or fruit flavored frozen confections on the other.”).

“Complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.” *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). *Accord Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990) (modems and computer programs are commonly used together in networking). “Merely because goods can be used together is not a sufficient basis on which to find them to be complementary. Rather, there must be some showing that customers would seek out both types of goods for the same purpose, for example, making an outfit by matching shoes and clothing, or making a sandwich by combining bread and cheese, to show that the goods are complementary.” *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1232 (TTAB 2015). Essential oils, skincare preparations, dietary supplements, and tinctures all may be used to increase health and wellness, whether by encouraging relaxation in general or treating skin conditions in particular. In addition, essential oils, skincare preparations, dietary supplements, and tinctures may be used in combination in furtherance of a common goal, such as adding essential oils to tea and taking a nutritional supplement to aid digestion, or applying a skin care preparation and topical herbal tincture to address a skin condition.

With respect to channels of trade and prospective purchasers, we find that the common herbal ingredients would cause Applicant's and Registrant's herbal goods to be found in overlapping channels, such as health stores and to appeal to purchasers seeking herbal remedies. We note that the record includes webpages from the retailer The Vitamin Shoppe, which offers goods in the categories of "Vitamins and Supplements," "Herbs and Natural Remedies," and "Natural Beauty & Skin."¹⁸

We find the *DuPont* factors regarding the goods, channels of trade and classes of purchasers weigh in favor of finding a likelihood of confusion.

C. Balancing the Factors

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. When we balance the *DuPont* factors, we conclude that the marks PACHAMAMA and PACHAMAMA PEOPLE share the identical dominant term, create highly similar commercial impressions, and are applied to in-part identical, and otherwise closely related and complementary herbal goods, so that Applicant's mark is likely to create confusion with the registered mark. 15 U.S.C. § 1052(d).

II. Decision

The refusal to register Applicant's mark PACHAMAMA in International Classes 3 and 5 is affirmed. The application will go forward as to remaining International Class 34.

¹⁸ May 12, 2021 Office Action TSDR 30-82.